

ADMINISTRATIVE PANEL DECISION

Davis Polk & Wardwell LLP v. Domains by Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2022-1360

1. The Parties

The Complainant is Davis Polk & Wardwell LLP, United States of America (“United States”), represented by Fross Zelnick Lehrman & Zissu, P.C., United States.

The Respondent is Domains by Proxy, LLC, DomainsByProxy.com, United States / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 14, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 20, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 20, 2022.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on May 25, 2022. 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 that traces its beginnings to Francis N. Bangs, who opened his own one-man law firm in Manhattan in 1849. In 1925, the firm began using the name “Davis Polk Wardwell Gardiner & Reed,” changing to “Davis Polk Wardwell Sunderland & Kiendel” in 1942.

In 1967, the partnership voted to change the firm name to “Davis Polk & Wardwell” with 10 offices strategically located in key business centers and political capitals, Davis Polk & Wardwell (“Davis Polk”) is a premier firm that leading companies and financial institutions around the world turn to for counsel on their most significant business and legal matters.

Davis Polk has offices in New York, New York; Menlo Park, California; Washington, D.C.; São Paulo; London; Paris; Madrid; Hong Kong, China; Beijing; and Tokyo. The Complainant opened its Paris office in 1962, followed by London in 1972, Washington, D.C. in 1980, Tokyo in 1987, Hong Kong, China in 1993, Menlo Park, California in 1999, Madrid in 2001, Beijing in 2007, and São Paulo in 2011. The Complainant has prestige obtained over the years of experience and International legal practice.

The Complainant has owned and operated an active website at the <davispolk.com> domain name since 1996. See Exhibit G. The Complainant’s website at <davispolk.com> features prominent use of the DAVIS POLK and DAVIS POLK & WARDWELL trademarks.

In addition the Complainant is the owner of DAVIS POLK Marks in many countries: the Complainant owns United States trademark registrations for DAVIS POLK and DAVIS POLK & WARDWELL: DAVIS POLK, United States Reg. No. 3,820,693, registered July 20, 2010 based on first use in 2009 for “legal services” in International Class 45; DAVIS POLK & WARDWELL, United States Reg. No. 2,321,090, registered February 22, 2000 based on first use in 1967 for “legal services” in International Class 45.

As a result of the Complainant’s extensive advertising and promotional efforts and commercial success, as well as the amount, volume, and geographic extent of its legal practice using the DAVIS POLK Marks, the DAVIS POLK Marks have achieved widespread recognition that they have both become famous and represent goodwill.

The disputed domain name was registered in October 25, 2021. The disputed domain name resolves to a pay-per-click site which in turn redirects Internet users to third-party commercial websites.

5. Parties’ Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its trademarks DAVIS POLK and DAVIS POLK & WARDWELL. Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name and finally, that the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established that it has registered trademark rights over the DAVIS POLK and DAVIS POLK & WARDWELL trademarks. As noted in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1: "Where the Complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case."

In order to establish the confusing similarity test, panels typically do a side-by-side comparison between the trademark and the domain name to establish if the complainant's trademark is recognizable within the domain name.

In this case, the disputed domain name is <davisoolk.com> has a misspell of the DAVIS POLK trademark with an "o" instead of "p".

This represents typosquatting case, which "has been considered in numerous URDP decisions" and is sufficient, by itself, to establish confusing similarity. See *Gaetano, Inc. d/b/a Lisa Curran Swim v. Texas International Property Associates*, WIPO Case No. [D2007-1428](#) (holding that <lisacurren.com> is identical to the name and the mark LISA CURRAN "but for the typographical error of one letter").

In cases where the domain name consists of a common, obvious, or intentional misspelling of a trademark (*i.e.*, typosquatting) the domain name is considered to be confusingly similar to the relevant mark for purposes of the first element (see [WIPO Overview 3.0](#), section 1.9). Due to the fact that the disputed domain name consists of an obvious misspelling of the Complainant's DAVIS POLK trademark, omitting the "p" and instead including an "o" the Panel finds that the disputed domain name is confusingly similar to the trademark. In the present case, the disputed domain name is a misspelling of the DAVIS POLK trademark.

For all the foregoing reasons, the Panel finds that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

- (i) before any notice to you of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) The Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent is not referred to or commonly known by the disputed domain name or any related trademark. It claims it has not authorized the Respondent to use the trademark in any way including use in a domain name. The Complainant presented evidence that the disputed domain

name resolves to a pay-per-click site which in turn redirects Internet users to third-party commercial websites. This type of use does not show any *bona fide* offering of goods or services. In the present case, the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name.

The Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not responded, and the Panel is unable to conceive any basis upon which the Respondent could have any rights or legitimate interests in respect of the disputed domain name.

For the foregoing reasons the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and the requirements of paragraph 4(a)(ii) of the Policy therefore are fulfilled.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, the Complainant must show that the disputed domain name has been registered and is being used in bad faith.

The Complainant's DAVIS POLK trademarks are well known in connection with the Complainant's legal advisory services. The Complainant's trademarks have been continuously and extensively used for many years and have as a result acquired considerable reputation and goodwill worldwide. Accordingly, the Panel is satisfied that the Respondent must have been aware of the DAVIS POLK trademarks when it registered the disputed domain name, observing also that the disputed domain name is a misspelling of the trademark DAVIS POLK, using an "o" instead of a "p".

There is no doubt that the Respondent must have been aware of existence of the DAVIS POLK trademark before registering the disputed domain name. This, in light of the similarity between the disputed domain name and the Complainant's DAVIS POLK trademark, and also taking into consideration the time of registration of the disputed domain name in October 2021, many years after the Complainant's first registration of its DAVIS POLK Marks trademark.

At the time of the Complaint and at the moment of this decision, the disputed domain name resolves to a pay-per-click site which in turn redirects Internet users to third-party commercial websites. This type of use, misleading Internet users, creates confusion and has been considered a use in bad faith.

Panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names comprising typos) to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4, and *Redbox Automated Retail, LLC d/b/a Redbox v. Milen Radumilo*, WIPO Case No. [D2019-1600](#).

Therefore, the Panel concludes that the disputed domain name was registered and is being used in bad faith under paragraph 4(b)(iv) 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 <davisoolk.com> be transferred to the Complainant.

/Ada L. Redondo A./

Ada L. Redondo A.

Sole Panelist

Date: June 8, 2022