

ADMINISTRATIVE PANEL DECISION

Latham & Watkins LLP v. Biji Ki

Case No. D2023-3871

1. The Parties

The Complainant is Latham & Watkins LLP, United States of America ("United States"), represented by Latham & Watkins LLP, United States.

The Respondent is Biji Ki, Thailand.

2. The Domain Name and Registrar

The disputed domain name <latham-austin.com> is registered with Web Commerce Communications Limited dba WebNic.cc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 15, 2023. On September 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 18, 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 (Domain Admin, whoisprotection.cc) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 19, 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 amended Complaint on September 20, 2023. In response to the Center's notification regarding the annexes to the Complaint, the Complainant re-submitted the amended Complaint and Annexes to the Complaint on October 3, 2023.

The Center verified that the Complaint together with the amended Complaints 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 October 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 26, 2023.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on November 3, 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 a law firm with over 3,200 attorneys in 30 offices located in 14 different countries, offering legal services under the name “Latham & Watkins” or the shortened name “Latham” since 1934. The Complainant has, *inter alia*, an existing office in Austin, Texas.

The Complainant is the owner of several trademarks for LATHAM & WATKINS, including:

- United States Trademark Registration LATHAM & WATKINS No. 2413795, registered on December 19, 2000;
- United States Trademark Registration LATHAM & WATKINS No. 4986824, registered on June 28, 2016;
- United States Trademark Registration LATHAM & WATKINS No. 4976906, registered on June 14, 2016;
and
- United States Trademark Registration LATHAM & WATKINS No. 4968228, registered on May 31, 2016.

The Complainant is also owner of several domain names including its trademarks, such as the domain name <latham.com>, registered on March 14, 1994.

The disputed domain name was registered on April 18, 2023. The Complainant has provided evidence showing that the disputed domain name resolved to a website purporting to offer legal services and displaying the LATHAM element of its trademarks as well as images, names, and job titles of the individuals listed on and the layout, format, and content identical to legitimate websites of third-party law firms. At the time of the decision, the disputed domain name does not resolve to any secure website.

5. Parties' Contentions

A. Complainant

On the first element of the Policy, the Complainant claims common law trademark rights to LATHAM by virtue of its continuous use since 1934 and that the disputed domain name is confusingly similar, if not identical, to the Complainant's LATHAM trademark. The disputed domain name includes the entire LATHAM trademark, with only the addition of the term “austin”, which refers to one of the Complainant's offices in the United States, located in Austin, Texas. The LATHAM trademark remains recognizable in the disputed domain name and the addition of the term “austin” does not prevent a finding of confusing similarity.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent never received the Complainant's authorization, license, consent, or permission to use the LATHAM trademark or register the disputed domain name, and it has not entered into any relationship with the Complainant. Further, 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 Respondent's only known use of the disputed domain name was an attempt to create a fraudulent website purporting to offer legal services. The images, names, and job titles of the individuals listed on the fraudulent website under the disputed domain appeared to have been stolen from other legitimate websites. For example, the website listed corporate personnel that appears to have been copied from a third party website.

Additionally, the layout, formatting, and content of the site was identical to another different third party website. This is a clear indication that the disputed domain name was created with fraudulent purposes and indicates that the Respondent has no legitimate rights or interests in the disputed domain name. Even if the Respondent's website were not fraudulent and was actually offering legal services, the Respondent's use of LATHAM trademark and content copied from third party websites grants it no legitimate rights or interests in the disputed domain name. Moreover, several additional facts support the conclusion that the Respondent has no legitimate rights or interest in the disputed domain name. For instance, the Respondent's contact, administrative, and technical information from the Registrar's Whois database printout does not reveal any rights or interest in the disputed domain name or in any way indicates the Respondent is commonly known by the LATHAM trademark.

On the third element of the Policy, the Complainant asserts that the Respondent registered and used the disputed domain name in bad faith. The Respondent's registration of the disputed domain name and website evidence an attempt to impersonate the Complainant. The LATHAM trademark is known in the legal market as designating the Complainant's high-quality legal services. Further, the Complainant has an office in Austin, Texas. The Respondent registered the disputed domain name that incorporate the LATHAM trademark and includes the term "austin," identifying one of the Complainant's offices. It is obvious that the Respondent was attempting to impersonate the Complainant to either scam third parties or offer competing legal services. It is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the LATHAM trademark at the time the disputed domain name was registered. Moreover, several additional facts support the conclusion that the Respondent registered and used the disputed domain name in bad faith. On these facts, the Respondent's use of a proxy service to conceal its identity also supports an inference of bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

It has been a consensus view in previous UDRP decisions that a respondent's default (i.e., failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

- (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.

A. Identical or Confusingly Similar

The Complainant, under the first requirement of paragraph 4(a)(i) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trademark or a service mark in which it has rights.

Section 1.8 of [WIPO Overview 3.0](#) states: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.” Further, the addition of a hyphen does not prevent a finding of identity or confusing similarity (see *The Channel Tunnel Group Ltd. v John Powell*, WIPO Case No. [D2000-0038](#)). Moreover, section 1.11.1 of [WIPO Overview 3.0](#) states: “The applicable TLD in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”.

The Complainant is registered as the owner of trademarks for LATHAM & WATKINS. Suitable evidence was submitted. Consequently, the Panel finds that the Complainant has proven that it has rights in the LATHAM & WATKINS trademark. The Complainant also claims common law rights to the formative portion of its trademark, namely LATHAM, by virtue of its continuous use for legal services since 1934. In view of the evidence submitted in support thereof, such as the Complainant’s ownership of <latham.com> and third party publications identifying the Complainant as “Latham” (Annex 5), and considering that “Latham” is derived from the surname of one of the two founding partners of the Complainant’s law firm, the Panel finds that the Complainant has proven that it has common law rights in the LATHAM trademark for purposes of the Policy.

The disputed domain name contains the term “latham”, which is part of the LATHAM & WATKINS trademark, with the addition of a hyphen and the term “austin”, as well as the generic Top-Level Domain (“gTLD”) “.com”. The gTLD “.com” will be disregarded in the Panel’s consideration of confusing similarity. The Panel finds that the relevant LATHAM & WATKINS trademark within the disputed domain name is recognizable, so that the term “austin” and the hyphen do not prevent a finding of confusing similarity. The Panel’s finding is identical with regards the side-by-side comparison to the Complainant’s common law trademark LATHAM.

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Regarding the second element of the Policy, section 2.1 of [WIPO Overview 3.0](#) states, “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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”. In addition, section 2.13.1 of [WIPO Overview 3.0](#) reads: “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”

In this case, the Respondent did not reply to the Complainant’s contentions. According to the Complaint, the Complainant has not authorized the Respondent to use the term “Latham” or the LATHAM trademark, the Respondent is not commonly known by the disputed domain name, and the Respondent has not used the disputed domain name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Further, the Respondent has not attempted to justify why the disputed domain name was registered. Moreover, the website under the disputed domain name fails to disclose the lack of relationship between the Parties and the Panel finds that the composition of the disputed domain name, namely the LATHAM trademark and the term “austin”, which refers to one of the Complainant’s offices in the United States, located in Austin, Texas, coupled with the use of the disputed domain name resolving to a website purporting to offer legal services and displaying the term “Latham”, affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and

the Complainant, as to the origin or affiliation of the website at the disputed domain name. An illegal activity of the Respondent is also confirmed by the fact that the Respondent's website contained images, names, and job titles of the individuals listed on the websites of third-party law firms as well as identical layout, formatting, and content.

Accordingly, the Panel finds that the Complainant has made a *prima facie* showing of the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent. The Panel therefore finds that the Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that the Complainant demonstrate that the Respondent registered and is using the disputed domain name in bad faith.

Section 3.1 of [WIPO Overview 3.0](#) states, "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark". Section 3.2.2 of the [WIPO Overview 3.0](#) reads: "Noting the near instantaneous and global reach of the Internet and search engines and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

Considering the public presence of the Complainant, it is unlikely that the Respondent had no knowledge of the LATHAM trademark. The incorporation of the LATHAM trademark within the disputed domain name adding the term "austin", which refers to one of the Complainant's offices in the United States, located in Austin, Texas, as well as the fact that the disputed domain resolved to a website displaying the term "Latham" and purporting to offer legal services, demonstrates the Respondent's actual awareness of and intent to target the Complainant. In light of the lack of any rights to or legitimate interests in the disputed domain name by the Respondent and in the absence of any conceivable good faith use, the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract Internet users to its website or affect the commercial activities of the Complainant by creating a likelihood of confusion with the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 <latham-austin.com> be transferred to the Complainant.

/Christian Gassauer-Fleissner/
Christian Gassauer-Fleissner
Sole Panelist
Date: November 16, 2023