

ADMINISTRATIVE PANEL DECISION

Williams-Sonoma, Inc. v. Nguyễn Văn Lư
Case No. D2023-0889

1. The Parties

The Complainant is Williams-Sonoma, Inc., United States of America (“United States”), represented by Sideman & Bancroft LLP, United States.

The Respondent is Nguyễn Văn Lư, Việt Nam.

2. The Domain Name and Registrar

The disputed domain name, <estelm.com> (the “Domain Name”), is registered with April Sea Information Technology Corporation (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 27, 2023. On February 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 8, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Redacted for Privacy c/o April Sea Information Technology Corporation) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 15, 2023, 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 amendment to the Complaint on March 15, 2023.

On March 15, 2022, the Center notified the Parties in both English and Vietnamese that the language of the registration agreement for the Domain Name is Vietnamese. On the same day, the Complainant requested that English be the language of the proceeding. The Respondent made no comment in relation to the issue as to the appropriate language of the proceeding.

In response to a notification by the Center that the Complaint needed further amendment, the Complainant filed an amended Complaint to the Complaint on March 28, 2023, correcting errors in the List of Annexes.

The Center verified that the Complaint, together with the amendment to the Complaint and 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 of the Complaint in English and Vietnamese, and the proceedings commenced on March 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2023. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent's default on April 19, 2023.

The Center appointed Tony Willoughby as the sole panelist in this matter on April 27, 2023. 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 United States corporation engaged in the retail sale of furniture and home products with substantial sales online and through numerous retail outlets. Its home décor and furnishings products are sold under the "West Elm" brand name, which is protected by a large number of trade mark registrations including, by way of example, United States Registration No. 2,860,667 WEST ELM (typed drawing) registered on July 6, 2004 (application filed June 1, 2001) in class 21 for dishes, bowls, cups, and serving platters. The Complainant uses the domain name <westelm.com> for its primary website.

The Domain Name was registered on July 22, 2004, and is connected to a parking page featuring pay-per-click links labelled "Kids Furniture", "West Elm Outlet Store", "Modern Home Decor", "West Elm Free Shipping", and "Small Dining Tables". When the Panel attempted to activate the links a message appeared stating: "we were unable to find results for the search term".

In March 2022, the Complainant's representative sent emails to the Registrar and to the entity hosting the Respondent's website, drawing attention to the Complainant's trade mark rights and seeking disablement or suspension of the Domain Name. The Complainant received no replies to those emails.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Complainant's WEST ELM registered trade mark; that the Respondent has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name has been registered and is being used in bad faith.

The essence of the Complainant's case is that the Respondent registered the Domain Name with knowledge of the Complainant's WEST ELM trade mark, intending it to be a close mis-spelling of that trade mark, and with a view to deriving commercial gain from the advertising links featuring on the pay-per-click parking page to which the Domain Name has been connected. The Complainant contends that the Respondent registered the Domain Name in the hope and expectation that the Domain Name would attract visitors to the Respondent's website, attracted by the fame of the Complainant's trade mark. The Complainant contends that the Respondent is a typosquatter *i.e.* someone registering a domain name using a mis-spelling of a trade mark owner's trade mark for commercial gain.

B. Respondent

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

6. Discussion and Findings

A. Preliminary Issue – Language of the Proceeding

Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the Registration Agreement. The language of the Registration Agreement for the Domain Name is Vietnamese, but as noted above the Complainant has requested that English be the language of the proceeding. The Complainant asserts that it does not communicate or regularly conduct business in the Vietnamese language and contends that it would be unfairly disadvantaged by being compelled to translate the Complaint into Vietnamese, an exercise that would lead to undue delay in the conduct of the proceedings. The Complainant asserts that English is a popular language in Vietnam and that the Respondent is likely to be conversant with English, observing that the advertising links on the Respondent's website are in English and, despite having been offered by the Center the opportunity to make submissions in relation to that the request, the Respondent has not taken advantage of that opportunity.

Noting the aim of conducting the proceedings with due expedition, paragraph 10 of the 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. (Section 4.5.1. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Those scenarios include (i) evidence showing that the respondent can understand the alternative language being suggested; (ii) the content of the respondent's website; (iii) the potential unfairness or unwarranted delay in ordering the complainant to translate the complaint; (iv) other indicia tending to show that it would not be unfair to proceed in a language other than that of the Registration Agreement.

In support of its request the Complainant has cited *Maggie Sottero Designs, LLC v. Nguyễn Văn Lưu*, WIPO Case No. [D2021-1226](#), a case with very similar background facts to this case in which the complainant requested that the language of the proceeding be English notwithstanding that the Registration Agreement was in Vietnamese. It involved a Vietnamese respondent with the same name as the Respondent, whose website was in the English language and targeted an American brand owner using a domain name featuring a mis-spelling of the complainant's trade mark.

That decision, issued by a Vietnamese panelist, notes that "the English language is quite popular in Việt Nam". Moreover, as stated by the Complainant, the advertising links on the Respondent's website are in English and refer expressly to the Complainant's American brand. The Panel concludes on the balance of probabilities that the Respondent is familiar with the English language.

The Panel accepts the Complainant's assertion that translating the Complainant into Vietnamese will not be easy for it and will be likely to lead to delays in the proceeding. The Panel also notes that the relevant case related communications were sent to the parties by the Center in both English and Vietnamese and that the Respondent did not reply to any of those communications; and thus while having been given the opportunity of objecting to the Complainant's request, elected not to do so.

It is now 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. In light of the Respondent's failure to respond to any of the communications in Vietnamese sent to him by the Center, the Panel concludes that (a) the Respondent has no intention of participating in this proceeding and (b) to direct that the language of the proceeding be English rather than Vietnamese will expedite the proceeding and cause the Respondent no inconvenience or unfairness of any kind.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

B. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

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

C. Identical or Confusingly Similar

The Domain Name comprises the name "estelm" followed by the ".com" generic Top-Level Domain ("gTLD") identifier.

Section 1.7 of [WIPO Overview 3.0](#) explains the test for identity or confusing similarity under the first element of the Policy and includes the following passages:

"This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. (This may also include recognizability by technological means such as search engine algorithms.) In some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain name to ascertain confusing similarity."

"While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, 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."

"In specific limited instances, while not a replacement as such for the typical side-by-side comparison, where a panel would benefit from affirmation as to confusing similarity with the complainant's mark, the broader case context such as website content trading off the complainant's reputation, or a pattern of multiple respondent domain names targeting the complainant's mark within the same proceeding, may support a finding of confusing similarity. On the other hand, if such website content does not obviously trade off the complainant's reputation, panels may find this relevant to an overall assessment of the case merits, especially under the second and third elements (with such panels sometimes finding it unnecessary to make a finding under the first element)."

The trade mark upon which the Complainant relies is WEST ELM. On its face “estelm”, meaningless to the Panel, is similar to the Complainant’s trade mark in that it features the last six letters of the Complainant’s trade mark.

An Internet search engine search for “estelm” features the Complainant’s trade mark as the top result; the Complainant’s trade mark is thus also recognizable by technological means ([WIPO Overview 3.0](#), section 1.7) and notwithstanding the omission of the initial “w” and the space between the “t” and the “e” ([WIPO Overview 3.0](#), section 1.9).

Moreover, as indicated in section 4 above, the pay-per-click links on the Respondent’s website all relate to areas of business in which the Complainant operates and two of them make express reference to the Complainant’s WEST ELM trademark, which affirms the confusing similarity ([WIPO Overview 3.0](#), section 1.7).

The Panel is satisfied that the Respondent is targeting the Complainant’s trade mark and that the Domain Name is confusingly similar for purposes of this element of the Policy.

The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights.

D. Rights or Legitimate Interests

Section 2.1 of [WIPO Overview 3.0](#) provides as follows:

“The UDRP Rules in principle provide only for a single round of pleadings, and do not contemplate discovery as such. Accordingly, a panel’s assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defences under UDRP paragraph 4(c) include the following:

- (i) before any notice of the dispute, the respondent’s 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) the respondent (as an individual, business, or other organization) has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Complainant asserts that it has no connection with the Respondent and has given the Respondent no permission to use the Domain Name or any variant of its WEST ELM registered trade mark. The Complainant categorises the Respondent as a typosquatter.

The Complainant recites the circumstances set out in paragraph 4(c) of the Policy, any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, and contends that none of them is applicable. The Complainant contends that the use being made of the Domain Name cannot constitute a *bona fide* offering of goods and services for the purposes of paragraph 4(c)(i) of the Policy. Self-evidently, the Respondent is not commonly known by the Domain Name, rendering paragraph 4(c)(ii) of the Policy inapplicable. Finally, the Complainant contends that the use being made of the Domain Name is a commercial use, is not fair and is not covered by paragraph 4(c)(iii) of the Policy.

The Panel finds that the Complainant has made out a *prima facie* case under this element of the Policy; in other words a case calling for an answer from the Respondent. The Respondent has not provided an answer.

In the absence of an answer from the Respondent and as it is unable to conceive of any basis upon which the Respondent could be said to have rights or legitimate interests in respect of the Domain Name, the Panel finds that the Respondent has no such rights or legitimate interests.

E. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances, which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Complainant relies upon sub-paragraph (iv), which provides: “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The Respondent registered the Domain Name on July 22, 2004, only 16 days after the Complainant’s WEST ELM registered trade mark entered the register on July 6, 2004. The Panel believes it most unlikely that the closeness of those dates is a coincidence.

The Respondent has used the Domain Name for a pay-per-click parking page, thereby deriving commercial gain from the traffic to his website, no doubt enhanced by the confusing similarity of the Domain Name to the trade mark. While the Panel has no detailed information as to the extent of the Complainant’s trade under and by reference to the “West Elm” name prior to registration of that trade mark, the Panel believes it to be most unlikely that the Respondent’s registration of the Domain Name was not made in the belief that the Domain Name would bring commercial benefit on the back of the reputation and goodwill associated with “West Elm”. The Panel accepts the Complainant’s categorisation of the Respondent as a typosquatter. By the same reasoning, in the absence of any explanation from the Respondent, the Panel finds that the Respondent registered the Domain Name intending to target the Complainant’s WEST ELM registered trade mark.

The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Although not mentioned in the body of the Complaint, the decision in the case cited by the Complainant in support of English as the language of the proceeding, *Maggie Sottero Designs, LLC v. Nguyễn Văn Lư*, WIPO Case No. [D2021-1226](#), featured the following paragraph under this element of the Policy:

“In addition, the Panel finds that the Respondent, Nguyễn Văn Lư, was involved in a pattern of several cybersquatting cases of domain name disputes, namely, *Thi Factory S.A. v. Vietnam Domain Privacy Services, Nguyễn Văn Lư*, WIPO Case No. [D2019-2596](#); *Squarespace, Inc. v. April Sea Information Technology Company Ltd. / Nguyễn Văn Lư*, WIPO Case No. [D2019-3064](#); *Skyscanner Limited v. Nguyễn Văn Lư*, WIPO Case No. [D2020-0672](#); *xHamster IP Holdings Ltd v. Nguyễn Văn Lư*, WIPO Case No. [D2020-3163](#); *CenterPoint Energy, Inc. v. Nguyễn Văn Lư*, WIPO Case No. [D2020-3300](#); *Hillsong Church Inc. v. Nguyễn Văn Lư*, WIPO Case No. [D2021-0368](#).”

While it has not been necessary for the Panel to consider this paragraph in reaching its decision under this element of the Policy, the coincidence of the respondents’ names in the above citations and the background facts of those cases would have led the Panel to conclude that this case was part of the same pattern. If anything, it adds support for the Panel’s findings under all three elements of the Policy.

F. Delay in bringing the Complaint

For completeness the Panel has considered the delay in bringing the Complaint. The Domain Name was registered on July 22, 2004 and the original Complaint was not received by the Center until February 28, 2023, over 18 and a half years later. Moreover, it took the Complainant nearly a year to file the original Complaint following the Respondent’s failure to respond to the cease and desist emails sent to the Registrar and the entity hosting the Respondent’s website.

The Panel has no information as to the reason for the delays, but it could be that it was only relatively recently that the Complainant was made aware of the Domain Name and the website to which it is connected. As to the delay of nearly a year in filing the original Complaint following the cease and desist emails, it could be that the issue relating to the Domain Name registers low in the Complainant’s order of priorities.

Section 4.17 of [WIPO Overview 3.0](#) deals with the issue of delay as follows:

“Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits.

Panels have noted that the UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. Panels have furthermore noted that trademark owners cannot reasonably be expected to permanently monitor for every instance of potential trademark abuse, nor to instantaneously enforce each such instance they may become aware of, particularly when cybersquatters face almost no (financial or practical) barriers to undertaking (multiple) domain name registrations.

Panels have therefore declined to specifically adopt concepts such as laches or its equivalent in UDRP cases.

Panels have however noted that in specific cases, certain delays in filing a UDRP complaint may make it more difficult for a complainant to establish its case on the merits, particularly where the respondent can show detrimental reliance on the delay.”

The Panel observes that the delays have disadvantaged the Respondent in no way at all, quite the reverse, and that on the facts of this case, there is no reason for the Complainant to be disentitled to a decision on the merits of the case.

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 Domain Name, <estelm.com>, be transferred to the Complainant.

/Tony Willoughby/

Tony Willoughby

Sole Panelist

Date: May 1, 2023