

ADMINISTRATIVE PANEL DECISION

Osborne Clarke LLP v. Michelle Stafford, osbornesclarke.net
Case No. D2025-0323

1. The Parties

The Complainant is Osborne Clarke LLP, United Kingdom ("UK"), represented internally.

The Respondent is Michelle Stafford, osbornesclarke.net, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <osbornesclarke.net> (the "Disputed Domain Name") is registered with Squarespace Domains II LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 28, 2025. On January 28, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 28, 2025, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Unknown / Redacted for Privacy, osbornesclarke.net) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 29, 2025, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 29, 2025.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 31, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 21, 2025.

The Center appointed Michael D. Cover as the sole panelist in this matter on February 25, 2025. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a limited liability partnership registered on January 12, 2015, which carries on business in the UK in relation to legal services. The Complainant has a history dating back to 1748. Prior to the Complainant's registration as an LLP in 2015, the OSBORNE CLARKE name was used by the Complainant's predecessors in title for over 35 years in the UK in relation to legal services.

The Complainant is the proprietor of registered trademark and service mark for OSBORNE CLARKE, as follows:

UK registered trademark No. UK 00002129400 OSBORNE CLARKE in Classes 35, 36 and 42 registered on September 26, 1997 for "Business management and organization consulting" (Class 35); "Debt collection agency; financial management; fund investment" (Class 36) and "Legal services" (Class 42).

The Complainant now offers legal services through offices in London, Bristol and Reading, employs over 1,000 people and regularly features in the top 25 UK law firms by revenue. All of the Complainant's services are sold under the OSBORNE CLARKE name. In addition, the Complainant is a member of Osborne Clarke International, a Swiss Verein, which includes other legal firms across Europe and Asia that trade under the OSBORNE CLARKE name.

The Complainant's website uses the domain name <osborneclarke.com>, which features the Complainant's OSBORNE CLARKE trademark.

The Disputed Domain Name was registered on October 21, 2024.

The Respondent has been using an email address that uses the Disputed Domain Name to contact members of the public, claiming to be a "Lawyer/Debt Collection Litigation Counsel" from the Complainant and demanding payment of an allegedly unpaid bill. The email signature on such emails includes the address of the Complainant's London office. The Disputed Domain Name does not resolve to any active website.

The Complainant had taken various steps to communicate with the Respondent about this conduct, including alerting the Complainant's regulator, the Solicitors Regulation Authority, which issued a fraud warning (Annex 6 to the Complaint), added a fraud warning to the Complainant's website at <osborneclarke.com> (Annex 7 to the Complaint) and sent a cease and desist letter to the Respondent on January 28, 2025 (Annex 8 to the Complaint), to which no response was received.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Identical or Confusingly Similar

The Complainant submits that the Disputed Domain Name is self-evidently almost identical to its OSBORNE CLARKE trademark, the only difference being the removal of the space between "Osborne" and "Clarke" and

the addition of the letter “s”. The Complainant contends that, visually and aurally, these changes will go unnoticed and, conceptually, the Disputed Domain Name is the same as the OSBORNE CLARKE trademark. The Complainant also states that the specific Top-Level Domain (“TLD”) of the Disputed Domain Name “.net” is irrelevant for the purposes of determining whether the Disputed Domain Name is identical or confusingly similar and cites in support *Rollerblade, Inc v. Chris McCrady*, WIPO Case [D2000-0429](#).

Noting the use that has been made of the Disputed Domain Name, the Complainant submits that, by holding themselves out as “Lawyer/ Debt Collection Litigation Counsel” and threatening litigation in the email, it is clear that the Respondent is purporting to offer legal services using the Disputed Domain Name, which are services identical to those covered by the OSBORNE CLARKE trademark. The Complainant notes that the Complainant has not consented to this.

The Complainant also submits the Respondent’s use of the Disputed Domain Name amounts to use of a highly similar sign for identical and/or similar services covered by the OSBORNE CLARKE trademark and that this is likely to lead customers to believe that the Respondent’s services are those of the Complainant or are authorized or endorsed by the Complainant or otherwise linked to the Complainant, when this is not the case.

The Complainant contends, as a result, that the Disputed Domain Name is confusingly similar to the OSBORNE CLARKE trademark, in which the Complainant has rights.

Rights or Legitimate Interests

The Complainant notes that paragraph 4(c)(i) of the Policy provides that a use is legitimate if, prior to commencement of the dispute, a respondent used the domain name or a name corresponding to the domain name in connection with the bona fide offering of goods or services. The Complainant submits that there is no evidence that the Respondent is using the Disputed Domain Name to offer bona fide goods or services and notes that, as shown in Annex 5 to the Complaint, the web page to which the Disputed Domain Name resolves appears to be inactive.

The Complainant continues that, as already described, it is apparent that the Respondent has used the Disputed Domain Name and its associated email address for the purposes of email-based fraud. The Complainant also notes that, as described the Respondent has been contacting businesses in the UK, claiming to work for the Complainant and demanding the payment of monies under the threat of litigation. The Complainant submits that this conduct reveals that the Respondent has no legitimate interests in respect of the Disputed Domain Name and is instead using the Disputed Domain Name as instrument of fraud by holding itself out as a representative of the Complainant.

The Complainant notes that previous panels have decided that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent and submits that, as the proprietor of the OSBORNE CLARKE trademark, only the Complainant would have a legitimate reason for using the Disputed Domain Name to offer legal services or to generate email addresses by which legal services are offered.

The Complainant concludes that it is clear that the Respondent’s conduct does not meet the criteria for bona fide use and that the Respondent has no rights or legitimate interests in using the Disputed Domain Name and that the sole purpose of the Respondent’s use of the Disputed Domain Name is to mislead consumers and/or take advantage of the OSBORNE CLARKE trademark and the Complainant’s goodwill.

Registered and Used in Bad Faith

The Complainant states that the Disputed Domain Name was registered and is being used in bad faith.

The Complainant notes that, according to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), UDRP panels have consistently found that the mere registration of a disputed domain name that is identical or confusingly similar to a famous or widely-known

trademark by an unaffiliated entity can by itself create a presumption of bad faith and submits that, given that the Disputed Domain Name is confusingly similar to the OSBORNE CLARKE trademark, the Panel should presume that the Dispute Domain Name was registered and is being used in bad faith.

The Complainant continues that the Respondent is using the Disputed Domain Name to conduct an email-based scam and that this confirms the prima facie assumption that the Disputed Domain Name was registered and is being used in bad faith.

The remedy requested by the Complainant

The Complainant requests that the Panel decide that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the Disputed Domain Name with the only addition of the letter "s" between "osborne" and "clarke". Accordingly, the mark remains recognizable and the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

It is also well-established in UDRP jurisprudence that the applicable generic TLD ("gTLD"), here ".net", is a standing requirement and is to be ignored in considering confusing similarity.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, Panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant

evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

Previous panels have held that the use of a disputed domain name for illegitimate purposes, here impersonation/passing off, phishing or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Accordingly, the Respondent has not demonstrated, before notice to the Respondent of the dispute, use or demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services; that the Respondent has been commonly known by the Disputed Domain Name; or that that the Respondent was making legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the Complainant's trademark.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent has engaged in behavior to disrupt the business of the Complainant, and has also engaged in illegal activity, here impersonation/ passing off and email phishing.

Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy and the Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <osbornesclarke.net> be transferred to the Complainant.

/Michael D. Cover/

Michael D. Cover

Sole Panelist

Date: March 10, 2025