

## **ADMINISTRATIVE PANEL DECISION**

Fenwick & West LLP v. Brennie Brackett, Brackett Brennie  
Case No. D2024-3305

### **1. The Parties**

The Complainant is Fenwick & West LLP, United States of America ("United States"), internally represented.

The Respondent is Brennie Brackett, Brackett Brennie, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <fenwcks.com> ("the Domain Name") is registered with Register.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 13, 2024. On August 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 13, 2024, 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 (Perfect Privacy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 15, 2024, 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 August 19, 2024.

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 August 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 11, 2024.

The Center appointed R. Eric Gaum as the sole panelist in this matter on September 16, 2024. 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 law firm with numerous areas of legal practice. The Complainant owns the following United States trademark registration for the mark FENWICK, as shown in the chart below:

Mark	Reg. Date	Goods and Services
<b>FENWICK</b> Registration Number: 3836798 Serial Number: 77784163	August 24, 2010	(International Class: 45) Legal services

The Complainant also owns the domain name <fenwick.com>. The Complainant has provided legal services under the FENWICK mark since at least as early as 2003.

The Domain Name was registered on July 13, 2024, and was used to create an email address confusingly similar to the Complainant's. This email address was associated with the name of a Complainant's associated attorney, along with that attorney's actual signature and email address in the body of the email.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

The Complainant contends that it has used the FENWICK mark continuously since well prior to July 13, 2024, the registration date for the Domain Name. The Complainant owns the trademark registration for the FENWICK mark registered on August 24, 2010, and used in commerce since September 30, 2003. The Complainant uses the FENWICK mark as a service mark that identifies the Complainant's business name. The Complainant is a law firm that provides legal services under the FENWICK mark. Thus, Complainant has rights in the FENWICK mark that clearly predate the registration date of the Domain Name.

The Complainant also contends that the Domain Name incorporates a mark that's nearly identical and confusingly similar to the FENWICK mark. Here, the Domain Name merely removes the "i" and adds an "s" to the FENWICK mark ("fenwicks"). Removing the letter "i" and adding the letter "s" to the FENWICK mark does not alter the phonetic or conceptual similarity between the Domain Name and the FENWICK mark, and is clearly intended to appear as the FENWICK mark.

The Complainant further contends that on information and belief, the Respondent is not commonly known by the name or nickname of the Domain Name, or any name containing Complainant's FENWICK mark. The Respondent's Whols information in connection with the Domain Name makes no mention of the Domain Name or the Mark as the Respondent's name or nickname.

In addition, the Complainant contends on information and belief, the Respondent is using the Domain Name to impersonate an attorney at the Complainant's law firm in order to defraud a third party. The Domain Name does not resolve to an active website; instead, the Respondent only uses the Domain Name in order to create an associated email address that purports to belong to an attorney associated with Fenwick & West LLP, for the sole purpose of impersonating that attorney. The Respondent's fraudulent email correspondence uses this attorney's real name and signature in the body of the email to further the fraud. The Respondent appears to have registered this particular Domain Name to intentionally mislead a third party to believe that the fraudulent email and wire transfer instructions are coming from an attorney at the Complainant's law firm. This indicates that, on information and belief, the Respondent created the site solely for the purpose of defrauding this party.

The Complainant further contends that the evidence demonstrates that the Respondent registered and is using the Domain Name in bad faith for the following reasons:

First, the Respondent clearly knew of the FENWICK mark and its use by the law firm Fenwick & West LLP and registered a nearly identical domain name in the face of that knowledge precisely so that the Respondent could impersonate one of the law firm's attorneys. Even the high profile and arbitrary quality of the FENWICK mark makes it extremely unlikely that the Respondent created the Domain Name independently.

Second, the Respondent has no relationship with the FENWICK trademark, which is further evidence of bad faith registration and use. Here, it is evident that the Respondent has no relationship with the FENWICK trademark, since the Respondent is using it only to impersonate an attorney in the Complainant's law firm. Additionally, by using the Domain Name solely to impersonate an attorney in the Complainant's law firm in order to create a veneer of credibility to defraud a third party, the Respondent shows an intent to capitalize on the goodwill and reputation of the Complainant and the Complainant's FENWICK trademark in active bad faith.

Third, the Respondent uses the Domain Name for one reason only: to deceive and induce a third party to make a bank payment to the Respondent. The Domain Name does not lead to an active webpage; the Respondent registered it solely to create an email address confusingly similar to the Complainant's to be used in connection with an actual name of Complainant's attorney, and that attorney's actual signature and email address in the body of the email, to further its fraud and bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the Domain Name. The Domain Name merely removes the "i" and adds an "s" to the FENWICK mark ("fenwicks"). Removing the letter "i" and adding the letter "s" to the FENWICK mark does not alter the phonetic or conceptual similarity between the Domain Name and the FENWICK mark, and is clearly intended to appear as the FENWICK mark. Accordingly, the Domain Name is nearly identical and confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.9.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy or otherwise.

Furthermore, Panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off to commit fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the Domain Name solely to create an email address confusingly similar to Complainant’s, and to be associated with the name of a Complainant’s associated attorney, along with that attorney’s actual signature and email address in the body of the email, to commit fraud.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off to commit fraud, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent’s registration and use of the Domain Name constitutes bad faith under the Policy.

The Panel finds the third element of the Policy has been established.

### **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 <fenwcks.com> be transferred to the Complainant.

*/R. Eric Gaum/*

**R. Eric Gaum**

Sole Panelist

Date: September 30, 2024