

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2023-0150

1. The Parties

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

The Respondent is Name Redacted¹.

2. The Domain Name and Registrar

The disputed domain name <taylorwessimng.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 January 12, 2023. On January 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 12, 2023, 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 January 13, 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 an amended Complaint on January 13, 2023.

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 and contact details of a lawyer at the Complainant’s firm when registering the disputed domain name. In light of the identity theft, the Panel has redacted the Respondent’s name from this decision, see *Cofra AG v. Privacy Service Provided by Withheld for Privacy ehf / Name Redacted*, WIPO Case No. [D2021-3762](#); *Virgin Enterprises Limited v. Registration Private, Domains by Proxy, LLC / Name Redacted*, WIPO Case No. [D2018-0645](#). 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case.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 January 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 23, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on March 2, 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 the registered owner of several trademarks worldwide for TAYLOR WESSING, *e.g.* United States of America trademark registration No. 2941089 TAYLOR WESSING registered on April 19, 2005 for goods and services in classes 16, 41, and 42; this mark has been duly renewed and is in force, and European Union trademark registration No 002727519 TAYLOR WESSING, registered on March 31, 2004 for goods and services in classes 9, 16, 35, 36, 38, 41, and 42. This mark has been duly renewed and is in force.

The disputed domain name was registered on January 8, 2023 and it resolves to an inactive webpage.

Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name has been used to send emails to third parties, while pretending to be a Manager/Partner of the Complainant, seemingly in order to obtain improper payment.

5. Parties' Contentions

A. Complainant

It results from the Complainant's undisputed allegations that the Complainant is a major global law firm. The firm's services are provided under the trademark TAYLOR WESSING. Each Taylor Wessing firm across the world is a member of (or affiliated to a member of) Taylor Wessing Verein and, therefore, affiliated with the Complainant. The Taylor Wessing firms operate in 17 locations, with 1,100 lawyers circa. Its origins span three centuries. Its current form, Taylor Wessing, arises from the merger of Taylor Joynson Garrett and Wessing & Berenberg-Gossler in 2002. Taylor Wessing has therefore been using the trademark TAYLOR WESSING for 20 years.

The Complainant use the domain name <taylorwessing.com> which resolve to its official website, featuring information about its activities and uses "taylorwessing.com" for all its email addresses.

The Complainant contends that its trademark TAYLOR WESSING is distinctive and is famous throughout the world.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark, since it contains the name Taylor Wessing in its entirety, save for the additional letter "m" being inserted in the word "wessing". Further, it conveys the meaning that the disputed domain name relates to the legal services offered by the Complainant.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the disputed domain name was registered many years after the establishment of the Complainant's well-known TAYLOR WESSING mark. Furthermore, the disputed domain name has been used on at least one occasion in an unlawful, fraudulent email scam. On January 11, 2023, a company received a fraudulent email from an alleged person named as a Manager/Partner of the Complainant, using the email address "@taylorwessimng.com", alleging to be a "Debt Collection

Litigation Counsel". The Respondent claimed to represent the Complainant in relation to "chasing an unpaid invoice" issued to the company. They also claimed that they had been advised to contact the company to get the matter "settled as soon as possible". The Respondent used the email address "@taylorwessimng.com" to masquerade as a genuine Partner in the Private Client group for Taylor Wessing in the United Kingdom.

The Complainant hereby confirms that it has no connection with the Registrar-identified registrant contact details, the Respondent or the fraudulent transaction, the disputed domain name or the Email Address. It is obvious that the Email Address was created by the Respondent to confuse the innocent third parties in this and potentially other instances into believing the Respondent is associated with, or part of, Taylor Wessing Limited Liability Partnership in a fraudulent attempt to defraud the third parties into transferring funds for the benefit of the Respondent.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. In fact, it 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 senior management 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 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

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (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 Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of several trademark registrations for TAYLOR WESSING, e.g. United States of America trademark registration No. 2941089 TAYLOR WESSING registered on April 19, 2005 for goods and services in classes 16, 41, and 42; this mark has been duly renewed and is in force, and European Union trademark registration No 002727519 TAYLOR WESSING, registered on March 31, 2004 for goods and services in classes 9, 16, 35, 36, 38, 41, and 42. This mark has been duly renewed and is in force.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark TAYLOR WESSING is fully included in the disputed domain name, with the addition of the letter "m" between the letters "i" and "n". Furthermore, it is the view of this Panel that the addition of the letter "m" in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Moreover, this Panel emphasizes that the case at hand is a typical case of "typosquatting", which occurs when a domain name consists of a misspelling of the complainant's trademark. According to the consensus view of UDRP case-law, a domain name which consists of a common, obvious or intentional misspelling of a trademark normally is found to be confusingly similar to such trademark, where the domain name contains sufficiently recognizable aspects of the relevant mark, see [WIPO Overview 3.0](#) at section 1.9 with further references.

Finally, the generic Top-Level Domain ("gTLD") ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did not authorize the Respondent's use of its trademarks or the registration of the disputed domain name.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

In addition, UDRP panels have categorically held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent, e.g. phishing, impersonation/passing off, or other types of fraud (see [WIPO Overview 3.0](#) at section 2.13.1 with further references). It results from the undisputed evidence before the Panel that the disputed domain has been used to send emails to third parties, while pretending to be a Manager/Partner of the Complainant, seemingly in order to obtain improper payment.

In the case at hand, the Complainant submitted substantial evidence of such illegal activities by showing the scams emails sent by the Respondent to third parties claiming to represent the Complainant in relation to "chasing an unpaid invoice" issued to them.

The Panel considers this evidence as sufficient to support the Complainants' credible claim of illegal activity by the Respondent.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of registration and use of the disputed domain name in bad faith.

This Panel agrees with the approach taken by previous UDRP panels following which the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g. to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers (see [WIPO Overview 3.0](#) at section 3.4).

As explained above, it results from the undisputed evidence submitted by the Complainant that the disputed domain name was registered using the name of one of the Complainant's Manager- Partner and has been used for sending fraudulent emails in the name of a Manager- Partner of the Complainant in order to solicit payment. In addition, the use of the disputed domain name in such an illegal scheme additionally demonstrates that the Respondent not only knew of the Complainant, its business and marks, but also attempted to pass itself off as the Complainant by the name of a Manager- Partner of the Complainant in order to solicit payment.

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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 <taylorwessimng.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: March 16, 2023