

## ADMINISTRATIVE PANEL DECISION

Tuft & Needle, LLC v. 郭田田 (guo tian tian)

Case No. D2022-3972

### 1. The Parties

The Complainant is Tuft & Needle, LLC, United States of America (“United States”), represented by Cantor Colburn LLP, United States.

The Respondent is 郭田田 (guo tian tian), China.

### 2. The Domain Name and Registrar

The disputed domain name <tuftneedle-mattress.com> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on October 24, 2022. On October 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 26, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on October 26, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center transmitted another email communication to the Parties in English and Chinese regarding the language of the proceeding. The Complainant filed an amended Complaint in English on October 31, 2022 including a request that English be the language of the proceedings. The Respondent did not comment on the language of the proceeding.

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 in Chinese and English of the Complaint, and the proceedings commenced on November 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2022. The Respondent did not submit any response. However, the Center received an auto reply by email from the Respondent for each

email communication with the Parties. Accordingly, the Center notified the Parties on November 25, 2022 that it would proceed with the panel appointment process.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on December 6, 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**

The Complainant is a company headquartered in the United States and produces mattresses, bedding, pillows, mattress accessories, sleep accessories, and bedroom furniture bearing the TUFT & NEEDLE marks. The Complainant initiated its business operations in 2012 and has used its TUFT & NEEDLE trademarks on its products since then. The Complainant's products have won awards from a large variety of publications, including U.S. News, Men's Health, and USA Today. The Complainant states that over one million consumers have purchased its mattresses bearing the TUFT & NEEDLE marks. The Complainant and its related companies and affiliates also have an extensive online presence and own a portfolio of official domain names, including in particular <tuftandneedle.com>, registered on October 10, 2012.

The Complainant provides evidence that it owns an international trademark portfolio for TUFT & NEEDLE (and, incidentally, also for the mark T&N), including, but not limited to United States Trademark Registration number 4616761 for TUFT & NEEDLE, registered on October 7, 2014 and European Union Trademark number 013157912 for TUFT & NEEDLE, registered on March 5, 2015.

The disputed domain name was registered on August 23, 2022, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Panel notes that the disputed domain name is linked to an active website in English, which purports to be the official website of the Complainant, but contains what are presumed to be pay-per-click hyperlinks titled "View on Amazon" which redirect Internet users to the Complainant's products as well as those of its competitors on the Amazon e-commerce platform to generate pay-per-click revenue.

#### **5. Parties' Contentions**

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

The Complainant essentially contends that the disputed domain name is confusingly similar to its trademarks for TUFT & NEEDLE, that the 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.

The Complainant claims that its trademarks are distinctive, used intensively and well-regarded in the sectors in which it operates and submits company and marketing information. The Complainant also submits a prior UDRP decision in which the panel recognized the Complainant's rights in its trademarks for TUFT & NEEDLE and considered these trademarks famous, see *Tuft & Needle, LLC v. 郭田田 (guo tian tian)*, WIPO Case No. [D2022-1941](#). Particularly, the Complainant provides evidence that the disputed domain name is linked to an active website displaying what are presumed to be pay-per-click hyperlinks and argues that this constitutes an intentional attempt by the Respondent to attract, for commercial gain, Internet users to the Complainant's competing websites and to other unrelated websites by creating a likelihood of confusion with the Complainant's well-known marks for TUFT & NEEDLE. The Complainant also essentially contends that, based on those facts, the Respondent's registration and use of the disputed domain name does not confer any rights or legitimate interests in respect of the disputed domain name and constitutes registration and use of the disputed domain name in bad faith. The Complainant finally also claims in its amended Complaint that the Respondent was involved in an earlier domain name dispute with very similar facts where bad faith use and registration was found by the panel, and argues that the Respondent has therefore engaged in a pattern

of trademark-abusive conduct.

The Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

Although the Center received an auto reply by email from the Respondent for each email communication with the Parties, the Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **6.1. Preliminary Issue: Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement. However, the Panel is given the authority to determine a language of the proceeding other than the language of the Registration Agreement, taking into account the circumstances of every individual case.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint and its amended Complaint in English, and requests that English be the language of the proceeding.

The Panel has carefully considered all elements of this case, and considers the following elements particularly relevant: the Complainant's request that the language of the proceeding be English; the lack of comments on the applicable language and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited in a timely manner, in Chinese and English, by the Center to present its comments and Response in either English or Chinese, but chose not to do so); the fact that the website hosted at the disputed domain name is exclusively in English and that the disputed domain name is written in Latin letters and not in Chinese characters and that it contains a word in English, namely "mattress"; and, finally, the fact that Chinese as the language of this proceeding could lead to unwarranted delays and additional costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and decides that the language of this administrative proceeding shall be English.

### **6.2. Discussion and Findings on the Merits**

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

#### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant has shown that it has valid rights in the mark TUFT & NEEDLE based on its intensive use and registration of the same as a trademark in several jurisdictions.

Moreover, as to confusing similarity, the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7, states: "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". In this case, the Panel considers that the disputed domain name was

created by incorporating the Complainant's trademark for TUFT & NEEDLE in its entirety, followed by the descriptive term "mattress", separated from the trademark by a hyphen. Accordingly, the Panel considers that the disputed domain name contains the entirety of the Complainant's trademark for TUFT & NEEDLE, which remains easily recognizable in the disputed domain name, and the addition of the word "mattress" does not impact on this finding. The Panel also notes that the applicable generic Top-Level Domain ("gTLD") (".com" in this case) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1. Finally, in the above assessment the Panel disregarded the ampersand symbol in the Complainant's marks since it cannot be used in the domain name system (see *H & M Hennes & Mauritz AB v. Privacy Guardian*, See *PrivacyGuardian.org*; *Joyce Cheadle*; *Gilberto Andino*; *Xue Lin*, WIPO Case No. [D2019-0454](#)) and finds that the hyphen in the disputed domain name may also be disregarded as it is considered merely a punctuation mark (see *Accor and SoLuxury HMC v. YinSi BaoHu Yi KaiQi (Hidden by Whois Privacy Protection Service) / Lin Qing Feng*, WIPO Case No. [D2016-1262](#)).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and the first element required by the Policy is fulfilled.

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

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a good faith provider of goods or services under the disputed domain name and is not making legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, the Respondent did not provide any Response or evidence in this proceeding.

Furthermore, upon review of the facts, the Panel notes that the disputed domain name directs to active website in English, which purports to be the official website of the Complainant, but contains what are presumed to be pay-per-click hyperlinks titled "View on Amazon" which redirect Internet users to the Complainant's products as well as those of its competitors on the Amazon e-commerce platform to generate pay-per-click revenue. The Panel concludes that this shows the Respondent's intention to capitalize on the reputation and goodwill of the Complainant's trademarks for TUFT & NEEDLE, from which the Respondent cannot derive any rights or legitimate interests in the disputed domain name (see also [WIPO Overview 3.0](#), section 2.9 and previous UDRP decisions in this sense such as *Maker Studios, Inc. v. ORM LTD / Contact Privacy Inc. Customer 0137258808*, WIPO Case No. [D2014-0918](#) and *Lennar Pacific Properties Management, Inc., Lennar Mortgage, LLC v. 徐海民 (Xu Hai Min), 权中俊 (Quan Zhong Jun), 殷磊 (Lei Yin), 杨智强 (Zhi Qiang Yang)*, WIPO Case No. [D2021-0576](#)).

On the basis of the foregoing elements, the Panel finds that the Complainant has satisfied the requirements for the second element under the Policy.

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

The Panel finds that the registration of the disputed domain name, which incorporates the Complainant's famous trademark for TUFT & NEEDLE in its entirety, was consciously selected and registered by the Respondent with the clear intention to divert unsuspecting Internet users to the Respondent's website linked to the disputed domain name. This finding is reinforced by the fact that the Respondent also added the descriptive word "mattress" in the disputed domain name, as this is one of the main products offered by the Complainant under the TUFT & NEEDLE marks. The Panel concludes that the registration of the disputed domain name was done with the Respondent's knowledge of the existence of the Complainant's famous marks. Given these elements, the Panel considers that the registration of the disputed domain name was in bad faith.

As to use of the disputed domain name in bad faith, the website linked to the disputed domain name currently displays what are presumed to be pay-per-click hyperlinks titled “View on Amazon” which redirect Internet users to the Complainant’s products as well as that of its competitors on the Amazon e-commerce platform to generate pay-per-click revenue. This shows that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website. The Panel considers that this constitutes direct evidence of bad faith of the Respondent under paragraph 4(b)(iv) of the Policy. Moreover, the Panel also finds that the Complainant sufficiently proves that the Respondent has been engaged in a pattern of trademark-abusive domain name registrations. In this regard, the Panel refers to the prior UDRP decision in the case *Tuft & Needle, LLC v. 郭田田 (guo tian tian)*, WIPO Case No. [D2022-1941](#), involving the same Respondent, where the Respondent had also engaged in very similar acts of cybersquatting against the Complainant’s same TUFT & NEEDLE marks. The preceding elements lead the Panel to conclude that the Respondent is using the disputed domain name in bad faith.

Finally, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third element 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 <tuftneedle-mattress.com> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: December 20, 2022