

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2023-1139

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 <taylorwesisinglaw.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 14, 2023. On March 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 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 16, 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 16, 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”).

¹ 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case.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 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 18, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on April 25, 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 operating in 17 locations, with 1,100 lawyers under the TAYLOR WESSING trademark.

In addition to the domain name <taylorwessing.com> used by the Complainant to operate its official website and for all its email addresses, the Complainant is the owner of 15 trademark registrations for TAYLOR WESSING throughout the world, amongst which:

- European Union trademark registration No. 002727519, filed on June 7, 2002, and registered on March 31, 2004, subsequently renewed, in classes 9, 16, 35, 36, 38, 41 and 42; and
- United States trademark registration No. 2941089, filed on December 4, 2002, and registered on April 19, 2005, subsequently renewed, in classes 16, 41 and 42.

The disputed domain name was registered on March 5, 2023 and presently does not resolve to an active webpage. The disputed domain name has been used in connection with a fraudulent email scam impersonating one of the Complainant's partners (Annex 9 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant asserts to be a major global law firm consistently ranked for many years in Chambers Global, Legal 500 UK and Legal 500 Deutschland. According to the Complainant, its origins span three centuries and its current form, Taylor Wessing, arises from the merger of Taylor Joynson Garrett and Wessing & Berenberg-Gossler in 2002, having the Complainant been using the trademark TAYLOR WESSING for 20 years and having reached combined global revenues in 2022 in excess of GBP 400 million.

The Complainant further asserts to have established very substantial international rights in the trademark TAYLOR WESSING which is inherently distinctive and non-descriptive, and has become famous throughout the world.

Under the Complainant's view, the disputed domain name reproduces the entirety of the Complainant's trademark with the addition of a letter "i" and of the descriptive term "law", thus conveying the meaning that the disputed domain name relates to the legal services offered by the Complainant.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (a) the Respondent has used the disputed domain name in an unlawful, fraudulent email scam (Annex 9 to the Complaint) impersonating one of the Complainant's partners and claiming to represent the Complainant in relation to "chasing an unpaid invoice";

- (b) the Complainant has no connection with the Respondent, the disputed domain name or email address created by the Respondent to confuse innocent parties in a fraudulent attempt to defraud third parties into transferring funds for the benefit of the Respondent;
- (c) 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; and
- (d) there is no credible evidence that the Respondent has been or could be commonly known by the disputed domain name.

As to the registration and use of the disputed domain name in bad faith, the Complainant asserts that the by sending fraudulent emails impersonating genuine senior management 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

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has established rights in the TAYLOR WESSING trademark duly registered in several jurisdictions.

The Panel finds that the disputed domain name reproduces the dominant feature of the Complainant's mark, adding a letter "i" and the term "law". 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". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the

Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, 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
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in choosing not to respond, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent (being the overall burden of proof always with the Complainant, but once the 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).

In that sense, the Complainant indeed states that it has no connection with the Respondent, the disputed domain name or email address created by the Respondent to confuse innocent parties in a fraudulent attempt to defraud third parties into transferring funds for the benefit of the Respondent.

Also, the absence of any indication that the Respondent holds rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage available at the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Therefore, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name. The second element of the Policy has also been met.

C. Registered and Used in Bad Faith

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain name:

- a) the Complainant is a prestigious law firm with an international reach, being its name and registered trademark well known;
- b) the use of the disputed domain name in connection with a fraudulent email scam impersonating one of the Complainant's partners;
- c) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name;
- d) the fact that the disputed domain name does not currently resolve to an active website;
- e) the Respondent's choice to retain a privacy protection service; and
- f) the indication of the details of a genuine partner of the Complainant potentially characterizing identity theft.

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name.

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 <taylorwesisinglaw.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: May 9, 2023