

## **ADMINISTRATIVE PANEL DECISION**

Trader Joe's Company v. Contact Privacy Inc. Customer 7151571251  
(Unknown) / Michelle Cheung  
Case No. D2022-3235

### **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 Contact Privacy Inc. Customer 7151571251 (Unknown) / Michelle Cheung, United States.

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

The disputed domain name <auntiejoes.com> (the "Domain Name") is registered with Google LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 31, 2022. On August 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 2, 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 7, 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 October 4, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on October 6, 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 a corporation established under California law and headquartered in Monrovia, California, United States. The Complainant has been doing retail grocery business as “Trader Joe’s” and using TRADER JOE’S and TRADER-JOE’s formative marks since 1967. It advertises and sells its products online at “www.traderjoes.com” (the “Complainant’s website”), with linked social media sites. The Complainant owns and operates more than 530 TRADER JOE’S grocery stores, distributes a newsletter by email to more than 700,000 customers monthly, and reaches consumers as well through regular podcasts and social media posts, as well as through the Complainant’s website at “www.traderjoes.com”, which attracts over 3.4 million monthly visitors.

The Complainant holds numerous United States and Canadian trademark registrations, including the following:

MARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE
TRADER JOE’S (word mark)	United States	1420628	December 9, 1986
TRADER JOE’S (word mark)	United States	1421310	December 16, 1986
TRADER JOE’S (word mark)	United States	1422216	December 23, 1986
TRADER JOE’S (word mark)	United States	1424176	January 6, 1987
TRADER JOE’S (stylized letters)	United States	2171157	July 7, 1998
JOE’S KIDS (word mark)	United States	2923911	February 1, 2005
TRADER JOE’S (stylized letters)	Canada	TMA958214	October 13, 2010
TRADER JOE’S (stylized letters)	United States	4001533	July 26, 2011

The Complainant has pending United States trademark applications for other formative word marks including JOE-JOE’S (Serial Number 97/085785) and JOE’S DINER (Serial Number 97/085,788).

In addition to its registered marks, the Complainant claims common law rights to the mark TRADER JOE’S.

The Registrar’s Whois database shows that the Domain Name was created on January 25, 2021, and that it is registered in the name of a domain privacy service. After receiving the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Michelle Cheung, who listed no organization and gave contact details including a Gmail email address and a postal address in the State of California, United States.

The Domain Name resolves to the website (the “Respondent’s website”) headed with an “Auntie Joe’s” logo in a color and font very similar to the Complainant’s trademarked TRADER JOE’S logo used on the Complainant’s website, as seen below:

**TRADER JOE’S**

**AUNTIE JOE’S**

The Respondent’s website advertises “Over 100+ Trader Joe’s Products Shipping Nationwide”, with photographs and descriptive text of the Complainant’s products copied from the Complainant’s website. The website appears to be a full-service retail website handling online sales, “Powered by Shopify”. Site visitors are encouraged to subscribe for information about daily deals, recipe ideas, and alerts about favorite products. Customer testimonials speak of the advantages of ordering the Complainant’s products with free shipping from the Respondent’s website, as opposed to traveling to one of the Complainant’s retail stores,

where the desired products may not be in stock.

The Complainant sent cease-and-desist letters to the Respondent in June and July 2022, with no reply.

## 5. Parties' Contentions

### A. Complainant

The Complainant asserts that the Domain Name is confusingly similar to its TRADER JOE'S marks because it is similar in sight, sound, and meaning and incorporates the dominant element "JOE'S" following a noun signifying a person. The content of the Respondent's website, mimicking the Complainant's logo and reselling the Complainant's products, indicates that the similarity is intentional.

The Complainant states that the Respondent has no permission to use the Complainant's marks and argues that the Respondent does not meet the standards for legitimate fair use as articulated in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (*Oki Data*). Specifically, the Respondent does not accurately disclose its relationship (or lack thereof) with the Complainant. The Respondent's website lacks a disclaimer and suggests association with the Complainant by displaying a logo that imitates the color and font of the Complainant's trademarked logo and publishing descriptive text copied from the Complainant's website, such as the following:

"We currently offer some fantastic honeys, but we haven't offered a creamed honey in quite some time. So, when our Buyer stumbled upon an opportunity to do so, she pounced—or stung, as it were... so when we say you won't find honey like this anywhere else, we mean it!"

The Complainant contends that the Respondent's conduct reflects bad faith in the registration and use of the Domain Name, misdirecting Internet users to its own website for commercial gain. The Complainant cites the Respondent's wholesale copying of content from the Complainant's website and its failure to reply to cease-and-desist letters as further indications of bad faith.

### B. Respondent

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the 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 domain name; and (iii) the domain name has been registered and is being used in bad faith. Under paragraph 15(a) of the Rules, "[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".

### A. Identical or Confusingly Similar

The first element of a UDRP complaint "functions primarily as a standing requirement" and entails "a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. The Domain Name is similar in sight, sound, and overall impression to the Complainant's registered TRADER JOE'S trademarks. (It is not necessary to rely on the Complainant's claimed common law marks, see [WIPO Overview 3.0](#), section 1.3).

Given the imitative content of the associated website, it appears that the Respondent itself considered the Domain Name to be similar to the Complainant's TRADER JOE'S mark. See *id.*, section 1.7, "panels have also found that the overall facts and circumstances of a case (including relevant website content) may support a finding of confusing similarity, particularly where it appears that the respondent registered the domain name precisely because it believed that the domain name was confusingly similar to a mark held by the complainant".

As usual, the generic Top-Level Domain ".com" is disregarded as a standard registration requirement. See *id.* section 1.11.1.

The Panel concludes that the Complainant has established the first element of the Complaint.

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

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent's 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) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is 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.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, and the Respondent's use of the Domain Name for an imitative website reselling the Complainant's products online. The Respondent has not come forward to assert rights or legitimate interests, but a review of the Respondent's website indicates that it fails the *Ok! Data* test for nominative fair use of trademarks by resellers or third parties because the Respondent's website does not "accurately and prominently disclose the registrant's relationship with the trademark holder". See [WIPO Overview 3.0](#), section 2.8.1. There is no disclaimer, the logo mimics the Complainant's logo, and the copied photos and text appear to come from the Complainant. The site gives the (wrongful) impression of affiliation with the Complainant and a site visitor must navigate to the "About Us" page to find a reference to the website operator as a purported "reseller", and this still does not explain whether there is any relationship with the Complainant. This may be important, for example, in assuring product and service standards associated with the Complainant's brand.

The Panel concludes that the Complainant prevails on the second element of the Complaint.

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

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that "shall be evidence of the registration and use of a domain name in bad faith", including the following (in which "you" refers to the registrant of the domain name):

"(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or

service on your web site or location.”

This example applies on the current facts. The Respondent was clearly aware of the Complainant and its long-established mark, as the Respondent created a website with an imitative logo and content copied from the Complainant’s website. The Respondent has used the Domain Name to confuse consumers as to source or affiliation and attract them to the Respondent’s website for commercial gain. To be clear, the Respondent might have proceeded as a reseller exclusively of the Complainant’s products in a manner that comported with nominative fair use of the Complainant’s trademark. But as discussed in the preceding section, the Respondent has not done that, obscuring its relationship with the Complainant, mimicking its logo, and copying the Complainant’s website content without permission. These actions are deceptive and compound the likelihood of confusion. Even if the Respondent’s is engaged in the purchase and resale of the Complainant’s products, the false impression of association or endorsement is not fair to the Complainant or consumers and may ultimately injure the Complainant’s reputation. This amounts to bad faith within the meaning of the Policy.

The Panel concludes that the Complainant has established the third element of the Complaint.

## **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 Domain Name, <auntiejoes.com>, be transferred to the Complainant.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: October 20, 2022