

## **ADMINISTRATIVE PANEL DECISION**

Latham & Watkins LLP v. rober lawss  
Case No. D2023-3873

### **1. The Parties**

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

Respondent is rober lawss, United States.

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

The disputed domain name <us-lwllp.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 15, 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 22, 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, Whois Privacy Protection Foundation) and contact information in the Complaint. The Center sent an email communication to Complainant on September 22, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on the same day.

The Center verified that the Complaint [together with the amendment to the Complaint/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 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. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 24, 2023.

The Center appointed Scott R. Austin as the sole panelist in this matter on October 26, 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 following facts appear from the Complaint (as amended) and its annexes, which have not been contested by Respondent.

Since its founding in Los Angeles in 1934, Complainant has become a law firm with over 3,200 attorneys in thirty offices located in fourteen different countries, is ranked among the best law firms in the world according to leading legal publications and provides professional legal services under the mark LATHAM & WATKINS, as well as associated logos and terms (collectively, the “LW Marks”).

Complainant also shows it incorporates the LW Marks into its official domain names including <lw.com> used to host the law firm’s official website (the “Official LW Mark Website”), as well as many other Latham & Watkins derivative domain names, such as <lathamwatkins.com>, that redirect visitors to <lw.com> to access the Official LW Mark Website.

Complainant shows in the Annexes to its complaint a listing of trademark registrations it owns around the world for the LW Marks, to demonstrate worldwide recognition of Complainant’s LW Marks as a source identifier for Complainant’s professional legal services, which listing includes the following incontestable trademark registrations of record with the United States Patent and Trademark Office (“USPTO”):

United States Registration No. 2,413,795, LATHAM & WATKINS, registered on December 19, 2000, for a range of legal services in International Class 42, claiming a first use date of 1934; and

United States Registration No. 4,986,824 LATHAM & WATKINS, registered on June 28, 2016, for a range of downloadable software and publications relating to business and law in International Class 9 and for a range of printed publications on business and law in International Class 16.

Complainant also asserts that in addition to owning the above-referenced trademark registrations, it has established common-law rights to the LW marks through extensive use and promotion of the marks since at least as early as 1934.

The Whois record shows Respondent registered the disputed domain name on March 23, 2023, and Complainant shows with redacted email evidence that Respondent used the disputed domain name to engage a fraudulent email scheme by impersonating one of Complainant’s attorneys to fraudulently extract money from at least one of their clients through questions over a purported outstanding invoice.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name: that the disputed domain name is confusingly similar to Complainant’s trademark; that Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

Respondent did not reply to Complainant’s contentions.

## 6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

### 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 Complainant’s trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds 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 Complainant has established registered trademark rights in LATHAM & WATKINS, and based on the available record, the Panel finds also that Complainant has established unregistered trademark rights in the mark LW for the purposes of the Policy. See also *Latham & Watkins LLP v. Xing Long Luo*, WIPO Case No. [D2023-4033](#); *Latham & Watkins LLP v. ren yu*, WIPO Case No. [D2023-3880](#).

The Panel finds the entirety of Complainant’s LW Mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of the other terms bookending Complainant’s LW Mark here, “us” and a hyphen leading before the Mark, followed by “llp”, the business descriptor for a “limited liability partnership”, the form of juristic entity under which many law firms operate, including Complainant, may impact the Panel’s assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain name and the LW 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 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 Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

First, Complainant asserts that Respondent is not sponsored by or affiliated with Complainant in any way, nor is Respondent licensed, or otherwise authorized, be it directly or indirectly, to register or use, the LW Marks in any manner whatsoever, including in, or as part of, a domain name.

Most importantly, Complainant contends, and its evidence shows that although the disputed domain name does not resolve to an active website, Respondent’s fraudulent activities undermine any claim of rights and legitimate interests. Respondent configured the disputed domain name as part of a fraudulent scheme to create the false impression that emails sent under the disputed domain name were sent by Complainant and thereby unlawfully extract money from unsuspecting third parties believing Respondent to be Complainant. Prior UDRP panels have held that impersonating a complainant by using a disputed domain name as part of an email address in furtherance of a fraudulent scheme constitutes *prima facie* evidence of a lack of rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.13.

Essentially it is a well-established principal according to a consensus of UDRP Panels 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) such as the fraudulent email scheme found here, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

In the present case, Complainant contends Respondent has registered and used the disputed domain name in bad faith in the manner prohibited under paragraph 4(b)(iv) of the Policy to “intentionally attempt to attract, for commercial gain, Internet users to [the] web site [. . .] by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the] web site [. . .] or of a product or service on [the] web site.” Policy, paragraph 4(b)(iv).

Prior UDRP panels have found a domain name was registered in bad faith where the respondent registered the domain name for the purpose of intentionally attempting to impersonate or mislead in order to commit fraud. See *Marlink SA v. Sam Hen, Elegant Team*, WIPO Case No. [D2019-1215](#); *Beam Suntory Inc. v. Name Redacted*, WIPO Case No. [D2018-2861](#).

Complainant shows in evidence in the Annexes to its Complaint that Respondent used the disputed domain name to impersonate one of Complainant's attorneys and attempted to fraudulently extract money from at least one of its clients in a scheme which under the well-established principles in the cases cited above constitutes evidence of bad faith. See also *Latham & Watkins LLP v. robert Iho, amex*, WIPO Case No. [D2022-4808](#); *Ropes & Gray LLP v. Domain Administrator, c/o DomainsByProxy.com / Account Receivable*, WIPO Case No. [D2020-0294](#).

Prior UDRP panels have also held where the disputed domain name is configured in a manner to wholly incorporate a complainant's mark, as Latham's LW Mark is incorporated here, the disputed domain name can only sensibly refer to the Complainant; thus, there is no obvious possible justification for Respondent's selection of the disputed domain name other than bad faith. See *Compagnie de Saint Gobain v. Com-Union Corp.*, WIPO Case No. [D2000-0020](#); *Latham & Watkins LLP v. Name Redacted*, WIPO Case No. [D2021-2877](#).

Paragraph 4(b) of the Policy also sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Prior UDRP panels have found the addition of a business descriptor identical to that found in a complainant's registered corporate name is the type of evidence that attests to a respondent's awareness of a complainant's marks and which supports Complainant's contention that Respondent targeted Complainant's LW Marks and registered the disputed domain name in bad faith in order to take predatory advantage of Complainant's reputation. See, e.g., *Latham & Watkins LLP v. Name Redacted, supra*; *Allen & Overy LLP v. WhoisGuard Protected, WhoisGuard, Inc. / Crystal Scheurecker, Jadestone energy pty*, WIPO Case No. [D2020-0299](#).

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) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. The Panel finds that the clear evidence presented here, Respondent's impersonation of one of Complainant's partners sending a fraudulent email to a firm client to discuss payment of an invoice, using details for such correspondence incorporating additional LW Marks and logo is sufficient evidence of illegal fraudulent activity to constitute bad faith registration and use under 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, <us-lwllp.com>, be transferred to Complainant.

/Scott R. Austin/

**Scott R. Austin**

Sole Panelist

Date: November 21, 2023