

## ADMINISTRATIVE PANEL DECISION

### Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2023-0909

#### 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 <taylorweissinglaw.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 March 1, 2023. On March 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 1, 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 March 2, 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 March 3, 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case.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 March 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 30, 2023.

The Center appointed Manuel Moreno-Torres 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 Operating in 17 locations, with 1,100 lawyers. The Complainant's combined global revenues in 2022 were more than GBP 400 million. The Complainant operates under "www.taylorwessing.com" and uses for all its email addresses.

The Complainant owns over 15 trademark registrations containing the name TAYLOR WESSING throughout the world. By way of example: United States of America Patent and Trademark Office registration number 2941089, registered on April 19, 2005, and European Union Intellectual Property Office registration number 002727519, covering business management, taxation services and legal services registered on March 31, 2004.

The disputed domain name was registered by the Respondent on February 26, 2023. While the disputed domain name resolves to an inactive website, the Complainant has provided evidence that the disputed domain name has been used in a fraudulent email scam impersonating one of its senior partners.

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

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

The disputed domain name contains the name Taylor Wessing in its entirety, save for the additional letter 'i' being inserted in the word 'wessing'. Additionally, the descriptive word "law" is inserted after '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 Taylor Wessing. Accordingly, says the Complainant, it is clear that the disputed domain name is confusingly similar to the TAYLOR WESSING trademark.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name. Thus, the Complainant notes that the disputed domain name was registered twenty years after the establishment of the well-known TAYLOR WESSING trademark. On February 27, 2023, a third-party company received a fraudulent email using the disputed domain name purporting to come from one of the Complainant's partner in relation to chasing an unpaid invoice. The Complainant confirms that the Complainant has no connection with the Respondent, the disputed domain name, the above email address or, the fraudulent transaction.

Further, the Complainant alleges that there is no credible evidence of the Respondent's use, or demonstrable preparations to use, the disputed domain name or a name corresponding to the dispute domain name in connection with a *bona fide* offering of goods or services. Neither there is credible evidence that the Respondent is commonly known by the disputed domain name, nor that the Respondent is, or could be, making any legitimate noncommercial or fair use of the disputed domain name.

As to the third requirement, the Complainant contends that the disputed domain name was registered and 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 employee 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 trademark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name.

And finally the Complainant considers, that the Respondent's registration and fraudulent use of the disputed domain name will disrupt the business and image of the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

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

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a Response. Under paragraph 14(a) of the Rules in the event of such a "default" the Panel is still required "to proceed with a decision on the complaint", whilst under paragraph 14(b) it "shall draw such inferences there from as it considers appropriate". This dispute resolution procedure is accepted by the domain name registrant as a condition of registration.

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

The Complainant has demonstrated trademarks rights over TAYLOR WESSING for purposes of the Policy, paragraph 4(a)(i).

The Panel looks at section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The Complainant has highlighted how its well-known trademark is fully reproduced in the disputed domain name save for the additional letter "i" inserted in the word "wessing" and the word "law". While the TAYLOR WESSING trademark is recognizable, the Panel looks at section 1.8 and 1.9 [WIPO Overview 3.0](#) to come to the conclusion that both, the typosquatting or, the additional term, do not prevent a finding of confusing similarity under the first element. See *Sanofi, Genzyme Corporation v. Domain Privacy*, WIPO Case No. [D2016-1193](#), *Allianz SE v. IP Legal, Allianz Bank Limited*, WIPO Case No. [D2017-0287](#).

It is also well established that the generic Top-Level Domain ("gTLD"), in this case ".com", is typically disregarded in the analysis whether the disputed domain name is identical or confusingly similar to the TAYLOR WESSING trademark.

Therefore, the first requirement is met under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests and Registered and Used in Bad Faith**

The Policy establishes a test with three layers, but the Panel finds appropriate in the present case to assess the issues of rights or legitimate interests and bad faith together. The Complainant has provided evidence of use of the disputed domain name in an attempt to impersonate one of its senior partners of the law firm in relation to “chasing an unpaid invoice” regarding to a third party by means of a fake email. This use cannot provide rights or legitimate interests.

The Panel also finds that the composition of the disputed domain name, with the minor misspelling and the additional term “law”, is such that the disputed domain name effectively impersonates the Complainant. Indeed, by sending a fake email to a third party pretending to be one of the partners of the Complainant strengthen these findings.

In any case, such use cannot provide any right or legitimate interest in the Respondent. See [WIPO Overview 3.0](#), section 2.12: “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”

Moreover, the registration and use of a domain name for such end goal tantamount bad faith registration and use. See *Temenos Headquarters SA v. Contact Privacy Inc. Customer 1242156699 / Philander Grabbe, Temenos Group AG*, WIPO Case No. [D2018-1057](#) or *Tenaris Connections B.V v. Contact Privacy Inc. Customer 1248154559, Contact Privacy Inc. Customer 1248154559 / Tomasz Butryn*, WIPO Case No. [D2020-2628](#). The Panel finds that the Respondent targeted the Complainant and its trademarks with the apparent purpose to gain some advantage illegally.

Noting the identity theft, the Panel also finds that the Respondent’s use of a privacy service is a further indication of the Respondent’s bad faith.

During year 2023 the Complainant has been involved in a number of UDRP proceedings acting as complainant. As such, *Taylor Wessing Limited Liability Partnership v. Name Redacted*, WIPO Case No. [D2023-0104](#); *Taylor Wessing Limited Liability Partnership v. Name Redacted*, WIPO Case No. [D2023-0150](#); *Taylor Wessing Limited Liability Partnership v. Name Redacted*, WIPO Case No. [D2023-0207](#); *Taylor Wessing Limited Liability Partnership v. Name Redacted*, WIPO Case No. [D2023-0546](#).

There are identical circumstances in these cases that matches with the present one: The Respondent used the Privacy Service called Contact Privacy Inc. Customer 7151571251, the Respondent appears to have used the name of a third party, in this case one of the Complainant’s senior partners, when registering the disputed domain name, the disputed domain names reproduce TAYLOR WESSING trademark with minor typosquatting, the disputed domain names are used in emails purporting to come from one of the Complainant’s partner in relation to chasing an unpaid invoice. That said and, on balance, the Panel finds that the Respondent has engaged in a pattern of registering domain names targeting TAYLOR WESSING to catch and bait third parties by way of fraudulent email scams to elicit the third parties into transferring funds.

Accordingly, the Complainant has made out the requirements of paragraphs 4(a)(ii) and (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, <taylorweissinglaw.com>, be transferred to the Complainant.

*/Manuel Moreno-Torres/*

**Manuel Moreno-Torres**

Sole Panelist

Date: April 11, 2023