

ADMINISTRATIVE PANEL DECISION

Cushman & Wakefield, Inc. v. Samuel Chan
Case No. D2024-5033

1. The Parties

The Complainant is Cushman & Wakefield, Inc., United States of America ("United States" or "U.S."), represented by Loeb & Loeb, LLP, U.S.

The Respondent is Samuel Chan, China.

2. The Domain Name and Registrar

The disputed domain name <cushmanwakefieldsolutions.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 December 6, 2024. On December 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 6, 2024, 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 (Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 11, 2024, 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 December 12, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on December 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 6, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 10, 2025.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on January 17, 2025. 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 commercial real estate services firm that provides real estate leasing, management, capital markets, valuation and other related services. It generated revenues of USD 9.5 billion in 2023 and in that year was named by Commercial Property Executive as number 2 out of the 25 top commercial real estate firms in the world. The Complainant operates from over 400 offices in approximately 60 countries, has around 52,000 employees and manages about 5.1 billion square feet of commercial real estate space on behalf of institutional, corporate and private clients.

The Complainant owns a number of trademark registrations in the U.S. and globally, including (the "Trade Marks"):

- United States word mark CUSHMAN & WAKEFIELD registered on July 04, 1978, under No. 1095427
- United States word mark CUSHMAN & WAKEFIELD registered on July 17, 2007, under No. 3265011
- United States device mark CUSHMAN & WAKEFIELD registered on May 16, 2017, under No. 5205514
- United States word mark CUSHMAN & WAKEFIELD IDEAS INTO ACTION registered on August 21, 2018, under No. 5543630

The Complainant has used the word mark CUSHMAN & WAKEFIELD since 1917. In 2015, the Complainant merged with a company called DTZ.

On October 16, 2024, the Complainant sent a demand letter to the Respondent asserting rights in the Trade Marks and requesting that the Respondent transfer the Domain Name to the Complainant. The Respondent did not react to this letter.

The Domain Name resolves to an active website (the "Website") featuring the Complainant's name in the heading and advertising services similar to the Complainant's services, including real estate leasing and management, repair and maintenance, and capital markets.

The "Contact" section of the infringing Website lists the address of a third company, while the phone number listed is for the Complainant's Boston office. The Respondent set up mail servers for the Domain Name, from which emails could be sent and received. The Website contains a contact form where visitors can leave their email address to be contacted about the Respondent's services.

The Domain Name was registered on August 30, 2024.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name on the following grounds.

The Domain Name incorporates the word mark CUSHMAN & WAKEFIELD in its entirety, only deleting the ampersand, and is confusingly similar to the Trade Marks. The addition of the term "solutions" and the generic Top Level Domain ("gTLD") ".com." does not negate the confusing similarity of the Domain Name to the Trade Marks. The term "solutions" is descriptive as it refers to the range of services offered under the

Trade Marks. Consequently, this does not preclude a finding of confusing similarity between the Domain Name, and the Complainant's name and the Trade Marks for the purposes of the Policy. The gTLD ".com" in the Domain Name is viewed as a standard registration requirement and is typically considered irrelevant in assessing confusing similarity between a trademark and a disputed domain name and as such disregarded in the analysis under the first element of the confusing similarity test.

The Respondent is not related to, affiliated or connected with the Complainant in any way. The Complainant also has never licensed or authorized the Respondent to use the Trade Marks, or to register any domain name incorporating the Trade Marks. In view of this, the Respondent cannot reasonably claim an actual or contemplated bona fide or legitimate use of the Domain Name. Furthermore, the Complainant is not aware of the Respondent's use of the CUSHMAN & WAKEFIELD name or word mark prior to the Complainant's adoption and use of the Trade Marks. There is no evidence that the Respondent is using or preparing to use the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services or a legitimate non-commercial or fair use of the Domain Name within the meaning of paragraph 4(c)(i) or (iii) of the Policy.

Also, there is no evidence that the Respondent has been known by the name "Cushman Wakefield" or "Cushman Wakefield Solutions" incorporated in the Domain Name. The name of the Respondent is "Samuel Chan." Therefore, the Whois information does not contain any evidence that the Respondent is commonly known by the name "Cushman Wakefield" or "Cushman Wakefield Solutions". As such, the Website does not demonstrate that the Respondent has been known by the name "Cushman Wakefield" or "Cushman Wakefield Solutions." The Respondent was put on notice of the Complainant's rights in the Trade Marks and the Complainant's objection to the Respondent's use and registration of the Domain Name through the Complainant's demand letter. The Respondent did not respond to the letter and thus did not provide any arguments or evidence asserting that the Respondent owned any rights or legitimate interests in the Domain Name.

The Domain Name has been registered and is being used by the Respondent in bad faith for several reasons. Mere registration of a domain name that is confusingly similar to a well-known registered trademark by an unaffiliated entity by itself creates a presumption of bad faith. Furthermore, the Respondent knew of the Complainant's rights in the Trade Marks prior to registration of the Domain Name. While the Respondent registered their Domain Name on August 30, 2024, the Complainant's rights to the Trade Marks date back to 1917, which significantly predates the registration date of the Domain Name.

In addition, the Respondent has registered and used the Domain Name in furtherance of a fraudulent scheme. The Respondent set up the Website impersonating the Complainant and its services, by using the Complainant's name, listing the Complainant's Boston office phone number and advertising the Complainant's services. Further, the Respondent set up the Domain Name with a mail exchange. This, coupled with the fact that the Website impersonates the Complainant creates a risk that the Domain Name could be used to facilitate fraudulent and phishing activities.

While the Respondent has no rights or legitimate interests in respect of the Domain Name, there is no credible explanation for the Respondent's choice of the Domain Name. Moreover, the Respondent has not responded to Complainant's demand letter and has used an incorrect or incomplete address in the Whois record when registering the Domain Name. The Respondent's address is missing the street number and street name. Further, the Complainant's Internet search of the Respondent's address "could not confirm its existence. Thus, the Respondent likely provided an incomplete or invalid address in the Whois record. The fact that Respondent has taken steps to conceal his identity by providing incomplete or invalid contact information can also be considered a further inference of bad faith registration.

B. Respondent

The Respondent did not reply to the Complainant's contentions

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it incorporates the CUSHMAN & WAKEFIELD word mark in its entirety, but for the ampersand, which cannot be used in a domain name. The addition of the term “solutions” in the Domain Name does not avoid a finding of confusing similarity between the Domain Name and the Trade Marks (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8; see also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#), and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The gTLD “.com” is typically disregarded under the confusing similarity test, since it is a technical registration requirement ([WIPO Overview 3.0](#), section 1.11.1). Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See [WIPO Overview 3.0](#), section 2.1.

Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent has not received the Complainant’s authorization or consent to use the Trade Marks as part of the Domain Name, is not commonly known by the Domain Name, and has not acquired trademark rights in the Domain Name. In addition, the Respondent’s use of the Domain Names does not constitute a bona fide offering of goods or services, since the Domain Name resolves to a website which creates the false impression of a relationship with or authorization of its services by the Complainant, *inter alia* by including the Complainant’s name, listing the Complainant’s Boston office phone number and advertising the Complainant’s services on the website. In addition, the Respondent has set up an email server under the Domain Name, which, together with the impersonation of the Complainant on the website and the contact form on the Website for visitors to leave their email address, creates the risk of phishing or other fraudulent activity.

In view of the above, the Panel concludes that the Complainant has established that the Respondent has no rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. This list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, leaves open that other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. See [WIPO Overview 3.0](#), section 3.2.1.

Based on the undisputed information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the Domain Name the Respondent was or should have been aware of the Trade Marks, since:

- the Respondent's registration of the Domain Name occurred some forty-six years after the registration of the earliest of the Trade Marks;
- the Trade Marks have a worldwide reputation, as evidenced, inter alia, by the worldwide presence of the Complainant and the services provided under the Trade Marks and the ranking by Commercial Property Executive of the Complainant as number 2 out of the 25 top commercial real estate firms in the world in 2023; and
- a simple trademark register search, or even an Internet search, prior to registration of the Domain Name would have informed the Respondent of the existence of the Trade Marks.

Since the Respondent has no authorization from or other affiliation with the Complainant and was or should have been aware of the Complainant's rights at the time of registration, the Domain Name was registered in bad faith.

With regard to bad faith use, the Panel finds that the use of the Trade Marks on the Website in connection with the offering of services similar or identical to those offered by the Complainant implies that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Trade Marks as to the source, sponsorship, affiliation, or endorsement of the Website and the services offered on the Website. In addition, the following circumstances taken together warrant a finding of bad faith use of the Domain Name:

- the probability that the Respondent was aware or should have been aware of the Complainant's rights in the Trade Marks;
- the fact that the Respondent has set up an email server under the Domain Name, which, together with the impersonation of the Complainant on the Website and the contact form on the Website for visitors to leave their email address, creates the risk of phishing or other fraudulent activity;
- the lack of a response to the Complainant's warning letter;
- the lack of a formal Response from the Respondent;
- the use of a proxy service upon registration of the Domain Name and, as disclosed by the Registrar, an incomplete or non-existing address, apparently to hide the identity of the Respondent.

Therefore, the Panel concludes that the Domain Name has been registered and is being used in bad faith.

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 <cushmanwakefieldsolutions.com> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: January 27, 2025