

ADMINISTRATIVE PANEL DECISION

JPW Industries Inc. v. yan zhang

Case No. D2023-0700

1. The Parties

The Complainant is JPW Industries Inc., United States of America, represented by Waller Lansden Dortch & Davis, LLP, United States of America.

The Respondent is yan zhang, China.

2. The Domain Name and Registrar

The disputed domain name <jettoolssale.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2023. On February 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 16, 2023, the Registrar 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 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 February 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 16, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on March 23, 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 retailer specialized in designing, manufacturing, importing, supplying, or otherwise providing tools, tool accessories, and other material-handling products.

The Complainant is the registered owner of several trademarks for JET, e.g. United States of America Trademark Registration No. 713132, JET, registered on March 28, 1961 for “chain and ratchet hoists” in class 7; United States of America Trademark Registration No. 834306, JET, registered on August 29, 1967 for “rail mounted, load supporting trolleys, pulley blocks, load lifting hydraulic jacks, [bench vices], speed reducing gear housings, drill presses and air tools—namely, grinders, hammers, chipping, [caulking] and riveting hammers, impact wrenches, drills, screw-drivers, and tampers” in classes 6, 7, 8, 9, 11, 12, 16, 21, and 28; International Trademark Registration No. 806142, JET, registered on October 23, 2002 for various goods in classes 6, 7, 8, 9, 11, 12, 16, 17, and 22 and designating several countries, amongst others China.

The Complainant operates the domain name <jettools.com>.

The disputed domain name was registered on August 20, 2022, and resolves to a website allegedly selling the Complainant's JET branded products, reproducing without any authorization the Complainant's trademarks and further using product images which are identical to those displayed on the Complainant's website and specifically reproducing the Complainant's advertising product material.

5. Parties' Contentions

A. Complainant

It results from the Complainant's allegations that since 1958 the Complainant, or its predecessors-in-interest, has operated a retail business specializing in designing, manufacturing, importing, supplying, or otherwise providing tools, tool accessories, and other material-handling products. Since 1960, the Complainant has operated that business under the JET trademark. Today, the Complainant is well-known, both to consumers and the public at-large, doing business not just in the United States of America, but also throughout the world.

The Complainant contends that its trademark JET is distinctive and well-known. In particular, the Complainant's trademarks have become widely known to consumers to identify tools, tool accessories, and other material-handling products.

It also uses the domain name <jettools.com>, registered on December 21, 1995, which redirects to its official online marketplace.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademark and domain name, since the disputed domain name incorporates the Complainant's JET marks in their entirety, adding only the generic and descriptive terms “tools” and “sale” and the generic Top-Level Domain (“gTLD”) “.com”. Similar changes in a registered mark have failed to sufficiently distinguish a domain name for purposes of Policy Paragraph 4(a)(i).

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, it has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the above-mentioned trademarks. In addition, the Respondent is not using the contested domain name in connection with a *bona fide* offering of goods or services, nor is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain, so as to confer a right or legitimate interest in it. In fact, the Respondent's website specifically reproduces content, such as product images, headings, and other graphics, from the Complainant's website “www.jettools.com”. Such conduct clearly establishes the Respondent's awareness of the Complainant's goods, in connection with which it uses the trademarks, and implies a false and

misleading connection between the Respondent's website and the Complainant's business. The Respondent uses the disputed domain name merely to lure unsuspecting website visitors into providing their payment information to the Respondent, with no evidence that the Respondent actually renders any services or provides any goods in return. Indeed, confusion and deception is evidenced through the Respondent's exact use of the Complainant's advertising graphics which creates an overall deceptive commercial impression in the minds of consumers who mistakenly visit the Respondent's website while searching for the Complainant's website. Confusion and deception is further evidenced through the Respondent's use of an apparently false business address in an effort to seemingly legitimize the Respondent's apparent business practices. However, the Respondent's purported address is that of a private residence, not a commercial business, and is located in an area where, per the local zoning code, commercial use is unauthorized. Finally, the alleged JET-branded products that are advertised for alleged sale on the disputed domain name are offered at extremely discounted prices. This practice intentionally and misleadingly diverts consumers away from the Complainant's legitimate website and legitimate business.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. In fact, the Respondent knowingly chose a domain name incorporating the Complainant's well-known trademarks, decades after the Complainant first registered its trademarks. Additionally, bad faith may be established by evidence that the Respondent had actual knowledge of the Complainant's trademark rights when registering and using the disputed domain name, as demonstrated by the totality of the circumstances surrounding such registration and use. Notwithstanding the Complainant's global, longstanding use of the trademarks and its numerous trademark registrations that gave the Respondent constructive knowledge of the Complainant's trademarks, the Respondent has specifically and exactly reproduced the Complainant's advertising and product graphics featuring the trademarks that are, or were, used on the Complainant's website, "www.jettools.com". The Respondent clearly had actual knowledge of the Complainant's rights in the trademarks upon registering and while continuing to use the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "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". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (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.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of various trademark registrations for JET as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark JET is fully included in the disputed domain name, followed by the terms "tools" and "sale". Furthermore, it is the view of this Panel that the addition of the terms "tools" and "sale" in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the gTLD ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and, in particular, did not authorize the Respondent's use of the trademark JET, e.g. by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, it results from the Complainant's non-contested evidence that the disputed domain name resolves to a website on which the Complainant's JET goods are allegedly sold and which did not accurately and prominently disclose the lack of the Respondent's relationship with the Complainant. Since this use is clearly commercial, it cannot be considered 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 pursuant to paragraph 4(c)(iii) of the Policy.

Furthermore, such use cannot be qualified a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy and the Oki Data test (e.g. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) as it is misleading and diverting consumers, making them erroneously believe that the Respondent is an authorized dealer, retailer, or re-seller of JET products, and is authorized to promote sales of JET products. This is reinforced by the following facts: (1) the Respondent did not add any note, information or disclaimer pointing out that it actually has no relationship with the Complainant; (2) the website is accessible under a disputed domain name that comprises the Complainant's trademark entirely, together with the terms "toolssale" (which are connected to the Complainant's business); (3) the Complainant operates the similar domain name <jettools.com>; and (4) the website to which the disputed

domain name resolves, reproduces without any authorization the Complainant's trademarks and further uses product images which are identical to those displayed on the Complainant's website and specifically reproduces the Complainant's advertising product material and allegedly offers for sale products claiming to be from the Complainant at discounted prices. See also [WIPO Overview 3.0](#), section 2.8.1: "Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Oki Data test', the following cumulative requirements will be applied in the specific conditions of a UDRP case: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark. The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

It is acknowledged that once the panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy). It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant's documented allegations that the disputed domain name resolves to a website allegedly selling the Complainant's JET branded products, reproducing without any authorization the Complainant's trademarks and further using product images which are identical to those displayed on the Complainant's website and specifically reproducing the Complainant's advertising product material.

For the Panel, it is therefore evident that the Respondent knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name, and likely registered it due to its similarity with the Complainant's trademark and domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant's trademark JET followed by the terms "tools" and "sale". Registration of a disputed domain name which contains a third party's mark, in awareness of the similarity with said mark and in the absence of rights or legitimate interests amounts to registration in bad faith (see *e.g.*, *FLRish IP, LLC v. Leonard Rotich*, WIPO Case No. [D2022-1706](#)). In the circumstances of this case, the Panel finds that the registration of the disputed domain name was in bad faith.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain name (a domain name incorporating the Complainant's mark plus the addition of the terms "tools" and "sale");
- (ii) the content of the website to which the disputed domain name directs, allegedly selling the Complainant's JET branded products, reproducing without any authorization the Complainant's trademarks and further using product images which are identical to those displayed on the Complainant's website and specifically reproducing the Complainant's advertising product material;
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name;
- (iv) the Respondent seems to have provided false or incomplete information for purposes of registering the disputed domain name, evidenced by the inability of the courier to deliver the Center's written notice to the address disclosed by the Registrar for the Respondent.

In light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) 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 <jettoolssale.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: April 6, 2023