

ADMINISTRATIVE PANEL DECISION

Susan Lordi v. Domains By Proxy, LLC / Pengcheng HU and Lin Zhuo
Case No. D2022-1320

1. The Parties

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

Respondents are Domains By Proxy, LLC, United States / Pengcheng HU, China, and Lin Zhuo, China.

2. The Domain Names and Registrar

The disputed domain names <willowtree.shop>, <willowtreedy.com>, <willowtreehome.store>, <willowtree.life> (the “Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint 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 Domain Names. On April 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondents and contact information in the Complaint. The Center sent an email communication to Complainant on April 21, 2022, 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 on April 25, 2022.

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 of the Complaint, and the proceedings commenced on May 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2022. Respondents did not submit any response. Accordingly, the Center notified Respondents’ default on May 27, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on June 3, 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. Consolidation of Multiple Respondents

The Panel has considered the possible consolidation of the Complaint for the Domain Names. According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2, "Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario".

The Panel notes the following features of the Domain Names and arguments submitted by Complainant in favor of the consolidation of the Domain Names:

- (i) Each of the Domain Names incorporates Complainant's WILLOW TREE trademark in its entirety;
- (ii) The websites to which the Domain Names resolved share identical content, such as webpages featuring Complainant's "Nativity Sets" and "Valentine's Day" products of Complainant marked down to significantly discounted and fraudulent prices, as well as identical Terms and Conditions pages and menu options and icons;
- (iii) Each of the Domain Names is registered with the same Registrar;
- (iv) The Domain Names were registered in an approximate two-week timeframe, between December 17, 2021 and December 30, 2021;
- (v) Both Respondents have created Facebook accounts between December 25, 2021 and January 9, 2022 that direct Internet users to the Domain Names; and
- (vii) Based on information available to Complainant, the Domain Names provide contact information using the same format (*i.e.*, service@xxxxxxxx).

The Panel finds that consolidation of the Domain Names is fair to the Parties, and Respondents have been given an opportunity to object to consolidation through the submission of pleadings to the Complaint (if indeed there are more than one Respondent for these Domain Names) but have chosen not to rebut the consolidation (see [WIPO Overview 3.0](#), sections 4.11.1 and 4.11.2; *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#)). Based on the file, the Panel finds that it is more likely than not that, the Domain Names are in common control of one entity, and hence the Panel grants the consolidation for the above Domain Names (and will refer to these Respondents as "Respondent").

5. Factual Background

Per Complaint, since at least 2000, Complainant has designed, manufactured, advertised, sold and distributed figurines and home décor under the WILLOW TREE mark. Complainant actively licenses the WILLOW TREE mark to a select group of authorized dealers who may market and distribute the WILLOW TREE items in the United States of America, Canada, Europe and Australia. Complainant's products are sold, among other authorized online marketplaces, at "www.willowtree.com", a website ran and operated by one of Complainant's authorized dealers, licensees, and business partners.

Complainant owns trademark registrations for WILLOW TREE including a) the United States trademark registration No. 2,687,795 WILLOW TREE (word), filed on November 26, 2001 and registered on February 18, 2003 for goods in international classes 20 and 24, b) the International trademark registration No. 1510409 WILLOW TREE (word), registered on December 19, 2019 for goods in international class 20, and c) the Chinese trademark registration No. 11633838, WILLOW TREE (word), registered on March 28, 2014 for goods in international class 28.

The Domain Names were registered on December 17, 2021 (<willowtree.shop>), December 20, 2021 (<willowtree.life>), December 25, 2021 (<willowtreehome.store>), and December 30, 2021 (<willowtreediy.com>).

At the time of filing of the Complaint, the domain names <willowtree.shop> and <willowtreediy.com> resolved to identical websites that prominently featured Complainant's WILLOW TREE trademarks and products, as well as information, photographs, and product listings taken directly from the authentic "www.willowtree.com" website. Furthermore, the "www.willowtree.shop" website prominently featured also Complainant's SUSAN LORDI trademarks and Complainant's name, image, and likeness, which were also taken directly from the authentic "www.willowtree.com" website. On Complainant's information and belief, Respondent is involved in the creation and operation of fraudulent Facebook accounts (with the profile names "Willow Tree by Susan Lordi" and "Nativity Story"), based on the fact that they direct users to the "www.willowtree.shop" and "www.willowtreediy.com" websites and identify email addresses that match the "service" email addresses identified on the Contact Us webpage for each domain name.

Before the time of filing of the Complaint, the domain name <willowtree.life> resolved to a website prominently featuring Complainant's WILLOW TREE and SUSAN LORDI trademarks, fraudulently offering the WILLOW TREE products for sale at significantly reduced prices, and copying information and images directly from the authentic "www.willowtree.com" website. Subsequently, this website was blocked, because it was not private and could be impersonating a website "to steal your personal or financial information."

At the time of filing of the Complaint, the domain name <willowtreehome.store> no longer resolved to an accessible website; however, two fraudulent Facebook accounts, using the profile names "Willowtree" and "Willowtree.shop" directed users to the "www.willowtreehome.store" website, featuring Complainant's WILLOW TREE trademark and images taken directly from Complainant's "www.willowtree.com" website, copying photographs of Complainant and Complainant's products, and verbatim product descriptions, all of which from the authentic "www.willowtree.com" website. Facebook accounts have been reported and subsequently removed by Facebook for infringement of Complainant's trademarks and/or copyrights.

Subsequently, the domain name <willowtree.shop> lead to a website mimicking that of Complainant, the domain name <willowtree.life> was resolving to an inactive website, and the other two domain names lead to blocked pages.

Currently all Domain Names lead to inactive websites.

6. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for the transfer of the Domain Names.

B. Respondent

Respondent did not reply to Complainant's contentions.

7. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Names:

- (i) the Domain Names 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 Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Complainant has demonstrated rights through registration and use of the WILLOW TREE mark.

The Panel finds that the Domain Names are either identical or confusingly similar to the WILLOW TREE trademark of Complainant.

The Domain Names incorporate the said trademark of Complainant in its entirety. This is sufficient to establish confusing similarity (*Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#)).

The addition of the letters “diy” (short for “do it yourself”), the word “home” and the substitution of an “i” for the letter “l” as an intentional misspelling, do not alter the above (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8).

The generic Top-Level Domains (“gTLD”) “.shop”, “.life”, “.store”, and “.com” are also disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are generally required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#)).

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Names, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel finds that Respondent lacks rights or legitimate interests in respect of the Domain Names.

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Names. As per Complainant, Respondent was not authorized to register the Domain Names.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Names or a trademark corresponding to the Domain Names in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Names resolved at times to websites mimicking that of Complainant, which suggested falsely that they are of an affiliated entity or of an authorized partner of Complainant.

Per Complaint, Respondent is not an affiliated entity or an authorized distributor or reseller of Complainant and no agreement, express or otherwise, exists allowing the use of Complainant's trademarks on the websites and the use of the Domain Names by Respondent.

A distributor or reseller can be making a *bona fide* offering of goods and thus have a legitimate interest in a domain name only if the following cumulative requirements are met (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), section 2.8.1: (i) respondent must actually be offering the goods at issue; (ii) respondent must use the site to sell only the trademarked goods; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) respondent must not try to "corner the market" in domain names that reflect the trademark.)

These requirements are not cumulatively fulfilled in the present case. The Domain Names falsely suggested that the websites to which they resolved were official sites of Complainant or of an entity affiliated to or endorsed by Complainant. The websites extensively reproduced, without authorization by Complainant, Complainant's trademark, without any disclaimer of association (or lack thereof) with Complainant.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Names.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Names in "bad faith":

(i) circumstances indicating that Respondent has registered or has acquired the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Domain Names registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Names; or

(ii) Respondent has registered the Domain Names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Names, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the Domain Names primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website 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 website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Names in bad faith. Because the WILLOW TREE mark had been used and registered by Complainant at the time of the Domain Names registrations by Respondent, the Panel finds that Respondent had Complainant's mark in mind when registering the Domain Names (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*,

WIPO Case No. [D2014-1754](#); *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

As regards bad faith use, the Domain Names lead at times to websites mimicking that of Complainant and giving the false impression that they were operated by Complainant or a company affiliated to Complainant or an authorized dealer of Complainant. The Domain Names operated therefore by intentionally creating a likelihood of confusion with Complainant's trademark and business as to the source, sponsorship, affiliation or endorsement of the website it resolves to. This can be used in support of bad faith registration and use (*Booking.com BV v. Chen Guo Long*, WIPO Case No. [D2017-0311](#); *Ebel International Limited v. Alan Brashear*, WIPO Case No. [D2017-0001](#); *Walgreen Co. v. Muhammad Azeem / Wang Zheng*, *Nicenic International Group Co., Limited*, WIPO Case No. [D2016-1607](#); *Oculus VR, LLC v. Sean Lin*, WIPO Case No. [DCO2016-0034](#); and [WIPO Overview 3.0](#), section 3.1.4). Furthermore, they at times lead to websites that were blocked as malicious, and also per Complaint were linked to fraudulent Facebook accounts.

The Domain Names currently lead to inactive websites. The non-use of a domain name would not prevent a finding of bad faith (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Under these circumstances and on this record, the Panel finds that Respondent has registered and used the Domain Names in bad faith.

Complainant has established Policy paragraph 4(a)(iii).

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names, <willowtree.shop>, <willowtreedy.com>, <willowtreehome.store>, and <willowtree.life>, be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: June 16, 2022