

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited Liability Partnership v. Name redacted
Case No. D2022-4741

1. The Parties

The Complainant is Taylor Wessing Limited Liability Partnership, United Kingdom (“UK”), represented by Jason Rawkins, UK.

The Respondent is Name Redacted, United States of America (“US”).¹

2. The Domain Name and Registrar

The disputed domain name <taylorwessinglaw.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 December 9, 2022. On December 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 12, 2022, 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 December 14, 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 December 15, 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 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case.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 December 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 6, 2023.

The Center appointed Cherise Valles as the sole panelist in this matter on January 17, 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 Taylor Wessing is a major international law firm, with over 1,100 lawyers in 17 locations.

The Complainant owns over 15 trade mark registrations containing the name TAYLOR WESSING ("trademark"). These include US trade mark registration number 2941089 and European Union Trade Mark registration number 002727519 for the word mark TAYLOR WESSING, covering business management, taxation services, and legal services in classes 35, 36, and 42 (among other goods and services), filed on December 4, 2002, and June 7, 2022, respectively (Annex 7 to the Complaint).

The disputed domain name was registered by the Respondent on December 6, 2022.

At the time of the decision, the disputed domain name resolves to an inactive website (Annex 8 to the Complaint). The Complainant has provided evidence that the disputed domain name has been used to impersonate a named partner at the Complainant via a fraudulent email scheme.

5. Parties' Contentions

A. Complainant

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

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.
- The disputed domain name is confusingly similar to the Complainant's registered TAYLOR WESSING trademark, in light of the fact that it wholly incorporates the Complainant's mark.
- The Respondent lacks rights or legitimate interests in the disputed domain name.
- The Complainant states that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name that included its trademarks.
- The Complainant asserts that the disputed domain name was registered and is being used in bad faith.
- The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use.

The Complainant requests the Panel to issue a decision finding that the disputed domain name be transferred to the Complainant, in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In terms of paragraph 4(a) of the Policy, for a Complaint to succeed, the Complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 Respondent has failed to file a Response in this proceeding. The Panel may draw appropriate inferences from the available evidence submitted by the Complainant.

A. Identical or Confusingly Similar

To prove this element, the Complainant must have relevant rights in a trademark and the disputed domain name must be identical or confusingly similar to such trademark.

The Complainant submits that the disputed domain name is confusingly similar to the trade mark in which it has rights. The disputed domain name incorporates the TAYLOR WESSING trademark in its entirety with the addition of the word "law" after "wessing".

Given the Complainant's trademark registration as detailed above, the Panel finds that the Complainant has established its trademark rights in TAYLOR WESSING for the purposes of paragraph 4(a)(i) of the Policy.

As noted above, the disputed domain name incorporates said trademark in its entirety with the addition of the word "law" after "wessing". As stated in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". Thus, the addition of the word "law" in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's TAYLOR WESSING trademark.

It is standard practice when comparing a disputed domain name to a complainant's trademark not to take the Top-Level Domain ("TLD") into account. See section 1.11.1 of the [WIPO Overview 3.0](#), which states that the "applicable [TLD] in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and, as such, is disregarded under the first element of the confusing similarity test". In the present case, the TLD ".com," is disregarded under the first element of the confusing similarity test.

In the light of the foregoing, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark and that the Complainant has met its burden with respect to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive set of circumstances, any of which, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

"[a]ny of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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

(ii) you (as an individual, business or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial 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 Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, whether on the basis of the non-exhaustive examples set out in paragraph 4(c) of the Policy or on any other basis, and the Panel draws inferences from this failure, where appropriate, in accordance with paragraph 14(b) of the Rules.

It is recognised in cases under the Policy that it is sufficient for a complainant to make a *prima facie* case under the second element of the Policy, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name concerned (see, for example, *Paris Saint-Germain Football v. Daniel Macias Barajas*, *International Camps Network*, WIPO Case No. [D2021-0019](#); *Spinrite Inc. v. WhoisGuard, Inc. / Gabriella Garlo*, WIPO Case No. [D2021-0012](#), and the discussion in section 2.1 of the [WIPO Overview 3.0](#)). If a respondent fails to rebut such a *prima facie* case by demonstrating rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy, or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant asserts that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy in order to demonstrate rights or legitimate interests in the disputed domain name. In particular, it submits that the Respondent cannot assert that, prior to any notice of this dispute, it was using, or had made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy.

On the evidence before the Panel, it appears that there has never been any relationship between the Complainant and the Respondent. The Respondent does not seem to be licensed, or otherwise authorized, be it directly or indirectly, to register or use the Complainant's TAYLOR WESSING trademark in any manner, including in, or as part of, the disputed domain name. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. There is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no evidence that the Respondent is, or could be, making any legitimate noncommercial or fair use of the dispute domain name, especially as the disputed domain name is used by the Respondent to impersonate the Complainant via a fraudulent email scheme. Such illegal use can never confer rights or legitimate interests upon a respondent. See section 2.13 of the [WIPO Overview 3.0](#).

In light of the foregoing, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

For this element, the Complainant is required to prove that the disputed domain name was registered and that it is being used in bad faith. The term “bad faith” is “broadly understood to occur where a respondent takes unfair advantage of, or otherwise abuses, a complainant’s mark”. See section 3.1 of the WIPO 3.0 Overview. Paragraph 4(b) of the Policy sets out four non-exhaustive examples of circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, namely:

- (i) circumstances indicating that the respondent registered or 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 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 its 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 its website or location.

In the present case, the Complainant’s submissions relate to paragraph 4(a)(iv) of the Policy.

1) Registration in bad faith

Given the well-known nature of the Complainant’s trademark, it is implausible that the Respondent was unaware of the TAYLOR WESSING trademark when it registered the disputed domain name.

Bad faith can be found where a respondent “knew or should have known” of a complainant’s trademark rights but nevertheless registered a particular domain name in which it has no rights or legitimate interests (see *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. [D2009-0320](#); *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

The Complainant is well known throughout the world including Canada and the United States where the Respondent allegedly has connections. As noted by the Complainant, it has been ranked consistently in several legal ratings guides, including Chambers Global, Legal 500 UK, and Legal 500 Deutschland. Several UDRP panels have previously acknowledged the worldwide reputation of the TAYLOR WESSING trademark (See, for example, *Taylor Wessing Limited Liability Partnership v. Name Redacted*, WIPO Case No. [D2022-4522](#)).

The composition of the disputed domain name is virtually identical to the Complainant’s well-known trademark. The fact that the disputed domain name incorporates the Complainant’s trademark TAYLOR WESSING with the additional word “law” inserted after “wessing” indicates that the Respondent registered the disputed domain name in order to be able to make fraudulent approaches to innocent third parties. Prior panels have held that bad faith can be found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademarks suggests opportunistic bad faith (see *LEGO Juris A/S v. store24hour*, WIPO Case No. [D2013-0091](#)). Given the strong reputation and distinctiveness of the Complainant’s trademark, registration in bad faith can be inferred.

The Complainant also alleges that the Respondent used the disputed domain name on at least one occasion in a fraudulent email scam. On December 7, 2022, a company received a fraudulent email message from the email address “[...]@taylorwessinglaw.com”, and purporting to be a “Debt Collection Litigation Counsel”. It alleges that the Respondent claimed to represent the Complainant in relation to an unpaid invoice. The Complainant claims that the Respondent used this email address to masquerade as an actual Partner in the Private Client group for Taylor Wessing in the UK. Thus, according to the Complainant, 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 party into transferring funds”.

The Complainant notes that the disputed domain name had been registered previously, but was then re-registered on December 6, 2022 – the day before the fraudulent email described above was sent. According to the Complainant, “it is a reasonable inference that the current owner of the Domain Name was the same owner of the registration at the time the scam took place. This inference is reinforced by the fact that the same Registrant has also registered other similar domain names and used them in a similar fraudulent manner”.

As noted above, the Complainant’s trademark rights predate the registration date of the disputed domain name (Annex 7 to the Complaint). Knowledge of a corresponding trademark at the time of the registration of the domain name suggests bad faith (see *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#)).

2) Use in bad faith

As previously noted, the Respondent had used the disputed domain name to make fraudulent approaches to at least one innocent third party in an attempt to generate revenues.

The disputed domain name currently resolves to an inactive page. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate under the Policy. Prior UDRP panels have held that the incorporation of a famous mark in a domain name, coupled with an inactive website, may be evidence of bad faith registration and use when assessing the totality of the circumstances. (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *CBS Broadcasting, Inc. v. Dennis Toeppen*, WIPO Case No. [D2000-0400](#)).

The Respondent has not participated in the administrative proceeding and has not answered the Complainant’s contentions. The fact that the Respondent has decided not to provide any legitimate explanation or to assert any alleged good faith motivation in respect of the registration or use of the disputed domain name in the face of the Complainant’s contentions can be regarded as an indicator of bad faith. Lastly, the Respondent has engaged in the use of a privacy service, masking its details in the publicly available Whois, and provided false contact information when registering the disputed domain name, seeing as the Registrar-disclosed information is actually that of the Complainant’s partner, all of which further supports a finding of bad faith under the circumstances present here. See [WIPO Overview 3.0](#), section 3.3.

Accordingly, the Panel concludes that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name under 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 <taylorwessinglaw.com> be transferred to the Complainant.

/Cherise Valles/

Cherise Valles

Sole Panelist

Date: January 31, 2023