

## **ADMINISTRATIVE PANEL DECISION**

Gibson, Dunn & Crutcher LLP v. Miller, Madalyn M.  
Case No. D2024-1144

### **1. The Parties**

Complainant is Gibson, Dunn & Crutcher LLP, United States of America (“United States” or “U.S.”), represented internally.

Respondent is Miller, Madalyn M., United States.

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

The disputed domain name <gbisondunn.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 March 15, 2024. On March 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 19, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to Complainant on March 22, 2024 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 27, 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 Respondent of the Complaint, and the proceedings commenced on April 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 29, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 1, 2024.

The Center appointed Scott R. Austin, Phillip V. Marano, and Dennis A. Foster as panelists in this matter on May 29, 2024. The Panel finds that it was properly constituted. Each member of 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 following facts appear from the Complaint and its attached Annexes, which have not been contested by Respondent, and which provide evidence sufficient to support:

Complainant is a prominent international law firm headquartered in Los Angeles, California which provides legal services under the service mark GIBSON DUNN (the “GIBSON DUNN Mark”) through more than 1,800 attorneys across 21 offices in the United States, Europe, Asia, and the Middle East. Originally founded in 1890, Complainant asserts that the firm has been known by the GIBSON DUNN Mark since at least 1911 and is well-known throughout the world.

Complainant is the holder of the following incontestable trademark registration for the GIBSON DUNN Mark with the United States Patent and Trademark Office (“USPTO”):

United States Registration No. 2,614,712, GIBSON DUNN, registered on September 3, 2002, for “legal services” and “providing information in the field of law via a website on global computer networks.” in International Class 45, and claiming a first use date of January 1, 1911.

Complainant has registered numerous domain names consisting of or incorporating the GIBSON DUNN Mark, including most prominently as the distinctive element of Complainant’s official domain name, <gibsondunn.com>, used to access the official GIBSON DUNN website (the “Official GIBSON DUNN Website”) which Complainant registered in 1997 and has continuously operated as an active and accessible website since that date to market and promote Complainant’s business.

Respondent registered the disputed domain name on January 22, 2024, and as of the date of the filing of the complaint it resolved to an inactive website. Complainant also asserts that Respondent has configured MX records for the disputed domain name, enabling Respondent to send and receive email with addresses that use the disputed domain name.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends, inter alia, that even though Respondent’s configuration of the disputed domain name inverting the letter “i” and the letter “b” in the GIBSON DUNN Mark (a common, obvious, and intentional misspelling of the trademark which amounts to “typosquatting”), the trademark is still clearly recognizable within the disputed domain name and therefore the disputed domain name is confusingly similar to Complainant’s well-known GIBSON DUNN Mark in which Complainant has established trademark rights.

Complainant further contends that Respondent has no rights or legitimate interests in the disputed domain name because Respondent has no commercial relationship with Complainant to support authorized use of Complainant’s mark, that Complainant’s prior use of the GIBSON DUNN Mark for over a century before registration of the disputed domain name makes it impossible that Respondent is commonly known by the GIBSON DUNN Mark, and nonuse by Respondent of the disputed domain name for an inactive website

supports a finding of no rights or legitimate interest in a disputed domain name. Respondent's typosquatting cannot be considered use in connection with a bona fide offering of goods or services, nor as a legitimate noncommercial or fair use.

Finally, Complainant contends that the disputed domain name is registered and used in bad faith because Respondent registered a domain name confusingly similar to Complainant's well established, century old GIBSON DUNN Mark, which is clearly widely recognized or well known, given that Complainant provides its legal services through more than 1,800 attorneys across 21 offices in the United States, Europe, Asia, and the Middle East, and, given the fame of Complainant's mark, Respondent must have known of Complainant's rights when she registered the disputed domain name. In support of bad faith use Complainant notably contends that Respondent's intentional misspelling of Complainant's mark incorporated in its entirety in the disputed domain name to provide Respondent a commercial benefit is bad faith use, that Complainant's GIBSON DUNN Mark was first registered at least 22 years prior to the registration of the disputed domain name, and Complainant's evidence on the record that Respondent set up MX-records for the disputed domain name indicates the risk that the disputed domain name may be intended for use or already being used for fraudulent email communications or phishing.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

The Panel will deal with each of these requirements in turn.

### **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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

To prove this element, Complainant must first establish that there is a trademark or service mark in which it has rights. Ownership of a nationally registered trademark constitutes prima facie evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy.

[WIPO Overview 3.0](#), section 1.2.1. Complainant claims trademark rights in the GIBSON DUNN Mark for legal services in the United States through its trademark registration for the GIBSON DUNN Mark referenced above in Section 4, for which sufficient evidence has been submitted in the form of an electronic copy of its valid and subsisting certificate of registration with the USPTO in the name of Complainant. Complainant has demonstrated, therefore, that it has rights in the GIBSON DUNN Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant's rights in the GIBSON DUNN Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's GIBSON DUNN. Complainant's GIBSON DUNN Mark is incorporated in its entirety except for Respondent's inverting the letter "b" with the letter "i" to intentionally misspell Complainant's Mark configuring the disputed domain name in a manner easily overlooked by unsuspecting consumers and essentially identical to Complainant's registered GIBSON DUNN Mark. Prior UDRP panels have held that a domain name which consists of a common, obvious, or intentional misspelling of a trademark, such as "the inversion of letters, is considered to be confusingly similar to the relevant mark for purposes of the first element. See [WIPO Overview 3.0](#), Section 1.9; see, also, *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. [D2005-0556](#) (finding <vlovo.com> confusingly similar to complainant's VOLVO Mark)

The misspelled form of Complainant's mark in the disputed domain name is followed only by the Top-Level Domain ("TLD") ".com". Prior UDRP panels have found the TLD, being viewed as a standard registration requirement, may typically be disregarded under the paragraph 4(a)(i) analysis. See [WIPO Overview 3.0](#), section 1.11.1; see also *L'Oréal v. Tina Smith*, WIPO Case No. [D2013-0820](#).

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy.

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 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Complainant contends that none of the circumstances provided in paragraph 4(c) of the Policy for demonstrating a respondent's rights to and legitimate interests in a domain name are present in this case. Respondent has not rebutted 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.

Complainant contends the fact that Respondent registered a domain name identical to the GIBSON DUNN mark with only two letters inverted itself proves that Respondent has no rights or interests in the disputed domain name.

Prior UDRP panels have found that non-use such as Respondent's failure to have the disputed domain name resolve to an active website supports a finding of no rights or legitimate interest in a disputed domain name. See *Latham & Watkins LLP v. Robert Iho, amex*, WIPO Case No. [D2022-4808](#); see also, *Philip Morris USA Inc. v. Torsten Rossing*, WIPO Case No. [D2015-2366](#).

Complainant also asserts that it has no commercial relationship with Respondent, who is not sponsored by or affiliated with Complainant in any way, nor has Complainant given Respondent authority or license to register or use Complainant's trademarks in any manner, including in domain names. Prior UDRP panels have held "in the absence of any license or permission from Complainant to use its trademark, no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Name could reasonably be claimed". See *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#).

Prior UDRP panels have also found that a misspelling of a complainant's trademark (i.e., a case of so-called typo-squatting), cannot be considered as use in connection with a bona fide offering of goods or services, nor as a legitimate noncommercial or fair use. See *Hogan Lovells International LLP v. Perfect Privacy, LLC / Christopher Starn*, WIPO Case No. [D2016-1293](#).

Complainant also shows the MX records for the disputed domain name indicate a risk that Respondent may also be using it for sending fraudulent emails. Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, 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. See *Valero Energy Corporation and Valero Marketing and Supply Company v. Valero Energy*, WIPO Case No. [D2017-0075](#).

Having reviewed the record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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 finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#).

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, Complainant contends the GIBSON DUNN Mark is widely recognized or well known, given that Complainant provides its legal services through more than 1,800 attorneys across 21 offices in the United States, Europe, Asia, and the Middle East, and given the widespread recognition of Complainant's mark Respondent must have known of Complainant's rights when she registered the disputed domain name. Prior UDRP panels have previously acknowledged Complainant's widely recognized reputation in the GIBSON DUNN Mark, making it unlikely that Respondent was not aware of Complainant's rights when she registered the disputed domain name. See, e.g., *Gibson, Dunn & Crutcher LLP v. james troyus*, WIPO Case No. [D2023-3677](#).

Complainant further contends that there is no other explanation for Respondent to register the disputed domain name other than to target Complainant. Prior UDRP panels have consistently found under the Policy

that “[T]he mere registration of a domain name that is identical or confusingly similar... to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.” [WIPO Overview 3.0](#), section 3.1.4. Given its GIBSON DUNN Mark has been recognized under the Policy as well-known worldwide, and the disputed domain name incorporates its confusingly similar term in its entirety, the Panel finds bad faith registration based on Respondent’s likely knowledge of the GIBSON DUNN Mark given its widespread recognition, including in the United States where Respondent is located. See *Equifax Inc. v. Super Privacy Service LTD c/o Dynadot / Babacan Gunduz*, WIPO Case No. [D2021-3814](#).

Panels have found that the non-use of a domain name (including a blank or “This site can’t be reached” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of Complainant’s GIBSON DUNN Mark, and the composition of the disputed domain name with its intentional misspelling to confuse consumers who may overlook or unknowingly transpose the letters of the GIBSON DUNN Mark in the manner misconfigured by the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Finally Complainant contends that given the widespread recognition of Complainant’s GIBSON DUNN Mark, including in the United States, where Respondent is located, and decades of use of the GIBSON DUNN Mark prior to Respondent’s registration of the disputed domain name on January 22, 2024, as well as Respondent’s configuration of the disputed domain name MX records in a manner which creates the strong possibility that Respondent intended or intends to use the disputed domain name to misuse emails as part of a fraudulent or illegitimate scheme such as phishing also must be considered to support a finding of bad faith use. See *Altria Group, Inc. and Altria Group Distribution Company v. Emerson Terry*, WIPO Case No. [D2021-0045](#).

The Panel finds Complainant’s arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and that Complainant has satisfied paragraph 4(a)(iii) 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 <gbisondunn.com> be transferred to Complainant.

*/Scott R. Austin/*

**Scott R. Austin**  
Presiding Panelist

*/Phillip V. Marano/*

**Phillip V. Marano**  
Panelist

*/Dennis A. Foster/*

**Dennis A. Foster**  
Panelist

Date: June 12, 2024