

ADMINISTRATIVE PANEL DECISION

Ropes & Gray LLP v. IPO 9809, Rope and Gray
Case No. D2024-0447

1. The Parties

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

The Respondent is IPO 9809, Rope and Gray, United States.

2. The Domain Name and Registrar

The disputed domain name <ropeandgray.site> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2024. On January 31, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 31, 2024, the Registrar transmitted by email to the Center its verification disclosing the 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 Complainant on February 7, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 12, 2024.

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 Respondent of the Complaint, and the proceedings commenced on February 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2024. On February 28, 2024, a third party apparently unrelated to the proceedings sent an email communication to the Center concerning the disputed domain name. Pursuant to paragraph 6 of the Rules, on March 6, 2024, the Center informed the Parties that it would proceed with the panel appointment process.

The Center appointed Georges Nahitchevansky as the sole panelist in this matter on March 15, 2024. 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

Complainant, Ropes & Gray LLP, is an international law firm with offices in the United States, Europe and Asia. Complainant provides legal services to businesses and individuals around the world under the name and mark ROPES & GRAY. Complainant owns a United States trademark registration for the ROPES & GRAY mark in connection with its legal services (Registration No. 29029360) that issued to registration on November 16, 2004. Complainant also owns and uses the domain name <ropesgray.com> to provide information concerning Complainant and its services and for email purposes.

Respondent appears to be based in the United States. Respondent registered the disputed domain name on September 27, 2023. To date, the disputed domain name does not appear to have been used for an active website. There is evidence, though, that the disputed domain name has been used for emails to invite at least one consumer to apply for a proofreader position with Complainant.

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.

Complainant contends that it has strong rights in the name and mark ROPES & GRAY in connection with legal services on account of its use of ROPES & GRAY for over 150 years and its trademark registration for ROPES & GRAY in the United States.

Complainant argues that Respondent has no rights or legitimate interests in the disputed domain name and has registered and used such in bad faith as Respondent has no rights in the ROPES & GRAY name and mark and has used the disputed domain name to impersonate Complainant as part of a fraudulent scheme for Respondent's profit.

B. Respondent

Respondent did not reply to Complainant's contentions.

On February 28, 2024, the Center received a communication from a representative of an unrelated third party advising that the third party had received notification of the instant proceeding. The communication noted that the third party had never owned or been associated with the disputed domain name and that their address had been used in relation to the disputed domain name.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)) at section 1.7. Complainant has provided evidence that it owns a trademark registration for the ROPES & GRAY mark and that such issued to registration well before Respondent registered the disputed domain name.

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.

Here, the disputed domain essentially copies the ROPES & GRAY mark by removing the letter “s” in “Ropes” and replacing the ampersand in Complainant’s mark with its equivalent “and.” Such minute differences are not material as the entirety of Complainant’s mark is recognizable in the disputed domain name. Accordingly, the disputed domain name is confusingly similar, if not nearly identical, to Complainant’s ROPES & GRAY mark for purposes of the Policy.

The Panel thus finds that 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 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 that Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. 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.

Here, the evidence shows that Respondent, who has no rights in the name and mark ROPES & GRAY, has sought to impersonate Complainant by registering a domain name that is likely to be viewed as affiliated with Complainant and its services and then using such as part of a likely fraudulent scheme to lure unsuspecting consumers into interviewing for a remote proofreader position. Underscoring Respondent’s lack of any legitimate interest is Respondent’s efforts to shield its identity by using the fictitious registrant name of “Rope and Gray,” which is nearly identical to Complainant’s ROPES & GRAY name and mark, and the use of an unrelated third party’s address to register the disputed domain name.

Panels have held that the use of a domain name in furtherance of illegal activity, such as the fake job offer scheme at issue here, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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

C. Registered and Used in Bad Faith

Given Respondent's actions as noted above, and its failure to appear in this proceeding to provide any bona fide evidence to explain or justify its actions, it is easy to infer that Respondent's registration of the disputed domain name that essentially consists of the name and mark ROPES & GRAY has been done in bad faith.

To be sure, panels have consistently held that the registration and use of a domain name based on the mark of another for illegal activity such as sending emails impersonating a brand owner as part of fraudulent scheme constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds that Respondent's registration and use of the disputed domain name was done opportunistically and in bad faith for purposes of furthering a fraudulent scheme at the expense of Complainant and its rights in the ROPES & GRAY name and mark.

Accordingly, the Panel finds that Complainant succeeds under this 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 <ropeandgray.site> be transferred to Complainant.

/Georges Nahitchevansky/

Georges Nahitchevansky

Sole Panelist

Date: March 29, 2024