

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited Liability Partnership v. Ivanov Vadym
Case No. D2022-4875

1. The Parties

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

The Respondent is Ivanov Vadym, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <wessingsolicitors.com> is registered with Gandi SAS (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 20, 2022. On December 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 21, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on December 27, 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 the first amended Complaint on December 29, 2022. In response to a notification by the Center regarding the Mutual Jurisdiction, the Complainant filed the second amended Complaint on January 12, 2023.

The Center verified that the Complaint, together with the first and second 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 6, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on February 14, 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. Further procedural considerations

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent's mailing address is stated to be in Ukraine (whether this is indeed accurate is not clear), which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel has reached this conclusion in part because the Panel does not believe the Respondent's purported mailing address in Ukraine to be genuine. The disputed domain name contains the English word "solicitors" and the language of the registration agreement for it is English. In addition, the Complainant has submitted evidence of email communications in English from an email address at the disputed domain name that refer to court proceedings taking place in the United Kingdom. These circumstances support an inference that the Respondent is not actually located in Ukraine. The Panel notes that the Center sent the Notification of Complaint by email to the Respondent at its email address as registered with the Registrar, and there is no evidence that the case notification email to this email address was not successfully delivered.

The Panel also notes that the Complainant has specified in the Complainant that any challenge made by the Respondent to any decision to transfer or cancel the disputed domain name shall be referred to the jurisdiction of the Courts of the location of the principal office of the concerned registrar. In this case, the principal office of the Registrar is in France.

It is moreover noted that, for the reasons which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of a formal Response) that the Respondent registered and has used the disputed domain name in bad faith and with the intention of unfairly targeting the Complainant's goodwill in its trademark.

On this basis, the Panel concludes that the Parties have been given a fair opportunity to present their cases, and proceeds to issue the present decision on the substance of the dispute.

4. Factual Background

The Complainant is a major global law firm. Each Taylor Wessing firm across the world is a member of (or affiliated to a member of) Taylor Wessing Verein. The Taylor Wessing firms have operated under the trademark TAYLOR WESSING for 20 years in 17 locations, with 1,100 lawyers, and their combined global revenues in 2022 were in excess of GBP 400 million. Taylor Wessing has been ranked consistently for many years in Chambers Global, Legal 500 UK and Legal 500 Deutschland.

The Complainant operates its official website at the domain name <taylorwessing.com>, which it also uses for all its email addresses.

The Complainant owns a number of trademark registrations of the sign "TAYLOR WESSING" (the "TAYLOR WESSING trademark"), including the following:

- the United States of America trademark TAYLOR WESSING with registration No.2941089, registered on April 19, 2005 for services in International Classes 16, 41, and 42; and

- the European Union trademark TAYLOR WESSING with registration No.002727519, registered on March 31, 2004 for services in International Classes 9, 16, 35, 36, 38, 41, and 42.

The disputed domain name was registered on October 7, 2022. It is currently inactive.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to the TAYLOR WESSING trademark, because it contains the distinctive "Wessing" element of the trademark, and the word "solicitors" is descriptive of the nature of the Complainant's business. The combination of these two elements conveys the meaning that the disputed domain name relates to the legal services offered by the Complainant.

According to the Complainant, the Respondent does not have rights or legitimate interests in respect of the disputed domain name, which was registered many years after the establishment of the Complainant's well-known TAYLOR WESSING trademark.

The Complainant notes that the disputed domain name does not resolve to a website, but an email account has been set up with it and the Respondent has used it on at least one occasion in a fraudulent email scam. On November 15, 2022, a company received a fraudulent email from the email address [...]@wessingsolicitors.com, using the name of an Associate in the Complainant's affiliate in the United Kingdom. Three subsequent fraudulent emails were sent on November 17, November 18 and November 21, using the same email address. The Respondent claimed to represent the Complainant in relation to a case in the "High Court of UK", and claimed to be notifying the recipient of the message of an "account of EUR 52.866,94 in Blockchain" which the Respondent said was due to the recipient. The Complainant confirms that it and its Associate have no connection with the Respondent or the fraudulent emails. According to the Complainant, the email address at the disputed domain name was created by the Respondent to confuse the innocent third party in this and potentially other instances into believing the Respondent is associated with Taylor Wessing Limited Liability Partnership in a fraudulent attempt to defraud the third party into transferring funds for the benefit of the Respondent.

The Complainant contends that the disputed domain name was registered and is being used in bad faith by the Respondent, because it was registered or acquired primarily for the purpose of using it to target a third party by way of fraudulent email scams to elicit the third party into transferring funds. By using the disputed domain name and sending fraudulent emails impersonating genuine 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 trademark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name. According to the Complainant, the Respondent's registration and fraudulent use of the disputed domain name may disrupt the business and image of the Complainant by misleading members of the public into believing that the disputed domain name is connected with the Complainant or may otherwise impede members of the public searching for genuine websites of the Complainant.

B. Respondent

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

6. Discussion and Findings

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

- (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 was registered and is being used in bad faith.

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]”

The Respondent however did not respond to the statements and allegations contained in the Complaint and did not include any bases for the Respondent to retain registration and use of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has provided evidence that it is the owner of the TAYLOR WESSING trademark. Therefore, the Panel is satisfied that the Complainant has established its rights in this trademark for the purposes of the present proceeding.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the Top-Level Domain (“TLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” generic Top-Level-Domain (“gTLD”) section of the disputed domain name for the purposes of its comparison to the Complainant’s trademark.

The disputed domain name reproduces the distinctive “wessing” element of the TAYLOR WESSING trademark with the addition of the dictionary word “solicitors”, which refers to the Complainant’s legal services provided under the TAYLOR WESSING trademark. As discussed in section 1.7 and 1.8 of the [WIPO Overview 3.0](#), in 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 to that mark for purposes of UDRP standing. Where 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.

Taking the above into account, the Panel finds that the disputed domain name is confusingly similar to the TAYLOR WESSING trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant maintains that the disputed domain name has been used for setting up an email account that was used for sending of fraudulent emails demanding payments. The Complainant denies having any relationship to the Respondent or to the email account used for the sending of these emails. The Complainant has thus established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response or disputed the contentions of the Complainant.

The disputed domain name is confusingly similar to the TAYLOR WESSING trademark, and the evidence submitted by the Complainant shows that it has indeed been used for setting up an email account that was then used for the sending of emails to third parties demanding them to make payments to the sender of the emails. The messages indicated as sender an Associate at the Complainant's affiliate in the United Kingdom. The Respondent has not disputed the evidence submitted by the Complainant and has not submitted any evidence that the emails sent from the email address at the disputed domain name were not fraudulent or were authorized by the Complainant.

Taking the above into account, it appears as more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant's TAYLOR WESSING trademark and targeted it when registering and using the disputed domain name for the distribution of fraudulent emails to third parties demanding them to make illegitimate payments. Such use of the disputed domain name cannot be regarded as a legitimate activity giving rise to rights or legitimate interests in the disputed domain name.

The Panel therefore reaches the conclusion that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

As discussed in section 3.1 of the [WIPO Overview 3.0](#), given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant's trademark would also satisfy the complainant's burden.

The disputed domain name is confusingly similar to the TAYLOR WESSING trademark and includes the element “solicitors” which refers to the Complainant’s business. It has been used for setting up an email account that was then used for the sending of emails to third parties demanding them to make payments to the sender of the emails. The Respondent has not disputed the allegations and the evidence submitted by the Complainant and has not submitted any contrary evidence supporting a conclusion that the emails sent from the email address at the disputed domain name were not fraudulent.

In view of this, the Panel concludes that it is more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the TAYLOR WESSING trademark, and has used it to create a likelihood of confusion that the Complainant is the source of or has approved the messages sent from the email account at the disputed domain name in an attempt to receive financial gain by deceiving the recipients of these messages to make payments to the Respondent. Such conduct is clearly abusive and detrimental to the Complainant’s trademark.

These considerations lead the Panel to the conclusion that the disputed domain name has been registered and used in bad faith.

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 <wessingsolicitors.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: February 22, 2023