

## **ADMINISTRATIVE PANEL DECISION**

Trader Joe's Company v. CHENG CHIEH LIU  
Case No. D2022-1620

### **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 CHENG CHIEH LIU, Singapore, represented by Reed Smith LLP, United States.

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

The disputed domain name <traderjoexyz.com> is registered with CloudFlare, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 4, 2022. On May 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 9, 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 May 9, 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 May 13, 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 May 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2022. On June 3, 2022, the Respondent requested an additional four calendar days in which to respond to the Complaint. On the same day, the Center granted the Respondent the automatic four calendar day extension for response under paragraph 5(b) of the Rules. The due date for Response was extended to June 9, 2022. The Response was filed with the Center on June 9, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on June 22, 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 states that it is an operator of grocery stores, asserting that it has used the mark TRADER JOE'S since 1967. The Complainant provides a list of its corresponding registered trademarks in the United States and Singapore. The Complainant did not provide individual register entries for each mark, and the Panel has viewed a sample on the official website for each jurisdiction.<sup>1</sup> For example, the Complainant owns United States Registered Trademark No. 1422216 for the word mark TRADER JOE'S, registered on December 23, 1986 in Class 32 (fruit and vegetable juices). The Complainant also owns Singapore Registered Trademark No. T9706493C for the word mark TRADER JOE'S, registered on July 8, 1999 in Class 31 (pet food and raw nuts). The Complainant's list does not specify any TRADER JOE'S registered trademarks in Class 36 (financial services) in either jurisdiction.

The disputed domain name was registered on July 7, 2021. The associated website indicates that it is a decentralized finance trading platform named "Trader Joe", stating on its "FAQ" page that "Trader Joe" is a "one-stop decentralized trading platform on the Avalanche network" and that "\$JOE" is "Trader Joe's native token that rewards holders with a share of exchange revenues". The site provides a "brand pack" of "Trader Joe brand assets" which Internet users are invited to use in their own materials, including various logos of cartoon characters named, for example, "Trader Joe" and "Banker Joe". The site also features a "technical team" who are each described by way of an alias.

The Respondent is one of the founders of the "Trader Joe" platform. Considerable evidence has been provided by the Respondent of the background to the platform's creation, including a timeline of the platform's history dating back to April 2021, accompanied by supporting annexes which include media coverage. For example, an article from the website "news.coincu.com" dated January 11, 2022 describes the Respondent's said platform in detail and repeats its aims and aspirations, noting that it has garnered 115,400 followers on Twitter. An earlier article from the website "www.theblockcrypto.com" dated September 2, 2021, notes that the said platform has raised USD 5 million in a token sale from Three Arrows Capital and other investors, that it has a Total Value Locked ("TVL")<sup>2</sup> of around USD 460 million, that its token, "JOE" is live and trading at around USD 2, that it plans to increase its current team from fifteen to twenty people, and that the project founders are anonymous because this allows them "to build fast" compared to typical tech startups. The article quotes a portfolio manager at a sub-fund of Three Arrows Capital, who states that the "Trader Joe" team is "one of the top teams in the Avalanche ecosystem". In an article dated May 27, 2022, on the website "news.coincu.com", the said platform is described as having a market cap of over USD 100 million.

The Respondent has a substantial following on social media, with its "@traderjoe\_xyz" presence on Twitter (founded April 2021) having 148,400 followers, while its YouTube channel, "Trader Joe XYZ" (founded July 2021) has 2,310 subscribers with 104,107 views, and its Reddit account "r/traderjoe\_xyz" (founded August 2021) has 3,100 members.

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

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

In summary, the Complainant contends as follows:

### **Identical or confusingly similar**

The Complainant has used TRADER JOE'S and TRADER JOE'S-formative trademarks in connection with grocery store services and goods since 1967, and operates the domain name <traderjoes.com>. The Complainant owns multiple trademark registrations, including in the United States and Singapore, for the mark TRADER JOE'S. Said mark is used internationally and is registered in numerous classes.

The Complainant has established common law rights to the mark TRADER JOE'S through extensive and continuous commercial use, owning and operating over 530 grocery stores under said mark and promoting these with "The Fearless Flyer" newsletter, distributed at said stores and emailed to more than 700,000 customers throughout the United States.

The disputed domain name is confusingly similar to the Complainant's mark because it closely mirrors and intentionally misspells it. The use of "xyz" in the disputed domain name is designed to be misleading because it appears intended to mimic the Top-Level Domain ("TLD") ".xyz". Such intent to mislead is underscored by the Respondent operating under the name "Trader Joe" rather than "Trader Joe xyz". "Trader Joe" is the dominant portion of the disputed domain name and suggests an affiliation with the Complainant.

### **Rights or legitimate interests**

The Complainant has not granted the Respondent rights to use its trademark and is in no way affiliated with the Respondent. The disputed domain name is not used in connection with a *bona fide* offering of goods or services. The Respondent's website is not compliant with the test in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) in that it does not use the site to sell only the trademarked goods, and the site does not accurately disclose the Respondent's (non-) relationship with the Complainant. The Respondent uses the website to promote its own services in a bait-and-switch tactic, misleading consumers into believing that the disputed domain name is owned or endorsed by the Complainant. The Respondent includes no disclaimer of non-affiliation with the Complainant. The Respondent uses the Complainant's exact TRADER JOE'S mark throughout its website. The Respondent refers to "Trader Joe" as its official "brand assets". The disputed domain name falsely implies that it is the trademark owner.

The Respondent is not commonly known by the disputed domain name. The disputed domain name was only registered in July 2021 and the Respondent holds no corresponding trademarks. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Internet searches return top-of-line results for the Respondent's websites rather than the Complainant's and create an unwanted and damaging affiliation in the minds of Internet users between the Parties. The use of the Complainant's trademark in the disputed domain name capitalizes on the Complainant's fame and commercial goodwill to divert Internet traffic to the Respondent's website for commercial gain.

### **Registered and used in bad faith**

The disputed domain name violates paragraph 4(b)(iv) of the Policy. The Respondent registered the disputed domain name decades after the Complainant had established its trademark rights and long after such trademark had become famous. The Respondent acquired the disputed domain name knowing it was confusingly similar to the Complainant's trademark and with intent to profit from the Complainant's goodwill and fame. The Complainant put the Respondent on actual notice of the Complainant's trademark rights by letters of September 8, 2021 and January 25, 2022, demanding that the Respondent cease the use of the disputed domain name, but the Respondent did not reply.

The Respondent's website does not refer to any person named "Joe". The Respondent has kept its details hidden and provided no information apart from a Singapore location. The Respondent's staff only use aliases. The Respondent provides no disclaimer of non-affiliation with the Complainant. There is no conceivable good faith use of the Complainant's trademark by the Respondent. The Respondent cannot prevail if it argues that the disputed domain name is a parody as neither the disputed domain name nor the

website suggest this. The Respondent has no basis for registering the disputed domain name other than to profit from the goodwill and recognition created by the Complainant.

## **B. Respondent**

In summary, the Respondent contends as follows:

The Respondent is one of the founders of “Trader Joe”, a decentralized finance exchange and crypto asset platform on the Avalanche blockchain, founded in June 2021. Said platform enables users to trade, borrow, lend, stake, farm, and swap cryptocurrencies, which has attracted more than USD 4 billion in assets. “Trader Joe” has received backing from decentralized finance investors, including USD 5 million in August 2021 via a private token sale. By one week prior to the date of the Complainant’s first cease and desist letter, the Respondent had 15 employees, a TVL of around USD 551 million, USD 468 million in liquidity, USD 155 million in daily trading volume, had amassed 20,000 followers on Twitter, had published numerous articles about the platform on social media, and had developed a protocol named “Banker Joe” to enable non-custodial leveraged trading.

### **Identical or confusingly similar**

The disputed domain name is not an intentional misspelling of TRADER JOE’S. The term “trader joe” denotes the purpose of the platform (cryptocurrency trading) and the notion that it is accessible to everyone (“the average joe”). The platform is also named for the Respondent’s brother, Joe Liu, who is an active member of the “Trader Joe” community. The Respondent has established a “\$JOE” token, “Rocket Joe” (a launch platform for decentralized finance protocols), and “Banker Joe” (a decentralized lending protocol), each utilizing the “Joe” name.

The letters “xyz” are not misleadingly descriptive but are strongly associated with, and have become the go-to URL, for Web 3.0 companies. The inclusion of “xyz” in the disputed domain name is likely to prevent rather than create confusion among the relevant consumers. Because the Complainant’s marks contain and are always used with an apostrophe “s”, the Panel should not find confusing similarity.

### **Rights and legitimate interests**

The evidence overwhelmingly supports a finding that the Respondent used and made demonstrable preparations to use the disputed domain name and “Trader Joe”, a name corresponding thereto, before receiving notice of this dispute. The Respondent’s representative explained to the Complainant’s representative on May 19, 2022 that neither of the Complainant’s cease and desist letters had been received. The Respondent’s timeline demonstrates that even if September 8, 2021 is the date of notice of the dispute, the Respondent had established rights and legitimate interests before then.

The Complainant’s reference to the “Oki Data” test is misplaced. This applies to situations in which a respondent is, or holds itself out as, an authorized agent of a complainant. The Respondent operates a decentralized finance platform and its services are wholly unrelated to retail grocery services offered by the Complainant under the TRADER JOE’S mark. The Respondent makes no use of the TRADER JOE’S mark on its website and the items cited by the Complainant are the possessive form of “Trader Joe” when taken in context. The Respondent has also been commonly known by the disputed domain name. The Respondent and numerous third parties have referred to its business as “Trader Joe” and the Respondent routinely holds itself out as “Trader Joe XYZ”. The key inquiry is whether the Respondent is commonly known by the distinctive element in the disputed domain name, namely “Trader Joe”.

### **Registered and used in bad faith**

The Respondent denies that it should have been aware of the Complainant’s mark, actually or constructively, and notes that the Complainant has not offered evidence of any rights in connection with the singular term, “trader joe”. The Complainant has acquiesced to the registration and use of several other TRADER JOE,

TRADER JOES, and TRADER JOE'S trademarks by third parties in various jurisdictions (evidence provided of third party marks). Even if the Respondent was on notice of the Complainant's marks, the Complainant cannot add that these are so broad and famous that no other party can register and use TRADER JOE, TRADER JOES, and TRADER JOE'S marks without causing confusion or acting in bad faith. The Respondent had no obligation to respond to the Complainant's cease and desist letters. Once the Respondent became aware of said letters in May 2022, it proposed a settlement to the Complainant with a view to resolving the matter amicably. The Respondent's use of a privacy service is above board and is not in itself an indication of bad faith. The Respondent has stated publicly that its team have chosen to remain anonymous to build out their platform more quickly, and they have willingly disclosed their identity to partners when necessary. The Respondent's representative reached out to explore the possibility of settlement shortly after receiving the amended Complaint.

The Respondent is using the disputed domain name in connection with legitimate and unrelated decentralized finance services, has presented a credibly-backed rationale for registering the disputed domain name, and there is no evidence on the record that the Respondent has attempted to disrupt the Complainant's business or to attract the Complainant's consumers for commercial gain by creating a likelihood of confusion with the Complainant or its marks.

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules provides: "A Panel shall 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 states that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark 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**

The first element inquiry under the Policy usually proceeds in two parts. First, the Complainant must demonstrate UDRP-relevant rights in a trademark, whether registered or unregistered. Secondly, such trademark is compared with the disputed domain name, typically on a straightforward side-by-side basis, usually disregarding the TLD, to assess identity or confusing similarity. If, on the basis of such comparison, the disputed domain name is seen to be identical to the Complainant's trademark, identity will generally be found, while if the Complainant's mark is otherwise recognizable in the disputed domain name, confusing similarity will usually be found.

In the present case, the Panel is satisfied that the Complainant possesses UDRP-relevant rights in its registered trademark TRADER JOE'S. The Complainant also claims common law trademark rights in the said mark but it does so entirely on the basis of assertions which have not been backed by supporting evidence. As noted in section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning."

The Panel has little doubt that it would have found the Complainant's claim of common law rights to have been established had the Complainant provided suitable evidence supporting its assertions that it has operated in the United States under the "Trader Joe's" name since 1967 and currently trades using such

name via some 500 grocery stores, with a newsletter reaching some 700,000 customers,<sup>3</sup> and a website which receives 3.4 million visitors monthly, together with having some 2.7 million followers of its TRADER JOE'S account on social media. This is not strictly necessary given the numerous registered marks, and the Panel assumes is merely intended to show the duration of the TRADER JOE's mark and bolster the claim to its fame and renown (which goes more to the third element).

Turning to the comparison exercise, the disputed domain name contains the Complainant's TRADER JOE'S trademark in its entirety in a non-possessive form (*i.e.*, without the apostrophe "s") coupled to the letters "xyz". It should be noted that it is not technically possible to reproduce an apostrophe in a domain name, and that, in any event, the presentation of a non-possessive form does not render the Complainant's mark unrecognizable, even if (as the Respondent asserts) its inclusion was not an intentional or deliberate misspelling thereof on the Respondent's part. In the Panel's view, a materially substantial and sufficiently recognizable aspect of the Complainant's mark is plainly visible in the disputed domain name, such that the dropping of the letter "s" (the apostrophe being non-reproducible) is of no consequence (see section 1.9 of the [WIPO Overview 3.0](#)). In addition, the Panel considers that the additional letters "xyz" do not alter the recognizability of the Complainant's mark in the disputed domain name (on the effect of the addition of such terms to a trademark, whether descriptive, meaningless, or otherwise, see section 1.8 of the [WIPO Overview 3.0](#)).

The Panel notes the Respondent's assertions regarding how it allegedly came by the name "Trader Joe", its use of "Joe" in a variety of ways in its business, and the alleged meaning of the letters "xyz" to denote a Web 3.0 company. These are not relevant to the first element assessment under the Policy, which essentially serves as a determination of the Complainant's standing to file the Complaint. However, the Panel will factor them into the second and third element assessments below.

In all of these circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and accordingly that the Complainant has carried its burden with regard to paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. In the present case, the Panel finds that the Complainant has established the requisite *prima facie* case based on its submissions that the Complainant has given the Respondent no rights to use its trademark, that there is no affiliation between the Parties, that the Respondent is not commonly known by the disputed domain name – strictly speaking at least (but see below), and holds no corresponding trademarks, that the Respondent is not making a legitimate

noncommercial or fair use of the disputed domain name, and that the use of the Complainant's mark in the disputed domain name is intended to capitalize on the Complainant's fame and commercial goodwill to divert Internet traffic to the Respondent's website for commercial gain. The Panel notes in passing that the Complainant's citation of "Oki Data" is not particularly relevant to the present case, in that the Respondent is not and does not claim to be either an authorized or unauthorized distributor of the Complainant's goods and services.

In the above circumstances, the burden of production shifts to the Respondent to bring forward evidence of any rights or legitimate interests which it might have in the disputed domain name. The essence of the Respondent's case is that it had used the disputed domain name in connection with a *bona fide* offering of goods or services before any notice to it of the dispute (effectively a case in terms of paragraph 4(c)(i) of the Policy) and that its business has been commonly known by the disputed domain name (or a close enough approximation thereto) even if it has acquired no corresponding trademark rights (effectively a case in terms of paragraph 4(c)(ii) of the Policy).

The Respondent has produced a wealth of supporting evidence, including apparently independent media coverage, which lends credibility to its assertions that it is operating a cryptocurrency trading business with related financial services. There is independent evidence that this business has attracted significant financial support from venture capitalists specializing in cryptocurrency investment and that the Respondent had built a substantial asset base between its initial preparations in April 2021 and its status report of August 2021, *i.e.*, before the Complainant gave notice to it of the present dispute on September 8, 2022. While there is a live issue between the Parties as to whether the Respondent received that notice, this is not of any significance for present purposes as the Respondent has used the date of the Complainant's cease and desist letter as the operative date when evidencing the substance of its prior trading activities.

The Panel is satisfied that the Respondent's evidence supports a finding that, in connection with its decentralized finance business, the Respondent used or made demonstrable preparations to use the disputed domain name and "Trader Joe", a name corresponding thereto, before receiving notice of the present dispute. However, for this Panel, the evidence needs to go further than that. In this case, the nub of the issue in determining whether the Respondent's business is using the disputed domain name in connection with a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy is whether the Respondent selected the name "Trader Joe" for its business independently of the Complainant's TRADER JOE'S trademark or whether it did so because it knew of and intended to exploit the goodwill and notoriety of such mark. In the latter case, its use of the disputed domain name could not be described as *bona fide*.

The Respondent addresses this topic by pointing out that a "trader" identifies the purpose of its platform, namely cryptocurrency trading. More accurately, the term appears to describe a person within the Respondent's target market, the "trader" in this sense being someone who wishes to trade crypto-assets on the Respondent's platform. The Respondent adds that "Joe", which refers both to its "\$JOE" tokens, and to the platform itself, was selected to reference "the average joe" in order to signal that its site was available to all consumers. "Joe" is also said to reference to the Respondent's brother, an active enthusiast in the crypto-asset space (although no evidence of such is provided). Finally, the term "xyz" is said to have been widely adopted by those engaging in Web 3.0 activities. As far as these submissions go, they appear to the Panel to be reasonably plausible. Crucially, the Panel does not have before it any information or evidence from the Complainant's side about the extent and reach of its marks whereby the contrary argument should prevail, namely that the Respondent is more likely than not to have had knowledge of the Complainant's mark and an intent to obtain some form of commercial benefit by referencing it. For example, despite providing a list of its Singaporean trademarks, many of which are of a longstanding nature, the Complainant does not specify what trading activities it undertakes in Singapore and whether or not these are consumer-facing.

Even if the Respondent was aware of the Complainant's mark – which the Panel is willing to assume for arguments' sake, there is no suggestion before the Panel that such mark has a presence in the financial services world, whereby the use of a term similar to TRADER JOE'S in the manner adopted by the

Respondent might cause confusion with the Complainant's goods or services. Furthermore, there is no support on the present record for the proposition that the Complainant's mark is sufficiently famous that it transcends the use classes in respect of which it is registered. The sample marks which the Panel reviewed from the Complainant's list all appeared to reference various different grocery supplies, and there was no mention on such list of a mark registered in Class 36, namely financial products and services.

There remains a possibility that the Complainant's activities under the TRADER JOE'S mark may be sufficiently substantial, especially in the Respondent's location, that the Respondent could not credibly claim to have been unaware of the Complainant's mark or to have had no intention to benefit commercially thereby. A grocery chain can be sufficiently well known that there would be an advantage to operating a crypto-asset platform under that name for the simple reason that it would lead a large body of consumers to believe that the chain concerned had moved into the provision of Web 3.0 services. For example, there are several cases of which the Panel is aware of such businesses developing into traditional financial services, often by licensing their name and brand identity to a pre-existing registered financial institution, which then provides back-end banking services to consumers who are often pre-existing customers of the grocery chain. In the present case, such a scenario would however be no more than mere speculation on the Panel's part. It is not supported by any submissions or evidence from the Complainant, on whom the burden of proof rests. The Complainant evidently has interests of some kind in Singapore, given that it has apparently registered ten Singaporean trademarks. However, the Panel is not told what these interests are, the listed use classes suggest that the trademarks are restricted to grocery items, and there is no suggestion from this evidence alone that the Complainant's mark is either famous or that the Complainant is engaged in the provision of financial services of any kind (including by way of partnership) which the Respondent may be seeking to exploit through false association.

There is some limited evidence from the Respondent which indicates that the term "trader joe" does not exclusively reference the Complainant or its trademark, insofar as there are several other registered trademarks in different jurisdictions from Indonesia to Mexico in respect of the marks TRADER JOE or TRADER JOE'S which do not belong to the Complainant. This includes a mark registered in the state of Louisiana, United States on December 28, 2010 with a first use claim of January 1, 1956 in respect of automobile dealerships. While such a mark is not federally registered, it nevertheless illustrates the fact that some third parties may have come by the name "Trader Joe" without necessarily being aware of or seeking to reference the Complainant's mark. This lends some credibility to the Respondent's assertion that it came by the term independently in the circumstances of the present case, albeit that there remains a possibility that the Respondent may have had in mind any one of the entities using such mark as a target.

No direct evidence has been supplied by the Respondent of its assertion that the term "xyz" (other than when used as a TLD) is strongly associated with and has become the "go-to URL for many Web 3.0 companies". The evidence available from the Respondent's Annex 17, being an article from "www.techcrunch.com" dated December 28, 2021, uses the "go-to URL" phrase when describing the ".xyz" TLD only. The article reports that this particular TLD is strongly associated with the crypto community, due to an early collaboration between the registry concerned and the Ethereum Name Service, which allowed early adopters to use a ".xyz" domain name as their wallet address. The disputed domain name does not use this TLD.

Despite the lack of direct evidence, the Panel is prepared to accept that the relative popularity of the ".xyz" TLD within the relevant community may have ultimately conferred a connotation of Web 3.0 activities upon the letters "xyz" standing alone or appearing in a domain name having another TLD, such as the disputed domain name. Accordingly, in this particular case, the fact that the letters "xyz" accompany the term "trader joe" in the disputed domain name seems to the Panel on balance to have been designed to signal the Respondent's intended use of the disputed domain name for its decentralized trading platform rather than to be a meaningless or irrelevant group of letters tacked on to a deliberately chosen typographical variant of the Complainant's trademark. The Panel notes that the Respondent has used the letters "xyz" along with the phrase "trader joe" consistently within its social media platforms, namely Twitter, YouTube, and Reddit, suggesting that this is purposively intended to be part of the Respondent's business identity. Furthermore, the fact that the Respondent uses "Joe" in the sense of its "Trader Joe" and "Banker Joe" offerings, coupled



with its "\$JOE" token, suggests that, for the Respondent at least, the "Joe" component of the disputed domain name is where it intended an emphasis to lie (rather than for there to be any intended confusion generated with the Complainant's TRADER JOE'S mark).

Finally, the Complainant's assertion that, in order to enhance confusion, the Respondent repeatedly refers to the Complainant's TRADER JOE'S trademark throughout the website associated with the disputed domain name is misconceived. When the Complainant's citations are placed in their proper context (for example, "A general overview of Trader Joe's features [...]" or "Banker Joe is Trader Joe's lending protocol") it may be seen that each such reference is using the possessive form of the business name "Trader Joe". When the Respondent is not using the possessive form, it appears to use the term "trader joe" or "trader joe xyz" alone.

In all of these circumstances, the Panel finds that there is insufficient evidence before it to suggest that the Respondent was necessarily targeting the Complainant's mark in order to obtain commercial benefit for its business venture. In light of this finding, it is unnecessary for the Panel to form a view regarding the Respondent's supplementary case in terms of paragraph 4(c)(ii) of the Policy. In all of these circumstances, the Panel finds that, on the present record, the Complainant has failed to carry its burden in terms of paragraph 4(a)(ii) of the Policy, and the Complaint fails.

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

As the Complainant requires to carry its burden in terms of all three elements of the Policy in order to succeed, it is not strictly necessary for the Panel to consider the question of registration and use in bad faith in this particular case. However, the Panel will briefly cover the issue for completeness.

The third element of the Policy requires the Complainant to establish the conjunctive requirement that the disputed domain name has been both registered and used in bad faith. "Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant." (See *Compagnie Générale des Etablissements Michelin v. Contact Privacy Inc. / Alex Wareing, AIWmedia*, WIPO Case No. [D2022-1111](#)).

Here, there is insufficient evidence before the Panel that the Respondent registered the disputed domain name because of its trademark significance. On the basis of the present record, the Respondent has denied prior knowledge of, or intent to target, the Complainant's trademark. The Respondent has given a plausible account of its selection of its business name and its reproduction in the disputed domain name, independently of any knowledge of the Complainant. The Respondent has built a business which is reportedly substantial in nature and which operates in a different line to that of the Complainant.

In general, the question of registration and use in bad faith here is closely aligned to the Panel's analysis of the Respondent's rights and legitimate interests in the preceding section. As the Complainant has been unable to persuade the Panel that the Respondent is not making a *bona fide* offering of goods or services before notice to it of the dispute, this suggests (on the balance of probabilities) that the disputed domain name, which was registered for that purpose, may not necessarily have been registered and used in bad faith.

The Complainant is correct that the Respondent registered and used the disputed domain name decades after the Complainant registered its TRADER JOE'S trademark, including in Singapore, where its earliest trademark appears to have been filed on May 16, 1997. However, the Complainant adds to that submission "[...] and long after the Complainant's trademark had become famous". As noted earlier, the Complainant does not provide supporting evidence of the fame of its mark, particularly in Singapore, nor does it elucidate as to how the Respondent might reasonably have become aware of this other than via the existence of its online presence or its Singaporean registered trademarks, which do not appear to cover financial services. On the other hand, a plausible explanation has been tendered by the Respondent for its selection of the disputed domain name as discussed fully in the preceding section, and the Respondent's use of the terms "trader joe" and "trader joe xyz" appear to be consistent both on the website associated with the disputed

domain name and on its several social media accounts such that they are not deliberately seeking to reference or benefit from an association with the Complainant's TRADER JOE'S mark.

In short, based on the present record, this case does not strike the Panel as one of prototypical cybersquatting. Should the Complainant believe that its trademarks are being violated by the actions of the Respondent then it may have remedies available in other fora. However, in the administrative proceeding before the Panel, the burden of proof in respect of registration and use in bad faith rests upon the Complainant and it has failed to carry that burden. The Complaint accordingly fails.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/Andrew D. S. Lothian/*

**Andrew D. S. Lothian**

Sole Panelist

Date: July 6, 2022

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<sup>1</sup> With regard to the Panel conducting limited factual research into matters of public record, such as consulting relevant publicly available websites including the official websites of trademark registries, see section 4.8 of the [WIPO Overview 3.0](#).

<sup>2</sup> The Respondent defines this term as representing the total number of crypto assets that are locked up (or staked) in a decentralized protocol, which is used to reflect the total activity, interest, and value of such protocol for potential investors. The Respondent produces a page from "www.cryptowallet.com" vouching the terms of this definition.

<sup>3</sup> The Panel notes that the Complainant indicated only that its newsletter was named "The Fearless Flyer" and did not mention whether the TRADER JOE'S mark was specifically promoted thereby. That may be a reasonable assumption to make, but the Panel is not in a position to make such assumptions in the absence of evidence which should have been readily available.