

## ADMINISTRATIVE PANEL DECISION

Fenwick & West LLP v. Name Redacted

Case No. D2024-0820

### 1. The Parties

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

Respondent is Name Redacted. <sup>1</sup>

### 2. The Domain Name and Registrar

The disputed domain name <fenwickslp.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 February 23, 2024. On February 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 23, 2024, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on February 28, 2024, 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 February 28, 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”).

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<sup>1</sup>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 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this Decision shall not be published due to the exceptional circumstances of this case.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](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on March 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on March 28, 2024.

The Center appointed Timothy D. Casey as the sole panelist in this matter on April 8, 2024. 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 is a law firm providing legal services under the FENWICK trademark since as early as 1972, including corporate, litigation, intellectual property and other legal services. Complainant has been considered among the best law firms in the United States of America and been highly rated by news services and well-regarded directories in the legal industry. Complainant registered the domain name <fenwick.com> in 1999 and has used the FENWICK mark since at least 2003.

Complainant has a registration for FENWICK (the "FENWICK Mark") as follows:

Mark	Jurisdiction	Class(es)	Registration No.	Registration Date
FENWICK	United States of America	45	3836798	August 24, 2010

The disputed domain name was registered on January 31, 2024. At the time of filing the Complaint, the disputed domain name did not resolve to any website. Complainant provided evidence indicating that the disputed domain name was utilized in an email impersonating an attorney at Complainant's law firm.

#### 5. Parties' Contentions

##### A. Complainant

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

Notably, Complainant contends that it has rights in the FENWICK Mark, as evidenced herein, and that the disputed domain name is identical or confusingly similar to the FENWICK Mark because the disputed domain name incorporates the FENWICK Mark in its entirety and the addition of an "s" and "llp" in the disputed domain name do nothing to reduce the confusing similarity. Complainant contends that the addition of "s" and "llp" increases the likelihood of confusion, when considering the manner in which the disputed domain name has been utilized by Respondent.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name as evidenced by Respondent's unlicensed and unauthorized utilization of the disputed domain name.

Complainant contends Respondent is not commonly known by the disputed domain name or any name containing the FENWICK Mark. Complainant alleges that Respondent has utilized the disputed domain name to impersonate an attorney at Complainant's law firm to intentionally mislead and defraud a third party, and therefore has no rights or legitimate interests in the disputed domain name. Nor does such utilization, contends Complainant, constitute a bona fide offering of goods or services.

Complainant contends that Respondent's registration of the disputed domain name was in bad faith as it was done so for the purpose of disrupting Complainant's business and intentionally attempting to attract, for commercial gain, Internet users to its website or other location by creating a likelihood of confusion with the FENWICK Mark. Such bad faith, along with bad faith utilization, is evidenced by Respondent's registration of a domain name nearly identical to Complainant's own domain name, with which Respondent has no

relationship, and Respondent's impersonation of an attorney at Complainant's law firm in an attempt to intentionally mislead and defraud a third party into paying money to Respondent.

## **B. Respondent**

Respondent did not reply to 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 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 within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the FENWICK Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, an "s" and "llp", which generally stands for "limited liability partnership", 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 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

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

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.

In the present case, the Panel notes that Respondent has registered and used the disputed domain name to disrupt the business of Complainant and intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the FENWICK Mark.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may 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.

Although the disputed domain name does not resolve to an active website, panels have found that the non-use of a domain name (including a blank or inactive page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Panels have also held that the use of a domain name for illegal activity here, claimed phishing and impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that 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 <fenwickslp.com> be transferred to Complainant.

*/Timothy D. Casey/*

**Timothy D. Casey**

Sole Panelist

Date: April 22, 2024