

ADMINISTRATIVE PANEL DECISION

CW Brands LLC v. 吴思山 (roy LI), 蒋春文 (roy LI)
Case No. D2023-5388

1. The Parties

Complainant is CW Brands LLC, United States of America (“USA”), represented by Kaufman & Kahn, LLP, United States of America.

Respondents are 吴思山 (roy LI), Hong Kong, China, and 蒋春文 (roy LI), Hong Kong, China.

2. The Domain Names and Registrar

The disputed domain names <coldwatercreekshop.com> and <coldwatercreekvip.com> are registered with West263 International Limited (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 28, 2023. On January 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 3, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registry Domain IDs: 2824677651_DOMAIN_COM-VRSN, 010668741f6949f5ab822b1fde235438-DONUTS, 2825961507_DOMAIN_COM-VRSN, and 2825729272_DOMAIN_COM-VRSN) and contact information in the Complaint. The Center sent an email communication to Complainant on January 4, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint in English on January 5, 2024.

On January 4, 2024, the Center informed the Parties in Chinese and English, that the language of the registration agreement for the disputed domain names is Chinese. On January 11, 2024, Complainant confirmed its request that English be the language of the proceeding. Respondents did not submit any comment on Complainant’s submission.

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 Respondents in Chinese and English of the Complaint, and the proceedings commenced on January 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 4, 2024. Respondents did not submit any response. Accordingly, the Center notified Respondents' default on February 6, 2024.

The Center appointed Yijun Tian as the sole panelist in this matter on February 14, 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

A. Complainant

Complainant, CW Brands LLC, is a company incorporated in USA. Complainant has rights in the COLDWATER CREEK related marks. Complainant is the owner of numerous COLDWATER CREEK trademarks in various countries, including the USA trademark registration for COLDWATER CREEK, registered on November 1, 1994 (registration number: 1861320) in international class 42 for retail services; and the USA trademark registration for COLDWATER CREEK, registered on January 31, 1995 (registration number: 1876534) in international class 14 for jewellery; (Annexes 7 and 8 to the Complaint).

B. Respondents

Respondents are 吴思山 (roy LI), Hong Kong, China, 蒋春文 (roy LI), Hong Kong, China.

- The disputed domain name <coldwatercreekshop.com> was registered (with West263 International Limited) by 吴思山 (roy LI), Hong Kong, China, on October 31, 2023.
- The disputed domain name <coldwatercreekvip.com> was registered (with West263 International Limited) by 蒋春文 (roy LI), Hong Kong, China, on October 30, 2023.

According to the Complaint and relevant evidence provided by Complainant, the disputed domain names resolved to inactive websites. (Annex 4 to the Complaint).

5. Parties' Contentions

A. Complainant

Complainant contends that the disputed domain names are identical or confusingly similar to the COLDWATER CREEK marks owned by Complainant because they both contain the dominant portion of the marks, "coldwater creek", along with minor additions ("shop" and "vip"), which do not change the overall meaning and impression.

Complainant contends that Respondents lack rights or legitimate interests in the disputed domain names.

Complainant contends that the disputed domain names were registered and are being used in bad faith.

Complainant requests that the disputed domain names be transferred to it.

B. Respondents

Respondents did not reply to Complainant's contentions.

6. Discussion and Findings

6.1. Language of the Proceeding

The language of the Registration Agreements for the disputed domain names <coldwatercreekshop.com> and <coldwatercreekvip.com> is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

From the evidence presented on the record, no agreement appears to have been entered into between Complainant and Respondents 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 reasons:

(a) The inclusion of “coldwater creek,” English words presented in the Roman alphabet, suggests Respondent’s proficiency in the English language.

(b) Complainant conducts its global business in English and should not be burdened with translating pleadings if Respondent fails to participate in the dispute process.

Respondents did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1).

On the record, Respondents, 吴思山 (roy LI) and 蒋春文 (roy LI), appears to be located in Hong Kong, China and are thus presumably not native English speakers, but considering the following aspects, the Panel has decided that the language of the proceeding shall be English: (a) the disputed domain names are registered in Latin characters, particularly in English (e.g. English words “cold”, “water”, “creek”, “vip”, and “shop”), rather than Chinese script; (b) the generic Top-Level Domain (“gTLD”) of the disputed domain names are “.com”, so the disputed domains names seem to be prepared for users worldwide, particularly in English speaking countries; (d) the Center has notified Respondents of the language of the proceeding in both Chinese and English, and Respondents have indicated no objection to Complainant’s request that English be the language of the proceeding; (e) the Center also notified Respondents in both Chinese and English of the Complaint, and informed Respondents that it would accept a response in either English or Chinese, but Respondents chose not to file any response.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on Complainant’s request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See [WIPO Overview 3.0](#), section 4.11.2.

As regards common control, the Panel finds that Complainant has provided sufficient evidence to establish that the disputed domain names or corresponding websites are subject to common control, for the following reasons:

- (a) The registrants for both disputed domain names share the same English name, "roy LI," despite having different Chinese names.
- (b) Both disputed domain names were registered through the same registrar, and on nearly the same date: October 30 and 31, 2023, respectively.
- (c) Both disputed domain names follow a similar naming pattern, incorporating "coldwater creek" and appending a single word at the end, imitating the format of Complainant's website addresses and registered trademark.
- (d) Both disputed domain names either lead to no website or initially feature a browser warning regarding the unsafe nature of the website being accessed, with identical security certificates.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "Respondent") in a single proceeding.

6.3 Substantive Issues: Three Elements

A. Identical or Confusingly Similar

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 the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the COLDWATER CREEK mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of the other terms "shop" and "vip" may bear on the assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

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

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

More specifically:

(i) there has been no evidence adduced to show that Respondent is using the disputed domain names in connection with a bona fide offering of goods or services. Respondent has not provided evidence of reasons to justify the choice of the terms “cold water creek”, Complainant’s COLDWATER CREEK trademark, in the disputed domain names. There has been no evidence to show that Complainant has licensed or otherwise permitted Respondent to use the COLDWATER CREEK marks or to apply for or use any domain name incorporating the COLDWATER CREEK marks;

(ii) there has been no evidence adduced to show that Respondent has been commonly known by the disputed domain names. There has been no evidence adduced to show that Respondent has any registered trademark rights with respect to the disputed domain names. Respondent registered the disputed domain names in 2023, long after the COLDWATER CREEK marks (registered as a trade mark since 1994) became widely known. The disputed domain names are confusingly similar to Complainant’s COLDWATER CREEK marks; and

(iii) there has been no evidence adduced to show that Respondent is making a legitimate noncommercial or fair use of the disputed domain names. By contrast, both disputed domain names resolved to inactive websites and, according to the evidence in the Complaint, initially feature browser warnings regarding the unverifiable security certificate of the websites and the potential for phishing attacks as a result.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

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 Panel notes that Respondent has registered and used the disputed domain names in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The disputed domain names are inactive, but have featured warning messages indicating the unsafe nature of the websites being accessed and the potential for phishing attacks. Given the browser warnings displayed, the Panel finds that the unverifiable security certificates of the disputed domain names support a finding that the Respondent has engaged in bad faith when registering the disputed domain names.

Regarding inactive disputed domain names, UDRP panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain names <coldwatercreekshop.com> and <coldwatercreekvip.com> does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, the composition of the disputed domain names <coldwatercreekshop.com> and <coldwatercreekvip.com>, the browser warning messages displayed when accessing the disputed domain names, and finds that in the circumstances of this case, the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy. Moreover, the Respondent appears to have furnished incomplete contact details, the Center being unable to send its written communications to the physical addresses disclosed, and such provision of false contact information further reinforces the Panel’s belief that the Respondent has engaged in bad faith conduct.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 names <coldwatercreekshop.com> and <coldwatercreekvip.com>, be transferred to Complainant.

/Yijun Tian/

Yijun Tian

Sole Panelist

Date: March 22, 2024