

## **ADMINISTRATIVE PANEL DECISION**

Latham & Watkins LLP v. nathaniel webber  
Case No. D2023-1964

### **1. The Parties**

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

Respondent is nathaniel webber, United States.

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

The disputed domain name <us-lw.com> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 3, 2023. On May 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 3, 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 Complainant on May 12, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on May 18, 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 Respondent of the Complaint, and the proceedings commenced on May 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified Respondent's default on June 13, 2023.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on July 11, 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

Complainant Latham & Watkins LLP (“Complainant” or “Latham”) is a United States global law firm providing legal services in numerous practice areas. Founded in 1934, Complainant employs over 3,400 attorneys across 30 offices in 14 countries. Complainant owns the domain name <lw.com> and maintains its website at <https://www.lw.com/en> (“Complainant’s Website”). Complainant has consistently been ranked No. 2 in The American Lawyer’s Am Law 200 ranking and No. 2 on the Global 200 ranking of top grossing law firms.

Complainant has offered legal services under the LATHAM & WATKINS trademarks since 1934 (the “Latham Marks”). Complainant also offers legal services under its LW trademark (the “LW Mark”), and features the LW Mark prominently across its online presence, including as the profile image for its Facebook, Instagram, Twitter, and LinkedIn accounts, which have over 219,000 total combined followers. The LW Mark is also used prominently as Complainant’s profile image used for the 2023 Vault Rankings. As discussed above, Complainant also owns the domain name <lw.com>, through which it maintains its official website. Complainant owns numerous registrations for the Latham Marks covering legal publications, legal services, business management consulting, financial consulting, and numerous other legal-related services, including the following:

- LATHAM & WATKINS, United States Trademark Reg. No. 2413795, registered on Dec. 19, 2000;
- LATHAM & WATKINS, United States Trademark Reg. No. 4986824, registered on Jun. 28, 2016;
- LATHAM & WATKINS, United States Trademark Reg. No. 4976906, registered on June 14, 2016.

The disputed domain name was registered on March 9, 2023. The disputed domain name does not resolve to an active website; however, the disputed domain name was used in a phishing attempt impersonating Complainant.

#### 5. Parties’ Contentions

##### A. Complainant

According to Complainant, the disputed domain name is identical or confusingly similar to Complainant’s LW Mark in which Complainant claims common law rights, demonstrated through its widespread use of the LW Mark to offer legal services. Complainant argues that the disputed domain name will cause clients and others in the legal industry to mistakenly believe that the disputed domain name is affiliated with Complainant’s LW and LATHAM & WATKINS Marks. Complainant argues that this risk of confusion is exacerbated because it maintains its online presence through its website hosted at the <lw.com> domain name.

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name. According to Complainant, Complainant has never licensed or otherwise permitted Respondent to use Complainant’s trademarks or register any domain name incorporating them, and Respondent is not making a fair use or legitimate noncommercial use of the disputed domain name because it used the disputed domain name to impersonate Complainant and conduct a phishing scheme through an email address associated with the disputed domain name.

Complainant asserts that Respondent registered and used the disputed domain name in bad faith. According to Complainant, Respondent was aware of Complainant’s LW Mark when Respondent registered the disputed domain name because it has no apparent meaning aside from a reference to Complainant, and because Respondent registered the disputed domain name long after Complainant began using its LW Mark. Complainant further alleges Respondent used the disputed domain name in bad faith by impersonating Complainant in a phishing scheme using an email address associated with the disputed domain name.

## B. Respondent

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

Under paragraphs 5(f) and 14(a) of the Rules, the effect of a default by a respondent is that, in the absence of exceptional circumstances, the panel shall proceed to a decision on the basis of the complaint.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

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

A respondent's default does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that the complainant's allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Thus, even though Respondent has failed to address Complainant's contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

### A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the LATHAM & WATKINS trademark as referenced above. Complainant also claims common law trademark rights in the LW Mark.

The term "trademark or service mark" as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered trademarks. See section 1.1, [WIPO Overview 3.0](#). To establish unregistered or common law trademark rights for purposes of the UDRP, Complainant must show that its trademark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. See section 1.3, [WIPO Overview 3.0](#). See also *Food Fighters Universe LLC v. Protection of Private Person / Evgeniy Kalinin*, WIPO Case No. [D2022-2448](#).

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 Complainant using the LW Mark, as evidenced by Complainant.

When a respondent is shown to have been targeting a complainant's mark (e.g., based on the manner in which the related website is used) may support a complainant's assertion that its mark has achieved significance as a source identifier (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.3 and 1.15). See also *Seeh Finance and Investments SA v. Andrej Pullenski*, WIPO Case No. [D2022-4899](#).

As discussed below regarding bad faith, Respondent has clearly targeted Complainant when it registered the disputed domain name and engaged in a phishing scheme impersonating Complainant, and especially when Respondent included the LW Mark in the signature block of the phishing email impersonating Complainant.

This use of the LW Mark by Respondent, in conjunction with the registration of the disputed domain name, indicates that the LW Mark has achieved significance as a source identifier.

Therefore, Complainant has established that it has common law trademark rights in the LW Mark for purposes of the UDRP.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain (“TLD”) in which the domain name is registered) is identical or confusingly similar to Complainant’s mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain name incorporates the entirety of the LW Mark, adding only the descriptive or geographic term “us” and a dash, which renders the disputed domain confusingly similar to the LW Mark. A side-by-side comparison of the Mark and the disputed domain name reveals that the Mark is easily recognizable within the disputed domain name.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

- (i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant’s contention that Respondent is not an assignee or licensee of Complainant and that Respondent has no other business relationship with Complainant. Complainant has contended that Respondent is not commonly known by the disputed domain name and that there is no evidence that Respondent has established trademark rights in the disputed domain name. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights.

Regarding paragraph 4(c)(i) of the Policy, Complainant has presented credible, uncontroverted evidence that the disputed domain name has been used to impersonate Complainant. Panels have categorically held that use of a domain name for illegal activity (e.g., impersonation, or other types of fraud) can never confer rights or legitimate interests on a respondent. See [WIPO Overview 3.0](#) at section 2.13.1. See also *Seeh Finance and Investments SA v. Andrej Pullenski*, WIPO Case No. [D2022-4899](#).

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain name.

### **C. Registered and Used in Bad Faith**

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

Here, Respondent's actions align with 4(b)(iv) of the Policy. The disputed domain name contains the entirety of the LW Mark, with the addition of the descriptive or geographic term "us" and a dash. Due to the well-known nature of Complainant's brand, evidenced by its numerous global trademark registrations for the LATHAM Mark and common law rights in the LW Mark, along with the unauthorized use of the LW Mark in the disputed domain name, and in conjunction with Respondent's impersonation of Complainant, Respondent was undoubtedly aware of Complainant and the LW Mark when it registered the disputed domain name. Further, Respondent's registration and use of the disputed domain name for an impersonation and phishing scheme can only serve to create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the disputed domain name for commercial gain. Respondent's use of the LW Mark in the disputed domain name, in connection with Respondent's use of the disputed domain name for an impersonation and phishing scheme, clearly evidences bad faith on the part of Respondent in the registration and use of the disputed domain name.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain name, intentionally creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's use of the disputed domain name for an impersonation and phishing scheme with the purpose of attracting Internet users for commercial gain as per paragraph 4(b)(iv) 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, <us-lw.com>, be transferred to Complainant.

*/Brian J. Winterfeldt/*

**Brian J. Winterfeldt**

Sole Panelist

Date: July 25, 2023