

ADMINISTRATIVE PANEL DECISION

Williams-Sonoma, Inc. v. Domain Admin, Hong Kong Domain
Case No. D2023-5160

1. The Parties

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

Respondent is Domain Admin, Hong Kong Domain, China.

2. The Domain Name and Registrar

The disputed domain name <pottybarn.com> is registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 12, 2023. On December 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 13, 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 (Domain Admin, Whois Privacy Corp.) and contact information in the Complaint. The Center sent an email communication to Complainant on December 13, 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 on December 13, 2023.

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 of the Complaint, and the proceedings commenced on December 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 8, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 15, 2024.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on January 18, 2024. 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 is a company organized under the laws of the United States that is active in the home-goods retailers and manufacturers business and trades, inter alia, under the brand “Pottery Barn”.

Complainant has provided evidence that it is the registered owner of numerous trademarks relating to this brand, inter alia, but not limited, to the following:

- word mark POTTERY BARN, United States Patent and Trademark Office (USPTO), registration number: 2021077, registration date: December 3, 1996, status: active.

Moreover, Complainant has demonstrated to own since 1995 the domain name <potterybarn.com>, which resolves to Complainant’s main website at “www.potterybarn.com”, used to promote Complainant’s home-goods (furniture, home decor etc.) internationally.

Respondent, according to the disclosed Whois information for the disputed domain name, is located in China. The disputed domain name was registered on September 8, 2011; at the time of filing of the Complaint, it resolved to a typical Pay-Per-Click (PPC) website with hyperlinks to active third parties’ websites, some of which directly refer to Complainant and its POTTERY BARN trademark, but – as demonstrated by Complainant – ultimately redirect Internet users to websites with commercial content that is totally unrelated thereto. Also, the PPC website at the disputed domain name indicated that the latter “may be for sale”.

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

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, Complainant contends to be one of America’s premier upscale and luxury home goods retailers and manufacturers with roots going back to the year 1949 and over 200 retail stores in the United States and other countries, and that its POTTERY BARN trademark is meanwhile distinctive and a well-known source identifier among the general public.

Complainant submits that the disputed domain name is confusingly similar to Complainant’s POTTERY BARN trademark, as it constitutes a typo-squatted version of the latter caused by the removal of the letters “er” in “Pottery”. Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent has engaged in a typical act of typo-squatting and consumers likely attempting to access information about Complainant and its products under the POTTERY BARN trademark will mistakenly enter the disputed domain name and be directed to Respondent’s website, and (2) it further appears that Respondent is using the disputed domain name in a “parking” fashion with a link tree or link farming operation that directly benefits from Complainant’s goodwill. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) Respondent was clearly aware of Complainant, its furniture and bedding products, and its prior POTTERY BARN trademarks, as those predate Respondent’s registration of the disputed domain name by decades, and (2) Respondent has clearly engaged in a textbook case of bad faith typo-squatting with the aim of confusing and redirecting Internet users who are interested in learning about and accessing Complainant’s

POTTERY BARN products, but mistakenly enter the disputed domain name, so that any alleged good-faith plans that Respondent may put forward to attempt to justify its registration of the disputed domain name lack credibility and should be ignored.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

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

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

A. Identical or Confusingly Similar

First, it is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's POTTERY BARN trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Complainant has shown rights in respect of the POTTERY BARN trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Also, the Panel finds that the POTTERY BARN trademark is still recognizable within the disputed domain name, which constitutes a typo-squatted version of said trademark by omitting the letters "er" in "Pottery". Accordingly, the disputed domain name is confusingly similar to Complainant's POTTERY BARN trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel, therefore, finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Second, paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In particular, Respondent has not been authorized to use Complainant's POTTERY BARN trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the terms "pottery" and/or "barn" on its own. Finally, Respondent obviously has neither used the disputed domain name for a bona fide offering of goods or services nor for a legitimate noncommercial or fair purpose. On the contrary, the disputed domain name resolves to a typical PPC website showing a variety of hyperlinks to third-party websites, some of which directly refer to Complainant and its POTTERY BARN trademark, but – as demonstrated by Complainant – ultimately redirect Internet users to websites with commercial content that is totally unrelated thereto, for the obvious purpose of generating PPC revenues. UDRP panels agree that using a domain name to host a PPC website does not present a bona fide offering where such PPC links compete with or capitalize on the reputation and goodwill of the complainant's trademark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9.

Also, given that the disputed domain name consists of Complainant's undisputedly distinctive and well-known POTTERY BARN trademark (albeit a deliberate misspelling constituting typo-squatting), the disputed domain name is intentionally misleading and, therefore, carries, as such, the high risk of implied affiliation with this trademark. [WIPO Overview 3.0](#), section 2.5.1.

The Panel, therefore, finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Third, the Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the circumstances allow to conclude that the disputed domain name constitutes a typo-squatted version of Complainant's undisputedly distinctive and well-known POTTERY BARN trademark by omitting the letters "er" in "Pottery", and that, therefore, Respondent was well aware of said trademark when registering the disputed domain name. Moreover, resolving the disputed domain name which is confusingly similar to Complainant's POTTERY BARN trademark to a typical PPC website showing a variety of hyperlinks to active third-party websites, some of which directly refer to Complainant and its POTTERY BARN trademark, but – as demonstrated by Complainant – ultimately redirect Internet users to websites with commercial content that is totally unrelated thereto, for the obvious purpose of generating PPC revenues, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with Complainant's POTTERY BARN trademark as to the source, sponsorship, affiliation or endorsement of this website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

In this context, it also carries weight in the eyes of the Panel that Respondent obviously provided false or incomplete contact information in the Whois register for the disputed domain name since, according to the email correspondence between the Center and the postal courier DHL, the Written Notice on the Notification of Complaint dated December 19, 2023, could not be delivered. This fact at least throws a light on Respondent's behavior which supports the Panel's conclusion that the disputed domain name has been registered and is used in bad faith within the meaning of the Policy.

For the sake of completeness, it is finally worth mentioning that the registration date of the disputed domain name back in 2011 is not in contrast to such finding, because (1) Complainant's POTTERY BARN trademark has been registered and has been used even many decades prior to the disputed domain name's registration, and (2) panels have widely recognized that the 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. [WIPO Overview 3.0](#), section 4.17.

The Panel, therefore, finds the third element of the Policy has been established, too.

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 <pottybarn.com> be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: February 1, 2024