

ADMINISTRATIVE PANEL DECISION

Fenwick & West LLP v. Evan Beinstock

Case No. D2024-3611

1. The Parties

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

The Respondent is Evan Beinstock¹, United States of America.

2. The Domain Name and Registrar

The disputed domain name <fenwick.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 6, 2024. On September 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 6, 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 (Domain Administrator, See Privacy Guardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 9, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

The Center verified that the 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 While the Complaint identifies “Domain Administrator, See Privacy Guardian.org” as the “Respondent”, the Registrar disclosed “Evan Beinstock” as the underlying registrant. Under paragraph 1 of the Rules, “Respondent” means the holder of a domain-name registration against which a complaint is initiated. Since the Complaint in the present proceeding is initiated against the disputed domain name, and the Registrar has confirmed that Evan Beinstock, is the holder of the registration of the disputed domain name, the Panel accepts that Evan Beinstock is the proper Respondent in this proceeding. The above ruling does not affect the Mutual Jurisdiction under paragraph 3(b)(xii) of the Rules, since the Complainant has agreed to submit, with respect to any challenges that may be made by the Respondent to a decision by the Panel to transfer or cancel the disputed domain name, to the jurisdiction of the courts at the location of the principal office of the Registrar.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 14, 2024.

The Center appointed Dennis A. Foster as the sole panelist in this matter on October 18, 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 prominent United States of America ("USA") law firm based in California with offices elsewhere in the USA and abroad. The Complainant engages in numerous areas of legal practice and has been in business since 1972. The domain name <fenwick.com> has been registered to the Complainant since 1999.

The Complainant owns a USA federal service mark registration for the word mark FENWICK: registration no. 3836798; registration date August 24, 2010; used in commerce since September 30, 2003; Int. Class 45 for legal services. FENWICK is the short form of the Complainant's business name, whereas the full name is Fenwick & West LLP.

The Respondent is an individual located in the USA who registered the disputed domain name on August 13, 2024. The Respondent does not use the disputed domain name for a website, but only for email communications.

5. Parties' Contentions

A. Complainant

-The disputed domain name is confusingly similar to the Complainant's service mark. An obvious typo or misspelling does not change the confusing similarity.

-Unlicensed or unauthorized use of a domain name incorporating the Complainant's service mark is strong evidence that the Respondent has no rights or legitimate interests in the disputed domain name.

-The Respondent also has no rights or legitimate interests in the disputed domain name because it is being used to attempt email fraud.

-The Respondent registered the disputed domain name in bad faith because it knew or should have known about the Complainant's FENWICK service mark prior to registering the disputed domain name.

-The Respondent's activity is a textbook example of registering and using the disputed domain name in bad faith within the meaning of Policy paragraph 4(b)(iv).

-The disputed domain name should be transferred from the Respondent to the Complainant.

B. Respondent

The Respondent did not file a response in this proceeding.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must demonstrate each of the following:

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

Under paragraph 15(a) of the Rules, a Panel 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.

A. Identical or Confusingly Similar

The Complainant has exhibited proof that it owns the USA federal service mark FENWICK, whose details are set out above in the Factual Background section. As is customary under the Policy, the Panel accepts that this is proof that the Complainant has trademark rights in the name “Fenwick”. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.2.1.

The disputed domain name differs from the Complainant’s service mark only where the Respondent’s disputed domain name has replaced the “n” with an “m”. The Panel finds that this slight change still leaves the disputed domain name confusingly similar to the Complainant’s service mark.

[WIPO Overview 3.0](#), section 1.9 notes that “A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.” See also, e.g., *Fenwick & West LLP v. Privacy Service Provided by Withheld for Privacy ehf/ Be Fast*, WIPO Case No. [D2022-0835](#) (finding that the “additional letter ‘i’” in the disputed domain name <fenwiick.com> is an “intentional misspelling of Complainant’s FENWICK trademark” and that the disputed domain is confusingly similar).

The Panel therefore finds that the Complainant has carried its burden of proof under Policy paragraph 4(a)(i) to show that the disputed domain name is confusingly similar to the Complainant’s service mark.

B. Rights or Legitimate Interests

It is well-settled under the Policy that a complainant may have difficulty proving the negative proposition that a respondent has no rights or legitimate interests in a given domain name. For this reason, it is also well-settled that a complainant need only make a prima facie case that a respondent does not have rights or legitimate interests in a given domain name. Thereafter, the burden of production shifts to a respondent to come forward and show that it does have rights or legitimate interests in the disputed domain name, although the ultimate burden of proof remains on the complainant. [WIPO Overview 3.0](#), section 2.1.

In the present case, the Complainant asserts that the Respondent does not have a license or other authorization to use the Complainant’s FENWICK service mark in the disputed domain name. This constitutes a prima facie case under the Policy. [WIPO Overview 3.0](#), section 2.1.

The Respondent has not submitted a response in this proceeding, and thus has not come forward to attempt to rebut the Complainant’s prima facie case. The Policy, at paragraph 4(c), posits three ways in which the Respondent may show that he does have rights or legitimate interests in the disputed domain name. For the sake of completeness, and even in the absence of a response from the Respondent, the Panel will examine the record if there is evidence that the Respondent may have rights or legitimate interests in the disputed domain name.

First, under Policy paragraph 4(c)(i), the Respondent may have rights or legitimate interests in a disputed domain name if it is using the name to pursue a bona fide offering of goods or services. But here, the

Respondent is using the disputed domain name to impersonate an attorney at the Complainant's law firm in order to defraud third parties. This, assuredly, is not a bona fide offering of goods and services under the Policy. [WIPO Overview 3.0](#), section 2.13.1. See also WIPO Case No. [D2022-0835](#), *supra*, (finding no rights or legitimate interests in using a domain name to attempt to "impersonate an attorney at Complainant's law firm and defraud Complainant's client using fraudulent wire transfer instructions.").

Further, under Policy paragraph 4(c)(ii), a Respondent may have rights or legitimate interests in a domain name when it is commonly known by the domain name. Here, however, the Respondent apparently is not commonly known by the disputed domain name or any other name containing Complainant's FENWICK service mark. Respondent's Whois information makes no mention of the disputed domain name or the Complainant's FENWICK service mark as being the Respondent's name or nickname.

And finally, the record does not suggest in any way that the Respondent is using the disputed domain name for a legitimate noncommercial or fair use per Policy paragraph 4(c)(iii).

The Panel is thus justified in finding that the Respondent does not have rights or legitimate interests in the disputed domain name per Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Policy lays out four non-exhaustive ways in which a complainant may show that a respondent has registered and is using a disputed domain name in bad faith (Policy paragraph 4(b)).

In our case under consideration, the evidence shows that the Respondent registered and is using the disputed domain name in bad faith. First, at the time the Respondent registered the disputed domain name, the Respondent was well aware of the Complainant's FENWICK mark and its use as a short form for the law firm Fenwick & West LLP. As the Complainant tellingly points out, how else could the Respondent have been prepared to move so rapidly - within a few weeks - to impersonate one of the Complainant's attorneys in contacting one of the Complainant's client's billing department?

Furthermore, as the Complainant contends, Respondent's activity here is a "textbook example" of registering and using the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy, which prohibits using a domain name to "intentionally attempt to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location." The Respondent did not open a website at the disputed domain name, but the disputed domain name allowed the Respondent to mimic the Complainant's Internet location in emails.

The Respondent proceeded to impersonate one of the Complainant's attorneys and to solicit contact with the billing department of one of the Complainant's clients. Most likely, the Respondent planned to solicit payment on bogus invoices for illicit financial gain. Policy panels consistently have found that "[t]he use of a 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 and employees, constitutes bad faith on the side of the Respondent." *PharmaZell GmbH v. Fred Bingo*, WIPO Case No. [D2021-1564](#). See also [WIPO Overview 3.0](#), section 3.4.

Given the above, it is clear that the Respondent has registered and is using the disputed domain name in bad faith, and that the Complainant has carried its burden of proof under Policy paragraph 4(a)(iii).

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 <femwick.com> be transferred to the Complainant.

/Dennis A. Foster/

Dennis A. Foster

Sole Panelist

Date: November 1, 2024