

## ADMINISTRATIVE PANEL DECISION

### Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2023-0697

#### 1. The Parties

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

Respondent is Name Redacted.<sup>1</sup>

#### 2. The Domain Name and Registrar

The disputed domain name <taylorweissing.com> (the “Domain Name”) is registered with Google LLC (the “Registrar”).

#### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2023. On February 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same date, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to Complainant on February 20, 2023, 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 February 20, 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”).

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<sup>1</sup> The Respondent appears to have used the name and/or contact details 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this Decision shall not be published due to the exceptional circumstances of this case.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 Respondent of the Complaint, and the proceedings commenced on March 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on March 29, 2023.

The Center appointed Marina Perraki as the sole panelist in this matter on April 12, 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**

Per the Complaint, Complainant is a major global law firm, providing its services under the trademark TAYLOR WESSING and maintaining its website at "www.taylorwessing.com". Complainant operates in 17 locations, with 1,100 lawyers. With combined global revenues in 2022 in excess of GBP 400 million, Complainant has been ranked consistently for many years in Chambers Global, Legal 500 UK, and Legal 500 Deutschland.

Complainant owns trademark registrations for TAYLOR WESSING including:

- the United States Trademark Registration No. 2941089, TAYLOR WESSING (word), filed on December 4, 2002 and registered on April 19, 2005, for goods and services in international classes 16, 41, and 42; and,
- the European Union Trademark Registration No. 002727519, TAYLOR WESSING (word), filed on June 7, 2002 and registered on March 31, 2004 for goods and services in international classes 9, 16, 35, 36, 38, 41, and 42.

The Domain Name was registered on February 13, 2023, and does not resolve to an active website. As per the evidence provided by Complainant, the Domain Name was used on at least one occasion in a fraudulent email scam. In particular, on February 13, 2023, namely on the same day that the Domain Name was registered, a company received a fraudulent email from a person using the name of an actual partner of Complainant, under the email address "[...]@taylorweissing.com", alleging to be a "Lawyer from Taylor Wessing LLP". Respondent claimed to represent Complainant in relation to "chasing a court order judgment" issued to the company.

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

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

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

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

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

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

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

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

Complainant has demonstrated rights through registration and use of the TAYLOR WESSING mark.

The Panel finds that the Domain Name is confusingly similar with the TAYLOR WESSING trademark of Complainant.

The Domain Name essentially incorporates the said trademark of Complainant in its entirety. This is sufficient to establish confusing similarity (*Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#)).

The addition of the letter “i” in the “wessing” portion of the Domain Name is disregarded (*Express Scripts, Inc. v. Whois Privacy Protection Service, Inc. / Domaindeals, Domain Administrator*, WIPO Case No. [D2008-1302](#)). Such addition is an obvious or intentional misspelling of Complainant’s trademark TAYLOR WESSING which supports the finding of confusing similarity to such trademark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.9).

The generic Top-Level Domain (“gTLD”) “.com” is disregarded, as TLDs typically do not form part of the comparison on the grounds that they are required for technical reasons only (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#)).

Complainant has established Policy, paragraph 4(a)(i).

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

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] are making a legitimate noncommercial 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 Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any response and has not claimed any rights or legitimate interests with respect to the Domain Name. As per the Complaint, Respondent was not authorized to register the Domain Name.

Respondent did not demonstrate, prior to the notice of the dispute, any use of the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

Complainant demonstrated that Respondent used the Domain Name for the purpose of initiating a fraudulent scheme, namely to send fraudulent emails to a company impersonating a current partner of Complainant for the only purpose of a scam. The use of the Domain Name for an illegal activity such as constructing an email composition containing the Domain Name for deceiving purposes cannot confer rights or legitimate interests on Respondent (*L'Oréal v. Cimpress Schweiz GmbH*, WIPO Case No. [DCO2017-0021](#)).

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

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

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation" are evidence of the registration and use of the Domain Name in bad faith:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or
- (ii) that 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the 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.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. As per the Complaint, Complainant's TAYLOR WESSING trademark is known for legal services. Because the TAYLOR WESSING mark had been used and registered at the time of the Domain Name registration by Respondent, the Panel finds it more likely than not that Respondent had Complainant's mark in mind when registering this Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#)).

Respondent should have known about Complainant's rights, due to the fact that Complainant's mark had goodwill when the Domain Name was registered. Furthermore, such knowledge is readily obtainable through a simple browser search due to Complainant's use of TAYLOR WESSING mark on the Internet, namely at the website "www.taylorwessing.com" (*Caesars World, Inc. v. Forum LLC*, WIPO Case No. [D2005-0517](#)).

Furthermore, the Domain Name incorporates in whole Complainant's mark plus the additional letter "i" on the "wessing" part of the Domain Name. This further indicates that Respondent knew of Complainant and chose the Domain Name with knowledge of Complainant.

Lastly, it is apparent that Respondent was aware of Complainant and Complainant's mark TAYLOR WESSING when registering the Domain Name. As Complainant demonstrated, Respondent used the Domain Name on the day it was registered, to create an email address and send a fraudulent email impersonating Complainant's partner to a company (*Arla Foods Amba v. Michael Guthrie, M. Guthrie*

*Building Solutions*, WIPO Case No. [D2016-2213](#)). In furtherance of the fraudulent email scheme impersonating the Complainant's partner, the Panel also notes that the Respondent used fraudulent contact details upon the registration of the disputed domain name, which reinforces the Panel's finding on bad faith registration.

As regards bad faith use, Complainant demonstrated that the Domain Name was used to create an email address and send email, impersonating a current partner of Complainant, to a third party inviting it, *inter alia*, to "settle" a matter. The email was sent on the date when the Domain Name was registered. The purpose of this email was to trick its recipient into believing that they were dealing with Complainant and, thus, proceeding with the requested action. Use of a domain name for purposes other than to host a website may also constitute bad faith. Such purposes include sending deceptive emails, phishing, identity theft, or malware distribution ([WIPO Overview 3.0](#), section 3.4). This pattern can be used in support of bad faith registration and use (*Arla Foods Amba v. Michael Guthrie, M. Guthrie Building Solutions*, WIPO Case No. [D2016-2213](#); [WIPO Overview 3.0](#), section 3.4).

Under these circumstances and on this record, the Panel finds no good-faith basis for Respondent's conduct *vis-à-vis* the Domain Name.

Complainant has established Policy, paragraph 4(a)(iii).

## 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, <taylorweissing.com>, be transferred to the Complainant.

*/Marina Perraki/*

**Marina Perraki**

Sole Panelist

Date: April 26, 2023