

## **ADMINISTRATIVE PANEL DECISION**

Fenwick & West LLP v. matthew jones

Case No. D2023-3226

### **1. The Parties**

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

Respondent is matthew jones, United States.

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

The disputed domain name <us-fenwick.com> (the "Domain Name") is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 26, 2023. On July 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 27, 2023, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on July 28, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 28, 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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on August 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on September 1, 2023.

The Center appointed Maxim H. Waldbaum as the sole panelist in this matter on September 20, 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

Complainant is a well-known law firm with an address listed in Mountain View, California. It has used the trademark FENWICK since September 30, 2003, and has the FENWICK trademark registered since August 24, 2010. Complainant identifies its website as “www.fenwick.com”. Proof of the registered trademarks for FENWICK are appended as Exhibit C to the Complaint (e.g., United States Reg. No. 3836798, registered on August 24, 2010). Complainant’s rights clearly predate the Domain Name, which was created on June 25, 2023.

Complainant is a prominent law firm recognized and cited in the American Lawyer (Exhibit E), Chambers and Partners (Exhibit F), and Forbes (Exhibit G) to the Complaint. It is ranked among the best law firms in the United States (Exhibit H to the Complaint). The FENWICK Mark is used in the Complainant’s business name, Fenwick & West LLP, and its website, as reflected above. Complainant’s domain name is used for company email addresses, intercompany addresses, and communications with customers, vendors, and the general public.

#### 5. Parties’ Contentions

##### A. Complainant

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

Policy, Para. 4(a)(i); Rules, Paras 3(b)(viii), b(ix)(1))

This Rule requires that the Domain Name be identical or confusingly similar to Complainant’s rights. Complainant has used the FENWICK Mark since at least 1999 and registered FENWICK in 2010. Respondent has set forth the same Mark and added the prefix “us” to the name. Adding such a term does not avoid likelihood of confusion. In fact, the use of the additional term “us” increases confusion as Complainant is a recognized United States law firm. Further Respondent has created an email address with this Domain Name to send emails fraudulently purporting to be an attorney associated with Complainant’s firm accurate identifying information all without authorization. (Exhibit I to the Complaint).

2. The Respondent has no rights or legitimate interests in respect of the domain name

Policy, Para.4(a)(ii); Rules Para.3(b)(ix)(2))

Respondent is unlicensed and unauthorized and thus has no legitimate rights in the disputed Domain Name. This is strong evidence coupled with the extensive rights of Complainant. Respondent is not known by the Domain Name or any mark related to Complainant. Respondent is using the mark to impersonate an attorney at Complainant’s law firm. (Exhibit I to the Complaint). Respondent’s fraudulent email correspondence uses the attorney’s real name, email address, signature, and phone number to complete the fraud. *Fonds de placement immobilier Cominar/Cominar Real Estate Investment Trust v. WhoisGuard Protected, WhoisGuard, Inc / Ferdinand Robert*, WIPO Case No. [DCO2021-0020](#) ; *Speck Pumpen Verkaufsgesellschaft GmbH v. giung gong, bowman consulting*, WIPO Case No. [D2021-1976](#). There is no *bona fide* offering of goods and services. The *Kraft Heinz Food Company v. Kraft Heinz*, WIPO Case No. [D2016-2152](#).

The only reason to create and use this Domain Name is to take unfair advantage of the recognition and prominence of Complainant's law firm and to fraudulently induce third parties to make a bank payment to Respondent. It is apparent Respondent has no legitimate rights or interest in the Domain Name.

3. The domain was registered and being used in bad faith

(Policy, paras. 4(a)(iii), 4(b); Rules, Para. 3(b)(ix)(3))

Under the Policy bad faith is demonstrated, among other things, by a registrant registering the domain name primarily for the purpose of disrupting the business of a competitor or to intentionally attract, for commercial gain, Internet users to its website or other locations, by creating a likelihood of confusion with a complainant's (here Complainant's) mark as to source, sponsorship, affiliation or endorsement of a website or of a product or service on the website. WIPO Panels routinely find bad faith registration and use where a respondent creates email addresses specifically similar to a known trademark. *Valero Energy Corporation, Valero Marketing and Supply Company v. Contact Privacy Inc. Customer 1244321008/ Alyce Player*, WIPO Case No. [D2019-0852](#).

Respondent's activity is a textbook of registering and using in bad faith a disputed domain name for fraudulent purposes. Where a Respondent sends deceptive emails to obtain information or solicit a payment for fraudulent purposes, e.g., commercial gain or establish Internet confusion that is bad faith under the Policy. Clearly Respondent has registered and used the Domain Name in bad faith. Complainant has met the criteria for showing registration and use in bad faith.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

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

Policy Para. 4(a)(i); Rules Paras. 3(b)(viii), (b)(ix)(1))

Complainant has provided evidence attesting to its rights in the trademark FENWICK.

Pursuant to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements".

The addition "us-" in the Domain Name does not prevent a finding of confusing similarity.

Accordingly, Complainant has satisfied the requirements of paragraph 4(a)(i).

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

Policy Para. 4(a)(ii); Rules Para 3(b)(ix)(2))

While 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 often impossible 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. 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.

Complainant has demonstrated that Respondent created the Domain Name to confuse customers of Complainant's firm and to fraudulently impersonate at least one of Complainant's attorney through an email scheme. The use of a domain name for illegal activity can never confer rights or legitimate interests upon a respondent. WIPO Overview 3.0, section 2.13.

Furthermore, Respondent has no connection to Complainant, no trademarks that show possible rights or legitimate interests, and is not commonly known by the Domain Name given that the Respondent was disclosed to be, "matthew jones", which bears no resemblance to the Domain Name.

Accordingly, Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Policy Para 4(a)(iii), 4 (b)Rules, Para.3(b)(ix)(3))

Under the facts and evidence presented by Complainant and the failure to respond by Respondent no registration or use in good faith has or can be shown. Respondent is an individual who has decided to use the Domain Name to masquerade as an actual lawyer in Complainant's firm. He has clearly done so for some illegal purpose. Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. [WIPO Overview 3.0](#), section 3.4.

Also, Respondent's addition of "us" to the Domain Name further reflects Respondent's intentional targeting of Complainant, seeing as Complainant is well-known in the United States.

Respondent's actions and creation and use of its Domain is found to be in bad faith, meeting all the requirements 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 <us-fenwick.com> be transferred to Complainant.

*/Maxim H. Waldbaum/*

**Maxim H. Waldbaum**

Sole Panelist

Date: October 10, 2023