

ADMINISTRATIVE PANEL DECISION

K&L Gates LLP v. jason jonnes
Case No. D2023-1098

1. The Parties

The Complainant is K&L Gates LLP, United States of America (“United States”), represented by ZeroFox, United States.

The Respondent is jason jonnes, United States.

2. The Domain Name and Registrar

The disputed domain name <klgates-us.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 10, 2023. On March 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 13, 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 (Withheld for Privacy Ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 21, 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 amendment to the Complaint on March 24, 2023.

The Center verified that the Complaint together with the amendment to 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 March 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 18, 2023.

The Center appointed Colin T. O’Brien as the sole panelist in this matter on April 27, 2023. 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 an international law firm established in 1883, with 48 offices worldwide. The Complainant services every major field of law with 1,800 attorneys, and by employment were the 12th largest law firm in the United States in 2018.

The Complainant owns the United States Trademark Registration Number 3,373,473, for K&L GATES, registered on January 22, 2008.

The Disputed Domain Name <klgates-us.com> was registered November 11, 2022, and does not resolve to an active page.

5. Parties' Contentions

A. Complainant

The Disputed Domain Name is confusingly similar to the Complainant's trademark, with the addition of a simple geographic descriptor "-us". This addition is not sufficient to distinguish the Disputed Domain Name from the Complainant's trademark in that not only does the Disputed Domain Name wholly incorporate their trademark into the Disputed Domain Name but also that K&L Gates originated from the United States, therefore the geographic descriptor can easily be mistaken to further associate with the Complainant.

The Disputed Domain Name is not being used for any *bona fide* offerings of goods or services, and in its current state there is no preparation to use it for that purpose. The Disputed Domain Name currently has no content and has not had any changes made to it since its registration last year.

There is also no evidence that the Respondent is commonly known by this name. A quick search engine query shows that "klgates" is universally known to belong to the Complainant. Additionally, the simple addition of "-us" can give the impression that the Disputed Domain Name is affiliated with, sponsored by, or owned by the Complainant. Being an international law firm based out of the United States, a consumer may mistakenly believe that the Disputed Domain Name is for legal services related to the United States.

The Disputed Domain Name was registered in bad faith, leveraging the Complainant's brand to either impersonate them or to use their reputation to mislead consumers.

In addition to the confusing registration which wholly incorporates the Complainant's trademark, there is also an MX record associated with the Disputed Domain Name. The Mail Exchange ("MX") record indicates that the Respondent is preparing to or already using the Disputed Domain Name to send emails and trick current or potential clients into believing they are speaking with the Complainant.

The Complainant attests that they already have had an instance of a client receiving an impersonating email from the Disputed Domain Name. Along with the MX record previously mentioned, the Respondent also used a privacy shield to register the Disputed Domain Name.

The domain is also being used in bad faith, first, the active leveraging of the Complainant's trademark to register a confusingly similar domain and maintain that registration without any indication of fair use or legitimate commercial use. There is an implied relationship with the Complainant, of which any association has not been consented to by the Complainant especially in the use of their trademark.

The active MX record, even without the claim of an impersonating email, indicates the present ability to do so. Without any independent use of the Disputed Domain Name and the confusing similarity to the Complainant domain, a consumer could easily be led to believe that an email from the Disputed Domain Name is associated with the law firm and because of the sensitive nature of communications between attorney and client, there is an exceptional amount of damage that can be caused.

The Respondent is currently using a privacy shield to obfuscate their personal information and hinder any attempt to answer for the Disputed Domain Name. While not an indication by itself, this argument is extremely strong given prior holdings in tandem with the other facts presented.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the K&L GATES mark. The addition of the term "us" does not prevent a finding of confusing similarity. See sections 1.8 and 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions Third Edition ("[WIPO Overview 3.0](#)").

Accordingly, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent obtained the Disputed Domain Name years after the Complainant had begun using its K&L GATES mark indicates that the Respondent sought to piggyback on the mark for illegitimate reasons.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name. Moreover, the Disputed Domain Name incorporates the Complainant's trademark in its entirety along with the acronym "us", potentially conveying to unsuspecting Internet users the false belief that any website or email connected to the Disputed Domain Name is associated with the Complainant. Such a risk of affiliation or association with the Complainant and its mark cannot constitute fair use.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name was registered years after the Complainant first registered and used its K&L GATES mark. The evidence provided by the Complainant with respect to the extent of use of its K&L GATES mark combined with the absence of any evidence provided by the Respondent to the contrary, is sufficient to satisfy the Panel that, at the time the Disputed Domain Name was registered, the Respondent undoubtedly knew of the Complainant's K&L GATES mark, and knew it had no rights or legitimate interests in the Disputed Domain Name.

Moreover, UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names comprising typos 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 Panel finds that the only plausible basis for registering and using the Disputed Domain Name is for illegitimate and bad faith purposes. In addition, in view of section 3.3 of the [WIPO Overview 3.0](#), the current inactive state of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

Accordingly, the Panel finds that the 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, <klgates-us.com>, be transferred to the Complainant/

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: May 8, 2023