

## **ADMINISTRATIVE PANEL DECISION**

Ropes & Gray LLP v. Gary Aaronson  
Case No. D2023-0287

### **1. The Parties**

The Complainant is Ropes & Gray LLP, United States of America (“United States”), represented internally.

The Respondent is Gary Aaronson, United States.

### **2. The Domain Name and Registrar**

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 23, 2023. On January 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 23, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 January 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 17, 2023.

The Center appointed Carol Anne Been as the sole panelist in this matter on February 28, 2023. 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 Ropes & Gray LLP, an international law firm with its principal place of business in New York, United States.

The Complainant owns a United States trademark registration for ROPES & GRAY, Registration Number 2,902,936 in Class 42 for “Legal services; provision of information in the field of law” with a registration date of November 16, 2004, and claimed first use in 1865.

In addition to its registered trademark, the Complainant operates a website using the domain name, <ropesgray.com>, which was initially registered on October 12, 1995.

The Respondent is Gary Aaronson, United States.

The Disputed Domain Name was registered on January 12, 2023. As of March 2023, the Disputed Domain Name does not resolve to an active website.

No facts have been asserted by the Respondent since the Respondent did not submit a Response in this proceeding.

#### **5. Parties' Contentions**

##### **A. The Complainant**

The Complainant contends that the Disputed Domain Name is practically identical with and confusingly similar to the Complainant's trademark, firm name, and domain name. The Complainant claims to be well known for its legal services and points out that it has operated under its current name since its founding in 1865. The Complainant contends that the minor alterations to its mark in the Disputed Domain Name, removing the “&”, changing the “a” to “e”, and adding an “s” to the end, do not dispel the confusing similarity to the Complainant's mark.

The Complainant contends that the Respondent has not demonstrated any rights or legitimate interests in the Disputed Domain Name. The Complainant contends that there is no relationship between itself and the Respondent that could give rise to any license, permission, or rights. According to the Complainant, this creates a strong presumption that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. Additionally, the Complainant contends that the Respondent has not used the Disputed Domain Name with any *bona fide* offering of goods or services.

The Complainant alleges that the Respondent has registered and is using the Disputed Domain Name in bad faith. The Complainant notes that the Respondent registered the Disputed Domain Name long after the Complainant was founded and nearly 30 years after the Complainant registered its domain name and nearly 20 years after the Complainant registered its trademark. Further, the Complainant alleges that the Respondent is using the Disputed Domain Name to send phishing emails to the Complainant's current and prospective clients falsely claiming to come from a partner at the Complainant as part of a “business email compromise scheme”.

## **B. The Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainant has established that it holds rights in its mark ROPES & GRAY and uses its mark for legal services. The Disputed Domain Name is nearly identical to the Complainant's mark, only removing the "&", changing the "a" to "e", and adding an "s". The removal of the "&" does not prevent a finding of confusing similarity as the ampersand symbol is not a permitted character in domain names and punctuation marks are not required for finding that a mark is identical or confusingly similar. See, e.g., *Chernow Communications, Inc. v. Jonathan D. Kimball*, WIPO Case No. [D2000-0119](#) ("the use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark"). Additionally, neither the addition of the single-letter "s" nor the changing of the "a" in "gray" to an "e" prevent the Disputed Domain Name from being confusingly similar to the Complainant's mark. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.9.

Therefore, the Disputed Domain Name is confusingly similar to the Complainant's ROPES & GRAY mark.

### **B. Rights or Legitimate Interests**

The Respondent has not set forth any evidence of circumstances of the type described in paragraph 4(c) of the Policy to demonstrate any rights to or legitimate interests in the Disputed Domain Name. The Complainant's assertion that the Respondent has no rights or legitimate interests in the Disputed Domain Name is unopposed. After a complainant has made a *prima facie* case, the burden of production shifts to the respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#). The Respondent has shown no evidence of any rights or legitimate interests in the Disputed Domain Name. Further, the Respondent's use of the Disputed Domain Name to send a "phishing" email seriously undermines any claim to rights or legitimate interests that the Respondent could potentially make.

Therefore, the Respondent has no rights or legitimate interests in the Disputed Domain Name.

### **C. Registered and Used in Bad Faith**

The Disputed Domain Name was registered nearly 20 years after the Complainant registered its ROPES & GRAY trademark. The Respondent's use of the Disputed Domain Name to send a "phishing" email to the Complainant's client is clear evidence of use in bad faith. See *Ropes & Gray LLP v. Domain Administrator, c/o DomainsByProxy.com / Account Recievable*, Case No. [D2020-0294](#). The phishing email also indicates that the Respondent registered the Disputed Domain Name because of its similarity to the Complainant's established trademark rights and existing domain name, further demonstrating bad faith. When the Disputed Domain Name was registered in 2023, the Respondent had constructive knowledge of the Complainant's earlier trademark registration under United States trademark law. See [WIPO Overview 3.0](#), section 3.2.2 ("In limited circumstances - notably where the parties are both located in the United States and the complainant has obtained a federal trademark registration pre-dating the relevant domain name registration - panels have been prepared to apply the concept of constructive notice.") The lack of an active website at the Disputed Domain Name does not bar a finding of bad faith. See *The Coca-Cola Company v. PrivacyProtect.org/ N/A, Stephen Chukwumaobim*, WIPO Case No. [D2012-1088](#).

Therefore, the Respondent registered and is using the Disputed Domain Name in bad faith.

## **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, <ropesgreys.com>, be transferred to the Complainant.

*/Carol Anne Been/*

**Carol Anne Been**

Sole Panelist

Date: March 14, 2023