

## **ADMINISTRATIVE PANEL DECISION**

Latham & Watkins LLP v. Victory Saga

Case No. D2023-5394

### **1. The Parties**

Complainant is Latham & Watkins LLP, United States of America (“United States”), represented internally.

Respondent is Victory Saga, United States.

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

The disputed domain name <lathamslawgroup.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 December 29, 2023. On January 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 2, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on January 2, 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 January 4, 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 January 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2024. Respondent did not submit a formal response. Accordingly, the Center notified Respondent’s default on February 2, 2024.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on February 6, 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**

Complainant is a global provider of legal services. Since its founding in Los Angeles, California in 1934, Complainant has offered its legal services under the mark LATHAM & WATKINS. Complainant is the owner of several trademark registrations for its LATHAM & WATKINS mark. These include, among others, United States Registration No. 2,413,795 (registered December 19, 2000). Complainant further owns the registration for the domain name <latham.com> (registered March 14, 1994), which Complainant uses to communicate with prospective clients online.

The disputed domain name was registered on July 19, 2023. It appears to resolve to a currently inactive webpage. Respondent nevertheless has no affiliation with Complainant. Complainant has not authorized any activities by Respondent, nor any use of its trademarks thereby.

#### **5. Parties' Contentions**

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

Complainant contends that (i) the disputed domain name is identical or confusingly similar to Complainant's trademarks, (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

Specifically, Complainant contends that it owns the rights to the LATHAM & WATKINS mark, for which Complainant has corresponding trademark registrations. Complainant further contends that it also frequently referred to by the "shortened trademark name, LATHAM," which is also the sole term in Complainant's own domain name, <latham.com> Complainant contends that Respondent has incorporated this term into the disputed domain name, with the addition of the letter "s" and the term "law group," which directly describes the legal services offered under Complainant's LATHAM & WATKINS and "shortened" LATHAM mark.

Complainant contends that Respondent lacks rights or legitimate interest in the disputed domain name, and rather has registered and is using it in bad faith to profit from the good will of Complainant's mark for Respondent's own commercial gain. Complainant contends that Complainant's LATHAM & WATKINS and "shortened" LATHAM mark are "well-known" and "famous" and that Complainant has been noted in media, such as the 2024 Vault Rankings, as the "#1 Best Law Firm in Southern California."

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

This Panel must first determine whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy. The Panel finds that it is. The disputed domain name incorporates the dominant portion of Complainant's registered mark LATHAM & WATKINS, while using Complainant's "shortened" LATHAM mark.

Incorporating the "dominant feature" of a mark may be sufficient for a finding under this first element of the UDRP. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. Furthermore, Respondent's addition of the letter "s" and of the dictionary terms "law group" does not affect the confusing similarity. See *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#) (transferring <ge-recruiting.com>).

The Panel therefore finds that the disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

The Policy provides some guidance to respondents on how to demonstrate rights or legitimate interests in the domain name at issue in a UDRP dispute. For example, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include: (i) use of the domain name "in connection with a bona fide offering of goods or services;" (ii) demonstration that Respondent has been "commonly known by the domain name;" or (iii) "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."

Respondent did not submit a reply to the Complaint. The Panel finds that Complainant has made a prima facie showing of Respondent's lack of rights or legitimate interest in the disputed domain name, which Respondent has not rebutted.

### C. Registered and Used in Bad Faith

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. For example, paragraph 4(b)(iv) of the Policy states that bad faith can be shown where "by using the domain name [respondent has] intentionally attempted to attract, for commercial gain, Internet users to [respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or of a product or service on [the] web site or location." As noted in Section 4 of this Panel's decision, the disputed domain name resolves to an inactive web page.

It is nevertheless well-established that the "non-use of a domain name" does not necessarily negate a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3. Rather, that a panel must examine "the totality of the circumstances." This is particularly so, given the nature of the disputed domain name, which indicates an apparent familiarity with Complainant and its marks. Here, Respondent did not reply to the Complaint. Further, Complainant has established a degree of consumer exposure to its LATHAM & WATKINS and "shortened" LATHAM mark for legal services. See *Latham & Watkins LLP v. Robert Joanne*, WIPO Case No. [D2023-2161](#); *Latham & Watkins LLP v. Name Redacted*, WIPO Case No. [D2021-2877](#). Other factors the Panel considers relevant in this case include: (i) Respondent's concealing its identity by using a privacy service and (ii) the implausibility of any good faith use to which the inherently

misleading disputed domain name may be put. Hence, the Panel finds that Respondent is targeting Complainant's trademarks and that the non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

Overall, the Panel finds that Respondent registered and used the disputed domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For all 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 <lathamslawgroup.com> be transferred to Complainant.

*/Lorelei Ritchie/*

**Lorelei Ritchie**

Sole Panelist

Dated: February 16, 2024