

ADMINISTRATIVE PANEL DECISION

Williams-Sonoma, Inc. v. 陈军 (Chenjun)

Case No. D2023-0884

1. The Parties

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

The Respondent is 陈军 (Chenjun), China.

2. The Domain Name and Registrar

The disputed domain name <potterybarn-kids.com> is registered with Xiamen ChinaSource Internet Service Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 27, 2023. On February 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 1, 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 (Respondent Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 1, 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 amendment in English to the Complaint on March 2, 2023.

On March 1, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On March 2, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment to 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 the Respondent in Chinese

and English of the Complaint, and the proceedings commenced on March 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 30, 2023.

The Center appointed Douglas Clark as the sole panelist in this matter on April 4, 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 an international retailer of furniture and home products. The Complainant's brands include, among others, the Pottery Barn and Pottery Barn Kids lines of home furnishings and textiles. The Complainant also operates the domain names <potterybarn.com> and <potterybarnkids.com>.

The Complainant is also the owner of several trade mark registrations for POTTERY BARN and POTTERY BARN KIDS in the United States, including the following:

<u>Mark</u>	<u>U.S. Registration Number</u>	<u>First Use</u>	<u>Date Registered</u>
POTTERY BARN	2021077	As early as April, 1956	Registered on December 3, 1996
POTTERY BARN	976344	As early as April 2, 1956	Registered on January 8, 1974
POTTERY BARN	976194	As early as April 2, 1956	Registered on January 8, 1974
POTTERY BARN	959383	As early as April 2, 1956	Registered on May 22, 1973
POTTERY BARN	6389622	As early as December, 1987	Registered on June 15, 2021
POTTERY BARN KIDS	2383910	As early as January 1, 1999	Registered on September 5, 2000
POTTERY BARN KIDS	3397441	As early as October 1, 1999	Registered on March 18, 2008
POTTERY BARN KIDS	6598102	As early as October 14, 2020	Registered on December 21, 2021
POTTERY BARN KIDS	6471333	As early as September, 1999	Registered on August 31, 2021

The Respondent is an individual based in China.

The disputed domain name <potterybarn-kids.com> was registered on April 4, 2021. At the date of this Complaint, the disputed domain name resolved to a website that claimed to be the "Official Online Shop" of Pottery Barn Kids. .

5. Parties' Contentions

A. Complainant

The Complainant contends that:

- (a) The disputed domain name is confusingly similar to its trade mark. The disputed domain name wholly incorporates the Complainant's well known POTTERY BARN and POTTERY BARN KIDS trade

marks. The generic Top-Level Domain (“gTLD”) “.com” in the disputed domain name does not eliminate the overall notion that the designations are connected to the trade mark and the likelihood of confusion that the disputed domain name and the trade mark are associated;

- (b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Complainant has never granted any authorisation or license to use the Complainant’s trade mark. The Respondent is not commonly known by the disputed domain name, and has not made a *bona fide* offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name; and
- (c) The disputed domain name was registered and is being used in bad faith. The mere fact that the Respondent has registered a domain name incorporating a well-known mark gives rise to an inference of bad faith. Based on the use of the disputed domain name, the Respondent registered and is using the disputed domain name to attract Internet users for commercial gain, creating a likelihood of confusion with the Complainant’s trade mark.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue – Language of the Proceeding

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In this case, the language of the Registration Agreement for the disputed domain name is in Chinese. Based on the given evidence, there is no agreement between the Complainant and the Respondent regarding the language of the proceeding. The Respondent did not respond as to the language of the proceeding. The Complainant has filed its Complaint in English and has requested that English be the language for the proceeding under the following grounds:

- a) the website of the disputed domain name is in English; and
- b) in order to proceed in Chinese, the Complainant would have had to retain specialised translation services that would cause an unnecessary burden to the Complainant and delay the proceeding.

In accordance with paragraph 11(a) of the Rules, the Panel hereby determines that the language of the proceeding shall be in English after considering the following circumstances:

- the Center has notified the Respondent of the proceeding in both English and Chinese;
- the Respondent has not commented on the language of the proceeding;
- the website under the disputed domain name is wholly in English;
- The contact address for the website under the disputed domain name is in Hong Kong, China. English is an official language of Hong Kong, China; and

- an order for the translation of the Complaint will result in significant expenses for the Complainant and a delay in the proceeding.

Further, this Panel decided in *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#), that a respondent's failure to respond to a preliminary determination by the Center as to the language of the proceeding "should, in general, be a strong factor to allow the Panel to decide to proceed in favour of the language of the Complaint".

6.2 Substantive Issues

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

- (i) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights to;
- (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 are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name <potterybarn-kids.com> is confusingly similar to the Complainant's trade mark. The disputed domain name incorporates the POTTERY BARN and POTTERY BARN KIDS trade marks in full followed by the gTLD ".com". The gTLD is generally disregarded when considering the first element. See Section 1.11.1, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel notes that the Complainant did not rely on any registered trade marks in China where the Respondent is located. The ownership of a trade mark is generally considered to be a threshold standing issue. The location of the trade mark, its date of registration (or first use) and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trade mark under the first element of the UDRP. These factors may however bear on a panel's further substantive determination under the second and third elements. (See section 1.1.2 of [WIPO Overview 3.0](#)).

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Respondent has not asserted any rights or legitimate interests in relation to the disputed domain name.

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, the Respondent has no rights or legitimate interests in regard to the disputed domain name.

The Panel also notes that the disputed domain name resolves to a page that advertises POTTERY BARN and POTTERY BARN KIDS products. No allegation is made in the Complaint that these are counterfeit. Instead, the Complainant refers to it as a “spoof” website. The Panel will consider the matter on the assumption that genuine products are being sold.

In principle, it is not objectionable to resell or promote for resale genuine trademarked goods by reference to the mark. Further, as long as certain conditions are met a seller can make use of a trade mark in a domain name to sell genuine products. In *Oki Data Americas, Inc. v. ASD, Inc.* WIPO Case No. [D2001-0903](#), the panel in that case held that to be “*bona fide*” within the meaning of paragraph 4(c)(i) of the policy, the offering should meet the following requirements:

- The Respondent must actually be offering the goods or services at issue;
- The Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trade mark to bait internet users and then switch them to other goods;
- The site must accurately disclose the registrant’s relationship with the trade mark owners; it may not, for example, falsely suggest that it is the trade mark owner, or that the website is the official site; and
- The Respondent must not try to corner the market in all domain names, thus depriving the trade mark owner of reflecting its own mark in a domain name.

In this case, the Respondent does not meet, at least, the third requirement set out above. The website under the disputed domain name does not accurately disclose its relationship with the Complainant, rather it clearly states it is an official Pottery Barn Kids website when, in fact, it is not.

In addition, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1, [WIPO Overview 3.0](#).

The second element of paragraph 4(a) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

Based on the given evidence, the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered long after the Complainant has registered the POTTERY BARN and POTTERY BARN KIDS trade marks and the use of the Complainant’s POTTERY BARN and POTTERY BARN KIDS trade marks are clearly not a coincidence. The POTTERY BARN and POTTERY BARN KIDS trade marks are used by the Complainant to conduct its business and the Complainant has used the trade mark for over 50 years. The Panel is satisfied that the Respondent was aware of the Complainant and its POTTERY BARN and POTTERY BARN KIDS trade marks when he or she registered the disputed domain name.

The Respondent has registered the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy. The disputed domain name directs Internet users to an almost identical copycat website of the Complainant’s website at “[www.potterybarnkids.com](#)”. The Respondent is intentionally attracting Internet users to the disputed domain name by misleading them into believing they are transacting on the Complainant’s official website.

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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 <potterybarn-kids.com> be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: April 19, 2023