

ADMINISTRATIVE PANEL DECISION

Davis Polk & Wardwell LLP v. Andres Giraldo, Asset Legacy
Case No. D2023-4547

1. The Parties

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

The Respondent is Andres Giraldo, Asset Legacy, Colombia.

2. The Domain Name and Registrar

The disputed domain name <davispolklatam.com> is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2023. On November 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 4, 2023, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on November 13, 2023, 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 17, 2023.

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 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 3, 2023.

The Center appointed Cherise Valles as the sole panelist in this matter on January 10, 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 in this administrative proceeding is a law firm with offices around the world. The law firm traces its beginnings to Francis N. Bangs, who opened his 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.” For decades, the Complainant, its clients, and others in the legal industry also have referred to the Complainant by the shorthand name “Davis Polk.”

The Complainant has nine offices around the world, including in the United States, the United Kingdom, Brazil, Belgium, Spain, Hong Kong, China, and Japan. From its office in Sao Paulo, Brazil, it serves many clients throughout Latin America. The Complainant has received many awards and accolades for its legal services from Chambers USA, American Lawyer, International Financial Law Review, Global Investigations Review, and International Financial Law Review, among others.

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

In addition to the Complainant’s extensive and strong common law rights in the DAVIS POLK Marks, the Complainant owns United States trademark registrations for DAVIS POLK and DAVIS POLK & WARDWELL (See Exhibit I):

- 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; and,
- 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 42.

The Complainant also owns several additional trademark registrations in jurisdictions around the world for its DAVIS POLK Marks, including, without limitation, in Brazil, Chile, Colombia, Mexico, Panama, Peru, Puerto Rico (United States), and Venezuela. Exhibit J.

The disputed domain name was registered on September 26, 2023.

The disputed domain name is not currently being used by the Respondent in connection with an active website but is configured for email purposes and has been used in a fraud scheme. Exhibit K.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

- The disputed domain name is confusingly similar to the Complainant’s registered DAVIS POLK trademarks, in light of the fact that it wholly incorporates the Complainant’s mark.

The Respondent lacks rights or legitimate interests in the disputed domain name.

- The Complainant states that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name that included its trademarks.

The disputed domain name has been registered and is being used in bad faith.

- The Complainant asserts that the disputed domain name was registered and is being used in bad faith. The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use.

The Complainant requests the Panel to issue a decision finding that the disputed domain name be transferred to the Complainant, in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In terms of paragraph 4(a) of the Policy, for a Complain to succeed, the Complainant must prove each of the following elements:

- (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.

The Respondent has failed to file a Response in this proceeding. The Panel may draw appropriate inferences from the available evidence submitted by the Complainant.

A. Identical or Confusingly Similar

To prove this element, the Complainant must have relevant rights in a trademark and the disputed domain name must be identical or confusingly similar to such trademark.

The Complainant submits that the disputed domain name is confusingly similar to the trademark in which it has rights. The disputed domain name incorporates the DAVIS POLK trademark in its entirety with the addition of the term "latam" and the generic Top-Level Domain ("gTLD") ".com". Given the Complainant's trademark registration as detailed above, the Panel finds that the Complainant has established its trademark rights for DAVIS POLK for the purposes of paragraph 4(a)(i) of the Policy.

The Complainant asserts that the disputed domain name is confusingly similar to its trademark. The disputed domain name incorporates the DAVIS POLK trademark in its entirety. As stated in section 1.7 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) ("[WIPO Overview 3.0](#)"), "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The addition of the geographical indicator "latam" to the Complainant's DAVIS POLK trademark does not prevent a finding of confusing similarity and may be disregarded when comparing the disputed domain name and the Complainant's trademark, because the Complainant's DAVIS POLK trademark is still recognizable within the disputed domain name. See section 1.8 of the [WIPO Overview 3.0](#).

The gTLD “.com” may also be disregarded under the first element. See *Foundation Le Corbusier v. Mercado M.*, WIPO Case No. [D2004-0723](#); and section 1.11.1 of the [WIPO Overview 3.0](#).

In light of the foregoing, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s registered trademark and that the Complainant has met its burden with respect to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive set of circumstances, any of which, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent’s rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

- (i) before any notice to you of the dispute, your 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) you (as an individual, business or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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.”

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, whether on the basis of the non-exhaustive examples set out in paragraph 4(c) of the Policy or on any other basis, and the Panel draws inferences from this failure, where appropriate, in accordance with paragraph 14(b) of the Rules.

It is recognised in cases under the Policy that it is sufficient for a complainant to make a *prima facie* case under the second element of the Policy, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name concerned upon which the burden of production of evidence shifts to the Respondent (see, for example, *Paris Saint-Germain Football v. Daniel Macias Barajas, International Camps Network*, WIPO Case No. [D2021-0019](#); and section 2.1 of the [WIPO Overview 3.0](#)). If a respondent fails to rebut such a *prima facie* case, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

On the evidence before the Panel, it appears that there has never been any relationship between the Complainant and the Respondent. The Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant’s trademark in a domain name or in any other manner.

The Complainant asserts that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy in order to demonstrate rights or legitimate interests in the disputed domain name. In particular, the Respondent cannot assert that, prior to any notice of this dispute, he was using, or had made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy.

Rather, it appears that the Respondent’s use of the disputed domain name is in connection with an email server used to impersonate the Complainant—*i.e.*, as an email server for sending fraudulent email messages to confuse the Complainant’s clients so that those individuals would share personal contact details and confidential and privileged information with the Respondent. Such use demonstrates neither a *bona fide* offering of goods or services nor can it confer upon the Respondent rights or legitimate interests. [WIPO Overview 3.0](#), section 2.13.

From the evidence, it appears that the Respondent has made no actual use of the disputed domain name in connection with an active website or any legitimate noncommercial or fair use of the disputed domain name. “There is no evidence to suggest that that the Respondent has, before notice of the dispute, made demonstrable preparations to use the disputed Domain Name in connection with a bona fide offering of goods or services. There is also no evidence to suggest that the Respondent has been commonly known by the Disputed Domain Name or that the Respondent is or has been making legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain misleadingly to divert consumers or tarnish the Complainant’s trademark. The evidence in fact points strongly in the other direction with the Disputed Domain Name.” See *Philip Morris USA Inc. v. Zou Yali*, WIPO Case No. [D2014-2164](#). Furthermore, the nature of the disputed domain name, consisting of the Complainant’s trademark with the addition of the term “latam”, carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

In light of the foregoing, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

For this element, the Complainant is required to prove that the disputed domain name was registered and that it was being used in bad faith. The term “bad faith” is “broadly understood to occur where a respondent takes unfair advantage of, or otherwise abuses, a complainant’s mark”. See section 3.1 of the [WIPO Overview 3.0](#). Paragraph 4(b) of the Policy sets out four non-exhaustive examples of circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, namely:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent’s website or location or of a product or service on its website or location.

The Complainant is one of the best-known law firms in the world. It is therefore inconceivable that the Respondent was unaware of the DAVIS POLK trademark when it registered the disputed domain name. Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typographical errors or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The fact that the Respondent has used the disputed domain name and its associated email servers, to impersonate the Complainant is evidence that the Respondent knew of the Complainant’s rights in its DAVIS POLK trademark and suggests the Respondent’s opportunistic bad faith in registering the disputed domain name. See *Demco, Inc. v. Adminprivateregcontact a/k/a Demco USA*, WIPO Case No. [D2011-1516](#).

The disputed domain name is not currently associated with an active website. However, such non-use does not necessarily prevent a finding of bad faith use under the doctrine of “passive holding” enshrined in [WIPO Overview 3.0](#), section 3.3. Moreover, the underlying use of the disputed domain name for a fraudulent email scheme is *per se* evidence of bad faith registration and use. [WIPO Overview 3.0](#), section 3.4.

The Respondent has not participated in the administrative proceeding and has not answered the Complainant’s contentions. The fact that the Respondent has decided not to provide any legitimate explanation or to assert any alleged good faith motivation in respect of the registration or use of the disputed domain name in the face of the Complainant’s contentions can be regarded as an indicator of registration and use in bad faith.

Accordingly, the Panel concludes that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name under 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 <davispolklam.com> be transferred to the Complainant.

/Cherise Valles/

Cherise Valles

Sole Panelist

Date: January 24, 2024