

## ADMINISTRATIVE PANEL DECISION

### Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2023-0471

#### 1. The Parties

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

The Respondent is Name Redacted.<sup>1</sup>

#### 2. The Domain Name and Registrar

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

#### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2023. On February 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 6, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed the first amended Complaint on February 6, 2023. In response to the Center’s email regarding the Mutual Jurisdiction, the Complainant filed the second amended Complaint on February 15, 2023.

The Center verified that the Complaint together with the amended Complaints 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”).

---

<sup>1</sup> The Respondent appears to have used the name and/or contact details of a third party when registering the disputed domain name. In light of 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 disputed 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this Decision shall not be published due to the exceptional circumstances of this case.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 February 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 17, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on March 27, 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 a major global law firm which provides its services under the trademark TAYLOR WESSING. The Complainant owns numerous trademark registrations containing TAYLOR WESSING throughout the world, including the following:

- United States of America Trademark Registration No. 2941089 for TAYLOR WESSING registered on April 19, 2005, for the goods and services in classes 16, 41, and 42; and
- European Union trademark No. 002727519 for TAYLOR WESSING registered on March 31, 2004, for the goods and services in classes 9, 16, 35, 36, 38, 41, and 42.

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

The disputed domain name was registered on January 31, 2023. The disputed domain name has been used in connection with a fraudulent email scheme. There is no evidence before the Panel to suggest that the disputed domain name has ever resolved to an active website.

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

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

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy have been satisfied. In particular, the Complainant asserts that:

(1) the disputed domain name is confusingly similar to its TAYLOR WESSING trademark in which the Complainant has rights. The disputed domain name contains the trademark TAYLOR WESSING in its entirety, save for the additional letter "i" being inserted in the word "taylor". Therefore, it is highly similar to the distinctive and famous TAYLOR WESSING trademark. Further, it conveys the meaning that the disputed domain name relates to the legal services offered by Taylor Wessing;

(2) the Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent used the disputed domain name in a fraudulent email scam. The Respondent impersonated a Complainant's partner who purportedly tried to collect a debt from the Complainant's clients. The Respondent is not commonly known by the disputed domain name. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, especially since the disputed domain name is not actively used by the Respondent;

(3) the disputed domain name was registered and is being used in bad faith. The disputed domain name was registered or acquired primarily for the purpose of using it to target third parties by way of serious, unlawful and fraudulent email scams to elicit the third parties into transferring funds. By using the disputed

domain name and sending fraudulent emails impersonating genuine partner of the Complainant, 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 disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

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

According to paragraph 4(a)(i) of the Policy it should be established that the disputed domain name is identical or confusingly similar to a mark in which the complainant has rights.

The Panel confirms that for the purposes of paragraph 4(a)(i) of the Policy the Complainant has satisfied the threshold requirement of having relevant trademark rights for TAYLOR WESSING in jurisdictions throughout the world.

With the Complainant's rights in TAYLOR WESSING trademark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to the Complainant's mark.

It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The disputed domain name contains the trademark TAYLOR WESSING in its entirety, save for the additional letter "i" being inserted in the word "taylor". Therefore, it is confusingly similar to the TAYLOR WESSING trademark. Prior UDRP panels have recognized that confusing similarity is established for purposes of the Policy where the disputed domain name incorporates the complainant's trademark in its entirety. See [WIPO Overview 3.0](#), section 1.7.

Furthermore, the Panel considers that the misspelling of the Complainant's trademark within the disputed domain name cannot prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.9.

The generic Top-Level Domain ("gTLD"), such as ".com" in this case, may be disregarded for purposes of comparison under the first element, as it is viewed as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1.

For all of the above-mentioned reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

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

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark TAYLOR WESSING and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name.

The evidence in the case file shows that the Respondent is not commonly known by the disputed domain name. Nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name, because it attempted to resort to fraud to obtain payments from third parties.

The Complainant has credibly submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain name, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain name and is not commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

Furthermore, according to the case file, the disputed domain name has been used in a fraudulent email scam with the obvious intention of misleading the recipient of the email sent from the disputed domain name in the name of a partner of the Complainant into transferring funds for the presumed benefit of the Respondent, which cannot constitute a legitimate noncommercial or fair use of the disputed domain name.

Accordingly, the Panel finds that the Complainant has made a *prima facie* case that has not been rebutted by the Respondent. Once the complainant makes a *prima facie* case, the burden of production shifts to the respondent to come forward with appropriate allegations or relevant evidence demonstrating rights or legitimate interests in the domain name. The Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name.

With the evidence on file, it is undoubtedly established that the Respondent has no rights or legitimate interests in respect to the disputed domain name under paragraph 4(a)(ii) of the Policy.

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

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

Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, if

found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent’s] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or of a product or service on [the respondent’s] website or location.”

Considering that the Respondent has fraudulently pretended to be an employee of the Complainant, it is obvious that the Respondent was aware of the Complainant and its trademark when registering the disputed domain name. Therefore, the Panel is of the opinion that 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 disputed domain name.

Considering that the Panel has found that the Respondent has used the disputed domain name in an attempt to fraudulently obtain funds for the presumed benefit of the Respondent, the Respondent has not responded to the Complaint, the Respondent has used a privacy service to conceal its identity, the Panel considers, on balance, that the disputed domain name was registered and is being used in bad faith.

Previous UDRP panels have held that the use of a domain name for purposes such as phishing, identity theft, or to send deceptive emails, *e.g.*, to obtain sensitive or confidential personal information or to solicit payment of fraudulent invoices from the complainant’s actual or prospective customers is evidence of registration and use of the domain name in bad faith ([WIPO Overview 3.0](#), section 3.4).

For the reasons set out above, the Panel concludes that the disputed domain name was registered and is being used in bad faith, within the meaning of paragraph 4(a)(iii) 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, <taylorwessing.com>, be transferred to the Complainant.

*/Ganna Prokhorova/*

**Ganna Prokhorova**

Sole Panelist

Date: April 10, 2023