

## **ADMINISTRATIVE PANEL DECISION**

Fenwick & West LLP v. On behalf of fenwickinc.com owner, Whois Privacy Service / Aven Ahmad  
Case No. D2022-0782

### **1. The Parties**

Complainant is Fenwick & West LLP, United States of America (“United States” or “U.S.”), internally represented.

Respondent is On behalf of fenwickinc.com owner, Whois Privacy Service, U.S. / Aven Ahmad, U.S.

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

The disputed domain name <fenwickinc.com> is registered with Amazon Registrar, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 5, 2022. On March 7, 2022, 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 and contact information in the Complaint.

The Center sent an email communication to Complainant on March 14, 2022 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 March 19, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on March 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2022. An email communication was received from a third party on April 7, 2022. No response was received from the Registrar-confirmed email address for Respondent. Accordingly, the Center notified the Commencement of Panel Appointment Process on April 12, 2022.

The Center appointed Phillip V. Marano as the sole panelist in this matter on April 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**

Complainant is Fenwick & West LLP, a California-based law firm that has provided legal services in a variety of areas since 1972. Complainant owns a valid and subsisting registration for the FENWICK trademark in the United States, namely U.S. Reg. No. 3,836,798 registered August 24, 2010, which has priority dating back to September 30, 2003.

Respondent registered the disputed domain name <fenwickinc.com> on June 3, 2021. At the time this Complaint was filed, the disputed domain name failed to resolve to any active website.

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

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

Complainant asserts ownership of the FENWICK trademark and has adduced evidence of a trademark registration in the United States, with priority dating back to September 30, 2003. The disputed domain name is confusingly similar to Complainant's FENWICK trademark, according to Complainant, because it entirely incorporates Complainant's FENWICK mark, with the additional element "inc".

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on the lack of evidence that Respondent is commonly known by the disputed domain name, the lack of evidence that Respondent has made use of, or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, and the fact that the disputed domain name has been used to create and send takedown notices under the US Digital Millennium Copyright Act ("DMCA") to threaten third parties by posing as an attorney at Complainant's law firm.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith to send such fraudulent DMCA takedown notices to third parties by posing as an attorney at Complainant's law firm.

##### **B. Respondent**

On April 7, 2022, an email communication was received from a third party indicating that "We have received a copyrights notice for fenwickinc.com. as of right now we are not using the domain but we did purchase it with intent to use it. We have spent money on this domain and we would like to know if we will be financially compensated for transferring [sic] the domain." No response was received from the Registrar-confirmed email address for Respondent. According to the case file, it is unclear how this third party is related to Respondent except that they appear to share the same First Name, Aven.

#### **6. Discussion and Findings**

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark 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 has been registered and is being used in bad faith.

Although the Registrar-confirmed Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, *e.g.*, where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. UDRP panels have also typically treated a respondent's submission of a so-called "informal response" (merely making unsupported conclusory statements and/or failing to specifically address the case merits as they relate to the three UDRP elements, *e.g.*, simply asserting that the case "has no merit" and demanding that it be dismissed) in a similar manner as a respondent default. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

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

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the FENWICK trademark has been registered in the United States with priority dating back to September 30, 2003. Thus, the Panel finds that Complainant's rights in the FENWICK trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's FENWICK trademark. In this Complaint, the disputed domain name is confusingly similar to Complainant's FENWICK trademark because, disregarding the ".com" generic Top-Level Domain ("gTLD"), the trademark is contained in its entirety within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. [...] [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar [...]"). In regards to gTLDs, such as ".com" in the disputed domain names, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the term "inc" does not prevent a finding of confusing similarity between Complainant's FENWICK trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms "whether descriptive, geographical, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#) ("[E]ach of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant's [ATT trademark]"); *OSRAM GmbH v. Cong Ty Co Phan Dau Tu Xay Dung Va Cong Nghe Viet Nam*, WIPO Case No. [D2017-1583](#) ("[T]he addition of the letters 'hbg' to the trademark OSRAM does not prevent a finding of confusing similarity between the Disputed Domain Name and the said trademark.").

In view of Complainant's registration for the FENWICK trademark, and Respondent's incorporation of that trademark in its entirety in the disputed domain name, the Panel concludes that Complainant has established the first element of the Policy.

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

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain names, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. WIPO Overview, section 2.1.

It is evident that Respondent, identified by the Registrar for the disputed domain name as “Aven Ahmad”, is not commonly known by the disputed domain name or Complainant’s FENWICK trademark.

UDRP panels have categorically held that use of a domain name for illegal activity — including the impersonation of the complainant and other types of fraud — can never confer rights or legitimate interests on a respondent. Circumstantial evidence can support a credible claim made by Complainant asserting Respondent is engaged in such illegal activity, including that Respondent has improperly masked its identity to avoid being contactable. WIPO Overview 3.0, section 2.13. See e.g. *Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. D2009-1017 (“Respondent has used the domain name to pretend that it is the Complainant and in particular to create false emails pretending that they are genuine emails coming from the Complainant and one of its senior executives.”). In this Complaint, Complainant has proffered strong evidence to establish that Respondent registered and used the disputed domain name in a clear attempt to impersonate an attorney at Complainant’s law firm to send fraudulent DMCA takedown notices to third parties. Specifically, Respondent sent a DMCA takedown notice from “[...]@fenwickinc.com”, impersonating a specific attorney at Complainant’s law firm, and threatening third party online intermediaries. To this end, the second and third elements of the Policy may be assessed together (as discussed further below) where clear *indicia* of bad faith suggests that there cannot be any Respondent rights or legitimate interests. WIPO Overview 3.0, section 2.15.

In view of the absence of any evidence supporting any rights or legitimate interests in the disputed domain name, and Complainant’s clear-cut evidence that the disputed domain name has been used to send fraudulent DMCA takedown notices, the Panel concludes that Complainant has established the second element of the Policy.

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

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

UDRP panels have categorically held that registration and use of a domain name for illegal activity — including impersonation and other types of fraud — is manifestly considered evidence of bad faith. WIPO Overview 3.0, section 3.4. See *Edelman, Inc. v. Devteam Meetey*, WIPO Case No. D2016-0500 (“The bad faith of the Respondent follows from the uncontested fact that the Respondent impersonated employees of the Complainant and even used the disputed domain name in requesting a third party to pay a large amount of money to the Respondent. This can only be seen as a very clear fraudulent behavior. Registering a domain name which is confusingly similar to the trademark of a complainant and subsequently using such domain name to impersonate employees of Complainant in an attempt to commit fraud is a clear example of registration and use in bad faith. This Panel considers such behavior as an attempt to disrupt the business of the Complainant [...] by creating a likelihood of confusion with the Complainant’s trademark”); see also *Sumitomo Dainippon Pharma Co., Ltd., Sunovion Pharmaceuticals Inc. v. Raid Benson*, WIPO Case No. D2018-2893 (finding bad faith when the domain name was used to create email addresses that were used to defraud third parties by impersonating employees of the complainants). Again, Complainant has produced clear email evidence establishing that Respondent purposefully targeted Complainant’s FENWICK trademark in the disputed domain name in bad faith and in furtherance of Respondent’s illegal scheme to impersonate an attorney at Complainant’s law firm, and thereby deceive third party online intermediaries into thinking that Complainant was sending DMCA takedown notices.

Moreover, where it appears that a respondent employs a privacy or proxy service merely to avoid being notified of a UDRP proceeding filed against it, UDRP panels tend to find that this supports an inference of bad faith. WIPO Overview section 3.6. Use of a privacy or proxy registration service to shield a respondent’s identity and elude or frustrate enforcement efforts by a legitimate complainant demonstrates bad-faith use and registration of a disputed domain name. See *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. D2006-0696 (the use of a proxy registration service to avoid disclosing the identity of the real party in interest is also consistent with an inference of bad faith when combined with other evidence of evasive, illegal, or irresponsible conduct).

In view of Respondent’s attempted impersonation of Complainant to deceive third party online intermediaries through fraudulent DMCA takedown notices, and Respondent’s use of a proxy registration service to mask its identity, the Panel concludes that Complainant has established the third 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 <fenwickinc.com> be transferred to Complainant.

*/Phillip V. Marano/*  
**Phillip V. Marano**  
Sole Panelist  
Date: May 3, 2022