



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

**Kirkland & Ellis LLP v. DefaultData.com, American Distribution Systems, Inc.**

**Case No. D2004-0136**

### **1. The Parties**

1.1 The Complainant is Kirkland & Ellis LLP, Chicago, Illinois, United States of America, represented by Tracy L. Reilly, Kirkland & Ellis LLP.

1.2 The Respondent is DefaultData.com, Denver, Colorado, United States of America.

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

2.1 The disputed domain name is <kirklandandellis.com>.

2.2 The Registrar of the disputed domain name is eNom.

### **3. Procedural History**

3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 19, 2004. On February 20, 2004, the Center transmitted by email to eNom, a request for registrar verification in connection with the domain name at issue. The Registrar did not verify the Center's request; accordingly, on February 23, 2004, the Center independently verified, via the WHOIS database, that the disputed domain name was registered with eNom, that the Respondent, DefaultData.com was the current registrant of the disputed domain name and the status of the registration was locked.

3.2 The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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").

3.3 In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 23, 2004. In accordance with the Rules, paragraph 5(a), the due date for Response was March 14, 2004. The Respondent did not submit any response. Accordingly, the Center notified the Respondent of its default on March 15, 2004.

3.4 The Center appointed Jay Simon as the sole panelist in this matter on March 22, 2004. 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.

3.5 The case file was transmitted electronically to the Panel on March 22, 2004, and a hard copy was forwarded to the Panel that same day.

#### **4. Factual Background**

4.1 Complainant, Kirkland & Ellis is a well-known firm providing legal services to clients world wide from its offices in major U.S. cities and London, England. The firm has been in existence for almost 100 years, and since 1971 has been known as Kirkland & Ellis. In every year since 1995, the National Law Journal (a respected legal newspaper) has ranked the firm among the top five most frequently used firms by the 250 largest U.S. corporations.

4.2 On July 21, 1998, Complainant registered with the United States Patent and Trademark Office (U.S.P.T.O.), the service mark KIRKLAND & ELLIS and received registration no. 2,174,936 for the mark.

4.3 The Complaint is based on the domain name registration of <kirklandandellis.com> registered by Respondent on February 20, 2000.

4.4 Respondent did not file a response in these proceedings and was notified of its default by the Center. Thus, the allegations and evidence contained in and attached to the Complaint are uncontested.

#### **5. The Parties Contentions**

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

5.1 Complainant contends that the disputed domain name is identical or confusingly similar to Complainant's service mark, and that the substitution of the word "and" for the ampersand in "Kirkland & Ellis" is of no consequence.

5.2 Complainant further contends that its name "has become one of the most well-known and respected" names in the legal profession, and that it has exerted tremendous effort to create an association of excellence with its service mark in the minds of clients and potential clients.

5.3 Complainant contends that Respondent has no rights or legitimate interests in respect of the disputed domain name because:

- a) there is no evidence that Respondent offers *bona fide* goods or services of any kind;
- b) Respondent has never been commonly known by the disputed domain name or acquired trademark or service mark rights of any kind in that name; and
- c) Respondent makes no legitimate non-commercial or fair use of the disputed domain name.

5.4 Complainant contends that the disputed domain name did not, at the time of filing the Complaint, resolve to a website or other on-line presence. (Complainant includes with the Complaint, Annex 6, a copy of a website as of September 8, 2002.)

5.5 Complainant contends that the disputed domain name was registered and is being used by Respondent in bad faith because:

(a) Respondent registered the domain name in order to prevent Kirkland & Ellis from reflecting the mark in a corresponding domain name, and Respondent has engaged in a pattern of such conduct;

(b) Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor;

(c) Respondent registered and used domain names identical to the marks of law firms, including Kirkland & Ellis, primarily for the purpose of selling, renting, or otherwise transferring the registrations to the owners of the marks or to competitors of the owners of the marks for valuable consideration in excess of his out-of-pocket costs directly related to acquiring the domain names; and that a reasonable inference exists of intent to sell the domain names for profit, even though Respondent has not yet had an opportunity to pursue financial gain from the domain names for other reasons;

(d) Respondent's conduct has manifested an intent to commit fraud on the owners of trademarks or service marks by supplying false and misleading contact information when applying for registration of domain names; and

(e) Respondent is using the disputed domain name in bad faith in that inaction (e.g., passive holding) in relation to a domain name registration can constitute a domain name being used in bad faith.

5.6 Complainant requests that the domain name be transferred to Complainant.

## **B. Respondent**

5.7 Respondent has failed to respond to the Complaint.

## **6. Discussion and Findings**

6.1 The Policy, as effected by the Rules and the Supplemental Rules, provides specified remedies to trademark owners against registrants of domain names where the trademark owner (Complainant) proves each of the following elements:

(a) that the domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(b) that the registrant (Respondent) has no rights or legitimate interests in respect of the domain name; and

(c) that the domain name has been registered and is being used in bad faith.

6.2 This case involves the registration of a domain name corresponding to the name of Complainant's firm.

6.3 Complainant has the burden of proof, by a preponderance of the evidence, respecting each element noted above in paragraph 6.1.

6.4 Respondent, having failed to respond in this proceeding, is in default, and in accordance with the Rules,

paragraph 14(b), "the Panel shall draw such inferences...as it considers appropriate."

6.5 Respondent is no stranger to proceedings under the Policy, having been named a respondent in a number of cases, e.g., *Hunton & Williams v. American Distribution Systems, Inc. et al*, [WIPO Case No. D2000-0501](#); *Gardere Wynne Sewell LLP v. DefaultData.com*, [WIPO Case No. D2001-1093](#); and *Chadbourne & Parke LLC v. American Distribution Systems, Inc. dba DefaultData.com and Brian Wick*, [WIPO Case No. D2003-0553](#). In each of these cited cases, Respondent was accused of registering, as a domain name, the name of the complainant firm. Respondent has done so, again, in this case.

6.6 While past practices do not necessarily predict the future and it remains the burden of Complainant to prove each and every feature of the elements of paragraph 6.1 above, certain inferences may be drawn by this Panel based on repeated actions of Respondent.

#### **A. Identical or Confusingly Similar (Paragraph 4(a)(i) of the Policy)**

6.7 Complainant registered its service mark, KIRKLAND & ELLIS with the U.S.P.T.O. prior to Respondent's registration of the disputed domain name. Complainant, too, has been well known for many years as a provider of legal services.

6.8 The only difference between Complainant's well-known registered service mark and the disputed domain name is the use of the ampersand "&" by Complainant, the word "and" being written out in the disputed domain name. The "&" sign is commonly used in the names of firms providing legal services, but is not used in the creation of domain names. The functional equivalent of the "&" sign is the word "and," or deletion of the sign; see *Hunton & Williams v. American Distribution Systems, Inc. et al.*, above.

6.9 Therefore, the domain name <kirklandandellis.com> is the functional equivalent of Complainant's well-known, registered service mark, and this Panel finds that the domain name is identical or confusingly similar to Complainant's registered service mark.

#### **B. Lack of Rights or Legitimate Interests (Paragraph 4(a)(ii) of the Policy)**

6.10 Paragraph 4(c) of the Policy lists three, non-exclusive methods for demonstrating rights to and legitimate interests in the domain name.

(a) before any notice of the dispute, Respondent's use or preparation to use the domain name or a name corresponding to the domain name is in connection with a *bona fide* offering of goods and services; or

(b) Respondent has been commonly known by the domain name, even if Respondent has acquired no trademark or service mark rights; or

(c) Respondent is making a legitimate non-commercial 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.

6.11 Respondent has failed to contest any of the allegations or evidence presented by Complainant. Consequently, this Panel has only the evidence presented by Complainant for deciding this case.

6.12 There is no evidence that Respondent has been commonly known by the domain name. Indeed, Respondent registered the domain name 19 months after Complainant registered its service mark with the U.S.P.T.O. Further, there is no evidence of Respondent's use or preparation to use the domain name in connection with an offering, *bona fide* or otherwise, of goods or services.

6.13 The website to which the domain name resolves declares "Freedom of Speech using Parody" and further states that the "website is merely a 'free speech flyer' being passed out at a possible electronic address to an Established business (no different than free speech at a physical address to a business)..." and "...attempts a U.S.A. Constitutionally granted free speech parody of the Supreme Court Judges, U.S. Legal System, U.S. Constitution, U.S. Attorney General, U.S. Jury and U.S. Courtroom..." The website further states that it "has no

relation to any person, organization, lawyer or law firm claiming rights to Kirkland & Ellis."

6.14 This Panel agrees with the panel in [WIPO Case No. D2000-0501](#), and the panel in [WIPO Case No. D2001-1093](#) in that (a) Respondent's website is not a parody in that it does not seek to imitate any distinctive style of the firm for comic effect or ridicule, and (b) that material critical of the U.S. legal system is not fair use of the Policy, citing *McLane Company, Inc. v. Fred Craig*, [WIPO Case No. D2000-1455](#). The latter panel also noted that it does not seem a fair use that Respondent deliberately chooses law firm names, including Complainant's name, in order to criticize the legal profession as a whole.

6.15 Rather, it seems that Respondent's purpose is to tarnish the legal profession as a whole, and specifically tarnish Complainant's firm, it being a prominent member of the legal profession.

6.16 Respondent has the right to express its views in any forum of its choice, subject of course to libel and similar causes of action. Nevertheless, the right to express one's views is not the same as the right to identify itself by another's name when expressing those views. Thus, while Respondent may express its views about the quality, or lack thereof, of the U.S. legal profession, in general, or any firm offering legal services, in particular, Respondent does not have the right to identify itself as that particular firm. And, there is nothing in the domain name to indicate that the site is devoted to criticism, even though that fact is apparent when visiting the site. By using Complainant's service mark, Respondent diverts Internet traffic to its own site, thereby potentially depriving Complainant of visits by Internet users. These views are just as applicable in this case as when first expressed in *Monty and Pat Roberts, Inc. v. Bill Keith*, [WIPO Case No. D2000-0299](#).

6.17 This Panel finds that Respondent has no rights or legitimate interests in the domain name.

### **C. Registration and Use in Bad Faith (Paragraph 4(a)iii of the Policy)**

6.18 Paragraph 4(b)(ii) of the Policy indicates that evidence of registration and use in bad faith arises when registration of the domain name prevents "the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [Respondent]...engaged in a pattern of such conduct."

6.19 In view of Respondents' actions, there can be no doubt that Respondent has prevented Complainant from using its registered service mark in a corresponding domain name and that Respondent has engaged in a pattern of registering, as domain names, the names of firms offering legal services; see *Chadbourne and Parke LLC v. American Distribution Systems, Inc., dba DefaultData.com and Brian Wick*, [WIPO Case No. D2003-0553](#) and cases cited therein, and *Hunton & Williams v. American Distribution Systems, Inc. et al.*, [WIPO Case No. D2000-0501](#) and domain name registrations cited therein.

6.20 This Panel finds it unnecessary to discuss Complainant's several other allegations of registration and use in bad faith.

6.21 Respondent being in default, there is no evidence to refute the charge of registration and use in bad faith; consequently, this Panel finds that the domain name was registered and is being used in bad faith.

## **7. Decision**

7.1 For all of the foregoing reasons, in accordance with Paragraph 4(a) of the Policy and Paragraph 15 of the Rules, the Panel orders that the domain name <kirklandandellis.com> be transferred to Complainant.

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Jay Simon  
Sole Panelist

Dated: April 2, 2004