

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Case No. DNL2019-0003

Date 27 March 2019

1. The Parties

The Complainant is JUUL Labs, Inc, of San Francisco, California, United States of America, represented by Taylor Wessing, the Netherlands.

The Respondent is Versio B.V. of Leeuwarden, the Netherlands.

2. The Domain Name and Registrar

The disputed domain name <esigaretjuul.nl> (the “Domain Name”) is registered with SIDN through AXC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 4, 2019. On the same day, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed domain name. On February 5, 2019, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 11, 2019. In accordance with the Regulations, article 7.1, the due date for Response was March 3, 2019. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 4, 2019.

The Center appointed Willem J. H. Leppink as the panelist in this matter on March 13, 2019. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

The Complainant manufactures and sells vaporizer devices and accessories. These products are sold at convenience stores and other retail outlets, as well as via the website of the Complainant. The Complainant’s products have received a lot of media attention.

The Complainant owns various registrations for the JUUL trademark, including the European Union Trade Mark (“EUTM”) (word mark) JUUL with registration number 012477791 for goods in class 34, registered on July 11, 2014, and with a filing date of January 6, 2014, and the EUTM (figurative mark mark) JUUL with registration number 014944251 for goods in classes 11, 34 and 35 registered on April 13, 2016, and with a filing date of December 19, 2015 (hereinafter collectively referred to as the “Trademark”).

In addition, the Complainant is the owner of various domain names that incorporate the Trademark, such as <juul.com> and <juulvapor.com>.

The Domain Name was registered on December 22, 2018, and resolves to a website that appears to offer the Complainant's products. The Panel notes that the website does not seem to be fully functioning, as for instance, the button "Bestel online" ("Order online") does not work (the "Website").

5. Parties' Contentions

A. Complainant

Insofar as relevant the Complainant contends the following.

The Domain Name is confusingly similar to the Trademark, as it incorporates the Trademark and adds the descriptive term "esigaret". The addition of the descriptive term "esigaret" contributes to the confusion with the Complainant, as the Complainant is active in the e-cigarette business.

The Respondent has no rights or legitimate interests in the Domain Name. The Respondent is using the Domain Name to lure Internet users seeking the Complainant's products to the Website that is not at all affiliated with the Complainant. The products sold via the Website (once the Website works) are likely to be counterfeit or at least unauthorized.

Respondent is not known by the name "Juul" and has no rights in this name.

Respondent designed the Website to capitalize on confusion between the Complainant and the Respondent. Diversion to a scam website is not a legitimate, noncommercial, or fair use of the Domain Name.

Respondent registered the Domain Name after the Complainant had already started using the Trademark. Furthermore, the Respondent clearly had actual knowledge of the Trademark, since the Respondent uses the Domain Name to promote and/or sell fraudulent products of the Complainant. Even if the Respondent is not engaged in the sale of counterfeit or unauthorized products of the Complainant, the use of the Domain Name to divert Internet traffic and to disrupt a third-party business constitutes bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to article 2.1 of the Regulations the Complainant must prove each of the following three elements:

a. the Domain Name is identical or confusingly similar to:

I) a trademark or trade name protected under Dutch law in which the Complainant has rights; or

II) a personal name registered in the General Municipal Register ("Gemeentelijke Basisadministratie") of a municipality in the Netherlands, or the name of a Dutch public legal entity or the name of an association or foundation registered in the Netherlands under which the Complainant undertakes public activities on a permanent basis; and

- b. the Respondent has no rights to or legitimate interests in the Domain Name; and
- c. the Domain Name has been registered or is being used in bad faith.

As the Respondent has not filed a response, the Panel shall rule on the basis of the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or in fact.

A. Identical or Confusingly Similar

Pursuant to article 2.1(a) under I of the Regulations, the Complainant must establish that the Domain Name is identical or confusingly similar to a trademark or trade name in which the Complainant has rights.

The Complainant has shown that it has rights in the Trademark.

The Domain Name incorporates the Trademark in its entirety and adds the descriptive word “esigaret” (which translates to “e-cigarette” in English). The Panel finds that the dominant part of the Domain Name is “juul” and that the element “esigaret” is merely descriptive.

The Panel finds that the Domain Name is confusingly similar to the Trademark for purposes of the Regulations. As the Trademark is registered for in particular e-smoking products, the inclusion of the descriptive element “esigaret” further adds to the confusing similarity between the Trademark and the Domain Name.

The Complainant has therefore established the first element of article 2.1 of the Regulations.

B. Rights or Legitimate Interests

Pursuant to article 2.1 of the Regulations, the Complainant must demonstrate that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent may demonstrate such rights or legitimate interests on its part *inter alia* through the following circumstances listed in article 3.1 of the Regulations:

- a. before having any notice of the dispute, the [Respondent] made 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;
- b. the [Respondent] as an individual, business or other organization is commonly known by the Domain Name;
- c. the [Respondent] is making a legitimate noncommercial use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish or otherwise damage the relevant trademark, trade name, personal name, name of a Dutch public legal entity or name of an association or foundation located in the Netherlands.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name for the reasons listed above under Section 5.A. The Panel is satisfied that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name.

If and to the extent the Respondent may be considered to be a reseller, the question whether it is using the Domain Name in connection with a *bona fide* offering of goods or services is to be assessed in light of the decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903. Having been rendered under the Uniform Domain Name Dispute Resolution Policy (“UDRP”), this decision has been confirmed to be of relevance for the Regulations, *inter alia* in *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. DNL2010-0024 and *Maison Louis Latour v. Jos Beeres Wijnkoperij*, WIPO Case No.

DNL2011-0074.

Pursuant to this test, to be *bona fide* the offering must meet several requirements. These include, at minimum, the following:

- the respondent must actually be offering the goods or services at issue.

See, e.g., *World Wrestling Federation Entertainment, Inc. v. Ringside Collectibles*, WIPO Case No. D2000-1306;

- the respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods.

See, e.g., *Nikon, Inc. and Nikon Corporation v. Technilab, Inc.*, WIPO Case No. D2000-1774;

- the website must accurately disclose the respondent's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents.

See, e.g., *Houghton Mifflin Co. v. The Weatherman, Inc.*, WIPO Case No. D2001-0211; *R.T. Quaife Engineering, Ltd. and Autotech Sport Tuning Corporation d/b/a Quaife America v. Bill Luton*, WIPO Case No. D2000-1201; and *Easy Heat, Inc. v. Shelter Products.*, WIPO Case No. D2001-0344;

- the respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name. See, e.g., *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525.

The Oki Data case furthermore confirms that the above criteria are non-limitative and that other indications relevant to the legitimacy of respondents' conduct may be taken into account.

In the present case, the Panel notes that, based on the evidence provided by the Complainant, the Website does not appear to work properly. Therefore, the Respondent is not actually using the Website to offering the goods at issue. In addition, the Website fails to accurately and prominently disclose the Respondent's (lack of) relationship with the Complainant. On the contrary, the Website is designed in a highly similar way as the website of the Complainant.

Accordingly, the Panel is not convinced that the Domain Name was used in connection with a *bona fide* offering of goods or services, and in any event concludes that the Respondent fails the Oki Data test.

The Panel finds that the Respondent lacks rights to or legitimate interests in the Domain Name.

The Complainant has thus established the second element of article 2.1 of the Regulations.

C. Registered or Used in Bad Faith

The Panel refers to its considerations under Section 6.B.

The Panel finds that the Respondent has used the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to the Website, by creating a likelihood of confusion which may arise with the Trademark as to the source, sponsorship and endorsement of the Website.

The Panel considers the following factors: (i) the reputation of Complainant's mark, (ii) the failure of Respondent to submit a response, and (iii) the implausibility of any good faith use to which the Domain Name may conceivably be put, given that, the Domain Name resolves to a website which prominently displays the Complainant's logo and official product images. This gives the false impression that it is operated by Complainant or an official retailer of Complainant.

The Domain Name operates by intentionally creating a likelihood of confusion with Complainant's trademark and business as to the source, sponsorship, affiliation or endorsement of the Website. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), section 3.1 and 3.4 .

Lastly, the Respondent is selling what are likely counterfeit goods of the Complainant on the websites under the Domain Name, taking unfair advantage of the reputation and goodwill of the Complainant's trademarks.

This constitutes evidence of bad faith registration and use in accordance with article 3.2(d) of the Regulations.

The Panel finds that the Complainant has also established the third element of article 2.1 of the Regulations.

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the domain name <esigaretjuul.nl> be transferred to the Complainant.

Willem J.H. Leppink
Panelist