

ADMINISTRATIVE PANEL DECISION

Future Motion, Inc. v. Withheld for Privacy Purposes, Privacy Service
Provided by Withheld for Privacy ehf / Elhos Ait, onewheel4u
Case No. D2022-0778

1. The Parties

The Complainant is Future Motion, Inc., United States of America (“United States”), represented by Kolitch Romano LLP, United States.

The Respondent is Withheld for Privacy Purposes, Privacy Service Provided by Withheld for Privacy ehf, Iceland / Elhos Ait, onewheel4u, Morocco.

2. The Domain Name and Registrar

The disputed domain name <onewheel4u.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 4, 2022. On March 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 7, 2022, the Registrar transmitted by email to the Center its verification response registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 7, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On March 9, 2022, the Respondent sent an informal email communication to the Center stating the following: “Hello, please i want to understand what this dispute is about, thank you”. The Complainant filed an amendment to the Complaint on March 9, 2022.

The Center verified that the Complaint together with the amendment to the 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 March 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2022. The Respondent did not submit any response. The Center notified the Commencement of Panel Appointment Process on April 11, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on April 27, 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 sells electric skateboards under the trademark ONEWHEEL since January 2014. It is the owner, amongst several others, of the following trademark registrations (Annexes 8-15 to the Complaint):

- United States Trademark Registration No. 4,622,766 for the word mark ONEWHEEL, registered on October 14, 2014, in International Class 12; and

- International Trademark Registration No. 1227105 for the word mark ONEWHEEL, registered on August 26, 2014, in International Class 12.

The disputed domain name <onewheel4u.com> was registered on December 2, 2021, and presently does not resolve to an active webpage but has been used in connection with an electronic shop offering infringing and/or similar products to those of the Complainant (Annex 26 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant claims to be a well-known electric board sports company that sells a very successful line of electric skateboards under the ONEWHEEL trademark in the United States and internationally, including Australia, Canada, Central and South America, and Europe, among other locations (Annex 6 to the Complaint), having invested substantial amounts of time and resources in building, promoting, maintaining and protecting its rights in its ONEWHEEL trademark, which has become well known and a distinctive identifier that consumers associate with the Complainant.

The Complainant asserts that the Respondent has used the disputed domain name in connection with an electronic shop that reproduced, without authorization, the Complainant's products images and graphics in connection with similar and/or infringing products under the ONEWHEEL trademark (Annexes 26 and 36 to the Complaint), thus creating a misleading impression of association with the Complainant.

According to the Complainant, the disputed domain name incorporates the ONEWHEEL trademark with the addition of the numeral "4" and of the letter "u", which do not prevent a finding of confusing similarity with the Complainant's trademark, which remains clearly recognizable in the disputed domain name.

Regarding the absence of the Respondent's rights or legitimate interests, the Complainant argues that:

(i) the Respondent is not sponsored by or affiliated with the Complainant, not having the Respondent received any license, authorization, or permission from the Complainant to use its ONEWHEEL trademark in any manner, including in domain names;

(ii) the Respondent is not commonly known by the disputed domain name or by any name that incorporates the ONEWHEEL trademark; and

(iii) the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services given that the Respondent is using the disputed domain name to offer for sale inferior quality similar and/or infringing products of the Complainant's ONEWHEEL products, using the Complainant's promotional materials without authorization.

As to the registration and use of the disputed domain name in bad faith, the Complainant states that:

(i) given the popularity and well-known character of the Complainant's trademark the Respondent knew or should have known of the Complainant and its ONEWHEEL trademark when registering the disputed domain name;

(ii) the Respondent's use of the disputed domain name in connection with a webpage that demonstrates actual knowledge of the Complainant and its trademark leaves no doubt as to the Respondent's awareness of the Complainant at the time of registration;

(iii) the Respondent, by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's ONEWHEEL trademark as to the source, sponsorship, affiliation, or endorsement of its website, pursuant to paragraph 4(b)(iv) of the Policy; and

(iv) the Respondent's choice to retain a privacy protection service is a further indicative's of the Respondent's bad faith.

B. Respondent

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

On March 9, 2022, the Respondent sent an informal email communication to the Center stating the following: "Hello, please i want to understand what this dispute is about, thank you".

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

(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 Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

A. Identical or Confusingly Similar

The Complainant has established rights over the ONEWHEEL trademark.

The disputed domain name reproduces the Complainant's ONEWHEEL trademark in its entirety. The addition of the numeral "4" and of the letter "u" does not prevent a finding of confusing similarity with the Complainant's trademark, which remains clearly recognizable in the disputed domain name. As recognized by past UDRP panels, the first element test involves a "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" (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)"), section 1.7).

For the reasons above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the 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) the Respondent (as individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the 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.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

In that sense, the Complainant has indeed stated that the Respondent is not sponsored by or affiliated with the Complainant, not having the Respondent received any license, authorization, or permission from the Complainant to use its ONEWHEEL trademark in any manner, including in domain names.

Furthermore, and according to the evidence submitted by the Complainant, the Respondent has indeed not used the disputed domain name in connection with a *bona fide* offering of goods or services given the webpage that resolved from the disputed domain name reproduced without authorization the Complainant's promotional materials offering for significantly reduced prices products under the Complainant's trademark which purportedly are knockoffs, thus creating a misleading impression of association with the Complainant. Moreover, there is no evidence that the Respondent is commonly known by the disputed domain name.

Accordingly, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which the Respondent has not rebutted.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found in view of the nature of the disputed domain name, the notoriety of the Complainant's trademark, and the Respondent's use of the disputed domain name in connection with a competing webpage, where multiple references are made to the Complainant and its products.

The use of a privacy protection service, in this case, is a further indicative of the Respondent's bad faith.

The fact that the disputed domain name presently does not resolve to an active webpage does not prevent a finding of bad faith.

For the reasons above and absent evidence to the contrary, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith.

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, <onewheel4u.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: May 11, 2022