

## ADMINISTRATIVE PANEL DECISION

Susan Lordi v. 林洪国 (lin hong guo), 姚燊 (yao shen), and 王剑华 (wangjianhua)

Case No. D2022-1319

### 1. The Parties

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

Respondents are 林洪国 (lin hong guo), 姚燊 (yao shen), and 王剑华 (wangjianhua), China.

### 2. The Domain Names and Registrar

The disputed domain names <willowtree-nativityset.com>, <willowtree-outlet.com>, <willowtrees.top>, <willow-tree.top>, and <willowtree.top> are registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

### 3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2022. On April 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrants and contact information for the disputed domain names which differed from the named Respondents and contact information in the Complaint. The Center sent an email communication to Complainant on April 14, 2022 providing the registrants 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 April 19, 2022.

On April 14, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. Complainant confirmed its request that English be the language of the proceeding on April 15, 2022. Respondents 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 Respondents in English and Chinese of the Complaint, and the proceedings commenced on April 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified Respondents' default on May 12, 2022.

The Center appointed Yijun Tian as the sole panelist in this matter on May 17, 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**

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

Complainant is Susan Lordi, in the US. Complainant has designed, manufactured, advertised, sold, and distributed her famous WILLOW TREE branded figurines and home décor since 2000. Complainant's WILLOW TREE branded products have been distributed widely, such as in the US, Canada, Europe, and Australia.

Complainant is the owner of numerous WILLOW TREE trademarks worldwide, including the U.S. Trademark registered on February 18, 2003 (the US Trademark registration number 2687795), and the Chinese Trademark registered on March 28, 2014 (the Chinese Trademark registration number 11633838).

##### **B. Respondents**

Respondents are 林洪国 (lin hong guo), 姚燊 (yao shen), and 王剑华 (wangjianhua), China. The disputed domain names <willowtree.top> and <willowtrees.top> were registered by 林洪国 (lin hong guo) on the same day (November 3, 2021). The disputed domain name <willow-tree.top> was registered by 王剑华 (wangjianhua) on December 14, 2021. The disputed domain names <willowtree-nativityset.com> and <willowtree-outlet.com> were registered by 姚燊 (yao shen) on November 22, 2021 and November 13, 2021 respectively.

All the disputed domain names currently resolve to inactive websites. But according to the information provided by Complainant, three disputed domain names <willowtrees.top>, <willow-tree.top>, and <willowtree.top> were resolved to substantially identical websites that prominently feature Complainant's WILLOW TREE and SUSAN LORDI trademarks and products. Two Facebook accounts direct Internet users to the other two disputed domain names <willowtree-nativityset.com> and <willowtree-outlet.com>, and the disputed domain name <willowtree-nativityset.com> resolved to a website that prominently features Complainant's WILLOW TREE and SUSAN LORDI trademarks and products. Complainant's name, image, and likeness, and information, photographs, and product listings taken directly from the authentic "www.willowtree.com" website (Annexes 2-7 to the Complaint).

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

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

Complainant contends that all the disputed domain names are nearly identical to, or confusingly similar with, and a near-exact reproduction of the WILLOW TREE Marks. The disputed domain names consist entirely of Complainant's WILLOW TREE Mark, but for the addition of descriptive wording (*i.e.*, "nativityset", "outlet"); (ii) a hyphen between the words "willow" and "tree"; or (iii) the addition of an "s" to pluralize Complainant's WILLOW TREE Mark, none of which avoid the confusing similarity between the dispute domain names and Complainant's WILLOW TREE Marks, as such additions do not diminish the intended suggestion that the disputed domain names are connected or associated with Complainant and/or Complainant's WILLOW TREE branded figurines

Complainant contends that Respondents have no 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. Consolidation of Multiple Respondents**

The Panel notes that the present Complaint has been filed against multiple Respondents and Complainant has submitted a request for consolidation. On this subject, section 4.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") provides *inter alia* as follows:

"The WIPO Center may accept, on a preliminary basis, a consolidated complaint where the criteria described below are *prima facie* met. Any final determination on consolidation would be made by the appointed panel, which may apply its discretion in certain circumstances to order the separation of a filed complaint".

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 disputed domain names <willowtrees.top>, <willow-tree.top>, and <willowtree.top> have been used to host similar websites with Complainant's well-known WILLOW TREE mark on each webpage and are replete with images and text copied directly from Complainant's website;
- (b) the disputed domain names were registered with the same Registrar in an approximate six-week timeframe - between November 3, 2021 and December 14, 2021;
- (c) the disputed domain names have been registered in a similar naming pattern, *i.e.*, incorporating Complainant's well-known WILLOW TREE Mark in its entirety;
- (d) all the Respondents are located in China;
- (e) the disputed domain names <willowtree.top> and <willowtrees.top> provide the same contact information;
- (f) the disputed domain names <willowtrees.top>, <willow-tree.top>, <willowtree.top> and <willowtree-nativityset.com> that resolve to websites Complainant was able to access and save at the time this Amended Complaint was submitted share identical or similar content; and
- (g) the Facebook accounts related to the disputed domain names <willowtree-nativityset.com> and <willowtree-outlet.com> provide the same email address.

In all of these circumstances, the Panel considers that it is procedurally efficient to allow Complainant to proceed with the single Complaint as filed and is satisfied that such consolidation is fair and equitable to all of the Parties. Accordingly, Respondents are hereinafter referred to as "Respondent".

## 6.2. Language of the Proceeding

The language of the Registration Agreements for the disputed domain names <willowtree-nativityset.com>, <willowtree-outlet.com>, <willowtrees.top>, <willow-tree.top>, and <willowtree.top> 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. 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 reasons:

- (a) the disputed domain names consist of words in the English language (“willow tree”, “nativity set”, and “outlet”);
- (b) they incorporate the entirety of Complainant’s registered US trademark (WILLOW TREE);
- (c) Respondent chose the “.com” gTLD (“generic Top-Level Domain”) and “.top” gTLD, which are both in English;
- (d) the disputed domain names resolve to websites operated and written entirely in English without an option to choose a different language, which shows that Respondent is familiar with the English language;
- (e) the associated fraudulent “Nativityset” and “Willowtree-outlet” Facebook accounts that direct Internet users to “www.willowtree-nativityset.com” and “www.willowtree-outlet.com” are written entirely in English, further indicating that Respondent is familiar with the English language;
- (f) pricing of products fraudulently advertised at the disputed domain names’ websites are provided only in US dollars, which further shows Respondent is familiar with the English language and currency;
- (g) to submit the Complaint in Chinese would create an unfair burden on Complainant, as it would require significant time and cost;
- (h) the proceeding will be put through unnecessary trouble and delay if Chinese were made the language of the proceeding;
- (i) at least one of Respondents, Lin Hong Guo, has been a Respondent in prior UDRP proceedings filed by Complainant and related to the fraudulent “willow tree” domain names (*Susan Lordi v. 林洪国 (lin hong guo)*, WIPO Case No. [D2021-3272](#) and *Susan Lordi v. 林洪国 (Lin Hong Guo)*, WIPO Case No. [D2021-1523](#)), and those proceedings were conducted in English; and
- (j) the Panel has found sufficient evidence when similar factual circumstances have surrounded this Complainant’s proceedings related to fraudulent “willow tree” domain names and websites registered with Alibaba Cloud Computing Ltd in previous UDRP decisions, such as *Susan Lordi v. 熊丽芳 (xiong li fang)*, 青白江普妙溪日用品经营部 (*qing bai jiang pu miao xi ri yong pin jing ying bu*), WIPO Case No. [D2021-4148](#).

Respondents 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 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](#); *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 the [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](#)).

On the record, Respondent is located in China 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) all the disputed domain names include Latin characters and English words, rather than Chinese scripts; (b) the websites at the disputed domain names <willowtrees.top>, <willow-tree.top> and <willowtree.top> resolve to websites in English, and the two Facebook account related to the websites “www.willowtree-nativityset.com” and “www.willowtree-outlet.com” are in English, rather than in Chinese; (c) the Center has notified Respondent of the proceeding in both Chinese and English; and (d) the Center informed the Parties, in English and Chinese, that it would accept 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.

### **6.3. 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 names should be cancelled or transferred:

- (i) the disputed domain names registered by Respondent are 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 names; and
- (iii) the disputed domain names have been registered and are 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 WILLOW TREE mark acquired through registration and use. The WILLOW TREE marks have been registered in the US since 2003, and registered in China since 2014.

The Panel finds that all disputed domain names <willowtree-nativityset.com>, <willowtree-outlet.com>, <willowtrees.top>, <willow-tree.top>, and <willowtree.top> comprise the WILLOW TREE mark in its entirety. They only differ from Complainant's trademark by "-" and/or the term "nativity set", "outlet", or "s" and the gTLD ".com" or ".top". This does not compromise the recognizability of Complainant's mark within the disputed domain names, nor prevents a finding of confusing similarity between Complainant's registered trademark and the disputed domain names (*Decathlon v. Zheng Jianmeng*, WIPO Case No. [D2019-0234](#)).

Further, in relation to the gTLD suffix, [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." ([WIPO Overview 3.0](#), section 1.11.1.)

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 names:

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

(ii) Respondent has been commonly known by the disputed domain names, 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 names, 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 the 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 the respondent to rebut complainant's contentions. If the respondent fails to do so, a 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](#); [WIPO Overview 3.0](#), section 2.1, and cases cited therein).

Complainant has rights in the WILLOW TREE marks in the US since 2003 and in China since 2014, which precede Respondent's registrations of all the disputed domain names (2021). According to the Complaint, Complainant has designed, manufactured, advertised, sold, and distributed her famous WILLOW TREE branded figurines and home décor since 2000. Complainant's WILLOW TREE branded products have been distributed widely, such as in the US, Canada, Europe, and Australia.

Complainant asserts that it has not authorized Respondent to use its WILLOW TREE marks, and Respondent is not a licensee of Complainant. Complainant has therefore established a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain names and thereby shifted the burden to Respondent to produce evidence to rebut this presumption (*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](#)).

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

(a) 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 legitimate use of the disputed domain name or reasons to justify the choice of the term "willow tree" in the disputed domain names. There has been no evidence to show that Complainant has licensed or otherwise

permitted Respondent to use the WILLOW TREE marks or to apply for or use any domain names incorporating the WILLOW TREE marks;

(b) 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 2021, long after the WILLOW TREE marks became internationally known. The disputed domain names confusingly similar to Complainant's WILLOW TREE 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 names. By contrast, according to the information provided by Complainant, three disputed domain names <willowtrees.top>, <willow-tree.top>, and <willowtree.top> were resolved to substantially identical websites that prominently feature Complainant's WILLOW TREE and SUSAN LORDI trademarks and products. Two Facebook accounts direct Internet users to the other two disputed domain names <willowtree-nativityset.com> and <willowtree-outlet.com>, and the disputed domain name <willowtree-nativityset.com> resolved to a website that prominently features Complainant's WILLOW TREE and SUSAN LORDI trademarks and products.

The Panel finds that Respondent has failed to produce any evidence to rebut Complainant's *prima facie* case. 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 names in bad faith, namely:

- (i) circumstances indicating that Respondent has registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring the domain name registrations 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 names; or
- (ii) Respondent has registered the disputed domain names 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 names primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's websites 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 websites or location or of a product or service on the websites 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 names in bad faith.

#### **(a) Registered in Bad Faith**

The Panel finds that Complainant has a widespread reputation in the WILLOW TREE marks with regard to its products or services. Complainant has registered its WILLOW TREE marks in the US since 2003, and in China since 2014. As introduced above, Complainant has designed, manufactured, advertised, sold, and distributed her famous WILLOW TREE branded figurines and home décor since 2000. Its WILLOW TREE

branded products have been distributed widely, such as in the US, Canada, Europe, and Australia. All the disputed domain names were registered in 2021 long after Complainant's trademark registrations in the US and China. It is not conceivable that Respondent would not have had actual notice of Complainant's trademark rights at the time of the registration of the disputed domain names.

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 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 names were registered in bad faith.

(b) Used in Bad Faith

As introduced above, three disputed domain names <willowtrees.top>, <willow-tree.top>, and <willowtree.top> were resolving to substantially identical websites that prominently feature Complainant's WILLOW TREE and SUSAN LORDI trademarks and products. Two Facebook accounts direct Internet users to the other two disputed domain names <willowtree-nativityset.com> and <willowtree-outlet.com>, and the disputed domain name <willowtree-nativityset.com> resolved to a website that prominently features Complainant's WILLOW TREE and SUSAN LORDI trademarks and products also. Thus, the Panel concludes that Respondent is using the confusingly similar disputed domain names with the intention to attract, for commercial gain, Internet users to Respondent's websites.

Given the reputation of the WILLOW TREE marks, the Panel finds that the public is likely to be confused into thinking that the disputed domain names have 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 websites to which the disputed domain names resolve. In other words, Respondent has through the use of the confusingly similar disputed domain names created a likelihood of confusion with the WILLOW TREE marks.

The Panel, therefore, concludes that the disputed domain names were registered and are being used by Respondent in bad faith. Such use of the disputed domain names is also disruptive in relation to the interests of Complainant.

In summary, Respondent, by choosing to register and use the disputed domain names, which are confusingly similar to the WILLOW TREE mark, intended to ride on the goodwill of this trademark in an attempt to exploit, for commercial gain, Internet users destined for Complainant. In the absence of evidence to the contrary and rebuttal from Respondent, the choice of the disputed domain names and the conducts of Respondent as far as the websites to which the disputed domain names resolve are indicative of registration and use of the disputed domain names in bad faith.

The Panel, therefore, holds that the 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 names <willowtree-nativityset.com>, <willowtree-outlet.com>, <willowtrees.top>, <willow-tree.top>, and <willowtree.top> be transferred to Complainant.

*/Yijun Tian/*

**Yijun Tian**

Sole Panelist

Dated: June 15, 2022