

## **ADMINISTRATIVE PANEL DECISION**

Latham & Watkins LLP v. matthew rowwles  
Case No. DCO2023-0095

### **1. The Parties**

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

The Respondent is matthew rowwles, United States.

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

The disputed domain name <lathamwatkins.co> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 9, 2023. On November 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 10, 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 (Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 14, 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 November 17, 2023.

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 November 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 20, 2023.

The Center appointed Gregory N. Albright as the sole panelist in this matter on January 5, 2024. 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 32 offices in 14 countries. Since the Complainant was founded in Los Angeles, California in 1934, it has offered professional legal services under the LATHAM & WATKINS trademark and associated logos and terms.

The Complainant owns several trademark registrations for marks consisting of or containing the term “LATHAM & WATKINS.” Four registrations issued by the United States Patent and Trademark Office are summarized below.

| Mark             | Country       | Reg. No. and Date                                | Class and Goods Covered |
|------------------|---------------|--|-------------------------|
| LATHAM & WATKINS | United States | Registration No.<br>2413795<br>December 19, 2000 | Class 42                |
| LATHAM & WATKINS | United States | Registration No.<br>4986824<br>June 28, 2016     | Classes 9, 16           |
| LATHAM & WATKINS | United States | Registration No.<br>4976906<br>June 14, 2016     | Classes 35, 36          |
| LATHAM & WATKINS | United States | Registration No.<br>4968228<br>May 31, 2016      | Classes 41, 45          |

The Complainant has also registered and used numerous domain names consisting of or incorporating its LATHAM & WATKINS mark including <lathamwatkins.com>, which the Complainant registered on January 13, 2005.

The disputed domain name was registered on August 4, 2023. As discussed below, the Respondent’s only known use of the disputed domain name was in connection with an attempt to impersonate one of the Complainant’s attorneys to fraudulently extract money from one of the Complainant’s clients. The disputed domain name currently resolves to an inactive website.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for transfer of the disputed domain name.

Notably, the Complainant contends that it owns many trademark registrations for its LATHAM & WATKINS marks throughout the world, including those identified in Section 4, above. The Complainant also has established common law rights in the mark through extensive use and promotion of the mark since at least 1934.

The disputed domain name is identical to the Complainant's mark because it is composed entirely of the LATHAM & WATKINS mark, and merely removes the letter "m" from the end of the Top-Level Domain of the Complainant's legitimate domain name <lathamwatkins.com>. Further, the disputed domain name copies the dominant elements of the LATHAM & WATKINS mark – specifically, the names "Latham" and "Watkins." And as Panels have found, the missing ampersand in the mark does not distinguish the disputed domain name. See, e.g., *Latham & Watkins LLP v. Domain Hostmaster Customer ID: 01528735113163, Whois Privacy Services pty Ltd / Mike Patterson*, WIPO Case No. [D2016-2169](#) ("The Domain Name <lathamwatkins.com> is confusingly similar to Complainant's LATHAM & WATKINS mark because it contains Complainant's LATHAM & WATKINS mark in its entirety, minus only the ampersand character. The ampersand character cannot be used as part of a domain name and the Panel takes notice that it is commonly removed from legal services' firms' domain names. This Panel agrees that the deletion of the ampersand does not materially distinguish the Domain Name.").

The Respondent has no rights or legitimate interests in the disputed domain name because the Respondent has (1) no authorization, license or permission to use the LATHAM & WATKINS mark or register the disputed domain name; (2) no reason to be commonly known by the Complainant's mark; (3) not provided identifying information evidencing a reason to use the mark; (4) not made a bona fide offering of goods and services on the website to which the disputed domain name resolves, or other fair use of the disputed domain name; and (5) only used the disputed domain name in an attempt to defraud the Complainant's client.

Notably, the Complainant asserts that the Respondent used the disputed domain name in an attempt to impersonate one of the Complainant's attorneys, and fraudulently extract money from one of the Complainant's clients. Masquerading as one of the Complainant's partners, the Respondent emailed one of the Complainant's clients, requesting that the client provide a contact in their accounts department so the Respondent could receive information regarding outstanding invoices. The Respondent sent the email from an email address associated with the disputed domain name, included the legitimate address for the Complainant's New York office, and used the LATHAM & WATKINS mark, all to create the false impression that the email was from one of the Complainant's partners.

The Complainant also contends the Respondent registered and is using the disputed domain name in bad faith. The disputed domain name was registered in bad faith because the Respondent must have known about the LATHAM & WATKINS mark at the time the Respondent registered the disputed domain name: the mark was properly registered with the United States Patent and Trademark Office and the Complainant had made extensive use of the mark. Bad faith registration is also evidenced by the Respondent's incorporation of the entirety of the mark in the disputed domain name, and the lack of any justification for choosing the disputed domain name other than an effort to exploit confusingly similarity. Bad faith use of the disputed domain name is also shown, most significantly, by the Respondent's use of the disputed domain name to impersonate one of the Complaint's attorneys for fraudulent purposes.

## **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.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy, including through trademark registrations issued prior to registration of the disputed domain name. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. The Respondent's omission of the ampersand from the LATHAM & WATKINS mark in the disputed domain name does not prevent a finding of confusing similarity as the disputed domain name incorporates the predominant elements of the mark. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed 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 disputed domain name such as those enumerated in the Policy or otherwise.

Further, Panels have held that the use of a domain name for illegal activity – here, claimed impersonation by Respondent, passing himself off as a partner of the Complainant for fraudulent purposes – can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 non-exclusive circumstances that, if present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel finds that the Respondent registered the disputed domain name in 2023, long after the Complainant began its use of the mark in 1934, and after the Complainant obtained trademark registrations in the United States, where the Respondent is located. The confusing similarity between the disputed domain name and the Complainant's mark leaves no room for doubt that the Respondent registered the disputed domain name for the bad faith purpose of creating a false association with the Complainant.

Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's use of the disputed domain name constitutes bad faith under the Policy. Most importantly, impersonating one of the Complainant's partners for fraudulent purposes is quintessential bad faith use of the disputed domain name.

The Panel finds 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 disputed domain name <lathamwatkins.co> be transferred to the Complainant.

*/Gregory N. Albright/*

**Gregory N. Albright**

Sole Panelist

Date: January 19, 2024