

ADMINISTRATIVE PANEL DECISION

Pillsbury Winthrop Shaw Pittman LLP v. KINETICDOMAINS LTD, Dmitri Vassilev

Case No. D2025-0920

1. The Parties

The Complainant is Pillsbury Winthrop Shaw Pittman LLP, United States of America, represented by ZeroFox, United States of America.

The Respondent is KINETICDOMAINS LTD, Dmitri Vassilev, Seychelles.

2. The Domain Name and Registrar

The disputed domain name <pillsburylaw.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 5, 2025. On March 6, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 6, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 7, 2025, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant did not file an amended Complaint or amendment to the Complaint. The Panel finds that for the purposes of these proceedings the appropriate Respondent is the underlying registrant KINETICDOMAINS LTD, Dmitri Vassilev.

The Center verified that the 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 March 14, 2025. In accordance with the Rules, paragraph 5, the due date for Response was April 3, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 4, 2025.

The Center appointed Dr. Clive N.A. Trotman as the sole panelist in this matter on April 8, 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 full-service law firm with a New York headquarters. The Complainant has 20 offices worldwide and employs over 700 lawyers.

The Complainant holds trade or service marks that include:

PILLSBURY, United States Patent and Trademark Office (“USPTO”), registered December 23, 1997, registration number 2123586, in class 42.

The Complainant also owns and has used the domain name <pillsburylaw.com> since at least as early as January, 1996.

Nothing is known about the Respondent, which did not reply, except for the contact details provided to the Registrar at the time of registration of the disputed domain name on July 20, 2023. The disputed domain name has resolved to a website with pay-per-click links related to legal services, and also has an active Mail eXchange (“MX”) record.

5. Parties’ Contentions

A. Complainant

In its brief Complaint, 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 identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The word “pilsbury” in the disputed domain name differs from the Complainant’s trademark solely by the omission of one letter “l”, which, the Complainant says, does not create a new or unique phrase that can be reasonably distinguished from the Pillsbury trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and has not been permitted to use the Complainant’s trademark in any way. The Complainant is not aware of any bona fide offering or intended offering of goods or services associated with the disputed domain name, which has resolved to a parking page with what the Complainant says are pay-per-click advertisements. There has been no fair or noncommercial use of the disputed domain name.

The Complainant says it cannot find any other businesses that commonly go by the same name or operate a brand or trade name related to it.

The disputed domain name has an active MX record associated with it, which the Complainant says, suggests preparations for it to be used in email communication, with the potential emails to be confused with those of the Complainant.

The Complainant further contends that the disputed domain name was registered and is being used in bad faith. The Complainant says the incorporation of its trademark is enough to establish bad faith at the time of registration. Furthermore, the disputed domain name is passively held if it does not resolve to an active website or is parked.

The Complainant says the incorporation of its trademark in the disputed domain name, together with pay-per-click advertisements on the parking page, makes it likely that the Respondent was aware of the Complainant and that Internet users searching for the Complainant may be misdirected through the disputed domain name to the Complainant's competitors.

The Complainant reiterates under the heading of Bad Faith that the association of active MX records with the disputed domain name indicates that the Respondent intends to use it for email purposes, with a high likelihood of emails being attributed mistakenly to the Complainant.

The Respondent has availed itself of a privacy service when registering the disputed domain name, which the Complainant says could be intended to conceal its true contact details.

The Complainant requests the transfer of the disputed domain name.

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.

This Panel would have expected the Complainant to have produced at least one relevant trademark in the form of a copy of the registration document. In fact the Complainant merely stated that it held multiple registered trademarks and quoted the USPTO registration number of one of them. In the interests of expediency the Panel consulted the USPTO database to confirm this registration, as the Panel is permitted but not obliged to do. [WIPO Overview 3.0](#), section 4.8. The Panel is satisfied that the Complainant has rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name contains a misspelling of the Complainant's trademark PILLSBURY in which one letter "l" is omitted, thus: "pilsbury" (followed by "law"). The Panel finds that the Complainant's trademark is recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.9. Accordingly, the disputed domain name is confusingly similar to the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7

Although the addition of other terms (here, "law") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

The Panel does not find the resolution of the disputed domain name to a holding page with law-related links to constitute a bona fide offering of goods or services or to be a legitimate noncommercial or fair use. There is no evidence the Respondent is or has been commonly known by a name similar to the disputed domain name.

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)(iv) of the Policy reads:

“by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”.

The Complaint contains little in the way of evidence under the heading of Bad Faith. For example, the Complainant submits that “[i]t is well established that whole incorporation of the Complainant[']s mark is enough to establish bad faith at the time of registration. Under “passive holding” this would also be the case in its active use if the domain still does not resolve or is parked”.

The mere incorporation of a complainant’s trademark, without more, is insufficient to establish bad faith. Numerous examples exist of companies using the same trademark for non-conflicting purposes. In the process of checking the Complainant’s claimed trademark at the USPTO, the Panel noted that another well-established company holds numerous registrations for the trademark “Pillsbury” alone or in combination in the broad field of pastry products.

The Complainant’s brief allusion, above, to the doctrine of passive holding is not sufficient. For the ground of passive holding to be advanced, the Complainant would need to argue whether the disputed domain name is passively held, since in this instance it resolves to a page apparently offering remunerative pay-per-click links and has associated MX records. The Complainant would need to address in detail the criteria developed through jurisprudence tracing back to the case of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), including: “(i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put”. [WIPO Overview 3.0](#), section 3.3.

Whilst a registered trademark word identical to the Complainant's is in use by another and could be used legitimately elsewhere, the additional term "law" in the disputed domain name leaves little opportunity to doubt that the Respondent has targeted specifically the Complainant. Furthermore, the establishment of MX records supports a reasonable probability that the Respondent may have further intentions for the disputed domain name, directed towards the Complainant. The disputed domain name is in use to the extent of resolving to a website, albeit apparently a holding page, evidently monetized with what may reasonably be presumed are pay-per-click links in the field of law from which the Respondent would gain a share of the remuneration for referrals. On the evidence, the Panel finds on the balance of probabilities that the Respondent has registered and used the disputed domain name with intent to attract Internet users by confusion to the Respondent's on-line location, whether a website or an email address, for commercial gain, in the terms of paragraph 4(b)(iv) 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 <pilsburylaw.com> be transferred to the Complainant.

/Dr. Clive N.A. Trotman/

Dr. Clive N.A. Trotman

Sole Panelist

Date: April 17, 2025