

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited Liability Partnership v. Name Redacted
Case No. D2022-4396

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 <taylorwessing.com> (the “Disputed 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 November 21, 2022. On November 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same day, 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 November 22, 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 an amended Complaint on November 23, 2022.

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 of a third party (a partner of the Complainant) 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case.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 November 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 14, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on December 18, 2022. 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 an international law firm headquartered in the United Kingdom with 1,100 lawyers and global revenues in 2022 exceeding GBP 400 million. The Complainant holds a number of registrations for the trademark TAYLOR WESSING in numerous jurisdictions including, for example: United States Trademark Registration No. 2941089 for TAYLOR WESSING, registered on April 19, 2005.

The Complainant owns the domain name <taylorwessing.com> which hosts its main website.

The Respondent registered the Disputed Domain Name <taylorwessing.com> on November 7, 2022. The Disputed Domain Name resolves to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant cites its European Union Trademark Registration No. 002727519 registered on May 31, 2004 and other registrations internationally for the mark TAYLOR WESSING as *prima facie* evidence of ownership.

The Complainant submits that its rights in the mark TAYLOR WESSING predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the TAYLOR WESSING trademark and that the confusing similarity is not removed by the addition of the letter "s" to the word "taylor", or the addition of the generic Top-Level Domain ("gTLD") ".com". It submits that "(t)he mark TAYLOR WESSING is inherently distinctive and non-descriptive, and it is famous throughout the world".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it allegedly has been used in a phishing scheme "in a fraudulent attempt to defraud [a] third party into transferring funds for the benefit of the Respondent."

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules and submits that "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, [I]nternet 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

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark TAYLOR WESSING in numerous jurisdictions. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the TAYLOR WESSING trademark, the Panel observes that the Disputed Domain Name comprises: (a) a misspelling of the Complainant's trademark TAYLOR WESSING with the additional letter "s"; (b) followed by the gTLD ".com".

It is well established that the gTLD used as technical part of a domain name may be disregarded. The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "taylorswessing" (see section 1.11.1 of the [WIPO Overview 3.0](#)).

It is also well established that in cases where at least a dominant feature of the relevant mark of a complainant is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the addition of the letter "s" between the words "taylor" and "wessing" does not avoid a finding of confusing similarity between the Disputed Domain Name and the Complainant's trademark. "A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element." (see [WIPO Overview 3.0](#), section 1.9).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because (i) the Disputed Domain Name is inactive and has been used to send fraudulent e-mails to phish for payment by a third party of a fake invoice; (ii) the Respondent has not acquired or owned any trademark or service mark rights in the name TAYLOR WESSING, and has not been commonly known by the name TAYLOR WESSING; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain.

The Respondent is not using the Disputed Domain Name with legitimate interests in a domain name incorporating the Complainant's mark, and is not commonly known by the Disputed Domain Name. The Panel accepts the Complainant's uncontested submission and evidence that the Disputed Domain Name has "been used for fraudulent purposes by the Respondent."

The use of a domain name for illegal activity (*such as* impersonation, passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. Therefore, the Panel is satisfied that the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. In the absence of a response, this Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy requires that the complainant must also demonstrate that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the subsequent use of the Disputed Domain Name to enable phishing through an email address connected to the Disputed Domain Name, the Panel is satisfied that the Respondent targeted the Complainant's trademark TAYLOR WESSING when it registered the Disputed Domain Name (see *Taylor Wessing LLP v. Peter Smith*, WIPO Case No. [D2015-0701](#) ("the disputed domain name clearly reflects the Complainant's trademark, an artificial name which the Respondent must have known about to replicate so precisely in the [D]isputed [D]omain [N]ame") (see [WIPO Overview 3.0](#), section 3.2.2).

In addition, the gap of several years between registration of the Complainant's trademark and the Respondent's registration of the Disputed Domain Name, the nature of the Disputed Domain Name (containing a misspelling of the Complainant's trademark), and its use is a further indicator of bad faith. (See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Complainant's rights in its trademark predate any rights that could possibly flow from the Respondent's registration by nearly 20 years.

On the issue of use, the Complainant's evidence is that the Disputed Domain Name did not resolve to an active website and had been used in attempted phishing by using the Disputed Domain Name to send fraudulent emails impersonating a genuine employee of the Complainant in an attempting to fraudulently obtain payment from a third party of a fake invoice putatively issued by the Complainant's law firm. Past panels have held that the use of a domain name for *per se* illegitimate activity such as phishing is considered to be evidence of bad faith and this Panel accepts that the uncontested evidence of phishing in this case supports a finding of bad faith (see [WIPO Overview 3.0](#) at Section 3.1.4).

This Panel also views the provision of false contact information underlying the privacy or proxy service as an additional and separate indication of bad faith, since the notification emails seem to be undelivered to the email address provided by the Respondent to the Registrar (see [WIPO Overview 3.0](#), section 3.6).

In the absence of any evidence to the contrary, this Panel accepts the Complainant's evidence and finds that the Respondent has taken the Complainant's trademark TAYLOR WESSING and incorporated the additional letter "s" between the words "taylor" and "wessing" into the Disputed Domain Name, without the Complainant's consent or authorization, for the likely purpose of capitalizing on the reputation of the trademark to infringe upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements 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, <taylorswessing.com>, be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: December 27, 2022