

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited Liability Partnership v. Marcus Mekterovic Case No. D2022-4728

1. The Parties

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

The Respondent is Marcus Mekterovic, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <wessing-solicitors.com> (“the Domain Name”) is registered with Launchpad.com Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 9, 2022. On December 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 9, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 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 14, 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 the Respondent of the Complaint, and the proceedings commenced on December 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 10, 2023.

The Center appointed Dawn Osborne as the sole panelist in this matter on January 16, 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 global law firm and the owner of the mark TAYLOR WESSING registered, *inter alia*, in the European Union ("EU") as trade mark No. 2727519 for legal services, registered on March 31, 2004.

The Domain Name was registered on November 23, 2022 and does not resolve to an active web site, but has been used for a fraudulent email scheme using the name of one of the Complainant's associates.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarised as follows:

The Complainant is the owner of the mark TAYLOR WESSING registered, *inter alia*, in the EU for legal services since 2004.

The Domain Name registered in 2022 is confusingly similar to the Complainant's trade mark adding the word "solicitors", and the generic Top Level Domain ("gTLD") ".com", none of which prevents said confusing similarity.

The Respondent does not have any rights or legitimate interests in the Domain Name and is not commonly known by it.

The Domain Name does not resolve to an active web site, but has been used for fraudulent emails to impersonate the Complainant and one of its associates. This is not a *bona fide* offering of goods or services or a legitimate non-commercial or fair use. It is registration and use in bad faith disrupting the Complainant's business and intentionally attempting to opportunistically attract, for commercial gain, internet users by creating a likelihood of confusion with the Complainant's 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

A. Identical or Confusingly Similar

The Domain Name consists of part of the Complainant's mark TAYLOR WESSING (which is registered, *inter alia*, in the EU for legal services since 2004), a hyphen, the term "solicitors" and the gTLD ".com".

Previous Panels have held that 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 to that mark.

The addition of a hyphen to a complainant's mark in a domain name has been commonly held in cases under the UDRP not to prevent confusing similarity between that domain name and the complainant's mark.

Previous panels have found confusing similarity when a respondent merely adds a generic term to a complainant's mark.

The gTLD “.com” does not serve to distinguish a domain name from a complainant’s mark being a necessary part of the domain name.

The Panel agrees that the addition of a hyphen, the term “solicitors” and the gTLD “.com” to the Complainant’s mark does not prevent a finding confusing similarity between the Domain Name and the Complainant’s trade mark pursuant to the Policy.

Accordingly, the Panel holds that the Domain Name is confusingly similar to the Complainant’s registered mark.

As such the Panel holds that Paragraph 4 (a) (i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Complainant has not authorised the use of its mark. There is no evidence or reason to suggest the Respondent is, in fact, commonly known by the Domain Name.

The Domain Name has been used in fraudulent emails purporting to come from one of the Complainant’s associates and to be sent on behalf of the Complainant. Use of the name of the Complainant’s associate in the fraudulent emails shows the Respondent is aware of the Complainant and its business, rights and services. This is deceptive and confusing and amounts to phishing. As such, it cannot amount to the *bona fide* offering of goods and services or a non-commercial legitimate or fair use.

The Respondent has not answered the Complaint in this case and has not rebutted the *prima facie* case evidenced by the Complainant as set out herein.

As such, the Panelist finds that the Respondent does not have rights or a legitimate interest in the Domain Name and that the Complainant has satisfied the second limb of the Policy.

C. Registered and Used in Bad Faith

Fraudulent email scams are disruptive to a complainant’s business and evince bad faith registration and use. In the opinion of the Panelist, the use made of the Domain Name in relation to a fraudulent email scam is confusing and constitutes bad faith in that recipients of that material will reasonably believe it is connected to or approved by the Complainant, as the name of one of the Complainant’s associates is used, thereby disrupting the Complainant’s business. This shows that the Respondent had actual knowledge of the Complainant and its business, rights and services. The use of a domain name for phishing constitutes registration and use in bad faith *per se*.

The nature of the disputed domain name incorporating the term “solicitors” corresponding to the Complainant’s area of activity further demonstrates bath faith.

As such, the Panelist believes that the Complainant has made out its case that the Domain Name was registered and used in bad faith and has satisfied the third limb 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 Domain Name, <wessing-solicitors.com> be transferred to the Complainant.

/Dawn Osborne/

Dawn Osborne

Sole Panelist

Date: January 16, 2023