

## **ADMINISTRATIVE PANEL DECISION**

**K&L Gates LLP v. Steven Buckley, Tmymain Tmymain99, Still pending007,  
and Samson Louis  
Case No. D2023-3908**

### **1. The Parties**

The Complainant is K&L Gates LLP, United States of America (“United States”), represented by ZeroFox, United States.

The First Respondent is Steven Buckley, United States.

The Second Respondent is Tmymain Tmymain99, United States.

The Third Respondent is Still pending007, United States.

The Fourth Respondent is Samson Louis, Italy.

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

The disputed domain names <klgataes.com>, <klgaters.com>, <klgatesr.com>, and <kl-gate.com>, are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 18, 2023. On September 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 20, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 27, 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 amendment to the Complaint on October 10, 2023.

The Center verified that the Complaint together with the amendment to 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 Respondents of the Complaint, and the proceedings commenced on October 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2023. A third-party sent an email communication to the Center on October 17, 2023 claiming to be unrelated to the disputed domain name registered with their address. No formal Response was received, so the Center sent notice of the Commencement of Panel Appointment Process on November 8, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on November 14, 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, K&L Gates LLP (short for “Kirkpatrick & Lockhart Preston Gates Ellis LLP”) is an international law firm established in 1883 as “Preston Gates and Ellis” eventually becoming known as “K&L Gates, LLP” after a merger with another law firm in 2007. Presently, the Complainant counts with 48 offices worldwide and 1800 attorneys.

The Complainant holds trademark rights in several jurisdictions around the world amongst which the United States trademark registration No. 3,373,473 for K&L GATES, filed on November 8, 2006, registered on January 22, 2008, subsequently renewed, in class 42.

The disputed domain names were registered on and are presently used in connection with:

Disputed Domain Name	Registration Date	Present Use
<klgataes.com>	June 26, 2023	No active webpage
<klgaters.com>	August 1, 2023	No active webpage
<klgatesr.com>	June 20, 2023	No active webpage
<kl-gate.com>	August 1, 2023	No active webpage

A fraudulent email was sent using the disputed domain name <klgaters.com> (Annex 6 to the Complaint), there also being active MX records associated to the disputed domain names <klgataes.com> and <kl-gate.com>.

#### 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 names.

Notably, the Complainant argues that the disputed domain names were registered by the same respondent or organization given that: (i) they were all registered within a relatively short period of time (two in the same date); (ii) the information provided is clearly fake, having the Respondent willingly indicated false or incorrect information to obfuscate their real identity and contact information; (iii) all of the disputed domain names share the same privacy protection service and registrar.

Furthermore, the Complainant contends that the disputed domain names are all confusingly similar to the Complainant's trademark in that they add slight alterations to the Complainant's name and mark, thus characterizing classic examples of cybersquatting.

The Complainant further contends that the Respondents have no rights or legitimate interests in respect of the disputed domain names given that the only use of the disputed domain names so far has been the active MX records associated with three of the disputed domain name, being it highly unlikely that the Respondents are commonly known by the disputed domain names.

Moreover, under the Complainant's view, the MX record indicates that the Respondents are preparing to or already using the disputed domain names to send emails and trick current or potential clients into believing they are speaking with the Complainant, as has already occurred in an email received by one of the Complainant's clients impersonating the Complainant attempting to target the Complainant's client to scam them out of a settlement.

Lastly, according to the Complainant, the Respondents have also obfuscated their registration and contact details behind a privacy service, further evidencing that the Respondents are acting in bad faith.

## **B. Respondents**

The Respondent did not reply to the Complainant's contentions. A third party sent an informal message to the Center stating that their address had been wrongfully indicated as the First Respondent's address.

## **6. Discussion and Findings**

### **6.1 Procedural matter – Consolidation of Multiple Respondents**

The Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple registrants pursuant to paragraph 10(e) of the Rules.

The registrants did not comment on the Complainants' request. Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that: (i) the disputed domain names share a similar domain name pattern comprising of misspellings of the Complainant's well-known trademark; (ii) the disputed domain names were registered within a relatively short period of time (from June 20, 2023 until August 1, 2023); (iii) using the same privacy protection service; (iv) through the same registrar; and (v) all but one of the disputed domain names have active mail servers associated with them.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants in a single proceeding.

### **6.2 Substantive matter**

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

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

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain names.

#### **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 that the Complainant's mark is clearly recognizable within the disputed domain names. Accordingly, the disputed domain names are identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of the letters "a" and "r", and the suppression of the letter "s" and addition of a hyphen in the disputed domain names 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 names 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.

While 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 often impossible 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. 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 Respondents lack rights or legitimate interests in the disputed domain names. The Respondents, in choosing not to respond, have not rebutted the Complainant's *prima facie* showing and have not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Panels have 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. [WIPO Overview 3.0](#), section 2.13.1.

Also, the absence of any indication that the Respondents hold rights in a term corresponding to the disputed domain names, or any possible link between the Respondents and the disputed domain names that could be inferred from the details known of the Respondents or the webpage available at the disputed domain names, corroborate with the Panel's finding of the absence of rights or legitimate interests.

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.

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain names:

- a) the Complainant is a prestigious law firm with an international reach, being its name and registered trademark well known;
- b) the use of one of the disputed domain names in connection with a fraudulent email scam impersonating the Complainant ([WIPO Overview 3.0](#), section 3.4);
- c) the Respondents have provided no evidence whatsoever of any actual or contemplated good faith use by them of the disputed domain names;
- d) the fact that the disputed domain names do not currently resolve to active websites ([WIPO Overview 3.0](#), section 3.3);
- e) the Respondents' choice to retain a privacy protection service; and
- f) the indication of false contact details potentially characterizing identity theft.

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Having reviewed the record, the Panel finds the Respondents' registration and use of the disputed domain names constitutes bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

## **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 names, <klgataes.com>, <klgaters.com>, <klgatesr.com>, and <kl-gate.com>, be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: November 28, 2023