

ADMINISTRATIVE PANEL DECISION

Latham & Watkins LLP v. Mathias Wulf

Case No. D2023-4054

1. The Parties

The Complainant is Latham & Watkins LLP, United States of America, internally represented.

The Respondent is Mathias Wulf, Germany.

2. The Domain Name and Registrar

The disputed domain name <lathampartners.com> (the “Domain Name”) is registered with PSI-USA, Inc. dba Domain Robot (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2023. On September 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 29, 2023, 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 (Admin Contact, PrivateName Services Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 29, 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 the same day.

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 October 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 24, 2023.

The Center appointed Nicholas Smith as the sole panelist in this matter on December 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 an international law firm, headquartered in the United States, with over 3,200 attorneys providing services in 30 offices located in 14 different countries. The Complainant offers its legal services under the trademark LATHAM & WATKINS (the "LATHAM & WATKINS Mark"). It has a presence on the Internet through its primary website at "www.lw.com" (the "Complainant's Website").

The Complainant is the owner of trademark registrations for the LATHAM & WATKINS Mark in various jurisdictions including a United States trademark with a registration date of December 19, 2000 (registration number 2,413,795) for services in class 42.

The Domain Name <lathampartners.com> was registered on April 2, 2021. The Domain Name is presently inactive but prior to the commencement of the proceeding resolved to a website (the "Respondent's Website") that purported to offer legal services in Germany under the LATHAM Mark. The Complainant alleges, and this is not contested by the Respondent, that the Respondent's Website is fraudulent and is an attempt to pass the Respondent off as the Complainant. The Respondent's Website copies the design, colour and layout of the Complainant's Website and the photograph of the lawyer purportedly providing legal services for the Respondent is actually a photograph of the former managing partner of one of the Complainant's well-known competitors.

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 Domain Name.

Notably, the Complainant contends that:

- a) It is the owner of the LATHAM & WATKINS Mark, having registered the LATHAM & WATKINS Mark in the United States. The Domain Name is confusingly similar to the LATHAM & WATKINS Mark as it consists of the LATHAM element of the LATHAM & WATKINS Mark along with the descriptive term "partners" and the ".com" generic Top-Level Domain ("gTLD").
- b) There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the LATHAM & WATKINS Mark. The Respondent is not commonly known by the LATHAM & WATKINS Mark, nor does it make a legitimate noncommercial or fair use of the Domain Name. Rather, the Domain Name is used for a fraudulent website impersonating the Complainant, which does not provide the Respondent with rights or legitimate interests in the Domain Name.
- c) The Domain Name was registered and is being used in bad faith. The Domain Name is being used for a website that impersonates the Complainant. Given the nature of the Complainant's LATHAM & WATKINS Mark and the purported use in connection with the provision of legal services it is impossible to conceive of a plausible situation where the Respondent would have been unaware of the Complainant at the time of registration and hence the Respondent knew that its registration and use of the Domain Name would infringe the Complainant's rights in the LATHAM & WATKINS Mark.

B. Respondent

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

6. Discussion and Findings

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.

Based on the available record, the Panel finds 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.

The Panel finds the mark is recognizable within the Domain Name as the Domain Name reproduces a dominant feature of the LATHAM & WATKINS Mark. Accordingly, the 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, "partners" may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

Based on the available record, 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 record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the 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 Domain Name.

The Panel considers that the record of this case reflects that:

- Before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.

- The Respondent (as an individual, business, or other organization) has not been commonly known by the Domain Name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- The Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- The record contains no other factors demonstrating rights or legitimate interests of the Respondent in the Domain Name.

The Respondent's use of the Domain Name appears from uncontradicted information in the Complaint to be in connection with a fraudulent website, in which the Respondent has copied much of the design and layout from the Complainant's Website and has used the image of a partner of another leading law firm to create a fake individual purportedly providing legal services. Such use is not use in connection with a *bona fide* offering of goods or services.

Based on the available record, 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.

The Panel finds that, given the reputation of the Complainant in LATHAM & WATKINS Mark and the use of the Domain Name to purport to provide legal services, as well as the striking similarities in the design and layout of the Complainant's Website and the Respondent's Website, the Respondent was aware of the Complainant and its reputation in the LATHAM & WATKINS Mark at the time it registered the Domain Name. The registration of the Domain Name in awareness of the LATHAM & WATKINS Mark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

Moreover in creating a fraudulent legal website that impersonates both the Complainant (through the use of the LATHAM Mark and similar layout) and an individual partner at a competitor firm (through use of that partner's image), the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant and the Complainant's LATHAM & WATKINS Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website (Policy, paragraph 4(b)(iv)). The fact that the Domain Name presently resolves to an inactive website does not change the Panel's findings.

Based on the available record, 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 Domain Name <lathampartners.com> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: December 17, 2023