

## ADMINISTRATIVE PANEL DECISION

### Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2023-0752

#### 1. The Parties

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

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

#### 2. The Domain Name and Registrar

The disputed domain name <taylorweissing.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 February 20, 2023. On February 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 21, 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 February 22, 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 February 22, 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 the Complainant and one of its partners 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this Decision shall not be published due to the exceptional circumstances of this case.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 the Respondent of the Complaint, and the proceedings commenced on March 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 22, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on March 31, 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 major global law firm, which provides its services under the trademark TAYLOR WESSING. The Complainant owns numerous trademark registrations containing the name TAYLOR WESSING throughout the world, including the following:

- United States of America ("US") trademark registration for TAYLOR WESSING No. 2941089 registered on April 19, 2005, in classes 16, 41, and 42; and
- European Union ("EU") Trade Mark for TAYLOR WESSING No. 002727519 registered on March 31, 2004, for the goods and services in classes 9, 16, 35, 36, 38, 41, and 42.

The Complainant is the owner of the domain name <taylorwessing.com> since January 29, 2002, and has been operating its website under this domain name to promote its services and engage with clients.

The Respondent registered the disputed domain name on February 19, 2023. The disputed domain name does not resolve to an active webpage. However, the disputed domain name was used for configuring the mail server and dispatching fraudulent emails to third parties.

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

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

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

- (1) the disputed domain name is confusingly similar to its TAYLOR WESSING trademark in which the Complainant has rights. The disputed domain name contains the name "Taylor Wessing" in its entirety, save for the additional letters 'e' and 'i' being inserted in the word 'wessing'. Therefore, it is highly similar to the distinctive and famous TAYLOR WESSING trademark. Further, it conveys the meaning that the disputed domain name relates to the legal services offered by the Complainant;
- (2) the Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent used the disputed domain name in a fraudulent email scam. The Respondent impersonated a Complainant's partner who purportedly tried to collect a debt from the Complainant's clients. The Respondent is not commonly known by the disputed domain name. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, especially since the disputed domain name is not actively used by the Respondent;
- (3) the disputed domain name was registered and is being used in bad faith. The disputed domain name 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 employees of the Complainant, 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**

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (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 Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

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

According to paragraph 4(a)(i) of the Policy it should be established that the disputed domain name is identical or confusingly similar to a mark in which the complainant has rights.

The Panel confirms that for the purposes of paragraph 4(a)(i) of the Policy the Complainant has satisfied the threshold requirement of having relevant trademark rights for TAYLOR WESSING in jurisdictions throughout the world.

With the Complainant's rights in TAYLOR WESSING trademark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to the Complainant's mark.

It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The disputed domain name contains the name "Taylor Wessing" in its entirety, save for the additional letters 'e' and 'i' being inserted in the word 'wessing'. Therefore, it is confusingly similar to the TAYLOR WESSING trademark. Prior UDRP panels have recognized that confusing similarity is established for purposes of the Policy where the disputed domain name incorporates the complainant's trademark in its entirety. See [WIPO Overview 3.0](#), section 1.7.

Furthermore, the Panel considers that the misspelling of the Complainant's trademark within the disputed domain name <taylorweiessing.com> cannot prevent a finding a confusing similarity, as it adds additional letters 'e' and 'i' in the middle of the trademark, which is difficult to recognize. In addition, employing a misspelling in this way signals an intention on the part of the Respondent to confuse users seeking or expecting the Complainant ([WIPO Overview 3.0](#) at section 1.9).

The generic Top-Level Domain ("gTLD") ".com" may be disregarded for purposes of comparison under the first element, as they are viewed as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1.

For all of the above-mentioned reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

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

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark TAYLOR WESSING and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name.

The evidence in the case file shows that the Respondent is not commonly known by the disputed domain name. Nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name, because it attempted to use fraud to obtain payments from third parties.

The Complainant has credibly submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain name, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain name and is not commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

Furthermore, the Complainant provided evidence confirming that the Respondent used the disputed domain for fraudulent purposes, namely dispatching emails associated with the disputed domain name pretending to originate from the employees of the Complainant and soliciting for payment by a third party of a fake invoice. Therefore, it is difficult to see that the disputed domain name could be put into any legitimate or *bona fide* use.

The Panel notes, as it was found by the previous UDRP panels, any type of impersonation or passing off supports the finding that the respondent has no rights or legitimate interests in the domain name. See section 2.13.1 of the [WIPO Overview 3.0](#).

Moreover, given that the disputed domain name consists of a misspelling of the Complainant's trademark, the Panel struggles to conceive any legitimate interests of the Respondent in the disputed domain name. Under such circumstances, any use of the disputed domain name by the Respondent only increases the possibility of the Internet users to falsely attribute the disputed domain name to the activities of the Complainant. Such being the intent of the Respondent, considering the use of the typosquatting disputed domain name for a fraudulent email scheme impersonating the Complainant, as discussed above.

Accordingly, the Panel finds that the Complainant has made a *prima facie* case that has not been rebutted by the Respondent. Once the Complainant makes a *prima facie* case, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name.

The Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name.

With the evidence on file, it is undoubtedly established that the Respondent has no rights or legitimate interests in respect to the disputed domain name under paragraph 4(a)(ii) of the Policy.

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

Under the third UDRP element, the Complainant is required to prove that the disputed domain name was registered and is being used in bad faith.

Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that [the respondent has] registered or has 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 [the respondent's] documented out-of-pocket costs directly related to the domain name; or

(ii) [the 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 [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business or competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location.”

Considering that the Respondent has fraudulently pretended to be an employee of the Complainant, it is obvious that the Respondent was aware of the Complainant or its trademark when registering the disputed domain name. Therefore, the Panel is of the opinion that 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.

Considering that the Panel has found that the Respondent has used the disputed domain name in an attempt to fraudulently obtain funds for the benefit of the Respondent, the Respondent has not responded to the Complaint, the Respondent has used a privacy service to conceal its identity, there are no obvious good faith or legitimate uses to which the disputed domain name may be put, the Panel considers, on balance, that the disputed domain name has been registered and is used in bad faith.

Previous UDRP panels have held that the use of a domain name for purposes such as sending email, phishing, identity theft, or to send deceptive emails, *e.g.*, to obtain sensitive or confidential personal information to solicit payment of fraudulent invoices by the complainant's actual or prospective customers is evidence of registration and use of the domain name in bad faith ([WIPO Overview of 3.0](#), section 3.4).

The Respondent not only used a privacy service to mask its details, but upon the disclosure of the underlying contact details by the Registrar, it became apparent that the Respondent had engaged in identity theft, using the name and physical contact information belonging to the Complainant and one of its partners.

The Respondent failed to submit a Response, provide any evidence of good-faith use, or to show rights or legitimate interests in the disputed domain name.

For the reasons set out above, the Panel concludes that the disputed domain name was registered and is being used in bad faith, within the meaning of 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 <taylorweissing.com> be transferred to the Complainant.

*/Ganna Prokhorova/*

**Ganna Prokhorova**

Sole Panelist

Date: April 13, 2023