

ADMINISTRATIVE PANEL DECISION

Williams-Sonoma, Inc. v. D Pontiac

Case No. D2023-1510

1. The Parties

The Complainant is Williams-Sonoma, Inc., United States of America (“United States”), represented by Hanson Bridgett LLP, United States.

The Respondent is D Pontiac, Canada.

2. The Domain Name and Registrar

The disputed domain name <wwestelm.com> is registered with Sea Wasp, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2023. On April 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 7, 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 (Jewella Privacy – 9565f, Jewella Privacy LLC Privacy ID#1117434) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 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 an amended Complaint on April 15, 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 the Respondent of the Complaint, and the proceedings commenced on April 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2023.

The Center appointed Kaya Köklü as the sole panelist in this matter on June 12, 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 Complainant is a retailer of furniture, home products and related goods, selling internationally through its over 100 retail stores and online. Its revenue between February 2021 and January 2022 was reportedly above USD 2 billion.

The Complainant is the owner of the WEST ELM trademark. Among others, the Complainant owns the United States Trademark Registration No. 2845444 for WEST ELM, registered on May 25, 2004, and covering protection *inter alia* for retail store services and online retail store services featuring housewares and alike (Annex 3 to the Complaint). The earliest priority date for the Complainant's WEST ELM trademark dates back to June 1, 2001 (Annex 3).

Since the year 2001, respectively 2002, the Complainant further owns and operates its official website at <westelm.com> (Annexes 4 and 5 to the Complaint).

The Respondent is reportedly an individual from Canada, who has apparently been involved in other UDRP disputes as a Respondent, all of them decided against him. For instance, see *eBay Inc. v. D Pontiac / Whois Privacy Services Pty Ltd*, WIPO Case No. [D2015-0490](#).

The disputed domain name was registered on August 1, 2005.

In accordance with evidence presented by the Complainant, the Respondent used the disputed domain name by redirecting visitors to multiple third-party websites, including likely spam websites prompting visitors to click various pop-up links and approve browser notifications and suspicious downloads (Annex 6 to the Complaint).

At the date of this Decision, the disputed domain name does not resolve to an active website anymore.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name.

The Complainant is of the opinion that the disputed domain name is confusingly similar to its WEST ELM trademark.

The Complainant further argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Finally, the Complainant is convinced that the Respondent has registered and is using the disputed domain name in bad faith. Due to his involvement in other UDRP cases (all of which he lost), the Complainant particularly believes that the Respondent is a serial typo- and cybersquatter, who is engaged in pattern of registering domain names infringing third parties' trademark rights.

B. Respondent

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

6. Discussion and Findings

According to paragraphs 14 and 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable and on the basis of the Complaint where no formal response has been submitted.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

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

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") section 4.3.

It is further noted that the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views captured therein.

Before discussing the three elements under paragraph 4(a) of the Policy, the Panel notes that the Complaint was filed around 18 years after the registration of the disputed domain name. However, UDRP panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. See [WIPO Overview 3.0](#), section 4.17. In view of the Panel, this particularly applies in the present case, in which the Respondent (in the absence of a response) did not provide any indication that the Complainant has delayed its Complaint in a legally abusive manner.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has registered trademark rights in the WEST ELM mark by virtue of various trademark registrations, partly with a priority date that dates back to the year 2001.

The Panel further finds that the disputed domain name is confusingly similar to the Complainant's registered WEST ELM trademark, as it fully incorporates the Complainant's trademark.

As stated at section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of additional characters or terms would generally not prevent a finding of confusing similarity.

In the present case, the Panel notes that the disputed domain name incorporates the Complainant's WEST ELM trademark in its entirety combined with an extra "w" in its beginning, which in view of the Panel, still makes the Complainant's WEST ELM trademark well recognizable within the disputed domain name.

Hence, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's WEST ELM trademark.

Accordingly, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel further finds that the Respondent has failed to demonstrate any rights or legitimate interests in the disputed domain name.

While the burden of proof on this element remains with the Complainant, previous UDRP panels have recognized that this would result in the often impossible task of proving a negative, in particular as the evidence in this regard is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production of evidence shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name in order to meet the requirements of paragraph 4(a)(ii) of the Policy. See, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

The Panel finds that the Complainant has satisfied this requirement, while the Respondent has failed to file any evidence or make any convincing argument to demonstrate rights or legitimate interests in the disputed domain name according to the Policy, paragraphs 4(a)(ii) and 4(c).

In its Complaint, the Complainant has provided uncontested *prima facie* evidence that the Respondent has no rights or legitimate interests to use the Complainant's trademark WEST ELM in a confusingly similar way within the disputed domain name.

Bearing in mind that the visitors of the disputed domain name were redirected to third-party websites, including likely spam websites prompting visitors to click various pop-up links and approve browser notifications and downloads, presumably for malware, the Panel has no difficulties in concluding that the Respondent is not making a *bona fide* offering of goods or services of the disputed domain name nor a legitimate noncommercial or fair use.

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

C. Registered and Used in Bad Faith

The Panel further believes that the Respondent has registered and is using the disputed domain name in bad faith.

It is obvious to the Panel, that the Respondent has deliberately chosen the disputed domain name to target and mislead Internet users who particularly are searching for the Complainant and its services. Consequently, the Panel is convinced that the Respondent has registered the disputed domain name in bad faith.

Additionally, the Panel finds that the Respondent is using the disputed domain name in bad faith. There is no need to discuss in detail that using a confusingly similar domain name for redirecting visitors to predominantly spam websites with presumably malicious pop-up links and malware constitutes bad faith under the Policy. In this regard, the Panel also notes that the Respondent has been engaged in a bad faith pattern of domain name registrations before. Bearing all this in mind, the Panel concludes that this is rather a typical typosquatting case.

The fact that the disputed domain name currently does no longer resolve to an active website does not prevent a finding of bad faith.

The Panel therefore concludes that the disputed domain name was registered and is being used in bad faith and that the Complainant consequently has satisfied the third element of the Policy, namely, paragraph 4(a)(iii) 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, <wwestelm.com>, be transferred to the Complainant.

/Kaya Köklü/

Kaya Köklü

Sole Panelist

Date: June 26, 2023