

ADMINISTRATIVE PANEL DECISION

Williams-Sonoma, Inc. v. BergeronRichard
Case No. D2024-3348

1. The Parties

Complainant is Williams-Sonoma, Inc., United States of America, represented by Hanson Bridgett LLP, United States of America.

Respondent is BergeronRichard, United States of America.

2. The Domain Name and Registrar

The disputed domain name <westelmdecor.shop> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 15, 2024. On August 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 16, 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 (WestElmDecor.shop) and contact information in the Complaint. The Center sent an email communication to Complainant on August 19, 2024 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 August 24, 2024.

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 Respondent of the Complaint, and the proceedings commenced on August 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on September 21, 2024.

The Center appointed Bradley A. Slutsky as the sole panelist in this matter on September 30, 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

Complainant manufactures and sells home goods under a number of different brands, including the West Elm brand. Complainant launched the West Elm brand in 2002 and offers home decor and related products under the brand, such as furniture, rugs, bedding, mattresses, and accessories. Complainant has over 100 retail stores under the West Elm brand or variations of it. Complainant also has a West Elm catalog direct mail business, an e-commerce website at “www.westelm.com”, and a West Elm mobile application. According to the Complaint, “Complainant’s worldwide revenue in its WEST ELM brand exceeded USD 1.8 billion in 2023”, and “Complainant owns over 200 trademark registrations and applications for its WEST ELM Mark in over 30 jurisdictions worldwide, including the United States, Mexico, European Union, United Kingdom, Australia, China, and elsewhere”. These registrations include the following:

Mark	Goods/Services	Jurisdiction	Reg. No.	Reg. Date
WEST ELM	Mail order catalog services, etc.	United States of America	2725772	June 10, 2003 (date of first use: April 23, 2002)
WEST ELM	Bed linen, etc.	United States of America	2738123	July 15, 2003 (date of first use: September 17, 2002)
WEST ELM	Scented candles, etc.	United States of America	4597833	September 2, 2014 (date of first use: April 23, 2002)
WEST ELM	Computerized online retail store services, etc.	United States of America	2845444	May 25, 2004 (date of first use: October 15, 2003)

The disputed domain name was registered on August 7, 2024, and leads to a website that offers home furnishings for sale, such as a “west elm chair”, “west elm bed frame”, etc. After Respondent’s name and contact information were provided by the registrar, Complainant’s attorney called Respondent’s phone number and did not reach a “BergeronRichard” or “Richard Bergeron”. Complainant’s attorney also did not find evidence that a “BergeronRichard” or “Richard Bergeron” lives at the address for Respondent provided in connection with the Whois registration record for the disputed domain name.

5. Parties’ Contentions

A. Complainant

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

Specifically, Complainant contends that it has rights in the WEST ELM mark dating back to 2002 – over 22 years before Respondent registered the disputed domain name. Complainant contends that the disputed domain name is confusingly similar to Complainant’s WEST ELM marks, in that the disputed domain name contains the entirety of the WEST ELM mark, adding the term “décor” and the generic Top-Level Domain (“gTLD”) “.shop”. Complainant further contends that Respondent has no rights or legitimate interests in respect of the disputed domain name, in that the disputed domain name is being used to advertise “knockoff” and “look-alike” home furnishings that are falsely identified as “west elm” home furnishings, “Respondent also fraudulently self-identifies as ‘West Elm Home Décor’ on its ‘About’ page on its website to mislead consumers into thinking that Respondent is affiliated with or is Complainant”, and “Respondent has listed a fake address and phone number on the ‘Contact’ page of its website to further its scheme”. Complainant contends that “Respondent is not affiliated with Complainant, and Complainant has not licensed or permitted

Respondent to use the WEST ELM Mark or any domain names incorporating the WEST ELM Mark”. Complainant also contends that “Respondent’s website under the Disputed Domain Name contains malware” – as “Complainant’s internet browser blocked the website from opening on Complainant’s devices on the basis that the website could contain malware”. Complainant further contends that the disputed domain name was registered and is being used in bad faith, as the disputed domain name allegedly is not being used for any legitimate or good faith purpose, but rather is being used to sell “knockoff” or “look-alike” goods while attempting to confuse consumers into believing they are purchasing Complainant’s authentic goods. Complainant notes that Respondent was clearly aware of Complainant, its products, and its trademark rights, as Complainant’s trademark registrations and uses predate Respondent’s use of the disputed domain name by more than two decades. Complainant thus asserts that the disputed domain was registered and is being used “primarily for the purpose of disrupting the business of a competitor” or “to attract, for commercial gain, Internet users to [Respondent’s] web site or other on-line location, by creating a likelihood of confusion with the [C]omplainant’s mark as to the source, sponsorship, affiliation, or endorsement of [Respondent’s] web site or location or of a product or service on [Respondent’s] web site or location”. Accordingly, Complainant asserts that Respondent “is clearly engaged in a textbook case of bad faith cybersquatting with the aim of confusing and profiting from [I]nternet users who are interested in learning about and accessing the WEST ELM products and enter the Disputed Domain Name, which is comprised of Complainant’s WEST ELM Mark and the term ‘décor’”, and that therefore “Respondent’s bad faith use and registration of the Disputed Domain Name have been conclusively established”.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Pursuant to paragraph 15(a) of the Rules, a panel in UDRP proceedings “shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Under paragraph 4(a) of the Policy, Complainant must prove the following:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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 Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

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

The Panel finds the mark is recognizable within the disputed domain name. The disputed domain name consists of Complainant’s WEST ELM mark, with the term “décor” appended, plus the “.shop” gTLD. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7 (“in cases where [...] 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”); [WIPO Overview 3.0](#), section 1.11.1 (“[t]he 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.”). Although the addition of other terms (here, “décor”) may bear on assessment of the second and third elements, the Panel finds the addition of such term here does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8 (“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.”).

Accordingly, 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 Respondent may demonstrate rights or legitimate interests in a disputed domain name. “Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [Respondent’s] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [Respondent] of the dispute, [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) [Respondent] (as an individual, business, or other organization) ha[s] been commonly known by the [disputed] domain name, 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 name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”. Policy, paragraph 4(c).

Although the overall burden of proof in UDRP proceedings is on 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 Respondent. As such, where a complainant makes out a prima facie case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on Complainant). If Respondent fails to come forward with such relevant evidence, Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Specifically, the disputed domain name is confusingly similar to Complainant’s WEST ELM marks and is being used without Complainant’s authorization to sell what appears to be counterfeit goods and distribute malware. “Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent”. [WIPO Overview 3.0](#), section 2.13.1. In light of these uses of the disputed domain name, the fact that Respondent is neither affiliated with Complainant nor authorized by Complainant to use Complainant’s marks in the disputed domain names also indicates that Respondent has no rights or legitimate interests in respect of the disputed domain name. *Moelis & Company v. Sophia*, Sophia, WIPO Case No. [D2024-2851](#) (“the fact that Respondent is neither affiliated with Complainant nor authorized by Complainant to use Complainant’s mark in the disputed domain names also indicates that Respondent’s use is not bona fide or legitimate (...). Accordingly, the Panel finds the second element of the Policy has been

established.”). Respondent has not rebutted Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Accordingly, 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. Specifically, “the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [Respondent has] registered or [Respondent has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 [Respondent’s] documented out-of-pocket costs directly related to the domain name; or

(ii) [Respondent has] registered the domain name 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 domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [Respondent’s] web site 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”. Policy, paragraph 4(b).

“Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to Complainant’s trademark would also satisfy Complainant’s burden.”

[WIPO Overview 3.0](#), section 3.1.

In the present case, the Panel notes that Respondent registered the disputed domain name more than 22 years after Complainant began using the WEST ELM mark, and Respondent is using Complainant’s mark in the disputed domain name, in the description of what appears to be counterfeit products on Respondent’s website, and to identify Respondent’s business in the “About” page on Respondent’s website. This indicates that Respondent was aware of Complainant’s marks, and registered and is using the disputed domain name primarily for the purpose of disrupting Complainant’s business and to intentionally attempt to attract, for commercial gain, Internet users to Respondent’s website by creating a likelihood of confusion as to whether the users are on Complainant’s website, or on a website affiliated with Complainant, or whether the users are purchasing genuine WEST ELM home furnishings. This constitutes registration and use in bad faith in violation of paragraph 4(b)(iv) of the Policy. *Williams-Sonoma, Inc. v. 陈军 (Chenjun)*, WIPO Case No. [D2023-0884](#) (“The Respondent has registered the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy. The disputed domain name directs Internet users to an almost identical copycat website of the Complainant’s website at ‘www.potterybarnkids.com’. The Respondent is intentionally attracting Internet users to the disputed domain name by misleading them into believing they are transacting on the Complainant’s official website. For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.”).

Further, Panels have held that the use of a domain name for illegal activity (as applicable to this case: sale of what appears to be counterfeit goods and distributing malware) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Accordingly, the Panel finds the third element of the Policy has been established.

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 <westelmdecor.shop> be transferred to Complainant.

/Bradley A. Slutsky/

Bradley A. Slutsky

Sole Panelist

Date: October 14, 2024