

ADMINISTRATIVE PANEL DECISION

Latham & Watkins LLP v. Bill Legend

Case No. D2024-0076

1. The Parties

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

The Respondent is Bill Legend, United States.

2. The Domain Name and Registrar

The disputed domain name <lathamwatkinsllp.com> is registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 9, 2024. On January 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 11, 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 (Domain Admin, Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 11, 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 January 13, 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 the Respondent of the Complaint, and the proceedings commenced on January 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 5, 2024.

The Center appointed Angela Fox as the sole panelist in this matter on February 14, 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

The Complainant is a large international law firm with over 3,200 attorneys in thirty-two offices located in fourteen different countries. It is routinely ranked highly in legal market publications such as The American Lawyer and Chambers and Partners. It was founded in California in 1934 and has offered its services under the name and trademark LATHAM & WATKINS continuously since then.

The Complainant owns trademark registrations for LATHAM & WATKINS in countries throughout the world. Details of the following registrations were annexed to the Complaint:

- United States Trademark Registration No. 2,413,795 for LATHAM & WATKINS in Class 42, registered on December 19, 2000;
- United States Trademark Registration No. 4,986,824 for LATHAM & WATKINS in Classes 9 and 16, registered on June 28, 2016;
- United States Trademark Registration No. 4,976,906 for LATHAM & WATKINS in Classes 35 and 36, registered on June 14, 2016; and
- United States Trademark Registration No. 4,968,228 for LATHAM & WATKINS in Classes 41 and 45, registered on May 31, 2016.

The Complainant submits that it has also established common-law rights in the LATHAM & WATKINS mark through extensive use and promotion of it since at least as early as 1934, and that the LATHAM & WATKINS mark is well-known and famous throughout the United States and internationally.

The disputed domain name was registered on November 1, 2023. It does not link to any active website.

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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its LATHAM & WATKINS trademarks. The disputed domain name incorporates the LATHAM & WATKINS trademark and merely replaces the ampersand with the letter "n", which is pronounced "and". The additional letters "llp" merely denote the Complainant's corporate structure as a limited liability partnership.

The Complainant also submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to use the Complainant's trademark and there is no evidence that the Respondent has ever been commonly known by a name corresponding to the disputed domain name.

Finally, the Complainant argues that the disputed domain name was registered and has been used in bad faith. The disputed domain name is confusingly similar to the Complainant's trademark and there is no conceivable use the Respondent could make of it which would not be linked to the Complainant. The Complainant asserts that it is inconceivable that the Respondent did not have the Complainant firmly in mind when it acquired the disputed domain name. The Complainant submits that the Respondent knew or must have known of the Complainant and its trademark prior to registration of the disputed domain name. Although the Respondent is not making any use of the disputed domain name, the Complainant submits that its passive holding of it, taken into account along with other factors including the Respondent's use of a privacy service, amounts to registration and use in bad faith.

The Complainant asks that the disputed domain name be transferred to it.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

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 the trademark LATHAM & WATKINS for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the Complainant's 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.

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 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 disputed domain name incorporates "lathamwatkins", which is clearly recognizable as, and is pronounced identically to, the Complainant's LATHAM & WATKINS trademark. It moreover also incorporates the abbreviation "llp", which corresponds to the Complainant's business structure as a limited liability partnership. Against this backdrop, it is implausible that the Respondent would not have been aware of, and targeting, the Complainant when it registered the disputed domain name.

Panels have found that the non-use of a domain name does 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 that the Complainant's LATHAM & WATKINS trademark is both inherently distinctive and has achieved a reputation in the legal field through its extensive use and high profile, including in the United States, where the Respondent is located. The Respondent has failed to respond to this Complaint and has therefore not disputed that it was aware of the Complainant's trademark when it registered the disputed domain name, and has not put forward any evidence of actual or contemplated good-faith use. The Respondent also used a privacy service to conceal its identity. Taking all of these factors into account, the Panel 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.

The Panel finds that the Complainant has established the third element 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 <lathamwatkinsllp.com> be transferred to the Complainant.

/Angela Fox/

Angela Fox

Sole Panelist

Date: March 4, 2024