

ADMINISTRATIVE PANEL DECISION

Taylor Wessing Limited v. Name Redacted
Case No. D2024-3344

1. The Parties

The Complainant is Taylor Wessing Limited, United Kingdom, represented by Taylor Wessing LLP, United Kingdom.

The Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <taylorwessinglawyer.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 August 14, 2024. On August 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 15, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 16, 2024, 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 August 19, 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").

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the clear 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Annex 1 to the Registrar as part of the order in this proceeding and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case.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](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 23, 2024.

The Center appointed Beatrice Onica Jarka as the sole panelist in this matter on September 27, 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

The Complainant is a major global law firm. The firm's services are provided under the trade mark TAYLOR WESSING.

Each office of the Complainant's firms across the world is a member of (or affiliated to a member of) Taylor Wessing Verein and, therefore, affiliated with the Complainant. The Taylor Wessing firms operate in 17 locations, with 1,200 lawyers.

The Complainant owns the trade mark TAYLOR WESSING. In this respect, the Complainant owns over 15 trade mark registrations containing the name TAYLOR WESSING throughout the world. These include United States of America ("United States") trade mark registration number 2941089 (registered on April 19, 2005, covering goods and services in classes 16, 41, and 42) and European Union trade mark registration number 002727519 for the word mark TAYLOR WESSING, registered on March 31, 2004, covering business management, taxation services and legal services in classes 9, 16, 35, 36, 38, 41, and 42.

The Complainant has therefore been using the trade mark TAYLOR WESSING for 20 years.

The Complainant uses the flagship domain name <taylorwessing.com>. The Complainant operates its official website at "www.taylorwessing.com" and uses the domain name <taylorwessing.com> for all its email addresses.

The Taylor Wessing brand has been consistently ranked among the world's top brands in the legal industry for many years.

The Complainant has accordingly established very substantial international rights in the trade mark TAYLOR WESSING. The mark TAYLOR WESSING is inherently distinctive and non-descriptive, and it is famous throughout the world.

The disputed domain name appears to have been registered on August 13, 2024. The Respondent appears to have used the name of a third party living in the United States when registering the disputed domain name. While the disputed domain name resolves to an inactive webpage, featuring a statement, "[w]e're under construction. Please check back for an update soon," the evidence reflects its use in a fraudulent email scheme impersonating one of the Complainant's employees and requesting payment for the Complainant's services.

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:

- the disputed domain name incorporates the Complainant's trade mark in its entirety.
- the disputed domain name is identical to the Complainant's trade mark, save for the word "lawyer" added at the end, which given that Complainant provides legal services, the use of the identifier "lawyer" in the disputed domain name creates an even stronger connection with the Complainant.
- the Respondent has no rights or legitimate interests in respect of the disputed domain name, as the disputed domain name was registered on August 13, 2024, many years after the establishment of the Complainant's well-known TAYLOR WESSING mark.
- the disputed domain name does not resolve to a valid website using URL "www.taylorwessinglawyer.com".
- it has come to the Complainant's attention that the Respondent has used the disputed domain name on at least one occasion in an unlawful, fraudulent email scam (the "Scam").
- on August 14, 2024, at least two companies received a fraudulent email from the Respondent, using the email address "[...]@taylorwessinglawyer.com", alleging to be a "Debt Collection Litigation Counsel, where the Respondent claimed to represent the Complainant in relation to chasing an "an unpaid invoice for professional services".
- the Respondent also claimed that payment of the invoice was due on April 26, 2024 and despite previous attempts to request payment, they have not received any response (the "Fraudulent Transaction").
- the Respondent used the email address "[...]@taylorwessinglawyer.com" (the "Email Address") to masquerade as one of the Complainant's employees, who is a genuine Partner in the Private Client group for Taylor Wessing in the United Kingdom.
- the Complainant hereby confirms that real Partner impersonated by the Respondent has no connection with the Respondent or the Fraudulent Transaction.
- the Complainant hereby confirms that the Complainant has no connection with the Respondent, the disputed domain name or the email address.
- the Complainant also confirms that it had not, until it was made aware of the Scam, heard of the Email Address. In these circumstances it is obvious that the Email Address was created by the Respondent to confuse the innocent third parties in these (and potentially other) instances into believing the Respondent is associated with, or part of, Taylor Wessing Limited Liability Partnership in a fraudulent attempt to defraud the third parties into transferring funds for the benefit of the Respondent.
- Accordingly, the Respondent is 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;
- there is no credible evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services – or no credible legitimate basis on which the Respondent could use the disputed domain name for bona fide purposes;
- there is no credible evidence that the Respondent has been – or no credible legitimate basis on which the Respondent could be – commonly known by the disputed domain name; and
- there is no credible evidence that – or no credible legitimate basis on which - the Respondent is, or could be, making any legitimate noncommercial or fair use of the disputed domain name, especially since the disputed domain name is not actively used by the Respondent.
- the disputed domain name was registered or acquired primarily for the purpose of using it to target third parties by way of a serious, unlawful and fraudulent email scams to elicit the third parties into transferring funds.
- by using the disputed domain name and sending fraudulent emails impersonating genuine senior management Taylor Wessing employees, 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.
- the Respondent's registration, fraudulent use, and any other use, of the disputed domain name will disrupt the business and image of Taylor Wessing by misleading members of the public into believing that the disputed domain name is connected with Taylor Wessing, and/or it will otherwise impede

members of the public searching for genuine Taylor Wessing websites, due to the confusing similarity to the Complainant and its trade mark registrations for Taylor Wessing.

B. Respondent

Although properly summoned, the Respondent did not reply to the Complainant's contentions.

5. 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 within the disputed domain name, while adding the word "lawyer" at the end. Accordingly, the disputed domain name is confusingly similar to the Complainant mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Accordingly, 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.

It is self-evident from the record that:

- there is no credible evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services – or no credible legitimate basis on which the Respondent could use the disputed domain name for bona fide purposes;
- there is no credible evidence that the Respondent has been – or no credible legitimate basis on which the Respondent could be – commonly known by the disputed domain name; and
- there is no credible evidence that – or no credible legitimate basis on which – the Respondent is, or could be, making any legitimate noncommercial or fair use of the disputed domain name, especially since the disputed domain name is not actively used by the Respondent.

Moreover, the record shows that the disputed domain name have been used for fraudulent purposes by the Respondent, as of August 14, 2024, at least two companies received a fraudulent email from the Respondent, using the email address “[...]@taylorwessinglawyer.com”, alleging to be a “Debt Collection Litigation Counsel” and claiming to represent the Complainant in relation to chasing an “an unpaid invoice for professional services” and finally requesting payment.

The Respondent used the Email Address to masquerade as one of the Complainant’s employees, who is a genuine Partner in the Private Client group for Taylor Wessing in the United Kingdom and for which the Complainant hereby confirms that she/he has no connection with the Respondent or the Fraudulent Transaction.

As expected, given the impersonation of an actual employee of the Complainant’s, 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.

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

Accordingly, 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 the Respondent appears to have registered and used the disputed domain name for fraudulent purposes, as it was used for sending fraudulent emails impersonating one of the Complainant’s employees in order to elicit the third parties into transferring funds. Such practice could be qualified as theft of identity.

The Panel finds that the disputed domain name appears in the light of the fraudulent emails/ theft of identity practice described above to be registered or acquired primarily for the purpose of using it to target third parties by way of a serious, unlawful and fraudulent email scams, by using the disputed domain name and sending fraudulent emails impersonating one of the Complainant’s employees which is a classical illustration of bad faith registration and use examples enumerated in the Policy at Paragraph 4(b). In this sense, all the circumstances of the case documents the intent of the Respondent in attempting to opportunistically attract, for commercial gain, Internet users by creating a likelihood of confusion with the famous Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name.

Accordingly, the Panel finds that the Complainant has established the third element of the Policy.

6. 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 <taylorwessinglawyer.com> be transferred to the Complainant.

/Dr. Beatrice Onica Jarka/

Dr. Beatrice Onica Jarka

Sole Panelist

Date: October 11, 2024