

ADMINISTRATIVE PANEL DECISION

Latham & Watkins LLP v. Magnus Nolis

Case No. D2023-3881

1. The Parties

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

The Respondent is Magnus Nolis, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <lathamwatkins-law.net> is registered with PDR Ltd. d/b/a <PublicDomainRegistry.com> (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 16, 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 19, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 September 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 10, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on October 13, 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

Founded in 1934 in Los Angeles, California, US, the Complainant is one of the largest international law firms with over 3,200 attorneys located in 14 countries.

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

- US trademark LATHAM & WATKINS no. 2413795, registered on December 19, 2000, for services in class 42;
- US trademark LATHAM & WATKINS no. 4986824, registered on June 28, 2016, for goods in classes 9 and 16;
- US trademark LATHAM & WATKINS no. 4968228, registered on May 31, 2016, for services in classes 41 and 45.

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

The disputed domain name was registered on May 14, 2023, and currently redirects to an inactive web page.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

- (1) the disputed domain name is confusingly similar to the Complainant's mark, and the Respondent's use of the disputed domain name will cause clients and others in the legal industry to mistakenly believe that the disputed domain name is affiliated with the Complainant's LATHAM & WATKINS trademark and/or the <lathamwatkins.com> domain name;
- (2) the Respondent does not have any rights or legitimate interests in the disputed domain name because it never received the Complainant's authorization, license, consent, or permission to use the LATHAM & WATKINS mark or register the disputed domain name, and it has not entered into any relationship with the Complainant. The disputed domain name resolves to a website without content. The Respondent's only use of the disputed domain name is to trade off of the LATHAM & WATKINS trademark and the trust and goodwill associated with the Complainant and its mark. The Respondent's contact, administrative, and technical information from the publicly available Whois database does not reveal any rights or legitimate interests in the disputed domain name or in any way indicates the Respondent is commonly known by the Complainant's mark;
- (3) the Respondent both registered and is using the disputed domain name in bad faith. The disputed domain name incorporates the Complainant's LATHAM & WATKINS mark and therefore can only sensibly refer to the Complainant, whereas there is no obvious possible justification for the Respondent's selection of the disputed domain name other than bad faith. The Complainant's use of its mark since 1934 greatly predates the Respondent's registration of the disputed domain name. The term "lathamwatkins-law" has no apparent existence or meaning except as a reference to the Complainant's LATHAM & WATKINS trademark and the services it provides. The Respondent knew or should have known about the Complainant's LATHAM & WATKINS mark because it was properly registered with the US as well as in numerous other countries and has been extensively used by the Complainant throughout the world, thereby justifying the application of the legal concept of constructive notice. Passive holding of the disputed domain name also supports a finding of bad faith use.

The Complainant seeks transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (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 further analyze the potential concurrence of the above circumstances.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Panel confirms that for the purposes of paragraph 4(a)(i) of the Policy the Complainant has satisfied the threshold requirement of having relevant trademark rights.

The disputed domain name incorporates the trademark LATHAM & WATKINS in its entirety, with the deletion of the "&" sign and the addition of the hyphen and the word "law". 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 3.0](#).

It is well accepted by UDRP panels that a gTLD, such as ".net", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark. See section 1.11.1 of the [WIPO Overview 3.0](#).

For all of the above-mentioned reasons, the Panel is of the view that the disputed domain name is confusingly similar to the Complainant's mark, which means that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

The Panel notes that the Respondent is not commonly known by the disputed domain name, whereas the Complainant has prior rights in the trademarks, which precede the Respondent's registration of the disputed domain name by years.

Furthermore, the Panel found out that the Respondent is not commonly known by the disputed domain name.

Moreover, the Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the disputed domain name or to seek the registration of any domain name incorporating the Complainant's mark. The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register the disputed domain name incorporating its trademarks.

There is no evidence in the case file that the Respondent is conducting any *bona fide* business in connection with the disputed domain name under the circumstances where it resolves to websites without content. Neither there is evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Further, the composition of the disputed domain name carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. Given the highly descriptive nature of the additional word "law" to the Complainant's trademark and the services provided thereunder, Internet users are likely to draw a direct inference between the Complainant and the disputed domain name.

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant made out a *prima facie* case that the Respondent is not a *bona fide* provider of goods or services under the disputed domain name and is not making legitimate noncommercial or fair use of the disputed domain name.

The Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name. With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove, on the balance of probabilities, both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Panel finds that the disputed 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 the Respondent knew or in any event should have known of the Complainant's LATHAM & WATKINS mark. In this Panel's view, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's trademark at the time the disputed domain name was registered (see also *Latham & Watkins LLP v. Name Redacted*, WIPO Case No. [D2021-2877](#)).

The term "lathamwatkins-law" has no apparent existence or meaning except as a reference to the Complainant's LATHAM & WATKINS trademark and its services. Therefore, the Panel believes that the disputed domain name to be so obviously connected with such a well-known trademark but used by someone with no connection with the Complainant suggests opportunistic bad faith.

Finally, the Respondent's passive holding of the disputed domain name does not prevent a finding of bad faith. Prior panels have recognized that passive holding of a domain name (*i.e.*, where the domain name does not resolve to any website) may not prevent a finding of bad faith when assessing the totality of the circumstances. While 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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. See section 3.3 of the [WIPO Overview 3.0](#). All of these conditions seem to have been met in the current proceedings.

The Respondent has not participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible.

In light of the above, the Panel finds that the Complainant has established its case under 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, <lathamwatkins-law.net>, be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: October 17, 2023