

## **ADMINISTRATIVE PANEL DECISION**

Williams-Sonoma, Inc. v. 林靖 (Jing Lin)

Case No. D2024-2797

### **1. The Parties**

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

The Respondent is 林靖 (Jing Lin), China.

### **2. The Domain Name and Registrar**

The disputed domain name <williamssonomastore.com> is registered with Cloud Yuqu LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 9, 2024. On July 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 11, 2024, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 11, 2024, 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 amended Complaint on July 11, 2024.

On July 11, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On July 11, 2024, the Complainant requested English to be the language of the proceeding.

The Center verified that 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 July 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2024.

The Center appointed Francine Tan as the sole panelist in this matter on August 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**

The Complainant is a U.S. home goods retailer and manufacturer. Its brands include WILLIAMS SONOMA, POTTERY BARN, WEST ELM, and REJUVENATION, which are sold internationally through its over 600 retail stores locations worldwide, catalogues, and online.

The Complainant states that it launched its WILLIAMS SONOMA brand in 1956, and has since continuously offered a full line of in-house designed products for the home including kitchenware, furniture, and bedding products under its distinctive and well-known WILLIAMS SONOMA, WILLIAMS SONOMA HOME, WILLIAMS SONOMA SIGNATURE, WILLIAMS SONOMA CALIFORNIA, and WILLIAMS-SONOMA RESERVE trade marks.

The Complainant further states that it owns over 400 WILLIAMS SONOMA trade mark applications and registrations (the "WILLIAMS SONOMA Marks") in approximately 30 jurisdictions worldwide (including in China). Its U.S. registrations include:

- U.S. Registration No. 1777864, registered on June 22, 1993;
- U.S. Registration No. 2292343, registered on November 16, 1999; and
- U.S. Registration No. 2353758, registered on May 30, 2000.

The Complainant owns and operates its primary website at the domain name <williams-sonoma.com>, registered on October 3, 1995. It has used the website since as early as 1997.

The disputed domain name was registered on June 20, 2024, and at the time of the filing of the Complaint resolved to a website resembling the Complainant's website. The Respondent's website offers for sale goods that are similar to the Complainant's own offerings.

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

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- The disputed domain name is confusingly similar to the WILLIAMS SONOMA Marks in which it has rights. The disputed domain name contains the identical letter string "williamssonoma", with the addition of the generic term, "store".
- The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not known by either the disputed domain name or "Williams Sonoma". The Respondent could not have developed common law trade mark rights in the WILLIAMS SONOMA Marks. The Respondent is not affiliated with the Complainant and the Complainant has not licensed or permitted the Respondent to use the WILLIAMS SONOMA Marks or any domain name incorporating them.
- The disputed domain name resolves to a website, the overall presentation of which reproduces the Complainant's official website with online purchasing functionality. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services that can be

considered to be legitimate fair use. Further, the Respondent's website utilizes unauthorized copies of the Complainant's copyright-protected photography and marketing text, in a manner that deceives consumers into believing they are purchasing goods from the Complainant. There is nothing on the Respondent's website that disclaims any affiliation with the Complainant. Much of the contact and other information shown on the "About Us" page of the Respondent's website is false and/or incomplete.

- The disputed domain name was registered and is being used in bad faith. The Respondent registered and used the disputed domain name in a deliberate attempt to direct third parties looking for the Complainant to its website by impersonating the Complainant. The Respondent was clearly aware of the Complainant and its WILLIAMS SONOMA brand and registered a domain name which is nearly identical to, and which incorporates the entirety of, the Complainant's WILLIAMS SONOMA Marks. The Respondent's website prominently displays the Complainant's WILLIAMS SONOMA Marks, which would mislead consumers into believing that they have reached the authentic and official website of the Complainant. It is implausible that the products offered for sale on the Respondent's website are genuine products as they are priced much lower than the genuine article. The Respondent has been a party to at least seven prior UDRP proceedings where orders for the transfer of the relevant domain names were made. The Respondent has also registered other domain names containing well-known third party trade marks.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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 unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that:

- the Complainant's language is English;
- the language of the Respondent's website is English, which demonstrates the Respondent's ability to communicate in English; and
- the "Contact Us" address listed on the Respondent's website is in California and its legal notices are all in English.

The Respondent 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).

Having considered all the matters above including the fact that the disputed domain name comprises Latin characters, containing the English surname "Williams" as well as the English word "store", and that the Respondent did not comment on the language of the proceeding, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English. The Panel is persuaded that the

Respondent is familiar with the English language and does not find any reason to delay the proceeding or burdening the Complainant with the costs stemming from an order for the Complaint to be translated into Chinese.

### **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 trade mark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trade mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the WILLIAMS SONOMA Marks are reproduced within the disputed domain name with the addition of the word "store". Accordingly, the disputed domain name is confusingly similar to the Complainant's marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the term "store" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trade mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

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 the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Considering the extensive fame and reputation of the WILLIAMS SONOMA Marks, it would in fact be extremely difficult to envisage any way in which the Respondent could attempt to assert rights or legitimate interests in the disputed domain name, in the absence of any consent or licence from the Complainant.

Moreover, panels have held that the use of a domain name for illegal activity, here, claimed passing off or impersonation, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 disputed domain name incorporates the entirety of the Complainant's well-established and famous trade mark with the addition of the term "store". It is evident that the Respondent knew of and targeted the Complainant and its WILLIAMS SONOMA Marks at the time it registered the disputed domain name. The Panel concludes in this case that the circumstances fall within paragraph 4(b)(iv) of the Policy, i.e., "by using the domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [his] web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of [his] web site or location or of a product or service on [his] web site or location".

Further, panels have held that the use of a domain name for illegal activity, here, claimed impersonation or passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, including the apparent pattern of cybersquatting, the Panel finds that the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <williamssonomastore.com> be transferred to the Complainant.

*/Francine Tan/*

**Francine Tan**

Sole Panelist

Date: August 27, 2024