

## ADMINISTRATIVE PANEL DECISION

### Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2022-4471

#### 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 <taylorwessingslaw.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 November 23, 2022. On November 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 23, 2022, 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 November 24, 2022, 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 November 24, 2022.

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 third party (a partner of the Complainant) when registering the disputed domain name. In light of the apparent identity theft, the Panel has redacted 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 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex to this Decision shall not be published due to the exceptional circumstances of this case. See *ASOS plc. v. Name Redacted*, WIPO Case No. [D2017-1520](#); *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 November 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 15, 2022. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent's default on December 20, 2022.

The Center appointed Oleksiy Stolyarenko as the sole panelist in this matter on December 22, 2022. 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 providing services under the TAYLOR WESSING trademark. Through a number of affiliates and member companies, the Complainant operates in 17 locations employing around 1,100 lawyers.

The Complainant is using the TAYLOR WESSING trademark for provision of legal services for the last 20 years. The Complainant's brand has been consistently ranked among the world's top brands in the legal industry for many years.

The Complainant's combined global revenues in 2022 were in excess of GBP 400 million.

The Complainant has registered a number of TAYLOR WESSING trademarks worldwide covering business management, taxation services and legal services in classes 35, 36, and 42 and other services related to the activities of the Complainant. Some of the TAYLOR WESSING trademark registrations are indicated below:

- United States of America ("US") trademark registration for TAYLOR WESSING No. 2941089 registered on April 19, 2005, in classes 16, 41, and 42;
- European Union ("EU") trademark for TAYLOR WESSING No. 002727519 registered on March 31, 2004, for the goods and services in classes 9, 16, 35, 36, 38, 41, and 42.

The Complainant is the owner of the domain name <taylorwessing.com> since January 29, 2002, and has been operating the website under this domain name to promote its services and engage with clients.

The Respondent registered the disputed domain name on November 15, 2022. The disputed domain name does not resolve to an active webpage. However, according to the Complainant, the disputed domain name was used for configuring the mail server and dispatching fraudulent emails to third parties.

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

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

The Complainant contends that it has established rights in TAYLOR WESSING trademark by virtue of its longstanding use and registration of the marks in a number of jurisdictions around the world.

The trademark TAYLOR WESSING is inherently distinctive and non-descriptive, and it is famous throughout the world.

The Complainant argues that the disputed domain name is confusingly similar to the Complainant's TAYLOR WESSING trademark as it incorporates the Complainant's registered TAYLOR WESSING trademark entirely. The addition of the letter "s" and the dictionary word "law" at the end of the Complainant's trademark does not make the Complainant's trademark less visible in the disputed domain name and it will be instantly understood by the Internet users as a reference to the legal services offered by Complainant.

Further, addition of the word “law” conveys the meaning that the disputed domain name relates to the legal services offered by the Complainant.

The Respondent has no rights or legitimate interests in the disputed domain name and the Respondent has registered the disputed domain name many years after the establishment of the Complainant’s well-known TAYLOR WESSING mark.

The disputed domain name does not resolve to an active website, however, the Complainant alleges that the Respondent was using the disputed domain name and the name of the Complainant opportunistically to make targeted, fraudulent requests and elicit the transfer of funds from a third party.

The Complainant has not authorized the Respondent to use the TAYLOR WESSING trademark in the disputed domain name or in any way to use the Complainant’s name or names of the Complainant’s employees.

The Respondent is not commonly known by the disputed domain name.

The Respondent was fully aware of the Complainant’s reputation and the Complainant’s rights on the TAYLOR WESSING trademarks when the Respondent registered the disputed domain name.

The disputed domain name was registered in bad faith for the purpose of fraudulently obtaining funds and personal information from the third parties.

The use of the disputed domain name by the Respondent is disruptive to the Complainant’s business and will harm the significant reputation that exists in the TAYLOR WESSING trademark, and members of the public would suffer as a result of the Respondent’s activity.

Therefore, the disputed domain name has been registered and used by the Respondent in an unfair manner and in bad faith. It is also inconceivable that the Respondent had any good faith intentions at the point of registering the disputed domain name.

The Complainant seeks a decision that the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

The Panel accepts that the Complainant has rights in the TAYLOR WESSING trademark, based on its EU and US trademark registrations, and continuous use in connection with provision of the legal services.

Therefore, the Panel considers that the Complainant has satisfied the threshold requirement of having relevant trademark rights.

The disputed domain name is comprised of the Complainant’s TAYLOR WESSING trademark with added letter “s” and dictionary word “law”, and combined with the generic Top-Level Domain (“gTLD”) “.com”.

Domain names that consists of a common, obvious, or intentional misspelling of a trademark are considered by panels to be confusingly similar to the relevant mark for purposes of the first element. See section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))).

Addition to the Complainant's trademark of a term does not prevent a finding of confusing similarity under the first element when the Complainant's trademark is still recognizable within the disputed domain name. See section 1.8 of the [WIPO Overview 3.0](#).

The gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#). Therefore, the Panel disregards the gTLD for the purposes of this comparison.

The Panel notes that addition of the letter "s" and dictionary word "law" after the words "taylor" and "wessing" in the disputed domain name does not prevent the Complainant's trademark from being recognizable in the disputed domain name.

Thus, the Panel finds that the disputed domain name incorporates the Complainant's TAYLOR WESSING trademark entirely.

Furthermore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's TAYLOR WESSING trademark.

For all the foregoing reasons, the Panel finds that the first element of paragraph 4(a) of the Policy has therefore been satisfied by the Complainant.

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

Paragraph 4(a)(ii) of the Policy requires the complainant to establish that the respondent has no rights or legitimate interests in the domain name. Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#). In this case, the Respondent did not rebut the Complainant's *prima facie* case regarding the lack of rights or legitimate interests.

However, the overall burden of proof remains with the Complainant. Paragraph 4(c) of the Policy provides circumstances that demonstrate the respondent's rights or legitimate interests to the disputed domain name, and that complainants frequently address to show that the activities of the respondent does not fall under the *bona fide* offering of goods or services (paragraph 4(c)(i) of the Policy), that the respondent is not commonly known by the disputed domain name (paragraph 4(c)(ii) of the Policy) and that the respondent is not involved into a legitimate noncommercial or fair use of the disputed domain name (paragraph 4(c)(iii) of the Policy).

The Panel finds that because the disputed domain name is confusingly similar to the Complainant's the TAYLOR WESSING trademark, and adds to it the descriptive term "law" associated with the services of the Complainant, any use of the disputed domain name by the Respondent carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

According to the Complainant, the Respondent is not an authorized or licensed to use the TAYLOR WESSING trademark in the disputed domain name.

Furthermore, the Complainant provided evidence confirming that the Respondent used the disputed domain for the fraudulent purposes, namely dispatching emails associated with the disputed domain name pretending to originate from the employees of the Complainant and soliciting for payment by a third party of a fake invoice.

The Panel notes, that as it was found by the previous UDRP panels any type of impersonation or passing off supports finding that the respondent has no rights or legitimate interests in the domain name. See section 2.13.1 of the [WIPO Overview 3.0](#).

Moreover, given that the disputed domain name consists of the misspelled Complainant's trademark and the descriptive term pointing to the Complainant's core business the Panel struggles to conceive any legitimate

interests of the Respondent in the domain name. Under such circumstances, any use of the disputed domain name by the Respondent only increases the possibility of the Internet users to falsely attribute the disputed domain name to the activities of the Complainant.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

Therefore, the Panel finds that the Respondent is not involved in a *bona fide* offering of goods or services (under paragraph 4(c)(i) of the Policy) and the Respondent's activities does not fall under a legitimate noncommercial use (under paragraph 4(c)(iii) of the Policy).

The Panel did not find any evidence that the Respondent is commonly known by the disputed domain name and concludes that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

Thus, the Panel finds that the Complainant has satisfied the second element of the Policy, namely paragraph 4(a)(ii).

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

As the Panel established above, the Complainant's the TAYLOR WESSING trademark was widely used in commerce well before the registration of the disputed domain name.

The Panel finds that the Respondent was well aware of the Complainant's the TAYLOR WESSING trademark when registering the disputed domain name. This conclusion is supported by the facts that the disputed domain name is confusingly similar to the Complainant's the TAYLOR WESSING trademark, the disputed domain name in addition to the misspelled Complainant's trademark contains a dictionary word "law" referencing to the core business activity of the Complainant, the disputed domain name was registered nearly 20 years after registration of the Complainant's trademark, and that the disputed domain name was used to configure the mail server to dispatch fraudulent emails impersonating the employees of the Complainant and soliciting payment of fake invoices issued in the name of the Complainant.

Previous panels found that bad faith is demonstrated when the Respondent registered the disputed domain name with the purpose of using it for unlawful purposes, profiting from the attempts to solicit business transactions with third parties while impersonating the Complainant, creating a likelihood of confusion and aiming to take undue advantage of the Complainant's reputation and goodwill. See *Minerva S.A. v. TT Host*, WIPO Case No. [D2016-0384](#).

The provision of the false contact information by the Respondent for the registration of the disputed domain name is viewed by the Panel as an additional indication of bad faith. See section 3.2.1 [WIPO Overview 3.0](#). Here, the Respondent not only used a privacy service to mask its details, but upon the disclosure of the underlying contact details by the Registrar, it became apparent that the Respondent had engaged in identity theft, using the name and physical contact information belonging to the Complainant and one of its partners.

Furthermore, the Panel finds it implausible that the disputed domain name could be used by the Respondent in good faith considering that it is confusingly similar to the Complainant's trademark and clearly references to the Complainant's core business activity. On the contrary, the Respondent has impersonated a genuine partner of the Complainant to send at least one email regarding an unpaid invoice to a third party, which indicates the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement with the Complainant.

The Respondent failed to submit a response or provide any evidence of a good-faith use or to show rights or legitimate interests in the disputed domain name.

Therefore, under the totality of the circumstances, the Panel finds the Respondent registered and used the disputed domain name in bad faith and that the Complainant consequently has satisfied the third element of the Policy, namely, paragraph 4(a)(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, <taylorwessingslaw.com>, be transferred to the Complainant.

*/Oleksiy Stolyarenko/*

**Oleksiy Stolyarenko**

Sole Panelist

Date: January 6, 2023