

ADMINISTRATIVE PANEL DECISION

Future Motion, Inc. v. Privacy Service Provided by Withheld for Privacy ehf /
Ayoub Baha

Case No. D2022-1511

1. The Parties

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Ayoub Baha, Morocco.

2. The Domain Name and Registrar

The disputed domain name <one-wheel.store> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 26, 2022. On April 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 27, 2022, the Registrar transmitted by email to the Center its verification response disclosing 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 April 29, 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 amendment to the Complaint on April 29, 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 May 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 31, 2022.

The Center appointed David Stone as the sole panelist in this matter on June 13, 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 is an electric board sports company that sells a line of electric skateboards using the trade mark ONEWHEEL, including in retail shops, at trade shows and online at “www.onewheel.com”. The Complainant offers and sells its products internationally, including in Australia, Canada, Central America, South America and Europe. The Complainant’s ONEWHEEL products are known from a 2014 Kickstarter campaign, and have been discussed and publicised in numerous online articles since then.

The Complainant owns the following trade marks (the Marks), among others:

- ONEWHEEL: United States registration number 4622766, registered on October 14, 2014 in international class 12;
- ONEWHEEL: United States registration number 5953007, registered on January 7, 2020 in international class 12; and
- ONEWHEEL: International registration number 1227105, registered on August 26, 2014 in international class 12.

The disputed domain name was registered on March 2, 2022, and it was used to advertise and sell products very similar to those of the Complainant. The disputed domain name currently does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to trade marks in which the Complainant has rights. The registrations listed above, and the brand recognition gained from the Kickstarter campaign and media exposure, show that the Complainant has rights in the Marks. The disputed domain name incorporates all elements of the Marks, with the only difference being a hyphen between the word “ONE” and the word “WHEEL” in the disputed domain name. As a result, the text of the Marks is highly recognisable within the disputed domain name. The presence of the additional hyphen fails to reduce the likelihood of confusion, and so does not prevent a finding of confusing similarity.

The website associated with the disputed domain name has been deactivated since approximately March 14, 2022. Before then, it was used by the Respondent, using both the Marks and images from the Complainant’s website, to advertise and sell goods similar to those sold by the Complainant. This increases the likelihood of confusion because consumers will have falsely believed that there was a connection between the disputed domain name and the Complainant, and that the products advertised and sold through the Respondent’s website were owned, controlled, sponsored and/or endorsed by the Complainant.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not licensed, authorized or otherwise permitted the Respondent to use the Marks in any way, the Complainant’s registration and use of the Marks pre-dates the Respondent’s registration of the disputed domain name, and, as far as the Complainant is aware, the Respondent is not commonly known by the disputed domain name. The fact that the disputed domain name consists of, essentially, the text of the Marks plus an additional term (“store”) suggests a false affiliation between the

Respondent and the Complainant that should prevent a finding of fair use. Furthermore, the Respondent used the disputed domain name to disrupt the business of the Complainant as described above, and not for any legitimate purpose or *bona fide* offering of goods or services. To the best of the Complainant's knowledge, the products sold on the Respondent's website were inferior "knockoffs" (copies) of the Complainant's products, advertised at prices between USD 300 and USD 650 less than the genuine articles. The Respondent's unauthorised use of the Marks and images for which the Complainant owns the copyright is another demonstration of the Respondent's desire to mislead consumers and divert them from the Complainant.

The Complainant contends that the disputed domain name was registered and is being used in bad faith, noting that a finding of use in bad faith is not precluded by the fact that the Respondent's domain is no longer accessible. The Respondent knew, or should have known, of the Marks and the Complainant's business when it registered the Disputed Domain Name. An online search using the keyword "onewheel" or "one-wheel" would have revealed the Complainant's existence. The similarity between the disputed domain name and the Marks shows in fact that the Respondent cannot credibly claim to have been unaware of the Marks, which creates a presumption of bad-faith registration. The Respondent's use of its website to imitate the Complainant, and so attract consumers for commercial gain, then falls squarely into the definition of bad-faith use of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets out the three requirements that the Complainant must prove in order to succeed:

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

A. Identical or Confusingly Similar

On the evidence provided by the Complainant, the Panel is satisfied that the Complainant has rights in the Marks. In assessing the similarity between the disputed domain name and the Marks it is permissible to ignore the Top-Level Domain. The disputed domain name contains the text of the Marks in its entirety and differs from it only by the addition of a hyphen: "one-wheel" versus "onewheel". This does not prevent a finding of confusing similarity with the Complainant's trademark. The Panel therefore finds that the disputed domain name is confusingly similar to the Marks, and concludes that the condition in paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the criteria that determine whether a domain name registrant has rights or legitimate interests in a domain name:

(i) before any notice to the respondent 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 an individual, business or other organisation) has been commonly known by the disputed domain name, even if the respondent has acquired no trade mark 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 misleadingly to divert consumers or to tarnish the trade mark or service mark at issue.

The Complainant makes out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and the Respondent has provided no evidence to contradict it.

On the facts and contentions before the Panel, the Respondent is not commonly known by the disputed domain name, is not authorised to use the Marks and cannot claim any right or interest in them by virtue of prior registration.

As contended by the Complainant, the composition of the disputed domain name itself falsely suggests sponsorship or endorsement by the Complainant, which cannot constitute fair use (see section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). On the evidence presented by the Complainant, the Panel is satisfied that the Respondent's website featured images taken from the Complainant's website at "www.onewheel.com". The actual use of the disputed domain name, that is, the unauthorised use of the Marks and these images to advertise and sell products very similar to those of the Complainant, confirms that the Respondent was making neither legitimate noncommercial nor fair use of the disputed domain name. The Respondent's behaviour amounts to impersonation of the Complainant, which also cannot confer rights or legitimate interests (see section 2.13.1 of the [WIPO Overview 3.0](#)).

The condition in paragraph 4(a)(ii) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out the non-exhaustive criteria for bad faith. Generally, for the purposes of the Policy, bad faith constitutes registration and use of a domain name in order to:

(i) sell, rent or transfer the domain name to the trade mark owner (or a competitor thereof) for a profit;

(ii) prevent the trade mark owner from registering its trade mark in a domain name, provided that the respondent is engaged in a pattern of such conduct;

(iii) disrupt the business of a competitor; or

(iv) divert Internet traffic for commercial gain.

The use of the disputed domain name to sell versions of the Complainant's products using the Marks and the Complainant's images is clear evidence that the Respondent was aware of the Complainant and its business. The Respondent therefore knew, at the time of registration, that the disputed domain name was almost identical to the Complainant's Marks. In the absence of any explanation of its behaviour by the Respondent, the Panel concludes that the disputed domain name can have been registered only for the purpose of disrupting the Complainant's business and diverting Internet traffic for commercial gain. The registration was therefore in bad faith. The Respondent's subsequent use of the disputed domain name to

impersonate the Complainant and sell competing products clearly amounts to bad-faith use for the same reason.

The condition in paragraph 4(a)(iii) of the Policy is therefore satisfied.

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, <one-wheel.store>, be transferred to the Complainant.

/David Stone/

David Stone

Sole Panelist

Date: June 23, 2022