

ADMINISTRATIVE PANEL DECISION

Latham & Watkins LLP v. Domains By Proxy, LLC / benson johnson
Case No. D2022-2118

1. The Parties

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

Respondent is Domains By Proxy, LLC, United States / benson johnson, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <lathamswatkins.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 10, 2022. On June 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on June 20, 2022, 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 June 24, 2022.

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 June 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 18, 2022.

The Center appointed Dinant T. L. Oosterbaan as the sole panelist in this matter on August 1, 2022. 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

According to the information provided Complainant is a large international law firm with over 3.000 attorneys located in 32 offices in 14 different countries. Complainant was founded in 1934 in Los Angeles, California.

According to the evidence submitted by Complainant, Complainant has a large number of trademark registrations for LATHAM & WATKINS, including

- the trademark LATHAM & WATKINS registered with the United States Patent and Trademark Office under number 2413795 and a registration date of December 19, 2000;

- the trademark LATHAM & WATKINS registered with the United States Patent and Trademark Office under number 4986824 and a registration date of June 28, 2016.

In addition, Complainant has registered and owns numerous domain names and websites consisting of or incorporating the LATHAM & WATKINS mark, including <lathamwatkins.com>.

The Domain Name <lathamswatkins.com> was registered on February 18, 2022.

At the time of the decision the Domain Name resolves to a website which starts with the following text: "SORRY! If you are the owner of this website, please contact your hosting provider: webmaster@lathamswatkins.com." At some point in time, it resolved to a parking page which mentions "This Account has been suspended".

The trademark registrations of Complainant were issued prior to the registration of the Domain Name.

5. Parties' Contentions

A. Complainant

Complainant submits that the Domain Name is confusingly similar and nearly identical to its LATHAM & WATKINS trademark as the Domain Name simply adds the letter "s" to the middle of Complainant's domain name <lathamwatkins.com>. The obvious similarity between the two makes clear that Respondent is attempting to trade off and make reference to Complainant's well-known LATHAM & WATKINS mark. Complainant submits that Respondent has engaged in "typosquatting".

According to Complainant Respondent has no rights or legitimate interests in the Domain Name. Complainant asserts that Respondent cannot claim any rights or legitimate interest in the Domain Name because it never received Complainant's authorization, license, consent, or permission to use the LATHAM & WATKINS mark or register the Domain Name, and it has not entered into any relationship with Complainant. Complainant also submits that Respondent's non-use of the Domain Name does not provide any evidence of legitimate interest in the Domain Name.

Complainant submits that the Domain Name was registered and is being used in bad faith. According to Complainant the practice of typosquatting, in and of itself, is evidence of the bad faith registration of the Domain Name. Respondent knew or should have known about Complainant's LATHAM & WATKINS mark because it was properly registered with the United States Patent and Trademark Office (as well as in numerous other countries) and has been extensively used by Complainant throughout the world.

Complainant asserts that Respondent's passive holding of the Domain Name evidences bad faith use. Complainant adds that Respondent's bad faith use is apparent based on its suspicious "Account Suspended" webpage. On March 31, 2022, Complainant sent a letter to the Registrar requesting that the Domain Name be suspended. Prior to the March 31, 2022 letter, the Domain Name resolved to an empty web page. After the March 31, 2022 letter, the Domain Name began to direct to a webpage that states "Account Suspended". However, when a visitor clicks the link in the text that says "Contact your hosting provider", an email populates that directs to "webmaster@lathamswatkins.com", evidencing that the Domain Name is in fact active and set up with email servers. According to Complainant, Respondent is aware that Complainant takes issue with the registration of the Domain Name and, in an effort to avoid suspicion, Respondent created the "Account Suspended" webpage to "play dead". However, as the link on the page indicates, the Domain Name is obviously still active and is even set up with an email server. Respondent's attempt to hide its tracks using the "Account Suspended" page is further indicia of bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires that the complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

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

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, Complainant must first of all establish rights in a trademark or service mark and secondly that the Domain Name is identical or confusingly similar to that trademark or service mark.

Complainant has established that it is the owner of several trademark registrations for LATHAM & WATKINS. The Domain Name incorporates the trademark LATHAM & WATKINS in its entirety, with the deletion of the "&" sign and the addition of the letter "s". Many UDRP panels have found that a disputed domain name is confusingly similar where the relevant trademark is recognizable within the disputed domain name. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"). The generic Top-Level Domain ("gTLD") ".com" is disregarded under the first element confusing similarity test. See section 1.11 of the [WIPO Overview 3.0](#).

The Panel finds that Complainant has proven that the Domain Name is confusingly similar to Complainant's trademarks under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In the opinion of the Panel, Complainant has made a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks or to register the Domain Name incorporating its trademarks. Respondent is not making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert Internet users or to tarnish the trademarks of Complainant.

The Panel notes that at the time of the decision the Domain Name resolves to a website, which starts with the following text: "SORRY! If you are the owner of this website, please contact you hosting provider: webmaster@lathamswatkins.com." Previously the Domain Name resolved to a parking page, which mentioned "This Account has been suspended".

The Panel does not consider such use a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Name. Respondent is also not commonly known by the Domain Name nor has it acquired any trademark or service mark rights.

No Response to the Complaint was filed and Respondent has not rebutted Complainant's *prima facie* case.

Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Domain Name has been registered and is being used in bad faith.

Noting the well-known status of the LATHAM & WATKINS trademarks and the overall circumstances of this case, the Panel finds it is more likely than not that Respondent knew or in any event should have known of Complainant's LATHAM & WATKINS mark.

The Panel notes that the Domain Name at the time of the decision resolves to a website, which starts with the following text: "SORRY! If you are the owner of this website, please contact you hosting provider: webmaster@lathamswatkins.com." The website continues with: "This IP address has changed."..., "There has been a server misconfiguration", and "This site may have moved to a different server".

The Panel also takes into account that the Panel has accessed the website under the Domain Name and has noted that at the time of the decision the hyperlink to "webmaster@lathamswatkins.com" is still operational.

In addition, with the obvious typosquatting consisting of the insertion of the letter "s" in the Domain Name the website and the hyperlink contained in the website under the Domain Name indicates that Respondent possibly registered the Domain Name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, which constitutes registration and use in bad faith in a similar manner to that provided under paragraph 4(b)(iv) of the Policy.

The Panel finds that Complainant has proven that the Domain Name has been registered and is being used in bad faith and paragraph 4(a)(iii) of the Policy has been satisfied.

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 Domain Name, <lathamswatkins.com>, be transferred to Complainant.

/Dinant T. L. Oosterbaan/

Dinant T. L. Oosterbaan

Sole Panelist

Date: August 11, 2022