

ADMINISTRATIVE PANEL DECISION

Williams-Sonoma, Inc. v. Wesley Karr, Power Click
Case No. D2022-3915

1. The Parties

Complainant is Williams-Sonoma, Inc., United States of America (“USA”), represented by Sideman & Bancroft LLP, USA.

Respondent is Wesley Karr, Power Click, USA.

2. The Domain Name and Registrar

The disputed domain name <atwestelm.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 18, 2022. On October 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 20, 2022 the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Domains By Proxy, LLC c/o GoDaddy.com) and contact information in the Complaint. The Center sent an email communication to Complainant on October 20, 2022 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 October 25, 2022.

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 October 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 15, 2022.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on November 22, 2022. 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 Williams-Sonoma, Inc. is a retailer of furniture and home products selling internationally through retail stores, catalogs, and online. It launched West Elm in 2002 in Brooklyn, New York, and the brand now offers its products (*e.g.*, furniture, dinnerware, home décor) and services through over 100 retail stores in the USA and other countries; a direct mail business that distributes millions of catalogs annually; and highly successful e-commerce sites including <westelm.com>. West Elm has sold billions of dollars worth of merchandise worldwide (*i.e.*, its worldwide revenue exceeded USD 2 billion between February 2021 and January 2022).

Complainant holds over 300 registrations in the USA and around the world incorporating the WEST ELM Mark (or the “Mark”) for a wide range of goods and services including the following: USA Registrations Nos. 2,738,123 (registered July 15, 2003) and 2,725,772 (registered June 10, 2003).

The Domain Name <atwestelm.com> was registered January 11, 2012. It resolves to a website that sets forth on the landing page three blue boxes marked with the words, respectively: “At West End”; “Home Décor”; and “West Elm”. Each of these boxes are linked to other websites that are selling products and services (*e.g.* design) that compete with those offered by Complainant’s West Elm business. For example, the blue box marked “At West End” resolves to a website that sells the scope of goods West Elm sells on its website, and that merchandise is presented in a manner on the website similar to the way West Elm presents its goods on its website. The blue box marked “Home Décor” resolves to the website of an individual offering design services, home décor videos, and the website of a business that installs Christmas lights. Lastly, the blue box marked “West Elm” resolves to West Elm’s own website.

In January 2022, Complainant filed a claim with the Registrar regarding Respondent’s registration and use of the Domain Name, however the Registrar concluded in pertinent part:

“Also, our internal policies, as well as ICANN regulations, prevent us from acting as the arbiter of domain name disputes. We are not able to assist you with claims regarding the wording of a registered domain name.

Complaints of this nature need to be taken up with the domain name registrant directly, or should be filed in a UDRP or court proceeding”.

5. Parties’ Contentions

A. Complainant

The Domain Name was registered on January 11, 2012, nine years after Complainant first used its WEST ELM Mark, nine years after the earliest registrations for the WEST ELM Mark issued, and long after the WEST ELM Mark became well-known. The Domain Name is confusingly similar to the WEST ELM Mark because it incorporates the entirety of the Mark. Adding the preposition “at,” does not lessen the likelihood of confusion and in fact may enhance the possibility of confusion since the distinctive portion of the Domain Name - WEST ELM - remains the dominant portion.

Respondent is not affiliated with Complainant and is not an authorized reseller of WEST ELM-branded products. Complainant has not licensed the WEST ELM Mark to Respondent, nor consented to Respondent's use of the WEST ELM-mark for any purpose, including the Domain Name. And there is nothing indicating that Respondent is commonly known as "atwestelm.com." Also, Respondent is not engaged in any legitimate or *bona fide* use of the Domain Name because Respondent is using the Domain Name to present links to advertisements on its webpage in a common "parked" webpage format. The website contains Google ad tags linking to other websites and operating as a "pay-per-click" domain parking service whereby Respondent is generating revenue. Respondent's domain name only derives value from its connection to the Mark. Without that, Respondent's domain would receive no traffic. Respondent also has not included any disclaimers or markings on the webpage to distinguish itself from Complainant, but even if Respondent had used a disclaimer, it would do nothing to dispel the consumer confusion that is created by Respondent's actions of presenting links and advertisements for profit related to the services of the mark holder and profiting off the Mark's reputation.

Respondent's use of <atwestelm.com> is a classic case of "cybersquatting," which is clearly recognized as bad faith use of a domain name. Respondent registered the Domain Name well-after Complainant began using and had registered its WEST ELM Mark, even though Respondent has no rights or legitimate interest in the WEST ELM Mark and is unaffiliated with Complainant. This alone creates a presumption of bad faith, especially given that there is no credible explanation for Respondent's choice of domain names other than Respondent's desire to capitalize on Complainant's WEST ELM Mark and extort payment from Complainant.

Respondent was also put on notice of Complainant's rights, and Respondent's infringement by way of a report of abuse Complainant submitted to registrar GoDaddy.com, LLC. And Respondent's use of a privacy protection service to further conceal its identity is further evidence that Respondent is trying to frustrate Complainant's ability to protect its Mark against cybersquatting. Using a "parking page," with links to unaffiliated or competing websites with Complainant's, is strong evidence of bad faith. The unauthorized use of Complainant's trademark to generate pay-per-click revenue or to sell competitive services constitutes bad faith. And the fact that the webpage contains advertising links, from which Respondent likely benefits through "cash parking" monetization programs, supports the inference that the purpose of Respondent's diversion of traffic from Complainant's own webpage is for Respondent's commercial gain.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is uncontroverted that Complainant has established rights in the WEST ELM Mark based on the aforementioned trademark registrations for it.

Furthermore, the Domain Name is confusingly similar to the WEST ELM Mark because it incorporates that Mark in its entirety and adds the preposition "at", which does not prevent a finding of confusingly similarity. The WEST ELM Mark, remains the dominant portion of the Domain Name. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is well settled that the addition of the generic Top-Level Domain, here ".com", is not significant in determining whether a domain name is identical or confusingly similar to a trademark. *CBS Broadcasting Inc. v. Worldwide Webs, Inc.*, WIPO Case No. [D2000-0834](#).

For the foregoing reasons, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

It is uncontroverted that Respondent is not affiliated with Complainant and is not an authorized reseller of WEST ELM-branded products. Furthermore, Complainant has neither licensed the WEST ELM Mark to Respondent, nor consented to Respondent's use of the WEST ELM Mark for any purpose, including registering the Domain Name. And there is nothing indicating that Respondent is commonly known as "atwestelm.com."

The uncontroverted evidence shows that the Domain Name resolves to a commercial parking page showing pay-per-click advertising links to websites offering products and services identical or related to those of Complainant (as described above). Complainant argues that because the major links on Respondent's site are Google ad tags, this indicates that Respondent is generating revenue via a "pay-per-click" domain parking service, which is a popular industry practice used to generate Internet traffic and revenue. And Complainant argues that the Domain Name only derives value from its connection to the Mark because without that, the Domain Name would receive no traffic. And although Respondent has not included any disclaimers or markings on his webpage to distinguish itself from Complainant, Complainant maintains that such a disclaimer would do nothing to dispel the consumer confusion that is created by Respondent's actions of presenting links and advertisements for profit related to the services of the mark holder and profiting off the Mark's reputation.

Where, as here, Complainant has raised a *prima facie* presumption of Respondent's lack of any rights or legitimate interests in the Domain Name, and Respondent has failed to rebut that presumption, the Panel is satisfied that Complainant has carried its burden of proving that Respondent has no rights or legitimate interests in the Domain Name within the meaning of the Second element of the Policy.

For the foregoing reasons, the Panel finds that Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Respondent registered the Domain Name on January 11, 2012, years after Complainant began using the Mark and obtained the aforementioned trademark registrations in 2003. It is further undisputed: (1) West Elm was launched in 2002 and under that Mark it has been offering products (e.g., furniture, dinnerware, home décor) and services (e.g., design) through over 100 retail stores in the U.S. and other countries, a direct mail business that distributes millions of catalogs annually, and e-commerce sites including <westelm.com>; and (2) West Elm has sold billions of dollars' worth of merchandise worldwide (i.e., its worldwide revenue exceeded USD 2 billion between February 2021 and January 2022). Moreover, on the website associated with the Domain Name, the links resolve to websites offering goods and services that compete with those offered by West Elm and there is even a link to West Elm's website. Given this undisputed evidence, the Panel finds it is more likely than not Respondent was aware of Complainant's West Elm's business and the West Elm Mark when it registered the Domain Name. Respondent's bad faith registration is also evidenced by the facts that the Domain Name: (1) is confusingly similar to the Mark; and (3) it is not being legitimately used by Respondent.

Respondent has used the Domain Name in bad faith to divert Internet users to commercial parking pages with links related to products and services that compete with those offered under the WEST ELM Mark. By using the Domain Name in this manner, Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website associated with the Domain Name. See *Asurion, LLC v. Cindy Willis*, WIPO Case No. [D2018-2643](#) (finding bad faith based on Complainant's plausible allegations that "Respondent derives per-click revenue through the hyperlinks at her website"); *Asurion, LLC v. Colours Ltd.*, WIPO Case No. [D2013-0388](#) (finding bad faith based on the Respondent's use of the domain to direct users to a pay-per-click site advertising related services). Even if the users who access Respondent's website may conclude that it is not what they were originally looking for, Respondent has already succeeded in its purpose of using the Mark to attract users for commercial gain. See *Red Bull GmbH v. Unasi Management Inc.*, WIPO Case No. [D2005-0304](#).

For the foregoing reasons, the Panel finds that the third element of the Policy has been satisfied.

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 Domain Name <atwestelm.com> be transferred to Complainant.

/Harrie R. Samaras/

Harrie R. Samaras

Sole Panelist

Date: November 29, 2022