

ADMINISTRATIVE PANEL DECISION

JPW Industries Inc. v. Jiang Wei
Case No. D2023-2362

1. The Parties

Complainant is JPW Industries Inc., United States of America (“United States”), represented by Holland & Knight LLP, United States.

Respondent is Jiang Wei, China.

2. The Domain Name and Registrar

The disputed domain name <thewiltontool.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2023. On June 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 2, 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 Information Hidden By Private Service) and contact information in the Complaint. The Center sent an email communication to Complainant on June 5, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint in English on June 23, 2023.

On June 5, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On June 6, 2023, Complainant confirmed its request that English be the language of the proceeding. 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 Respondent in English and Chinese of the Complaint, and the proceedings commenced on June 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 16, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 25, 2023.

The Center appointed Yijun Tian as the sole panelist in this matter on August 11, 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

A. Complainant

Complainant is a company incorporated in the United States. Founded in 1941, Complainant, or its predecessors-in-interest, has operated a retail business specialising in providing certain tools, tool accessories, and other material-handling products under the WILTON trademark.

Complainant has exclusive rights in the WILTON and WILTON-related marks. Complainant is the exclusive owner of numerous WILTON trademarks worldwide, including the United States trademark registration for WILTON, registered on November 21, 1950 (registration number 0533620); the United Kingdom trademark registration for WILTON, registered on February 24, 1999 (registration number UK00900346254); and the International trademark registration for WILTON, registered on November 25, 2003 (registration number 828763) which contains China as one of the designations.

B. Respondent

Respondent is Jiang Wei, China. The disputed domain name was registered on November 2, 2022. According to the Complaint and relevant evidence provided by Complainant, the disputed domain name is currently resolving to a website purporting to be an authorised online store for Complainant's products, and the website is in the English language and contains the contents copied from the original website of Complainant.¹

5. Parties' Contentions

A. Complainant

Complainant contends that the disputed domain name is confusingly similar to the WILTON trademark. By using a domain name and marks which are confusingly similar to Complainant's internationally-and federally-protected marks; using product images which are identical to those displayed on Complainant's website; and purporting to offer tool and tool accessory products under the disputed domain name and mark, Respondent's actions are calculated to trade off Complainant's established trademark rights, reputation, and goodwill.

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

Complainant contends that Respondent has registered and used the disputed domain name in bad faith.

Complainant requests that the disputed domain name be transferred to Complainant.

¹ See the website resolved by the disputed domain name "<https://www.thewiltontool.com/>"; see also the original website of Complainant "<https://wiltontools.com/>".

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

6.1. Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between 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. From the evidence presented on the record, no agreement appears to have been entered into between Complainant and Respondent to the effect that the language of the proceeding should be English. Complainant filed initially its Complaint in English, and has requested that English be the language of the proceeding for the following main reasons:

- (a) Respondent is purportedly offering WILTON-branded goods to the consuming public through an English-based business and e-commerce website. Indeed, and as seen on the disputed domain name's resultant website, Respondent alleges to have a business address in New Jersey, United States;
- (b) Respondent is communicating to the general consuming public that it (allegedly) operates a business establishment within the United States - a country where English is the primary language; and
- (c) all relevant evidence concerning the disputed domain name, and its resultant website, are in English. Complainant, who is the rightful owner of the WILTON brand and marks, is an English business with a principal place of business within the United States.

Respondent did not make any submissions with respect to the language of the proceeding and did not object to the use of English as the language of the proceeding.

Paragraph 11(a) of the Rules allows the UDRP panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding. In other words, it is important to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes (*Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. ltd.*, WIPO Case No. [D2008-0293](#); and *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#)). The language finally decided by the panel for the proceeding should not be prejudicial to either one of the parties in its abilities to articulate the arguments for the case (*Groupe Auchan v. xmxzl*, WIPO Case No. [DCC2006-0004](#)). Section 4.5.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") further states:

"Noting the aim of conducting the proceedings with due expedition, paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

Against this background, panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant's mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names,

the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.” (See also *L’Oreal S.A. v. MUNHYUNJA*, WIPO Case No. [D2003-0585](#)).

The Panel has taken into consideration the facts that Complainant is a company from the United States, and Complainant will be spared the burden of working in Chinese as the language of the proceeding. The Panel has also taken into consideration the fact that the disputed domain name includes Latin characters and particularly English words (“the” and “tool”), and is registered in the generic Top-Level Domain (“gTLD”) “.com” (*Compagnie Gervais Danone v. Xiaole Zhang*, WIPO Case No. [D2008-1047](#)).

On the record, Respondent appears to be a Chinese resident and is thus presumably not a native English speaker. However, considering the following, the Panel has decided that English should be the language of the proceeding: (a) the disputed domain name includes Latin characters, and particularly English words (“the” and “tool”), rather than mere Chinese scripts; (b) the website resolved by the disputed domain name is in the English language also;² (c) the Center has notified Respondent of the proceeding in both Chinese and English, and Respondent has indicated no objection to Complainant’s request that English be the language of the proceeding; and (d) the Center informed the Parties, in English and Chinese, that it would accept a Response in either English or Chinese. The Panel would have accepted a response in either English or Chinese, but none was filed.

Accordingly, the Panel finds the choice of English as the language of the present proceeding is fair to both Parties and is not prejudicial to either one of the Parties in its ability to articulate the arguments for this case. Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that English shall be the language of the proceeding, and the decision will be rendered in English.

6.2. Substantive Issues

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that the disputed domain name should be cancelled or transferred:

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

On the basis of the evidence introduced by Complainant and in particular with regard to the content of the relevant provisions of the Policy (paragraphs 4(a)-(c)), the Panel concludes as follows:

A. Identical or Confusingly Similar

The Panel finds that Complainant has rights in the WILTON marks. The disputed domain name comprises the WILTON mark in its entirety. The disputed domain name only differs from Complainant’s trademarks by the prefix “the”, the suffix “tool”, and the gTLD “.com” to the WILTON marks. This does not prevent a finding of confusing similarity between Complainant’s registered trademarks and the disputed domain name (*Decathlon v. Zheng Jianmeng*, WIPO Case No. [D2019-0234](#)).

Previous UDRP panels have consistently held that a domain name is identical or confusingly similar to a trademark for purposes of the Policy regardless of additional material. [WIPO Overview 3.0](#), section 1.8.

² See website at “www.thewiltontool.com”.

Further, in relation to the gTLD, section 1.11.1 of [WIPO Overview 3.0](#) further states: “The applicable Top-Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”

The Panel therefore holds that the Complaint fulfils the first condition of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to Respondent of the dispute, the use by Respondent of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) Respondent has been commonly known by the disputed domain name, even if Respondent has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish Complainant’s trademarks.

The overall burden of proof on this element rests with Complainant. However, it is well established by previous UDRP panel decisions that once a complainant establishes a *prima facie* case that a respondent lacks rights or legitimate interests in a domain name, the burden of production shifts to respondent to rebut complainant’s contentions. If respondent fails to do so, complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. (*Danzas Holding AG, DHL Operations B.V. v. Ma Shikai*, WIPO Case No. [D2008-0441](#); and [WIPO Overview 3.0](#), section 2.1 and cases cited therein).

According to the Complaint, founded in 1941, Complainant has operated a retail business specialising in providing certain tools, tool accessories, and other material-handling products under the WILTON trademark. The WILTON marks have been registered internationally, including the United States since 1950, the United Kingdom since 1999, and international trademark registration which contains China as one of the designations since 2003.

Moreover, Respondent, while not affiliated with Complainant, is allegedly offering purported WILTON branded products and services, and using WILTON trademark and product images from Complainant’s official website, and using the disputed domain name to allegedly sell Complainant’s WILTON branded products. (*The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. [D2009-0610](#); *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#); and *Philip Morris Products S.A. v. Lin Cheng, Han Ming*, WIPO Case No. [D2018-2688](#)).

Based on the following reasons, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name:

(a) there has been no evidence adduced to show that Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Respondent has not provided evidence of legitimate use of the disputed domain name or reasons to justify the choice of the term “wilton” in the disputed domain name and in his/her business operation. There has been no evidence to show that Complainant has licensed or otherwise permitted Respondent to use the WILTON marks or to apply for or use any domain name incorporating the WILTON marks, and Respondent has, through the use of the confusingly similar disputed domain name and its webpage contents, created a risk of implied affiliation with Complainant and its WILTON marks;

(b) there has been no evidence adduced to show that Respondent has been commonly known by the disputed domain name. There has been no evidence adduced to show that Respondent has any registered trademark rights with respect to the disputed domain name. Respondent registered the disputed domain name in 2022, long after the WILTON marks became internationally known. The disputed domain name is confusingly similar to the WILTON marks; and

(c) there has been no evidence adduced to show that Respondent is making a legitimate noncommercial or fair use of the disputed domain name. By contrast, the Panel finds that the disputed domain name resolves to a website allegedly selling purported WILTON products and accessories, without any statement clarifying the website's ownership or (lack of) affiliation to Complainant.

The Panel notes that Respondent has not produced any evidence to establish his/her rights or legitimate interests in the disputed domain name.

Accordingly, Complainant has established that Respondent has no rights or legitimate interests in the disputed domain name. The Panel therefore holds that the Complaint fulfils the second condition of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out four circumstances, which, without limitation, shall be evidence of the registration and use of the disputed domain name in bad faith, namely:

(i) circumstances indicating that Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on the website or location.

The Panel concludes that the circumstances referred to in paragraph 4(b)(iv) of the Policy are applicable to the present case and upon the evidence of these circumstances and other relevant circumstances, it is adequate to conclude that Respondent has registered and used the disputed domain name in bad faith.

(a) Registration in Bad Faith

The Panel finds that Complainant has a widespread reputation in the WILTON marks with regard to its products and services. Founded in 1941, Complainant has operated a retail business specialising in providing certain tools, tool accessories, and other material-handling products under the WILTON trademark as mentioned above. It is not conceivable that Respondent would not have had actual notice of the WILTON marks at the time of the registration of the disputed domain name (in 2022), particularly given that Respondent has used the WILTON logo and product photos taken from Complainant's official website on the website at the disputed domain name, and is allegedly selling purported WILTON products. The Panel therefore finds that the WILTON mark is not one that a trader could legitimately adopt other than for the

purpose of creating an impression of an association with Complainant (*The Argento Wine Company Limited v. Argento Beijing Trading Company, supra*).

Moreover, Respondent has chosen not to respond to Complainant's allegations. According to the UDRP decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company, supra*, "the failure of the Respondent to respond to the Complaint further supports an inference of bad faith". See also *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#).

Thus, the Panel concludes that the disputed domain name was registered in bad faith.

(b) Use in Bad Faith

Respondent is using the website resolved by the disputed domain name to allegedly sell purported WILTON products. Thus, the Panel concludes that Respondent is currently using the confusingly similar disputed domain name with the intention to attract, for commercial gain, Internet users to Respondent's website.

Given the reputation of the WILTON marks, the Panel finds that the public is likely to be confused into thinking that the disputed domain name has a connection with Complainant, contrary to the fact. There is a strong likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the website to which the disputed domain name resolves. In other words, Respondent has, through the use of a confusingly similar disputed domain name, created a likelihood of confusion with the WILTON marks. Moreover, as mentioned above, Respondent allegedly sells purported WILTON products and accessories via the website to which the disputed domain name resolves, presumably for commercial gain.

The Panel concludes that the disputed domain name was registered and is being used by Respondent in bad faith. Such use of the disputed domain name is also disruptive in relation to the interests of Complainant.

In summary, by choosing to register and use the disputed domain name, which is confusingly similar to the WILTON marks, Respondent intended to ride on the goodwill of this trademark in an attempt to exploit Internet users for commercial gain destined for Complainant. In the absence of evidence to the contrary and rebuttal from Respondent, the choice of the disputed domain name and the conduct of Respondent as far as the website to which the disputed domain name resolves is indicative of registration and use of the disputed domain name in bad faith.

The Panel, therefore, holds that Complaint fulfils the third condition of paragraph 4(a) of the Policy.

7. Decision

For all 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 <thewiltontool.com> be transferred to Complainant.

/Yijun Tian/

Yijun Tian

Sole Panelist

Date: September 9, 2023