

ADMINISTRATIVE PANEL DECISION

Fenwick & West LLP v. fredu lassy
Case No. D2023-2268

1. The Parties

Complainant is Fenwick & West LLP, United States of America, self-represented.

Respondent is fredu lassy, United States of America.

2. The Domain Name and Registrar

The disputed domain name <fenwick-law.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 24, 2023. On May 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 25, 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 (Unknown Registrant / Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on May 29, 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 May 30, 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 June 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 23, 2023.

The Center appointed Bradley A. Slutsky as the sole panelist in this matter on July 17, 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, Fenwick & West LLP, is a law firm that has been using the FENWICK mark in commerce since at least September 30, 2003. Complainant owns a trademark registration for the FENWICK mark – United States of America Trademark Registration Number 3836798, registered on August 24, 2010. Complainant's website at "www.fenwick.com", has been registered since 1999. The disputed domain name, <fenwick-law.com>, was registered on January 24, 2023. The disputed domain name does not resolve to an active website, but Complainant alleges that Respondent has used the disputed domain name to create an email address in order to impersonate an attorney at Complainant's law firm, and attached a copy of such an email as Annex I to the Complaint.

5. Parties' Contentions

A. Complainant

Complainant asserts that the disputed domain name is confusingly similar to Complainant's FENWICK mark because it fully incorporates the FENWICK mark and merely adds "law" next to the mark. Complainant notes that its mark ordinarily is used in connection with legal services, and therefore argues that the addition of the word "law" "increases the likelihood of confusion". Complainant also asserts that "[t]he likelihood of confusion is exacerbated by the fact that ... Respondent has created an email address associated with this Domain Name to send emails fraudulently purporting to be an attorney associated with Complainant and using the attorney's and the firm's accurate identifying information, all without authorization". Complainant also asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that "[u]nlicensed, unauthorized use of a domain incorporating Complainant's trademark is strong evidence that Respondent has no rights or legitimate interests". Complainant also asserts that Respondent is not commonly known by the disputed domain name. Complainant also asserts that Respondent is using the disputed domain name to impersonate an attorney at Complainant's law firm, and that "Respondent appears to have registered this particular domain name to intentionally mislead a third party to believe that the fraudulent email and wire transfer instructions are coming from an attorney at Complainant[s] law firm. This indicates that, on information and belief, Respondent created the site solely for the purpose of defrauding this party". Complainant asserts that "Respondent's only plausible reason to register and use the Domain Name and associated email address is to take unfair advantage of the recognition and prominence associated with Complainant's FENWICK mark to fraudulently induce the third party to make a bank payment to Respondent. It is, therefore, apparent that Respondent has no rights or legitimate interests in the Domain Name". Complainant also asserts that Respondent registered and is using the disputed domain name in bad faith, and that this is evidenced by the fact that Respondent knew of Complainant's FENWICK mark "and registered a nearly identical domain name in the face of that knowledge precisely so that Respondent could impersonate one of the law firm's attorneys." Complainant notes that the fact that Respondent used the disputed domain name to create an email address that looks like the email address of a current Fenwick attorney, and sent an email with it asking about invoices and using the attorney's name, email signature, and phone number makes it apparent that Respondent knew of Complainant's FENWICK mark. Complainant also notes that Respondent has no relationship with the FENWICK mark, and has demonstrated an intent to capitalize on the goodwill of Complainant's mark. Complainant also notes that the use of the disputed domain name in order to deceive and induce a third party to make a bank payment to Respondent also is evidence of deception, fraud, and bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Pursuant to paragraph 15(a) of the Rules, a panel in UDRP proceedings "shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Under paragraph 4(a) of the Policy, Complainant must prove the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, Complainant must show that the disputed domain name is "identical or confusingly similar to a trademark or service mark in which Complainant has rights".

Complainant's trademark registration demonstrates that Complainant has rights in the FENWICK mark.

The disputed domain name consists of the FENWICK mark, followed by "-law", followed by the ".com" generic Top-Level Domain ("gTLD"). Generally, "where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. Moreover, "[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". [WIPO Overview 3.0](#), section 1.8. Thus, the addition of "-law" does not prevent a finding of confusing similarity. Similarly, the addition of the ".com" gTLD is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1 ("The applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.").

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a mark in which Complainant has rights, and that paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Complainant also must demonstrate that Respondent has "no rights or legitimate interests in respect of the domain name", paragraph 4(a)(ii) of the Policy.

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [Respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to [Respondent] of the dispute, [Respondent's] use of, or demonstrable preparations 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

(ii) [Respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [Respondent has] acquired no trademark or service mark rights; or

(iii) [Respondent is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.” Policy, paragraph 4(c).

There is no evidence that Respondent was making a *bona fide* use of the disputed domain name before receiving notice of this dispute, or that Respondent has been commonly known by the disputed domain name, or that Respondent is making a legitimate noncommercial or fair use of the disputed domain name. Rather, Complainant asserts that Respondent is using Complainant’s FENWICK mark without authorization, that Respondent is not commonly known by the disputed domain name, and that Respondent is using the disputed domain name to impersonate an attorney at Complainant’s law firm to further a payment fraud scheme.

These allegations make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, which Respondent has not rebutted. In particular, there is no evidence that Respondent used or prepared to use the disputed domain name in connection with a *bona fide* offering or goods or services, or that Respondent has been commonly known by the disputed domain name, or that Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain. Instead, the evidence indicates that Respondent registered and is using the disputed domain name not to be identified as Respondent, but to be identified as associated with Complainant, and is using an email address at the disputed domain name to attempt to conduct a commercial activity that is not *bona fide* or a fair use. See, e.g., *Fonds de placement immobilier Cominar/Cominar Real Estate Investment Trust v. WhoisGuard Protected, WhoisGuard, Inc. / Ferdinand Robert*, WIPO Case No. [DCO2021-0020](#) (“impersonating a complainant by using a disputed domain name as part of an email address in the furtherance of a fraudulent scheme constitutes prima facie evidence of no rights”); *Skyscanner Limited v. Mohan Pillai*, WIPO Case No. [D2020-3172](#) (finding a lack of rights or legitimate interests where “Respondent has not been authorized to use the Complainant’s mark, and there is no indication that the Respondent has been commonly known by the disputed domain name within the contemplation of paragraph 4(c)(ii) of the Policy”, and where Respondent allegedly “used the disputed domain name to commit business impersonation fraud”); [WIPO Overview 3.0](#), section 2.13.1 (“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”).

Accordingly, the record supports a conclusion that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Complainant also bears the burden of establishing that the “domain name has been registered and is being used in bad faith”. Policy, paragraph 4(a)(iii). As set forth in the Policy, paragraph 4(b):

“[T]he following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [Respondent has] registered or [Respondent has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to [C]omplainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of [Respondent’s] documented out-of-pocket costs directly related to the domain name; or

(ii) [Respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [Respondent has] engaged in a pattern of such conduct; or

(iii) [Respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] web site or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of [Respondent's] website or location or of a product or service on [Respondent's] website or location."

"Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to Complainant's trademark would also satisfy Complainant's burden."

[WIPO Overview 3.0](#), section 3.1.

Complainant asserts that Respondent registered and is using the disputed domain name "solely to create an email address confusingly similar to Complainant's to be used in connection with an actual name of Complainant's attorney, and that attorney's actual signature, email address and phone number in the body of the email, to further its fraud and bad faith". Complainant also asserts that Respondent knew of Complainant's FENWICK mark at the time Respondent registered the disputed domain name, and that Respondent has no relationship to the FENWICK mark. Respondent has not sought to controvert these allegations.

As noted in the [WIPO Overview 3.0](#), section 3.4, "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. (In some such cases, the respondent may host a copycat version of the complainant's website.) Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers".

Consistent with the WIPO Overview, UDRP panels have found that such registration and use of a confusingly similar domain name with no rights or legitimate interests constitutes bad faith under paragraph 4(b)(iv) of the Policy. See, e.g., *Fonds de placement immobilier Cominar, supra* ("registration and use of a domain name for phishing or fraudulent purposes constitutes evidence of bad faith"); *Valero Energy Corporation and Valero Marketing and Supply Company v. WhosiGuard Protected / Froedtert Health*, WIPO Case No. [D2020-2755](#) (finding bad faith where the Respondent used the domain name <valeroenergygroup.com> "to impersonate a purported employee of Complainant Valero Energy Corporation in an attempt to persuade a third party that Complainant Valero Energy Corporation is going to place an order for computer equipment with the third party. Respondent then, allegedly, directs the third party to send the computer equipment to Respondent"); *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#) ("The Panel notes that Respondent's use of the Domain Name which incorporates Complainant's trademark in its entirety indicates that Respondent possibly registered the Domain Name with the intention to attract, for commercial gain, Internet users to its website or other on-line location by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship or affiliation of its location, as per paragraph 4(b)(iv) of the Policy. Furthermore, the Panel accepts Complainant's undisputed submission that bad faith registration and use of the Domain Name is further indicated by the fact that there is strong suspicion of Respondent using the Domain Name in a phishing scam.").

Similarly, registration and uses of a domain name knowing that it is confusingly similar to a third party's mark, and without any relationship with the mark, also is evidence of bad faith. *Façonnable SAS v. Names4sale*, WIPO Case No. [D2001-1365](#) ("A finding of bad faith may be made where the Respondent 'knew or should have known' of the registration and use of the trademark prior to registering the domain name"); *The Kraft*

Heinz Foods Company v. Kraft Heinz, WIPO Case No. [D2016-2152](#) (“the registration of a domain name that is confusingly similar to a trademark by an entity that has no relationship to that mark may be sufficient evidence of opportunistic bad faith”).

Accordingly, the Panel finds that the record supports a conclusion that the disputed domain name has been registered and is being used in bad faith, and that paragraph 4(a)(iii) of the Policy is satisfied.

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, <fenwick-law.com>, be transferred to Complainant.

/Bradley A. Slutsky/

Bradley A. Slutsky

Sole Panelist

Date: July 31, 2023