

## **ADMINISTRATIVE PANEL DECISION**

Latham & Watkins LLP v. xie wan yu  
Case No. D2024-2315

### **1. The Parties**

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

The Respondent is xie wan yu, China.

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

The disputed domain name <lathamwllp.com> is registered with Gname 285 Inc (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2024. On June 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 7, 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 (Unavailable) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 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 in English on June 13, 2024.

On June 7, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On June 13, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on June 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 5, 2024.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on July 12, 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 an international law firm with over 3,200 attorneys based in thirty offices located in 14 different countries.

The Complainant claims longstanding unregistered trademark rights used in commerce at least as early as 1934 in both LATHAM & WATKINS and LATHAM, and also provided evidence of multiple trademark registrations for the LATHAM & WATKINS mark, including, inter alia: United States Trademark Registration for LATHAM & WATKINS, No. 2413795 registered on December 19, 2000, and United States Trademark Registration for LATHAM & WATKINS, No. 4986824 registered on June 28, 2016. The Complainant also owns a number of domain names including, inter alia, <lathamwatkins.com> and <lw.com> under which it promotes its legal services.

The disputed domain name was registered on January 12, 2024, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name resolved to an active Chinese-language website that hosted advertisements for, and links to several third-party gambling websites. However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive or blank webpage.

#### **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 trademarks, that the Respondent is in no way connected to, or licensed by the Complainant and that there are no other justifications for the use of its trademarks in the disputed domain name and argues that such registration and use was conducted in bad faith.

The Complainant particularly contends that the Respondent has not made a bona fide offering of goods and services on the website or other fair use of the disputed domain name. To the contrary, the Complainant argues that the Respondent's only known use of the disputed domain name is to advertise a Chinese-language website that hosts advertisements for and links to numerous third-party gambling websites. In this regard, the Complainant contends that using the Complainant's trademark to host a website to redirect visitors to others' gambling websites cannot be considered a bona fide offering of goods and services. The Complainant also essentially argues that the Respondent's use of the disputed domain name was in bad faith, since past panels have held that use of a well-known trademark in a domain name to offer gambling services constitutes both registration and use in bad faith.

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

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

## 6. Discussion and Findings

### 6.1. Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the allegation that the nature of the disputed domain name's nomenclature demonstrates the Respondent's facility with English; the fact that past panels have determined that English should be the language of the proceeding on facts nearly identical to the facts here; the fact that the Complainant's correspondence thus far to the Registrar has been in English; and the allegation that submission of the Complaint and annexes to the Complaint in Chinese would impose additional burdens and expenses on the Complainant, and also lead to unnecessary delay in the proceeding.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

### 6.2. Substantive Issues

#### 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 3.0](#), section 1.7.

The Panel finds that 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. More specifically, the Panel finds that the Complainant has provided evidence that it owns registered trademarks for the mark LATHAM & WATKINS and the Panel also accepts that the Complainant has provided sufficient evidence that it owns unregistered trademark rights in the standalone mark LATHAM (see in this regard also prior decisions of panels applying the Policy, such as *Latham & Watkins LLP v. Registration Private, Domains By Proxy, LLC / Barbara Jason*, WIPO Case No. [D2021-2238](#)).

The entirety of the mark LATHAM is reproduced 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 terms, here, "wllp", 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 that 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.

Upon review of the facts and evidence provided by the Complainant, the Panel notes that the disputed domain name directed to a website that hosted advertisements for and links to several third-party gambling websites. In the Panel’s view, this shows that the Respondent’s intention was not to make any use of the disputed domain name as a bona fide provider of goods or services, or to make legitimate noncommercial use or fair use of the Complainant’s trademarks in the disputed domain name. Instead, it shows the intention on the part of the Respondent to include the Complainant’s trademarks into the disputed domain name to obtain unlawful commercial gains.

Furthermore, the Panel notes that the disputed domain name currently directs to an inactive webpage. In this regard, the Panel finds that holding a domain name passively, without making any use of it, does not confer any rights or legitimate interests in the disputed domain name on the Respondent under the circumstances of this case (see in this regard earlier UDRP decisions such as *Bollore SE v. 赵竹飞 (Zhao Zhu Fei)*, WIPO Case No. [D2020-0691](#); and *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)*, WIPO Case No. [D2021-1685](#)).

The Panel finds that 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent has registered the disputed domain name which is confusingly similar to the Complainant’s intensively used and distinctive trademarks for LATHAM and LATHAM & WATKINS and has also consciously included the letters “w” and “llp” in the disputed domain name, which clearly refer to “Watkins” (i.e. the second part of the Complainant’s LATHAM & WATKINS mark) and “LLP” (which is the abbreviation of “Limited Liability Partnership”, i.e. the company structure of the Complainant), which, taken together, clearly refer to the Complainant’s full entity name, namely “Latham & Watkins LLP”. On this basis, there can be no doubt that the Respondent was clearly targeting the Complainant and its marks at the time of registration of the disputed domain name. Furthermore, the Panel

also notes that the Complainant's trademarks were registered and used years before the registration date of the disputed domain name. In the Panel's view, these elements sufficiently indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directed Internet users to a website that hosted advertisements for and links to numerous third-party gambling websites. The Panel accepts that this shows the intention on the part of the Respondent to attract, for commercial gain, Internet users to the website linked to the disputed domain name by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of such website. This constitutes direct evidence of bad faith under paragraph 4(b)(iv) of the Policy. Moreover, the Panel considers that the Respondent also tarnishes the Complainant's trademarks by using them in the disputed domain name which redirects Internet users to websites offering commercial gambling services (see also prior decisions under the Policy such as *Sbarro Franchise Co. LLC v. xiao ming chen, chenxiao ming*, WIPO Case No. [D2022-0550](#)).

However, the Panel notes that the disputed domain name currently refers to a blank webpage. In this regard, panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel notes the distinctiveness and intensive use of the Complainant's trademark, the Respondent's use of incomplete contact details (given the fact that the physical delivery of the Written Notice could not be completed by the Center), and the unlikelihood of any good faith use of the disputed domain name by the Respondent, and 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 <lathamwllp.com> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: July 22, 2024