

ADMINISTRATIVE PANEL DECISION

Latham & Watkins LLP v. Andrw Lanneee

Case No. D2023-2183

1. The Parties

Complainant is Latham & Watkins LLP, United States of America, represented by Latham & Watkins LLP, United States of America.

Respondent is Andrw Lanneee, United States of America.

2. The Domain Name and Registrar

The disputed domain name <uk-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 18, 2023. On May 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 1, 2023, the Registrar transmitted by email to the Center its verification response, confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 Respondent of the Complaint, and the proceedings commenced on June 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 21, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 22, 2023.

The Center appointed Timothy D. Casey as the sole panelist in this matter on July 25, 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 is a law firm with over 3,400 attorneys in 30 offices located in fourteen different countries, including the United States of America and the United Kingdom. Complainant has provided legal services under the LATHAM & WATKINS trademark and associated logos and abbreviations since 1934 (the “LATHAM & WATKINS Marks”), including the following:

Mark	Jurisdiction	Class(es)	Registration No.	Registration Date
LATHAM & WATKINS	United States of America	42	2413795	December 19, 2000
LATHAM & WATKINS	United States of America	9, 16	4986824	June 28, 2016
LATHAM & WATKINS	United States of America	35, 36	4976906	June 14, 2016
LATHAM & WATKINS	United States of America	41, 45	4968228	May 31, 2016

Furthermore, Complainant asserts its common-law rights in LW and among the abbreviations used by Complainant, the abbreviation “LW” is at least used in logos on various web portals, including LinkedIn and Vault, and Complainant’s website. Complainant also owns at least 20 domain name registrations including <lw.com>.

The disputed domain name was registered on March 8, 2023, in the name of Privacy Service provided by Withheld for Privacy ehf.

Complainant provided evidence showing that the disputed domain name was used the same day, March 8, 2023, in association with a fraudulent email in the name of a London office partner and attempting to collect invoice information from a client of Complainant.

5. Parties’ Contentions

A. Complainant

Complainant contends that the disputed domain name is confusingly similar to the LATHAM & WATKINS Marks and LW Marks. Complainant further contends that the addition of a hyphen and the country code identifier “uk,” which refers to the United Kingdom, is generic and is insufficient to prevent a finding of confusing similarity between the LATHAM & WATKINS Marks and LW Marks and the disputed domain name. Rather, Complainant suggests that the combination of the LATHAM & WATKINS Marks and LW Marks with the term “-uk” merely serves to confuse Internet users given Complainant’s extensive use of the <lw.com> domain name.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name because the disputed domain name is being used to defraud Complainant and Complainant’s clients and Complainant has not authorized, licensed or permitted Respondent to use the LATHAM & WATKINS Marks and LW Marks or to register the disputed domain name. Complainant further contends there is no reason for registering the disputed domain name incorporating the LATHAM & WATKINS Marks and LW Marks and no reason to be commonly known by the LATHAM & WATKINS Marks and LW Marks nor has Respondent made a *bona fide* offering of goods and services on a website or other fair use of the disputed domain name.

Complainant contends that use of the disputed domain name to impersonate Complainant's employee, along with use of the employee's signature block and one of the LATHAM & WATKINS Marks and LW Marks, in an attempt to fraudulently collect an outstanding invoices from Complainant's client, is bad faith. Complainant contends that bad faith registration of the disputed domain name can be inferred from the fraudulent use. Complainant further contends that the disputed domain name has no apparent existence or meaning except as a misspelling and reference to Complainant through use of the LATHAM & WATKINS Marks and LW Marks, which means it was registered in an attempt by Respondent to pass off as Complainant. Complainant asserts that Respondent had knowledge of the LATHAM & WATKINS Marks and LW Marks through registrations of some of the LW Marks in the United States of America and other countries as well as actual knowledge shown through Respondent's use of the disputed domain name to impersonate Complainant's employee. Finally, Complainant contends that Respondent's use of a privacy service to conceal Respondent's identity may also be taken as evidence of bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant has provided evidence of its registered trademark rights for LATHAM & WATKINS.

Furthermore, Complainant's use of the LW Marks for almost 90 years is sufficient to establish that Complainant has common-law trademark rights for the purpose of the Policy in the LW Marks prior to registration of the disputed domain name.

The fact that the disputed domain name was used to send fraudulent emails supports Complainant's assertion that its LW Mark has achieved significance as a source identifier for the purpose of the Policy. See section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Complainant contends that the disputed domain name is confusingly similar to the LW Marks.

Given that Complainant's LW Marks are recognizable in the disputed domain name, and the use of the disputed domain name, the Panel agrees and finds on balance that the disputed domain name is confusingly similar to the LW Marks.

B. Rights or Legitimate Interests

The Panel finds that Respondent has no rights or legitimate interests in the disputed domain name. Respondent does not appear to be commonly known by the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use the LATHAM & WATKINS Marks and LW Marks.

Respondent's use of the disputed domain name in an email fraudulently attempting to collect payment of an invoice issued by Complainant is not a *bona fide* offering of goods or service that would give rise to rights or a legitimate interest in the disputed domain name.

Furthermore, the nature of the disputed domain name, comprising the LATHAM & WATKINS Marks and LW Marks and adding the term "-uk," which is related to a location of Complainant's business, carries a risk of implied affiliation with Complainant as it effectively impersonates or suggests sponsorship or endorsement by Complainant, and accordingly cannot constitute a fair use in these circumstances. See section 2.5.1 of [WIPO Overview 3.0](#).

Respondent has not rebutted Complainant's *prima facie* case and has provided no arguments or evidence showing potential rights or legitimate interests in the disputed domain name. For these reasons, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Given i) the timing of Complainant's first use of the LATHAM & WATKINS Marks and LW Marks in 1934 and the prior registrations of the LATHAM & WATKINS Marks, predating registration of the disputed domain name by years, ii) the misleading nature of the disputed domain name as a combination of the LW Marks with the descriptive term "-uk", in combination with an email fraudulently attempting to collect payment of an invoice from Complainant, and iii) the timing of the registration of the disputed domain name and use of the disputed domain name on the same day, indicates that Respondent had clear knowledge of the LATHAM & WATKINS Marks and LW Marks and Complainant's business prior to registration.

The Panel finds that Respondent's registration of the disputed domain name was in bad faith.

In addition, the Panel finds Respondent usage of the disputed domain name to deceive someone into thinking they were being contacted by Complainant's employee constitutes use in bad faith.

The Panel concludes that the disputed domain name was registered and has been used in bad faith.

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, <uk-lw.com>, be transferred to Complainant.

/Timothy D. Casey/

Timothy D. Casey

Sole Panelist

Date: August 10, 2023