

## **ADMINISTRATIVE PANEL DECISION**

Fenwick & West LLP v. oliver james

Case No. D2024-4546

### **1. The Parties**

The Complainant is Fenwick & West LLP, United States of America (“United States”), represented internally.

The Respondent is oliver james, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <fenwickllp.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 November 5, 2024. On November 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 7, 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 November 11, 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”).

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

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on December 9, 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 law firm headquartered in San Francisco, California, United States. It is the proprietor of United States Trademark Registration No. 3836798 for FENWICK (word mark), registered on August 24, 2010 for “legal services” in class 45, claiming first use on September 30, 2003.

The Complainant operates its primary business website at the domain name <fenwick.com>, which it registered in 1999.

The disputed domain name was registered on October 14, 2024. At the time of the Complaint and of this Decision, it did not resolve to an active website. The record reflects that e-mail exchange (“MX”) servers have been configured for it, and that the Respondent has sent an e-mail message impersonating the Complainant’s employee from this address.

No information is available about the Respondent.

#### **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 it traces its origins to 1972, and that it has received national recognition in the United States for its legal services in the areas of copyright, trademark and patent litigation and prosecution and intellectual property transactions. The Complainant has used and widely promoted the FENWICK mark since at least 2003. The disputed domain name merely replaces the letter “n” in the FENWICK mark with the letter “m” and adds the acronym “llp,” and is similar to its domain name at <fenwick.com>, which the Complainant uses for both its website and e-mail addresses. The Respondent has never received permission to use the Complainant’s mark. The disputed domain name is not associated with a website. The Respondent’s only use of the disputed domain name is to send fraudulent email in which Respondent attempts to impersonate the finance director of the Complainant to obtain payment intended for it. The fact that the Respondent impersonated the Complainant’s employee demonstrates awareness of the Complainant and its marks.

The Complainant requests transfer of the disputed domain name.

##### **B. Respondent**

The Respondent did not reply to the Complainant’s contentions.

#### **6. Discussion and Findings**

Paragraph 4(a) of the UDRP requires the Complainant to make out all three 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; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the Respondent has registered and is using the disputed domain name 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**

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 Panel finds the mark is recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. In comparing Complainant’s mark with the disputed domain name, the Panel finds that the disputed domain name is a deliberate misspelling of the Complainant’s trademark. See [WIPO Overview 3.0](#), section 1.9. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy.

Although the addition of other terms (here, “llp”) may bear on assessment of the second and third elements, the Panel finds the addition of such a term 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 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 relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. The Panel notes there is no evidence that the Respondent has used the disputed domain name in connection with a bona fide offering of goods or services, nor that the Respondent has been commonly known by the disputed domain name. There is no evidence that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name.

Rather, the record contains evidence that the Respondent attempted to impersonate the Complainant’s employee to defraud a third party. Panels have held that the use of a domain name for illegal activity (here, claimed 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.

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 intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark. The Complainant's FENWICK mark was registered over 10 years prior to the registration of the disputed domain name, and the disputed domain name is a deliberate misspelling of that mark, together with the term "llp," which indicates a direct link to the Complainant. On this record, the Panel finds that the disputed domain name was registered in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

Panels have held that the use of a domain name for illegal activity (here, claimed impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds that the Complainant has provided evidence that the Respondent has used the disputed domain name to generate fraudulent email to a third party in an attempt to obtain payment intended for the Complainant. The Respondent has not attempted to provide a good-faith explanation for such conduct and the Panel does not find it credible that one could exist. On this record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: December 23, 2024