

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited Liability Partnership v. Name Redacted Case No. D2023-4656

1. The Parties

The Complainant is Taylor Wessing Limited Liability Partnership, United Kingdom (“UK”), represented internally.

The Respondent is Name Redacted, United States of America (“United States” or “US”).¹

2. The Domain Name and Registrar

The disputed domain name <taylorwessing.com> is registered with Squarespace Domains II LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 9, 2023. On November 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 24, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 27, 2023, 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 27, 2023.

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the 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 the 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

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 November 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 19, 2023.

The Center appointed Geert Glas as the sole panelist in this matter on December 22, 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

The Complainant is a major global law firm with operations in 17 locations and employs 1,100 lawyers. It arose from the merger in 2002 of Taylor Joynson Garrett with Wessing & Berenberg-Gossler. Since then, the Complainant provides legal services under the “Taylor Wessing” name. In 2022, the Complainant’s combined global revenues were in excess of GBP 400 million.

The Complainant owns over 15 trademark registrations throughout the world containing the Taylor Wessing name and covering primarily legal services, business management and taxation services in classes 35, 36, and 42. These trademark registrations include

- US trademark registration n° 2941089 filed on December 4, 2002, registered on April 19, 2005; and
- European Union trademark registration n° 002727519 filed on June 7, 2002, registered on March 31, 2004.

The Complainant also owns the domain name <taylorwessing.com> and operates its website at the URL “www.taylorwessing.com”. This domain name <taylorwessing.com> is also used for all its e-mail addresses.

The Respondent has registered the disputed domain name under the name of a partner in the UK Private Client Group of the Complainant, which was confirmed by the Registrar. The Complainant’s partner has confirmed that she has no connection with the Respondent and with the use which the Respondent has made of the disputed domain name.

The disputed domain name was registered on November 5, 2023.

The identity of the Respondent was initially shielded behind the privacy service, “Contact Privacy Inc. Customer 7151571251”. No further information on the Respondent is known as the Respondent failed to file a response.

It appears that the disputed domain name was used on November 6, 2023, when several emails sent from a fraudulent email address composed from the disputed domain name and using the Complainant’s partner’s name urged companies to avoid legal action by promptly paying an alleged invoice of the Complainant that would have remained unpaid. This email signature also contained the correct address of the Complainant’s London office. Several of these companies have alerted the Complainant of having received such email which they qualified as “scam”, “phishing”, or “impersonation”.

The disputed domain name does not resolve to any active website.

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 disputed domain name.

Notably, the Complainant contends that its TAYLOR WESSING trademarks are inherently distinctive and non-descriptive and are famous throughout the world. The disputed domain name is confusingly similar to its TAYLOR WESSING trademarks as it contains the trademarks in their entirety, save for the additional letter "v" being inserted between the "w" and the "e".

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name as the Respondent is merely using the disputed domain name and the name of the Complainant opportunistically to make targeted, fraudulent requests and elicit the transfer of funds from third parties. According to the Complainant, there is no credible evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services and no credible legitimate basis on which the Respondent could use the disputed domain name for *bona fide* services.

Finally, the Complainant contends that the disputed domain name was registered for the purpose of using it to target third parties by way of an unlawful and fraudulent email scam to elicit them into transferring funds. By using the disputed domain name in such email scam and thereby impersonating a senior management employee of the Complainant, the Respondent is intentionally attempting to opportunistically attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's famous TAYLOR WESSING mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name.

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.

Based on the available record, the Panel finds 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 Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The only difference between the disputed domain name and the TAYLOR WESSING trademarks of the Complainant is the presence of an additional letter "v" between the "w" and the "e". This misspelling is however hardly noticeable, both visually and phonetically, and does not prevent the confusing similarity between the disputed domain name and the TAYLOR WESSING trademarks. [WIPO Overview 3.0](#), section 1.9.

Based on the available record, 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 evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

There is indeed no evidence whatsoever of the Respondent using the disputed domain name (or having demonstrable plans for such use) with a *bona fide* offering, of the Respondent being commonly known by the disputed domain name or of the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

To the contrary, the Respondent has used the disputed domain name in fraudulent emails trying to elicit funds from third parties. The Respondent has thereby impersonated the Complainant not only by using the Complainant’s corporate identity, Taylor Wessing LLP, in the signature of these emails but also by using the name of a partner in the UK office of the Complainant.

Panels have held that the use of a domain name for illegal activity, as applicable to this case phishing and impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel 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.

As to the registration of the disputed domain name, it should be noted that panels have consistently found that the mere registration of a domain name which is confusingly similar (particularly domain names comprising typos) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4

This is clearly the case here, not only because TAYLOR WESSING is a widely-known trademark of an entity which confirms to have no connection whatsoever with the Respondent, but also because it cannot be envisaged how the disputed domain name with its intentional misspelling could be put to any *bona fide* use.

The disclosed identity of the Respondent offers additional evidence of the bad faith registration of the disputed domain name as the Respondent impersonated the same partner in the UK office of the Complainant in whose name scam letters were sent on November 6, 2023, one day after the registration of the disputed domain name.

Based on the available record, the Panel finds that the disputed domain name has been registered in bad faith.

The Respondent has used the disputed domain name by sending emails sent from an email address impersonating one of the Complainant's partners, even containing her signature, to companies urging them to avoid legal action by promptly paying an alleged invoice of the Complainant that would have remained unpaid. This email signature contained the Complainant's corporate name (without the typo) and the correct address of the Complainant's London office.

It is clear from the facts that this use constitutes a fraudulent scam as rightly pointed out by some of the addressees of the emails who have alerted the Complainant to what they themselves called a "scam", "phishing" or "impersonation".

By using a domain name which contains a hardly noticeable misspelling, by using the correct name and address of the Complainant in the email, and by having the email signed with the name of an actual partner in the Complainant's London office, the Respondent has made it even more likely that a third party would be lured into thinking that an outstanding invoice of the Complainant had to be settled by making a payment to the Respondent and would fall victim to the Respondent's fraudulent ploy.

Panels have held that the use of a domain name for illegal activity, as applicable to this case: phishing, and impersonation/passing off, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

It can be deduced from these facts that the Respondent has, by its use of the disputed domain name in emails, intentionally attempted to obtain online payments from third parties by creating a likelihood of confusion with the Complainant and its mark (Policy, paragraph 4(b)(iv)). As a result, and based on the available record, the Panel finds that the Complainant's registration and use of the disputed domain name constitutes bad faith under the Policy and that the third element of the Policy has been established.

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 <taylorwvessing.com> be transferred to the Complainant.

/Geert Glas/

Geert Glas

Sole Panelist

Date: January 5, 2024