

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited Liability Partnership v. Name Redacted
Case No. D2022-4437

1. The Parties

The Complainant is Taylor Wessing Limited Liability Partnership, United Kingdom, represented internally.

The Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <taylorwessimg.com> (the “Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 21, 2022. On November 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 21, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 2022 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 November 23, 2022.

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”).

¹ The Respondent appears to have used the name of a third party when registering the Domain Name. Considering the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the Domain Name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 15, 2022.

The Center appointed Olga Zalomiy as the sole panelist in this matter on December 19, 2022. 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 global law firm, which owns the trademark TAYLOR WESSING for use in connection with, amongst other things, the provision of legal and advisory services in 17 locations throughout the world. The Complainant owns 15 registrations for the trademark TAYLOR WESSING in many jurisdictions around the world, including the United States Registration Number 2941089, registered on April 19, 2005, and European Union Trade Mark number 002727519, registered on March 31, 2004.

The Complainant's main website is associated with its domain name <taylorwessing.com>.

The Domain Name was registered on October 28, 2022. The Domain Name has been used in connection with a fraudulent email scheme. There is no evidence before the Panel to suggest that the Domain Name has ever resolved to an active website.

5. Parties' Contentions

A. Complainant

The Complainant claims that the Domain Name is confusingly similar to its TAYLOR WESSING trademark. The Complainant alleges that it owns numerous trademark registrations in the TAYLOR WESSING trademark. The Complainant argues that the Domain Name is almost identical to the Complainant's TAYLOR WESSING trademark. The Complainant claims that its trademark is so well known in respect of legal services around the world that it is inevitable that public will believe that the Domain Name is somehow connected with the Complainant and its legal services.

The Complainant claims that the Respondent has no right or legitimate interests in respect of the Domain Name. The Complainant alleges that there is no evidence of the Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services. The Complainant argues that the Respondent used the Domain Name in a fraudulent email scam. The Complainant contends that the Respondent impersonated a Complainant's partner who purportedly tried to collect a debt from the Complainant's clients on three occasions. The Complainant claims that the Respondent is not commonly known by the Domain Name. The Complainant claims that the Respondent is not making a legitimate noncommercial or fair use of the Domain Name.

The Complainant claims that Domain Name was registered and is being used in bad faith. The Complainant claims that it learned that three emails were sent out to third parties to elicit the third parties into transferring funds to the Respondent. The Complainant claims that the emails were sent from an email address associated with the Domain Name, which closely resembled an email of one of the partners of the Complainant's firm. The Complainant alleges that the emails were not authorized by the Complainant but appeared to recipients as if that were the case. The Complainant claims that the emails provide the signature block of the Complainant and include the London registered office address of the Complainant. According to the Complainant, the contact details included for its member with respect to his email address

were incorrect and instead linked to the Domain Name. The Complainant claims that the Respondent's use of the Domain Name as well as the impersonation of the Complainant's partner evidences how the Domain Name is being used in bad faith. The Complainant argues that by using the Domain Name and sending fraudulent emails impersonating genuine senior management Taylor Wessing employees, the Respondent is intentionally attempting to opportunistically attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's famous TAYLOR WESSING mark as to the source, sponsorship, affiliation, or endorsement of the Domain Name.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The evidence on file shows that the Complainant owns trademark registrations for the TAYLOR WESSING trademark and, as a result, has rights in the TAYLOR WESSING trademark pursuant to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Domain Name is confusingly similar to the Complainant's TAYLOR WESSING trademark. It is well established that "[a] domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element".² Here, the Domain Name consists of the typo variant of the TAYLOR WESSING trademark, a letter "m" substituted for letter "n", and the generic Top-Level Domain ("gTLD") ".com". Because the misspelled TAYLOR WESSING trademark is sufficiently recognizable the Domain Name, and the gTLD ".com" would usually be disregarded under the confusing similarity test, as it is a technical requirement of registration, the Panel considers that the Domain Name is confusingly similar to the Complainant's trademark.³

Thus, the Panel finds that the first element of the UDRP has been met.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the UDRP, the Respondent may establish that it has rights or legitimate interests in the Domain Name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use the Domain Name or a name corresponding to the Domain name in connection with a *bona fide* offering of goods or services; or

² Section 1.9, [WIPO Overview 3.0](#).

³ Section 1.11, [WIPO Overview 3.0](#).

(ii) the Respondent has been commonly known by the Domain Name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel accepts that there is no evidence of the Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services. Prior UDRP panels held that the use of a domain name for illegal activity, such as impersonation, can never confer rights or legitimate interests on a respondent.⁴ The evidence on record demonstrates the Respondent's misuse of the Domain Name in its impersonation of the Complainant's partner to defraud third parties of money. Such activity does not confer rights or legitimate interests on the Respondent.

In addition, the evidence shows that the Respondent is not commonly known by the Domain Name. Nor is the Respondent making a legitimate noncommercial or fair use of the Domain Name, because it attempted to use fraud to obtain payments from third parties.

The Panel finds that the Complainant made out a *prima facie* case in respect of the lack of rights or legitimate interests of the Respondent in the Domain Name. Once complainant makes a *prima facie* case, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name;⁵ the Respondent has failed to do so, and consequently the Panel finds that in this proceeding the Complainant has satisfied paragraph 4(a)(ii) of the UDRP.

Thus, the Panel finds that the second element of the UDRP has been met.

C. Registered and Used in Bad Faith

Under the third UDRP element, the Complainant is required to prove that the Domain Name was registered and is being used in bad faith.

The evidence on record shows that third-party-disseminated emails requesting recipients to provide the sender with personal information for receipt of large sums were sent from a "[...]@taylorwessimg.com" email address. The email address was created using the Domain Name and was very similar to the real email address of one of the Complainant's members (partners), "[...]@taylorwessing.com". The emails represent that they were sent by the Complainant's partner as a "debt collection counsel" who attempted to collect on unpaid invoices.

Paragraph 4(b) of the UDRP sets forth circumstances, which shall be considered evidence of the registration and use of a domain name in bad faith. The examples of bad faith registration and use set forth in paragraph 4(b) of the UDRP are not meant to be exhaustive of all circumstances from which such bad faith may be found. Prior UDRP panels have held that "the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. [...] Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers".⁶

The Panel finds that the Respondent registered the Domain Name in bad faith, because the Respondent registered the Domain Name to commit a fraud. The Panel also finds that the Respondent's use of the

⁴ Section 2.13.1, [WIPO Overview 3.0](#).

⁵ Section 2.1, [WIPO Overview 3.0](#).

⁶ Section 3.4, [WIPO Overview 3.0](#).

Domain Name for fraudulent emails to Complainant's clients in attempt to unfairly obtain payments for purportedly unpaid invoices, constitutes bad faith use of the Domain Name. See, *e.g.*, *Admiral Group Plc and EUI Limited v. Cimpres Schweiz, Cimpres Schweiz GmbH*, WIPO Case No. [DCO2017-0043](#), where the panel stated that, "[r]espondent has used the disputed domain name as a fake email address in order to impersonate the CFO of Complainant A and mislead some employees, recipients of the emails. The fraudulent intentions of the Respondent are hereby clearly unveiled, and enable the Panel to conclude that the disputed domain name is used in bad faith". Similarly, the Respondent in this case used the Domain Name in attempt to defraud a third party of valuable goods. Therefore, the Respondent is using the Domain Name in bad faith.

Therefore, the Panel finds that the third element of the UDRP has been met.

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 Domain Name, <taylorwessimg.com>, be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: January 2, 2023