

ADMINISTRATIVE PANEL DECISION

Susan Lordi v. 方键铭 (fang jian ming)

Case No. D2022-0395

1. The Parties

The Complainant is Susan Lordi, United States of America (“US”), represented by Hovey Williams LLP, US.

The Respondent is 方键铭 (fang jian ming), China.

2. The Domain Names and Registrars

The disputed domain name <willowtree.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. and the disputed domain name <willowtree-store.shop> is registered with Alibaba Cloud Computing Ltd. (collectively the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 4, 2022. On February 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 9, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 9, 2022 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 in English on February 10, 2022.

On February 9, 2022, the Center transmitted another email communication to the Parties in English and Chinese regarding the language of the proceeding. On February 10, 2022, the Complainant confirmed her 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 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 English and Chinese of the Complaint, and the proceedings commenced on February 17, 2022. In accordance with

the Rules, paragraph 5, the due date for Response was March 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 11, 2022.

The Center appointed Rachel Tan as the sole panelist in this matter on March 18, 2022. 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 individual specialising in the design, manufacture, sale, and distribution of Willow Tree figurines and home decorations since 2000. Among other marketplaces, the Complainant's figures are sold at "www.willowtree.com", which is a website operated by one of the Complainant's authorised dealer, Demdaco (the "Complainant's Website").

The Complainant is the owner of the WILLOW TREE trade marks in multiple jurisdictions, including US Registration No. 2687795, registered on February 18, 2003 in classes 20 and 24; US Registration No. 3572110, registered on February 10, 2009 in class 28; and Chinese Registration No. 11633838, registered on March 28, 2014 in class 28.

The Complainant is also the owner of the trade marks covering the elements "Susan Lordi" in multiple jurisdictions, such as US Registration No. 3507543 for SUSAN LORDI, registered on September 30, 2008 in classes 20, 24 and 28; and Chinese Registration No. 11633840 for , registered on January 7, 2015 in class 20.

The Respondent is 方键铭 (fang jian ming), China.

The disputed domain names <willowtree.com> and <willowtree-store.shop> were registered on March 25, 2021 and April 16, 2021, respectively. At the date of this Decision, the disputed domain names do not resolve to any active website. At the time of filing of the Complaint, both disputed domain names resolved to websites in English which appeared to offer the Complainant's products for sale at a discounted price. The resolved websites displayed the Complainant's WILLOW TREE, SUSAN LORDI and  marks, as well as images and information of the Complainant's products taken from the Complainant's Website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are nearly identical to, or confusingly similar with, and a near-exact reproduction of the WILLOW TREE mark. The disputed domain names' incorporation of the WILLOW TREE mark demonstrates that they are identical or a confusingly similar approximation to the Complainant's trade mark registrations. The addition of "-store" and substitution of an "i" for the letter "l" as an intentional misspelling of the WILLOW TREE mark in the disputed domain names do not avoid the confusing similarity between the disputed domain names and the WILLOW TREE mark. The generic Top-Level Domains ("gTLD") ".shop" and ".com" component of the disputed domain names are disregarded when comparing the disputed domain names and the WILLOW TREE mark.

The Complainant further alleges that the disputed domain names were registered two decades after she acquired rights in the WILLOW TREE mark. The Complainant has no relationship with the Respondent and

the Respondent is not an authorised distributor nor licensee of the Complainant. The disputed domain names resolve to identical websites that prominently feature the Complainant's WILLOW TREE and SUSAN LORDI marks and products, as well as the Complainant's name, image, information, photographs and product listings taken directly from the Complainant's Website. The Respondent is also involved in the creation and operation of fraudulent Facebook accounts which direct users to the resolved websites of the disputed domain names. These Facebook accounts feature the Complainant's WILLOW TREE and SUSAN LORDI marks and associated products. The disputed domain names also resolve to landing pages fraudulently advertising Willow Tree products for sale at a significantly decreased price. Any offers of the Willow Tree products on the resolved websites fraudulently represent the authorization or approval from the Complainant, and results in consumer deception. The "nominative fair use" doctrine does not apply to the current situation. Further, the Respondent is not commonly known by the disputed domain names. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain names, but rather is using the disputed domain names for commercial gain with the intent to mislead and divert unsuspecting consumers looking to purchase the Complainant's Willow Tree products.

The Complainant finally asserts that the disputed domain names display the WILLOW TREE and SUSAN LORDI marks as well as photographs of the Complainant without authorisation and direct users to the Respondent's websites, which fraudulently advertise the sale of unauthorised and illegitimate Willow Tree figurines. The Respondent is intentionally attempting to traffic Internet users through the Respondent's websites, for commercial gain, by fraudulently holding itself out to be the Complainant, or a licensee or authorised distributor of the Complainant's WILLOW TREE mark and products in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The panel may choose to write a decision in either language, or request translation of either party's submissions.

In this case, the Registrar has confirmed to the Center that the language of the Registration Agreements as used by the registrant for the disputed domain names is Chinese. However, the Complainant has requested that English be adopted as the language of the proceeding for the reasons summarised below:

- (a) the disputed domain names consist of words in English and incorporate the entirety of the Complainant's registered US trade mark, WILLOW TREE;
- (b) the Respondent has chosen the ".shop" gTLD, which is in English;
- (c) the disputed domain names resolved to websites operated and written entirely in English without an option to choose a different language, and the associated fraudulent "Nativity" and "Willow Tree" Facebook accounts that direct users to the disputed domain names are also written entirely in English, which shows that the Respondent is familiar with the English language;
- (d) pricing of products fraudulently advertised at the resolved websites is provided only in US currency, which shows that the Respondent is familiar with the English language;

(e) to submit the Complaint in Chinese would create an unfair burden on the Complainant, as it would require significant time and cost; and

(f) the proceeding will be put through unnecessary trouble and delay if Chinese were made the language of the proceeding.

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 order to ensure fairness to the parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the parties and undue delay to the proceeding.

The Panel having considered the circumstances finds that English shall be the language of this proceeding. The reasons are set out below:

(a) the Complainant is an individual based in the US. Requiring the Complainant to submit documents in Chinese would lead to delay and cause the Complainant to incur translation expenses;

(b) the disputed domain names previously resolved to websites in English;

(c) even if the Respondent does not possess a sufficient command of English to understand the Complaint, there were ample opportunities for the Respondent to raise an objection. The Center notified the Parties in English and Chinese of the Complainant's request for English to be the language of the proceeding, but the Respondent did not protest against this request;

(d) the Respondent has failed to participate in the proceeding even though the Center sent the notification of the Complaint in English and Chinese, and has been notified of his/her default; and

(e) the Complaint has been submitted in English. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

Accordingly, the Panel will proceed with issuing this Decision in English.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has adduced evidence to demonstrate her established rights in the WILLOW TREE mark.

The Panel notes that the disputed domain name <willowtree.com> is comprised of the WILLOW TREE mark but with substitution of a letter "i" for the letter "l". The misspelling does not preclude a finding of confusing similarity between the WILLOW TREE mark and this disputed domain name. In cases where a domain name consists of a common, obvious, or intentional misspelling of a trade mark, the domain name will normally be considered confusingly similar to the relevant mark for purposes of UDRP standing. See section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"); *Mediarex Enterprises Limited v. Yong Woon Chin, Webolutions*, WIPO Case No. [DCO2020-0014](#).

The Panel notes that the WILLOW TREE mark is wholly encompassed within the disputed domain name <willowtree-store.shop>. The WILLOW TREE mark is instantly recognizable as the most distinctive element of this disputed domain name. In cases where a domain name incorporates the entirety of a trade mark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See section 1.7 of the [WIPO Overview 3.0](#).

Further, it is accepted by previous UDRP panels that the addition to the complainant's trade mark of other words or terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity between the domain name and the complainant's trade mark under the first element of the Policy. As such, the Panel finds the additional element "-store" in the disputed domain name <willowtree-store.shop> does not preclude a finding of confusing similarity between the WILLOW TREE mark and the disputed domain name. See section 1.8 of the [WIPO Overview 3.0](#).

Lastly, it is permissible for the Panel to disregard the gTLD in the disputed domain names, *i.e.*, ".com" in the disputed domain name <willowtree.com> and ".shop" in the disputed domain name <willowtree-store.shop>. It is accepted by UDRP panels that the practice of disregarding the gTLD in determining identity or confusing similarity is applied irrespective of the particular gTLD (including with regard to "new gTLD") and the ordinary meaning ascribed to a particular gTLD would not necessarily impact the assessment of the first element. See sections 1.11.1 and 1.11.2 of the [WIPO Overview 3.0](#).

Accordingly, the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

In circumstances where the Complainant possesses exclusive rights to the WILLOW TREE mark, whereas the Respondent seems to have no trade mark rights, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, and the burden of production shifts to the Respondent to show that he/she has rights or legitimate interests in the disputed domain names. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain names or reasons to justify the choice of the term "Willow Tree" or a misspelling of the term "Willow Tree" in the disputed domain names. There is no indication to show that the Respondent is commonly known by the disputed domain names or otherwise has rights or legitimate interests in any of them. In addition, the Complainant has not granted the Respondent any license or authorisation to use the Complainant's WILLOW TREE mark or register the disputed domain names.

The Panel notes that the disputed domain names previously resolved to websites in English which allegedly offered the Willow Tree products for sale. The websites noticeably displayed the Complainant's WILLOW TREE, SUSAN LORDI and  marks together with images of the Complainant's products at a discounted price. The websites did not accurately and prominently disclose a lack of a relationship between the Complainant and the Respondent. Therefore, the facts do not support a claim of a *bona fide* offering of goods or services under the "Oki Data test". See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Moreover, the disputed domain name <willowtree-store.shop> carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

Accordingly, the Complainant has satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant's WILLOW TREE mark was registered well before the registration of the disputed domain names. Through use and advertising, the Complainant's WILLOW TREE mark is known throughout the world, including in China. Search results using the term "willow tree" on the Internet search engines direct Internet users to the Complainant and her products, which indicates that an exclusive connection between

the WILLOW TREE mark and the Complainant has been established. As such, the Respondent either knew or should have known of the Complainant's WILLOW TREE mark when registering the disputed domain names.

The Panel notes that the disputed domain names previously resolved to websites allegedly offering for sale the Complainant's Willow Tree products, and on which the Complainant's WILLOW TREE, SUSAN LORDI and  marks prominently appeared. Further, the resolved websites allegedly used the Complainant's product images without authorization. The lack of a disclaimer that the Respondent is not affiliated with the Complainant is noticeably absent. Conversely, the content on the websites would lead Internet users to think that the online stores were authorised by the Complainant.

The Panel is satisfied that the Respondent intends to take advantage of the reputation of the Complainant's trade mark to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's mark as to source, affiliation, or endorsement of his/her websites. This demonstrates bad faith registration and use of the disputed domain names, as provided in paragraph 4(b)(iv) of the Policy.

Given all the circumstances of the case, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain names, and considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain names as discussed above, the Panel is led to conclude that the disputed domain names were registered and are being used in bad faith.

Accordingly, the Panel finds that the Complainant has 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 names, <willowtree.com> and <willowtree-store.shop>, be transferred to the Complainant.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: April 1, 2022