

ADMINISTRATIVE PANEL DECISION

Osborne Clarke LLP v. Zerasia Howard

Case No. D2025-0378

1. The Parties

The Complainant is Osborne Clarke LLP, United Kingdom, internally represented.

The Respondent is Zerasia Howard, United States of America.

2. The Domain Name and Registrar

The disputed domain name <osbornesclarke.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 30, 2025. On January 31, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 3 and 4, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 4, 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 February 4, 2025.

The Center verified that the Complaint and 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 February 7, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 27, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 28, 2025.

The Center appointed Fabrice Bircker as the sole panelist in this matter on March 10, 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

According to undisputed elements provided by the Complainant, it is a limited liability partnership registered on January 12, 2015, which carries on business in the United Kingdom in relation to legal services under the mark OSBORNE CLARKE. 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 mark.

The Complainant’s activities are notably protected through the following trademark registration:

OSBORNE CLARKE, United Kingdom trademark registration No. UK00002129400, filed on April 11, 1997, registered on September 26, 1997, regularly renewed since then, and protecting services of classes 35, 36, and 42.

The Complainant has also an online presence through the <osborneclarke.com> domain name, which directs to its official website, and which is also used for its email addresses.

The disputed domain name, <osbornesclarke.com>, was registered on January 3, 2025.

It does not resolve to an active website and does not seem to have been used according to the case file.

Very little is known about the Respondent, except that, based on the information disclosed by the Registrar, he is apparently located in the United States of America.

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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its OSBORNE CLARKE trademark, because it reproduces it with the exception of i) the removal of the space between “osborne” and “clarke”, ii) the addition of the letter “s” between these two elements, and iii) the presence of the generic Top-Level Domain (“gTLD”) “.com”, and these differences are not sufficient to prevent the OSBORNE CLARKE trademark from being recognizable within the disputed domain name.

Besides, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name, in substance because:

- the disputed domain name is inactive, there is no evidence that the Respondent is using it in relation to a bona fide offering of goods or services, and that the latter would have rights or legitimate interests in the disputed domain name,
- a Google search on “osbornes clarke” exclusively reveals results related with the Complainant, and
- the Complainant has reason to believe that the Respondent registered the disputed domain name for the purposes of carrying out an email-based fraud. In this respect, the Complainant submits that a number of domain names have recently been registered anonymously to mimic its trademark and are used to fraudulently impersonate it to demand the payment of monies under the threat of litigation as part of a phishing scam.

Finally, the Complainant contends that the disputed domain name has been registered and is being used in bad faith, notably because:

- the mere registration of a 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
- it is highly likely that the Respondent is using, or intends to use, the disputed domain name to conduct an email-based phishing scam.

B. Respondent

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

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds that the Complainant has shown rights in respect of a trademark or service mark (i.e., the OSBORNE CLARKE trademark detailed in section 4 above), for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds the OSBORNE CLARKE mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Indeed, the disputed domain name reproduces the Complainant's trademark and only differs from said trademark by a minor misspelling (namely the addition of the letter "s" between the two elements of the trademark) which does not prevent the Complainant's trademark from being clearly recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.9.

Regarding the gTLD ".com" in the disputed domain name, it is well established that gTLD do not generally affect the assessment of a domain name for the purpose of determining identity or confusingly similarity. [WIPO Overview 3.0](#), section 1.11.1

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.

Indeed, the Complainant has not given its consent to the Respondent to use its OSBORNE CLARKE trademark in a domain name registration or in any other manner.

Besides, there is nothing in the record of the case to indicate that the Respondent may be commonly known by the disputed domain name.

Furthermore, the disputed domain name is not used and nothing in the case file suggests that it may have been used or that the Respondent has made preparations to use it for legitimate purposes.

In addition, the Panel finds that the disputed domain name is so close to the Complainant's trademark and to the domain name it is using for its email addresses, and Internet users may not be able to notice such a subtle difference between the Complainant's trademark and the disputed domain name.

At last, the Respondent has not replied to the Complainant's contentions.

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.

As far as bad faith registration is concerned, the Panel finds that:

- the OSBORNE CLARKE trademark registration predates the registration of the disputed domain name by more than 25 years;
- the OSBORNE CLARKE trademark is intrinsically distinctive;
- the Complainant's trademark enjoys a significant repute;¹
- the disputed domain name is almost identical to the Complainant's trademark (it only differs from the Complainant's trademark by a minor misspelling); and
- the Respondent has not put forward any argument intended to establish his good faith.

In these circumstances, the Panel considers that the Respondent was more than likely well aware of the Complainant's rights when he registered the disputed domain name.

Besides, panels have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

¹To invoke the repute of its trademark, the Complainant mainly proceeds with conclusory statements, "[w]hile conclusory statements unsupported by evidence [are] normally (...) insufficient to prove a party's case ([WIPO Overview 3.0](#), section 4.2). However, the Complaint also includes references to the Complainant's website. "Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision." ([WIPO Overview 3.0](#), section 4.8). On this ground, the Panel visited the Complainant's website and found credible elements supporting its contentions.

Having reviewed the available record, the Panel notes:

- the distinctiveness and the reputation of the Complainant's trademark;
- the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- the Respondent's concealing its identity; and
- the implausibility of any good faith use to which the disputed domain name may be put (the disputed domain name is also almost identical to the Complainant's trademark and the domain name used by the Complainant for its emails addresses, therefore and given the overall circumstances of this case, the fact that the disputed domain name is in the hands of the Respondent constitutes a threat of fraudulent use hanging over the head of the Complainant).

Therefore, the Panel finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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.com> be transferred to the Complainant.

/Fabrice Bircker/

Fabrice Bircker

Sole Panelist

Date: March 24, 2025