

ADMINISTRATIVE PANEL DECISION

Fenwick & West LLP v. oliver matthew

Case No. D2025-2480

1. The Parties

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

The Respondent is oliver matthew, United States.

2. The Domain Name and Registrar

The disputed domain name <us-fenwicklaw.com> is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 24, 2025. On June 24, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 24, 2025, 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 (REDACTED FOR PRIVACY (DT)) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 25, 2025, 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 June 26, 2025.

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 June 26, 2025. In accordance with the Rules, paragraph 5, the due date for Response was July 16, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 17, 2025.

The Center appointed Gregory N. Albright as the sole panelist in this matter on July 23, 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 law firm in the United States that provides legal services under the FENWICK mark.

Since as early as 1972, the Complainant has been advising and litigating on behalf of clients regarding corporate, litigation, intellectual property, and other issues. The Complainant's services, publications, and a list of some of its clients are provided on the Complainant's website at the domain name <fenwick.com>, which the Complainant registered in 1999. The Complainant has used the FENWICK mark in commerce in connection with its services since September 30, 2003. The Complainant is consistently ranked by prominent industry reporters as among the best law firms in the United States.

The Complainant uses the FENWICK mark and the associated domain name <fenwick.com> for company email addresses, and for both intercompany communication and communication with clients, vendors, and the general public. As a result, the FENWICK mark symbolizes the goodwill and reputation associated with the Complainant.

The Complainant owns the trademark registration for the FENWICK mark, with registration number 3836798, issued by the United States Patent and Trademark Office on August 24, 2010, for legal services in International Class 45.

The disputed domain name was registered on May 29, 2025. The disputed domain name does not resolve to an active webpage. The Complainant contends the disputed domain name is being used solely for purposes of fraudulent emails using the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant contends it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

First, the Complainant contends that the disputed domain name is confusingly similar to the FENWICK mark because it incorporates the entirety of the mark. In addition, the Complainant contends, the addition of "us-" and "law" to the disputed domain name does not alter its phonetic or conceptual similarity with the FENWICK mark.

Second, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not licensed or otherwise authorized the Respondent to register or use the disputed domain name. The disputed domain name does not resolve to an active website. Instead, the Respondent has used the domain associated with the disputed domain name solely to create an email address that falsely masquerades as belonging to an attorney associated with the Complainant. The Respondent's fraudulent email uses this attorney's real name and signature in the body of the Respondent's email and seeks to defraud a third party into disclosing confidential financial information and making a bank payment to the Respondent.

Third, the Complainant asserts that bad faith registration and use may be found where, as here, the registrant knew or should have known of the registered mark prior to registering the disputed domain name. The Complainant also contends that the Respondent clearly knew of the FENWICK mark and its use by the

Complainant, and the Respondent knowingly registered a nearly identical domain name so the Respondent could impersonate one of the firm's attorneys. The Respondent's activity here is a textbook example of registering and using the disputed domain name in bad faith within the meaning of the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced and is recognizable within the disputed domain name, and the disputed domain name is therefore confusingly similar to the Complainant's mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7

Although the addition of other terms (here "us-" and "law") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In addition, panels have held that the use of a domain name for illegitimate or illegal activity (here, the Respondent's claimed impersonation of one of the Complainant's attorneys for fraudulent purposes) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel accordingly finds the second element of the Policy has been established.

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. Other circumstances may also be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent registered the disputed domain name some 15 years after the Complainant registered the FENWICK mark in the United States. The evidence adduced by the Complainant supports the conclusion that the Respondent must have known about the Complainant and its mark when the Respondent registered the disputed domain name, and the Respondent did so for the purpose of creating confusion about a purported association between the Complainant and the disputed domain name. The disputed domain name's use of "us-" and "law" together with the FENWICK mark reinforces the false suggestion that the disputed domain name is associated with the Complainant, its geographical location, and its legal services. The Panel finds the Respondent registered the disputed domain name in bad faith.

Panels have held that the use of a domain name in connection with illegitimate or illegal activity, such as the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's use of the disputed domain name in this case constitutes bad faith under the Policy. Specifically, the Complainant has shown the Respondent used an email address associated with the disputed domain name to impersonate one of the Complainant's attorneys for the purpose of defrauding a third party.

The Panel finds that the Complainant has established 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 <us-fenwicklaw.com> be transferred to the Complainant.

/Gregory N. Albright/

Gregory N. Albright

Sole Panelist

Date: August 6, 2025