

ADMINISTRATIVE PANEL DECISION

Gibson, Dunn & Crutcher LLP v. Yan John
Case No. D2024-1886

1. The Parties

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

The Respondent is Yan John, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <dunngibsonlaw.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2024. On May 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 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 (Redacted for Privacy, Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 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 May 10, 2024.

The Center verified that the Complaint [together with the amendment to the Complaint/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 May 13, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was June 2, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 3, 2024.

The Center appointed Pablo A. Palazzi, Phillip V. Marano and Fabrizio Bedarida as panelists in this matter on June 17, 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 Complainant is Gibson, Dunn & Crutcher LLP, a U.S. law firm founded in the year 1890 in California, United States. The law firm has more than 1,900 lawyers in 21 offices worldwide.

The Complainant is, inter alia, the owner of the word marks GIBSON DUNN (Ser. No. 76242768, Reg. No. 2,614,712, registered on September 3, 2002) and GIBSON, DUNN & CRUTCHER (Ser. No. 76242770 Reg. No. 2571258 registered on May 21, 2002) registered in the USPTO for services in class 45.

The Complainant is also the owner of the domain name <gibsondunn.com>, registered on November 6, 1997.

The disputed domain name was registered on March 13, 2024, and currently does not resolve to any active website. However, the Complainant has provided evidence that it was used for monetized domain parking featuring links for “lawyers nearby”, “lawyer office”, and “law office”, which when clicked lead to advertisements for various law firms and lawyers. In addition, the Complainant provides evidence that the disputed domain name was used for a fraudulent scheme consisting of a “recovery scam”.

Little is known about the Respondent, “Yan John”, which has not participated in the administrative proceeding. It has provided to the Registrar a patently false physical address, the only discernable portion of which is the fictitious “london” street in “Russian Federation”. All other address information provided by the Respondent is composed of keystroke jumbles, such as “fdsfdsfs”. The Respondent has also provided a false telephone number to the Registrar.

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, namely:

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

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements which a complainant must satisfy in order to succeed. The Complainants must satisfy that:

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

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 disputed domain name <dunngibsonlaw.com> is confusingly similar to the GIBSON DUNN mark since it contains the first two elements of the Complainant's trademark (the same names in reverse order) with the addition of the term "law".

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other term like "law" may bear on assessment of the second and third elements, the Panel finds the addition of such 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 inclusion of the term "law" together with the names "DUNN" and "GIBSON", corresponding to the Complainant's trademark but in reversed order, in the disputed domain name carries a risk of implied affiliation as this specific term is directly related to Complainant's business activity (in particular, legal

services), therefore misleading Internet users into believing that the disputed domain name is affiliated with, or endorsed by, the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Moreover, the Complainant has provided evidence that the disputed domain name has been used for a fraudulent email scheme. Panels have held that the use of a domain name for illegal activity such as 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 Complainant was founded in 1890 and has been using the trademark for more than a century to provide legal services.
- the disputed domain name was registered on March 13, 2024, and it contains the two first names of the Complainant and its trademark, with the addition of the term “law”, related to the Complainant services.
- the disputed domain name does not currently resolve to any active websites, however according to the documents attached to the Complaint, it appears that the disputed domain name was used for a fraud scheme impersonating the Complainant in order to offer recovery services and illegally obtain money from the Complainant’s clients.
- The Respondent is in default.
- The Respondent has used patently false information to register the disputed domain name¹.
- The Panel can’t see any plausible or possible legal use of the disputed domain name.

Panels have held that the use of a domain name for illegal activity such as 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 the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

¹ It appears to the Panel that neither the Registrar or the proxy or privacy service can have performed even the most cursory review of such contact details upon its acceptance of the Respondent as its customer. Such details could not in any reasonable view be thought of as reliable contact information within the terms of the ICANN 2013 Registrar Accreditation Agreement (“RAA”), section 3.7.7.1, whereby the Registrar is required to use commercially reasonable efforts to enforce compliance (section 3.7.7, *ibid*). The submission of this contact information as the underlying registrant of the disputed domain name in the present case strongly suggests to the Panel that the Registrar’s efforts to ensure compliance with the relevant section of the RAA were inadequate, whether commercially reasonable or not. The Panel suggests that the Center share this decision with ICANN so that ICANN may consider what actions it may wish to take, in the context of the Registrar’s contractual compliance or otherwise.

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, <dunngibsonlaw.com>, be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Presiding Panelist

/Phillip V. Marano/

Phillip V. Marano

Panelist

/Fabrizio Bedarida/

Fabrizio Bedarida

Panelist

Date: July 1, 2024