

ADMINISTRATIVE PANEL DECISION

Latham & Watkins LLP v. ren yu

Case No. D2023-3880

1. The Parties

- 1.1 The Complainant is Latham & Watkins LLP, United States of America (“United States” or “US”), internally represented.
- 1.2 The Respondent is ren yu, Cambodia.

2. The Domain Name and Registrar


- 2.1 The disputed domain name <lawlw.com> (the “Domain Name”) is registered with DropCatch.com 1322 LLC (the “Registrar”).

3. Procedural History

- 3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 16, 2023. As at that date the Whois details for the Domain Name were expressed to be “Redacted for GDPR Privacy”.
- 3.2 On September 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 18, 2023, the Registrar transmitted by email to the Center its verification response disclosing the underlying registrant and contact information held for the Domain Name. 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 a first amended Complaint on September 20, 2023. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed a second amended Complaint on September 22, 2023.
- 3.3 The Center verified that the second 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”).

- 3.4 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 16, 2023.
- 3.5 The Center appointed Matthew S. Harris as the sole panelist in this matter on October 24, 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

- 4.1 The Complainant is a well-known law firm. It is a Delaware limited liability partnership, with its principal office in Los Angeles, California, United States. Although based in California, it has over 3,200 attorneys in 30 offices located in 14 different countries. The law firm was founded in 1934 and has used the name "Latham & Watkins" since that date.
- 4.2 It is also the owner of various trade marks around the world that incorporate or comprise the term "Latham & Watkins". They include:
- (i) US registered trade mark no. 2413795 for LATHAM & WATKINS as a typed drawing in Class 42 filed on August 2, 1999 and proceeding to registration on December 19, 2000;
 - (ii) European Union registered trade mark no. 3658523 for LATHAM & WATKINS as a Word mark in Classes 16, 35, 36, 41, and 42 filed on February 10, 2004 and proceeding to registration on September 1, 2005; and
 - (iii) United Kingdom registered trade mark no. 903658523 for LATHAM & WATKINS as a Word mark in Classes 16, 35, 36, 41, and 42 deemed filed on February 10, 2004 and registered on September 1, 2005.
- 4.3 The Complainant has also for some time used the following logo, at least online in respect of its business:
- 
- 4.4 It further has used the term "lw" in respect of its activities online as part of the domain name <lw.com>, which it uses for its primary website. That domain name is also used for the Complainant's email addresses.
- 4.5 The Complainant has been successful in a large number of cases under the Policy. For the most part these cases involved domain names that incorporated variants of the terms "Latham" and/or "Watkins". However, it was also successful in *Latham & Watkins LLP v. nathaniel webber*, WIPO Case No. [D2023-1964](#), which involved the domain name <us-lw.com>.
- 4.6 The Domain Name was registered on June 8, 2023. It has been used at least for some time since registration for a website that displays what appears to be advertisements in Chinese for gambling and pornography websites.
- 4.7 The underlying contact details provided by the Registrar for the Respondent, suggest that the Respondent is an individual or entity located in Cambodia.

5. Parties' Contentions

A. Complainant

- 5.1 The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.
- 5.2 The Complainant claims that it has extensively used what it describes as the "LATHAM & WATKINS and LW trademarks". It does not appear to claim any registered trade mark rights in LW but asserts that it has established common-law rights in both LATHAM & WATKINS and LW. In this respect it also relies upon the statement by the panel in *Latham & Watkins LLP v. nathaniel webber*, WIPO Case No. [D2023-1964](#) that:
- "[The] Complainant has used the LW Mark extensively across its significant digital media presence in association with its legal and other services. Third-party publications have also referenced [the] Complainant using the LW Mark, as evidenced by [the] Complainant."
- 5.3 The Complainant further claims that the Domain Name has been registered and used without its authorisation and that none of the examples of rights or legitimate interests set out in the Policy apply. In this respect, it also claims that the pornographic advertisements displayed, which do have any obvious connection with the text used in the Domain Name support a finding of lack of rights or legitimate interests.
- 5.4 So far as bad faith is concerned, the Complainant appears to contend that the use of its marks predates the registration of the Domain Name. It also claims that the term "lawlw" in the Domain Name has no apparent existence or meaning except as a reference to the Complainant "by use of the LW trademark and the descriptive term 'law,' which describes the services [the Complainant] provide[s]". The Complainant further claims that by reason of its registration and "extensive use" of its marks, the Respondent had constructive notice of the Complainant's mark. It also contends that the use of the Domain Name in respect of pornographic content also support a finding of bad faith registration and use. Finally, it claims that the Respondent has used a proxy service to conceal its identity and that this also supports an inference of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

- 6.1 It is generally 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 trade mark and the disputed domain name. In this respect it is usually sufficient to satisfy this test if the mark is recognisable within the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.
- 6.2 Notwithstanding that this is usually a relatively easy test to satisfy, it is questionable whether the Complainant's registered trade mark for LATHAM & WATKINS is recognisable within the Domain Name. However, it is not necessary to consider this further, because the Complainant has satisfied the Panel that it has unregistered trade mark rights in the term "lw". The Panel accepts given the evidence that the Complainant has provided in this respect, that the Complainant has at least recently used the LW mark very extensively as a source identifier, both prominently in a logo it uses for its business and so far as its online activities are concerned.

- 6.3 Further, the fact that the Domain Name contains the LW mark and the word “law”, which is the field of activity in which the Complainant is engaged, does not prevent a finding that the Complainant’s mark and the Domain Name are confusingly similar.
- 6.4 Accordingly, the Panel finds the first element of the Policy to have been established.

B. Rights or Legitimate Interests

- 6.5 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.
- 6.6 In the present case the Complainant has asserted a *prima facie* case that none of the examples of rights or legitimate interests in the Policy apply and that the burden of production passes to the Respondent to show otherwise.
- 6.7 However, the Panel prefers to deal with this issue more directly. As is explained in greater detail in the context of the Panel’s assessment as to bad faith, the Panel is satisfied that the most likely explanation of why the Domain Name has been registered and is being held, is because of its likely association with the Complainant and its LW mark, and to take some form of unfair advantage of that association. The Panel’s finding is reinforced given the descriptive addition of “law” to the Complainant’s LW mark in the disputed domain name, which creates a direct inference to the Complainant and the industry within which it operates. Where this is the case, the Panel is of the view that this provides positive evidence that no rights or legitimate interests exists. In the absence of any argument or argument from the Respondent to the contrary, the Complainant has satisfied the Panel on the balance of probabilities (or to use the equivalent US terminology, on the preponderance of the evidence) that the Respondent has no relevant rights or legitimate interests in the Domain Name.
- 6.8 It follows that the Panel finds the second element of the Policy to have been established.

C. Registered and Used in Bad Faith

- 6.9 Somewhat unhelpfully the Complainant, although claiming unregistered trade mark rights in the “LW” letter combination (which clearly represents the initials for its full name, Lathan & Watkins), does not state when it started using that term in respect of its business. Nevertheless, the Panel is persuaded that this use predates the adoption of that term by the Respondent in June 2023. In this respect the Panel observes that the Complainant relied in this respect upon the decision in *Latham & Watkins LLP v. nathaniel webber*, WIPO Case No. [D2023-1964](#). The complaint in that case was filed on May 3, 2023 and it is clear from the decision in that case that by that date the Complainant had already been extensively using the LW mark as a source identifier for its business, including as part of <lw.com> domain name used by the Complainant for its primary website.
- 6.10 Further, the *Latham & Watkins LLP v. nathaniel webber*, case *supra* involved the domain name <us-lw.com>, which was registered in March 2023 and then used “to impersonate Complainant and conduct a phishing scheme through an email address associated with the disputed domain name”. The panel was of the view that this targeting of the Complainant was evidence that by the time of that use “LW” had already “achieved significance as a source identifier” (citing in support the decision in *Seeh Finance and Investments SA v. Andrej Pullenski*, WIPO Case No. [D2022-4899](#)).
- 6.11 With this in mind, the Panel is persuaded that the Domain Name was more likely than not registered with knowledge of and with the intent to take unfair advantage of the Complainant’s pre-existing unregistered LW mark. Other factors that support that conclusion are the facts that the page displayed from the Domain Name has no obvious or logical association with the letters “lwlaw”, that the most sensible reading of those letters is as the term “LW” combined with the ordinary English word “law”, and that law is the field of business in which the Complainant is primarily engaged.

- 6.12 Further, although there are perhaps many other law firms around the world that use names with the initials “LW”, the size of the Complainant, the fact that it uses the domain name <lw.com>, and the similarity between the domain name <lw.com> and <lwlaw.com> all strongly suggest that it was with the Complainant, rather than any other law firm with these initials in mind, that the Domain Name was registered.
- 6.13 Accordingly, in the absence of any argument or evidence from the Respondent to the contrary, the Panel is persuaded that the most likely explanation for the choice of the Domain Name was because of its potential associations with the Complainant.
- 6.14 The Panel also accept that the use made by the Respondent falls within the scope of the example of circumstances evidencing bad faith paragraph 4(b)(iv) of the Policy. Further and in any event, the Panel is satisfied that whatever the exact reason for the registration of the Domain Name, the Respondent has registered and held it with the intention of taking some form of unfair advantage of its association with the Complainant and this is sufficient to support a finding of bad faith registration and use (as to which see section 3.1 of the [WIPO Overview 3.0](#)).
- 6.15 The Complainant contends that this is a case where it can rely upon the concept of constructive knowledge by reason of the Complainant’s US trade mark registrations. The Panel disagrees. First, there is the obvious fact that the Complainant does not identify any registered trade mark for LW. Second, “constructive knowledge” although recognised in some trade mark systems and relied upon in a number of early decision under the Policy, is a concept that now rarely finds favour in decisions under the Policy (as to which see section 3.2.2 of the [WIPO Overview 3.0](#)). It is notable in this respect that the cases that the Complainant cites which it claims support its claims of constructive knowledge were predominantly decided in 2000.
- 6.16 The Panel is also similarly unpersuaded by the Complainant’s reliance upon the Respondent’s alleged use of a proxy service. Sometimes this can be a factor that points to bad faith where it is clear that such a service has been deliberately used to conceal a respondent’s identity. But no evidence is advanced by the Complainant that this is the case. On the contrary, the wording initially displayed in the Whois details for the Domain Name suggests that the registration details were automatically redacted for GDPR reasons pursuant to Internet Corporation for Assigned Names and Numbers’s (ICANN) Temporary Specification for gTLD Registration Data. The analysis might have been different had the Complainant alleged and evidenced that the underlying contact details disclosed for the Domain Name were false. But the Complainant has not claimed that this is so.
- 6.17 However, the Panel has not had to rely upon the concept of constructive knowledge or the alleged use of a proxy service to reach the conclusion that the Domain Name was most likely registered and used in bad faith.
- 6.18 It follows that the Panel finds the third element of the Policy to have been established.

7. Decision

- 7.1 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 <lawlw.com> be transferred to the Complainant.

/Matthew S. Harris/

Matthew S. Harris

Sole Panelist

Date: October 30, 2023