

## ADMINISTRATIVE PANEL DECISION

Tuft & Needle, LLC v. 杨智超 (Zhichao Yang)  
Case No. D2022-1940

### 1. The Parties

The Complainant is Tuft & Needle, LLC, United States of America (“United States”), represented by Cantor Colburn LLP, United States.

The Respondent is 杨智超 (Zhichao Yang), China.

### 2. The Domain Name and Registrar

The disputed domain name <tuftadneedle.com> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

### 3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 27, 2022. On May 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 31, 2022, 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 and contact information in the Complaint. On the same day, the Center sent an email communication to the Complainant 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 June 8, 2022.

On May 31, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on June 8, 2022. 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 June 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 29, 2022. The Respondent did not submit any

response. Accordingly, the Center notified the Respondent's default on June 30, 2022.

The Center appointed Matthew Kennedy as the sole panelist in this matter on July 11, 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 a mattress manufacturer. It was formed in 2012 and merged with Serta Simmons Bedding in 2018. The Complainant holds multiple trademark registrations in multiple jurisdictions, including United States registration number 4616761 for TUFT & NEEDLE, registered on October 7, 2014, specifying mattresses in class 20, with a claim of first use in commerce on October 10, 2012 and a disclaimer of the exclusive right to use the word "tuft" apart from in the mark as shown. That trademark registration remains current. The Complainant also registered the domain name <tuftandneedle.com> on October 10, 2012, which it uses in connection with a website where it prominently displays the TUFT & NEEDLE mark and provides information about itself and its mattress products. According to the evidence on record, its products have received favorable media coverage, including in U.S. News & World Report, Men's Health, and USA Today's Reviewed.

The Respondent is an individual resident in China.

The disputed domain name was registered on January 20, 2022. It resolves to a landing page displaying Pay-Per-Click ("PPC") links to websites regarding "Tuft and Needle", including for mattresses and reviews.

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

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

The disputed domain name is confusingly similar to the Complainant's TUFT & NEEDLE marks. The disputed domain name is an example of typosquatting.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The disputed domain name resolves to a PPC links landing page, by which the Respondent earns revenue. The Complainant is not aware of any relationship between it and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own the disputed domain name. The Respondent is not commonly known by the disputed domain name.

The disputed domain name was registered and is being used in bad faith. It is clear that the Respondent knew of the existence of the TUFT & NEEDLE mark at the time of registration of the disputed domain name. The use of a parked website with links to websites selling products competing with the Complainant's products is evidence of bad faith.

##### **B. Respondent**

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

## 6. Discussion and Findings

### 6.1. Language of the Proceeding

Paragraph 11(a) of the Rules provides that “unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”. The Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main argument is that conducting the proceeding in Chinese would create an undue burden for the Complainant and delay the proceeding due to the need for translation, and the Complainant does not understand Chinese.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that the Complaint and amended Complaint in this proceeding were filed in English. Despite the Center having sent an email regarding the language of the proceeding, and the Notification of the Complaint, in both Chinese and English, the Respondent did not comment on the language of the proceeding or express any interest in otherwise participating in this proceeding. Moreover, the Respondent has been involved in a large number of prior UDRP proceedings with many of those proceedings determining the language of the proceeding to be English. Therefore, the Panel considers that requiring the Complainant to translate the Complaint into Chinese would create an undue burden and delay whereas accepting the Complaint in English does not cause prejudice to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English. The Panel would have accepted a Response in Chinese, but none was filed.

### 6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

#### A. Identical or Confusingly Similar

Based on the evidence submitted, the Panel finds that the Complainant has rights in the TUFT & NEEDLE mark.

The disputed domain name incorporates the TUFT & NEEDLE mark but replaces the ampersand (which represents the conjunction “and”) with “ad”. Given that almost all the mark remains clearly recognizable within the mark, that difference does not prevent a finding of confusing similarity between the disputed domain name and the mark. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

The only additional element in the disputed domain name is a generic Top-Level Domain (“gTLD”) “.com”. As a mere standard requirement of domain name registration, this element may be disregarded in the comparison between the disputed domain name and the TUFT & NEEDLE mark. See [WIPO Overview 3.0](#), section 1.11.

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

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

As regards the first and third circumstances set out above, the disputed domain name resolves to a landing page that displays PPC links that all incorporate the Complainant’s TUFT & NEEDLE mark (spelling out the ampersand as “and”), including for mattresses and reviews. The disputed domain name gives the impression that it will resolve to a site affiliated with, or endorsed by, the Complainant. However, the Complainant submits that there is no relationship between the Respondent and itself. The PPC links generate revenue for the Respondent, if he is paid to direct traffic to the linked websites, or the operators of the linked websites, or both. This does not constitute a use in connection with a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name.

As regards the second circumstance set out above, the Respondent’s name is “杨智超 (Zhichao Yang)”, not the disputed domain name. Nothing indicates that the Respondent is commonly known by the disputed domain name.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that case because he did not respond to the Complaint.

Therefore, based on the record of this proceeding, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

- (iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or of a product or service on [the respondent’s] website or location.

The disputed domain name was registered in 2022, years after the Complainant obtained its earliest trademark registration for TUFT & NEEDLE. The disputed domain name incorporates that mark, replacing the ampersand with “ad”, a misspelling of “and”. While “tuft” and “needle” are two English words, their combination is arbitrary. The disputed domain name appears to have no other meaning than an approximation of the Complainant’s trademark and its domain name <tuftandneedle.com>, from which the disputed domain name differs by only one letter (the missing “n” in “and”). In view of these circumstances, the Panel finds that the Respondent had the Complainant and its TUFT & NEEDLE trademark in mind at the time when he registered the disputed domain name.

The disputed domain name is used to attract Internet users who type the Complainant’s trademark in an Internet browser but mistype the word “and” in place of the ampersand, or who mistype the Complainant’s domain name, by creating a likelihood of confusion with the Complainant’s TUFT & NEEDLE trademark as to the source, sponsorship, affiliation, or endorsement of the landing page to which the disputed domain name resolves. This use is intentional and for the commercial gain of the Respondent, or the operators of the linked websites, or both. In each of these scenarios, the facts fall within the circumstance described in paragraph 4(b)(iv) of the Policy. See *Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright*, WIPO Case No. D2007-0267.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in 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 name <tuftadneedle.com> be transferred to the Complainant.

*/Matthew Kennedy/*

**Matthew Kennedy**

Sole Panelist

Date: July 20, 2022