

## ADMINISTRATIVE PANEL DECISION

### Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2023-0367

#### 1. The Parties

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

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

#### 2. The Domain Name and Registrar

The disputed domain name <taylorwessing.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 26, 2023. On January 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 27, 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 30, 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 31, 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 of a genuine Partner in the Private Client group for Taylor Wessing in the United Kingdom 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case.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 February 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 6, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on March 15, 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 global law firm that operates under the mark TAYLOR WESSING.

The mark TAYLOR WESSING arises from the merger of TAYLOR Joynson Garrett and WESSING & Berenberg-Gossler, in 2002.

The Complainant owns numerous TAYLOR WESSING trademark registrations in different countries and regions, such as the United States trademark No. 2941089, registered on December 4, 2002, and the European Union trademark No. 002727519, registered on March 31, 2004.

The Complainant is also the owner of the domain name <taylorwessing.com>, which is linked to its official website.

The Respondent registered the disputed domain name <taylorwessing.com> on January 25, 2023. The Panel accessed the disputed domain name on March 24, 2023, when it was not linked to any active website. However, the Complainant brought evidence that the disputed domain name was recently used to perform a fraudulent email scam, trying to impersonate its employees to obtain money transfers from third parties.

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

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

The Complainant makes the following contentions:

- The disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant owns over 15 trademark registrations containing the name TAYLOR WESSING throughout the world. The Complainant has been using the trademark TAYLOR WESSING for 20 years. The TAYLOR WESSING brand has been consistently ranked among the world's top brands in the legal industry for many years. The mark TAYLOR WESSING is inherently distinctive and non-descriptive, and it is famous throughout the world. The disputed domain name contains the name "Taylor Wessing" in its entirety, save for the additional letter "i" being inserted in the word "Taylor". Therefore, it is highly similar to the distinctive and famous TAYLOR WESSING trademark.
- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The disputed domain name was registered many years after the establishment of the Complainant's well-known TAYLOR WESSING mark. The disputed domain name does not resolve to a valid website. The disputed domain name has been used in an unlawful, fraudulent email scam, trying to impersonate employees of the Complainant and to defraud third parties into transferring funds for the benefit of the Respondent. The Complainant has no connection with the Respondent, the disputed domain name or the respective email address. There is no credible 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 – or no credible legitimate basis on which the Respondent could use the disputed domain name for *bona fide* purposes. There is no credible evidence that the Respondent has been – or no credible legitimate basis on which the Respondent could be – commonly known by the disputed domain name. There is no credible evidence that – or no credible legitimate basis on which - the Respondent is, or could be, making any legitimate noncommercial or fair use of the disputed domain name, especially since the disputed domain name is not actively used by the Respondent.

- 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 a third party by way of serious, unlawful and fraudulent email scams to elicit the third party 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. The Respondent's registration, fraudulent use, and any other use, of the disputed domain name will disrupt the business and image of Taylor Wessing by misleading members of the public into believing that the disputed domain name is connected with Taylor Wessing, and/or it will otherwise impede members of the public searching for genuine Taylor Wessing websites, due to the confusing similarity to the Complainant and its trademark registrations for TAYLOR WESSING.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (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.

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

The Panel has no doubt that TAYLOR WESSING is a trademark directly connected with the Complainant's legal services.

Annex 7 to the Complaint shows numerous trademark registrations for TAYLOR WESSING, obtained since at least 2002.

The disputed domain name contains the mark in its entirety, simply inserting a letter "i" between the letters "y" and "l" (not even changing the sonority of the expression "Taylor Wessing"), as well as adding the generic Top-Level Domain ("gTLD") ".com".

Such misspelling of the Complainant's trademark is a practice commonly called typosquatting, a kind of cybersquatting in which a respondent registers a domain name in order to take advantage of typing errors eventually made by Internet users seeking a complainant's website (see *CPP, Inc. v. Virtual Sky*, WIPO Case No. [D2006-0201](#)).

It is also already well established that the addition of a gTLD such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark, and that the Complainant has satisfied the first element of the Policy.

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

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the respondent is 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 at issue.

Based on the Respondent’s default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the use of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name. The Respondent has not indicated any reason to justify why it has chosen the specific term “tayilorwessing” to compose the disputed domain name.

There is also no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the Complainant has showed that the Respondent recently used the disputed domain name to perform a fraudulent email scam.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

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

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or 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 documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent 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 of a competitor; or

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

When the disputed domain name was registered by the Respondent (in early 2023), the trademark TAYLOR WESSING was already directly connected to the Complainant's legal services.

Besides the gTLD ".com", the disputed domain name differs from the Complainant's mark by merely adding a letter that does not even change the way the trademark TAYLOR WESSING is pronounced.

The Respondent had the opportunity to justify the adoption of this peculiar expression. It preferred to remain silent.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent, at the time of the registration of the disputed domain name, could not have been aware of the Complainant's trademark, and that the adoption of term "tayilowwessing" could be a mere coincidence.

By using the disputed domain name and sending fraudulent emails impersonating genuine senior management Taylor Wessing employees, the Respondent has intentionally attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of disputed domain name. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied the third element 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 <tayilowwessing.com> be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: March 30, 2023.