

## **ADMINISTRATIVE PANEL DECISION**

Trader Joe's Company v. Hildegard Gruener  
Case No. D2022-3105

### **1. The Parties**

The Complainant is Trader Joe's Company, United States of America ("United States"), represented by O'Melveny & Myers, LLP, United States..

The Respondent is Hildegard Gruener, Austria.

### **2. The Domain Names and Registrar**

The disputed domain names <trader-joe.com>, <trader-joes.info> and <traderjoes.info> 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 August 22, 2022. On August 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 24, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 30, 2022, 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 on September 3, 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 the Respondent of the Complaint, and the proceedings commenced on September 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 30, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on October 7, 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 owns and operates over 530 grocery stores under the TRADER JOE'S mark in the United States. It promotes its products by email to more than 700,000 customers throughout the United States, by podcast throughout the United States, through social media on numerous online platforms, and through its website at its domain name <traderjoes.com>. Although customers cannot order through its website, it receives over 3.4 million visitors monthly and has over 2.7 million followers for its Instagram account. It owns numerous trade mark registrations for its TRADER JOE'S trade mark including United States registration number 1,424,176 filed on May 12, 1986 and registered on January 6 1987.

The disputed domain names were registered initially as follows: <trader-joe.com> on May 16, 2021; <traderjoes.info> on July 22, 2021; and <trader-joes.info> on August 25, 2022. The website at "trader-joe.com" previously advertised online grocery and delivery of Complainant's products although these are services that the Complainant has never offered and has never permitted third parties to offer. When a user attempted to order groceries from the Respondent's "trader-joe.com" website by clicking "shop online" or "online grocery shopping", the website re-routed to a pay-per-click ("PPC") website at "http://order-grocery-online.net". In July or August 2022, the Respondent began to re-route the <trader-joe.com> domain name to the "traderjoes.info" website that featured similar content and the same layout as the website at "trader-joe.com".

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

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

The Complainant submits that it owns registered trade mark rights in the TRADER JOE'S mark as set out above. It says that the disputed domain names are each confusingly similar to the Complainant's TRADER JOE'S trade mark. It says that the disputed domain names <trader-joe.com> and <trader-joes.info> closely mirror and intentionally misspell the Complainant's trade mark, whether by using a hyphen or omission of the letter "s" and submits that the disputed domain name <traderjoes.info> uses a mark that is identical to the Complainant's mark.

The Complainant says that it has not granted the Respondent rights to use its trade mark rights and that it is in no way affiliated with the Respondent. The Complainant also submits that the Respondent does not have any license, permission, contract, or other relationship with the Complainant that allows the Respondent to own or control the disputed domain names.

The Complainant submits that the Respondent does not use and has not used the disputed domain names, or any name corresponding to them, in connection with a *bona fide* offering of goods or services, prior to notice of the dispute. The Complainant says that the <traderjoe.com> website previously purported to advertise online grocery and delivery of Trader Joe's products, however these are services that the Complainant does not and has never offered, nor permitted any third party to offer. When a user attempted to order groceries from the Respondent's website at <trader-joe.com> by clicking "shop online" or "online grocery shopping", the website rerouted to a PPC website. at: "http://order-grocery-online.net/". In July or August 2022, the Complainant says that the Respondent began to re-route the "trader-joe.com" disputed domain name to the website at "traderjoes.info". It says that this website featured highly similar content and the same layout as the "trader-joe.com" website, and also used hyperlinks to reroute users to the same PPC website at "http://order-grocery-online.net/".

Subsequently and about four days after the Complainant filed this Complaint and shortly after the concerned Registrar placed the first two disputed domain names on Lock, the Complainant notes that the Respondent registered <trader-joes.info>. The Complainant suggests this disputed domain name was registered for the same purpose as the other two, namely, to re-route Internet users to this PPC website.

The Complainant says that the product list headings on the former “trader-joe.com” and the current “traderjoes.info” websites, being “Bakery”, “Beverages”, “Frozen”, “Wine & Beer & Spirits”, “Grocery”, “Produce & Flowers”, “Refrigerated Products”, “Snacks & Sweets”, and “What is HABA, Anyway”, are all hyperlinked to re-route Internet users to the PPC website and that this usage does not constitute a legitimate interest in the disputed domain names. It also notes that there is no disclaimer on any of the websites but rather the Respondent has attempted to exacerbate the level of confusion by using the Complainant’s registered TRADER JOE’S trade mark on its website, as well as the TRADER JOE’S logo and the “R” symbol. It notes also that the websites’ footer claims “Copyright © 2022 Trader Joe. All Rights Reserved”. As such, says the Complainant, the Respondent’s use of TRADER JOE, TRADER JOE’S, and the Trader Joe’s logo falsely implies that the Respondent is the Complainant and is likely to cause consumer confusion and harm to the Complainant.

The Complainant asserts that the Respondent is not commonly known by any of the disputed domain names which were all registered recently: <traderjoes.info> disputed domain name was registered on July 17, 2022, the <trader-joe.com> disputed domain name was registered on May 16, 2021, and the <trader-joes.info> disputed domain name was registered on or about August 25, 2022. The Complainant submits that the Respondent does not hold any trade marks consisting of TRADER JOE or TRADER JOE’S.

The Complainant also says that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names and is in fact using the Complainant’s trade mark in the disputed domain names for the purpose of capitalising on the fame and commercial goodwill attaching to the Complainant’s trade marks in order to divert internet traffic to the Respondent’s website and related sites that seek to commercialise such traffic.

As a consequence, the Complainant says the Respondent has intentionally attempted to attract, for commercial gain, internet users to the disputed domain names and the websites to which they resolve or re-direct by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website and the services available on the website in terms of paragraph 4(b)(iv) of the Policy.

It notes that the Respondent registered the disputed domain names in 2021 and 2022, decades after the Complainant had established its trade mark rights and long after the Complainant’s trade marks had become famous. It says that the fact that the Respondent is using the Complainant’s word and logo trade marks as well as the ® symbol and provides no disclaimer on the websites to which the disputed domain names resolve or re-direct is indicative that the Respondent intends to be mistaken as the Complainant and to trade off the goodwill attaching to the Complainant’s very well reputed trade marks, all in bad faith.

Finally, the Complainant notes that the Respondent has been an unsuccessful respondent in numerous prior UDRP cases and that a recent panel referred to the Respondent as “a serial cybersquatter”. *Homeaway.com Inc. v. Hildegard Gruener*, WIPO Case No. [D2022-2237](#) (WIPO Aug. 8, 2022); see also, e.g., *Trivago N.V. v. Hildegard Gruener*, WIPO Case No. [D2021-4012](#) (WIPO Feb. 2, 2022); *Decentraland Foundation v. Hildegard Gruener*, WIPO Case No. [D2022-0334](#) (WIPO March 18, 2022).

## **B. Respondent**

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns numerous trade mark registrations for its TRADER JOE'S trade mark. The disputed domain names <trader-joe.com> and <trader-joes.info> differ from the Complainant's trade mark registration only by the addition of a hyphen and/or omission of the letter "s" before the top level domain in each case, noting that an apostrophe cannot be replicated in a domain name. The disputed domain name <traderjoes.info> is otherwise identical to the Complainant's mark. On this basis the Panel finds that each of the disputed domain names is confusingly similar to the Complainant's trade mark registration for TRADER JOE'S and the Complaint succeeds under this element of the Policy.

### B. Rights or Legitimate Interests

The Complainant has submitted that it has not granted the Respondent rights to use its trade marks and that it is in no way affiliated with the Respondent. The Complainant has also submitted that the Respondent does not have any licence, permission, contract, or other relationship with the Complainant that allows the Respondent to own or control any of the disputed domain names.

The Complainant has submitted that the Respondent does not use and has not used any of the disputed domain names, or any name corresponding to them, in connection with a *bona fide* offering of goods or services, prior to notice of the dispute. It has also asserted that the "trader-joe.com" website previously purported to advertise online grocery and delivery of Complainant's products, however these are services that the Complainant does not and has never offered and has never permitted any third party to offer upon its behalf.

It appears that the Respondent set up websites at the <trader-joe.com> and <traderjoes.info> that looked very similar and both featured the TRADER JOE'S word and logo marks and the legend "Copyright © 2022 Trader Joe. All Rights Reserved" at the foot of the website page. The Complainant has submitted that when a user attempted to order groceries from the Respondent's website at <trader-joe.com> by clicking "shop online" or "online grocery shopping", the website rerouted to a pay-per-click website at: "http://order-grocery-online.net/". The Complainant has also submitted that in July or August, 2022, the Respondent began to re-route the "trader-joe.com" disputed domain name to the website at <traderjoes.info>. It says that this website featured highly similar content and the same layout as the "trader-joe.com" website, and also used hyperlinks to re-route users to the same pay-per-click website at: "http://order-grocery-online.net/". After the Complainant filed this Complaint and shortly after the concerned Registrar placed the first two disputed domain names on Lock, the Complainant notes that the Respondent registered <trader-joes.info>. The Complainant has suggested that this disputed domain name was registered for the same purpose as the other two, namely, to re-route Internet users to the same PPC website which appears to feature links to third party on-line shopping sites. The Complainant has submitted that this usage does not constitute a legitimate interest in the disputed domain names and is rather likely to cause consumer confusion and harm to the Complainant.

The Complainant has also asserted that the Respondent is not commonly known by any of the disputed domain names which were all registered recently. The Complainant has further submitted that the Respondent does not own any trade marks consisting of TRADER JOE or TRADER JOE'S.

The Complainant has also asserted that the Respondent is not making a legitimate noncommercial or fair use of any of the disputed domain names and is in fact using the Complainant's trade mark in the disputed domain names for the purpose of capitalising on the fame and commercial goodwill attaching to the Complainant's trade marks in order to divert internet traffic to the Respondent's website and related sites that seek to commercialise such traffic.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in any of the disputed domain names. The Respondent has failed to respond to or to

rebut the Complainant's case and for these reasons and for the reasons set out under Part C below, the Panel finds that the Complaint also succeeds under this element of the Policy.

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

The Respondent registered the disputed domain names many years after the registration of the Complainant's United States trade mark and the commencement of what has come to be a very substantial business and well reputed trade mark in the United States. This, combined with the fact that the first two disputed domain names registered by the Respondent resolved to websites featuring the TRADER JOES word and logo marks and copyright notice and appear to be masquerading as if they are owned by or associated with the Complainant, leaves that Panel in no doubt that the Complainant must have been well aware of the Complainant's business and trade mark when she registered each of the disputed domain names.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

It is apparent, as noted above, that the Respondent has used the disputed domain names: <trader-joe.com> and <traderjoes.info> to resolve to websites at which she sought to masquerade as if the websites were affiliated to or owned by the Complainant. When Internet users landed on the website and sought to make a purchase they were ultimately re-directed to the same PPC / which featured links to third party grocery traders. The Panel finds that this amounts to intentionally attracting, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of those websites in terms of paragraph 4(b)(iv) of the Policy and therefore amounts to evidence of registration and use in bad faith.

The fact that about four days after the Complainant filed this Complaint and shortly after the concerned Registrar placed the first two disputed domain names on lock, the Respondent registered <trader-joes.info> strongly suggests that the Respondent intended to use this disputed domain name for similar purposes. In circumstances that the Respondent had previously registered the first two domain names incorporating the Complainant's mark with minor misspellings and had used them to divert Internet users for its own commercial purposes and gain, there is a very strong inference that <trader-joes.info> was registered for a similar purpose.

The Panel finds that the Respondent's registration of <trader-joes.info> fulfills the requirements of paragraph 4(b)(ii) of the Policy, namely that the Respondent registered <trader-joes.info> in order to prevent the Complaint from reflecting its mark in a corresponding domain name after having engaged in a pattern of such conduct and this amounts to evidence of registration and use in bad faith of this disputed domain name.

The Panel's view of the Respondent's bad faith is only reinforced by her use of a privacy service to mask her real identity and by her recent past history as an unsuccessful respondent in cybersquatting cases, as noted by the Complainant, such as *Homeaway.com Inc. v. Hildegard Gruener*, WIPO Case No. [D2022-2237](#).

As the Panel finds that each of the disputed domain names have been registered and used in bad faith, the Complaint also succeeds under this element 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 names <trader-joe.com>, <trader-joes.info>, and <traderjoes.info> be transferred to the Complainant.

/Alistair Payne/

**Alistair Payne**

Sole Panelist

Date: October 24, 2022