

ADMINISTRATIVE PANEL DECISION

Anything Worldwide AB v. Emir Joldic

Case No. DAU2022-0042

1. The Parties

The Complainant is Anything Worldwide AB, Sweden, represented by Cooper Mills Lawyers, Australia.

The Respondent is Emir Joldic, Australia, self-represented.

2. The Domain Name and Registrar

The disputed domain name <magicvaporizers.com.au> is registered with Web Address Registration Pty Ltd (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 19, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 22, 2022, 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 satisfied the formal requirements of the .au Dispute Resolution Policy (the "Policy" or ".auDRP"), the Rules for .au Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 28, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was January 17, 2023. The Center received an email communication from the Respondent on December 30, 2022. The Center notified the commencement of Panel appointment process on January 18, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on January 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 an online supplier of dry herb vaporizers and related products. The Complainant was established in Sweden in 2013 and currently supplies products to 22 countries in Europe. The Complainant uses the domain names <magicvaporizers.com> and <magicvaporizers.co.uk> in connection with online stores that prominently display the MAGICVAPORIZERS mark with a logo and offer the Complainant's vaporizers and related products for sale. According to website traffic data presented by the Complainant, during the three-year period prior to the registration of the disputed domain name the websites associated with these domain names received a combined total of over 272,000 visits, of which 1,878 visits were from Internet users based in Australia; and during the one-year period prior to the filing of the Complaint they received a combined total of 416,000 visits, of which 2,964 visits were from Internet users based in Australia. The Complainant holds European Union trade mark registration number 18588693 for MAGICVAPORIZERS, registered on March 31, 2022 (filing date: October 27, 2021), specifying flavorings and solutions for oral vaporizers for smokers, personal vaporizers, and electronic cigarettes in class 34. That trademark registration is currently in effect. The Complainant filed Australian trademark application number 2304347 for MAGICVAPORIZERS on September 29, 2022, specifying online retail services and other services in class 35. That trademark application is currently pending.

The Respondent is an individual resident in Brisbane, Australia. According to his website, he has over 10 years' experience selling high-quality vaporizers. He registered the Australian business name "Magic Vaporizers Australia" on September 3, 2021.

The disputed domain name was created on July 15, 2021. According to an archived screenshot presented by the Complainant, the disputed domain name has resolved to an online store selling dry herb vaporizers and related products since at least December 15, 2021. At that time, the website was titled "Magic Vaporizers Australia" while the About Us tab was titled "Magic Vaporizers", to which it referred as the "Magic Vapo Shop", an online store based in the suburb of Brisbane where the Respondent resides. Lengthy portions of text were reproduced from the Complainant's website, including embedded hyperlinks to pages on the Complainant's website, with some changes (e.g. "Europe's Best Vape Shop – MagicVaporizers" was changed to "Australia's Best Vape Shop – MagicVaporizers"; and the list of favorite products was partly changed). At the present time, the website is titled "Magic Vaporizers" and prominently displays a "Magic Vaporizers" logo different from the Complainant's logo. The site is held out as an authorized seller of six brands, most of which are sold by the Complainant. According to evidence presented by the Complainant, the current contact email address on the website does not exist. There is no contact telephone number.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical to the Complainant's registered European Union trade mark MAGICVAPORIZERS. In light of the Complainant's long-standing use of its MAGICVAPORIZERS mark, the large volume of order received and fulfilled by the Complainant, and the substantial amount of traffic to the Complainant's website, it is clear that at the registration date of the disputed domain name and continuing to the date of filing of the Complaint, the Complainant and its mark were well-known and enjoyed a substantial reputation globally, including in Australia.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has no association, affiliation or other relationship with the Respondent. The Complainant has not consented or granted any license to the Respondent to use the Complainant's trademark or register the disputed domain name. The Respondent is not commonly known by the disputed domain name. The Respondent's Australian business name in and of itself does not establish any rights or legitimate interests in respect of the disputed domain name. The evidence that the contact email address shown on the Respondent's website does not exist calls into question the legitimacy of the online store and suggests that it may be a sham. The Respondent has registered the disputed domain name with full knowledge of the

Complainant and its trademark for the express purposes of, among other things, confusing and misleading consumers, appropriating the Complainant's reputation and preventing the Complainant from registering the disputed domain name in connection with its legitimate business. Accordingly, the Respondent's use of the disputed domain name in connection with his website cannot be considered *bona fide*.

The disputed domain name has been registered and is being used in bad faith. It is undeniable that the Respondent was aware of the Complainant, its business and trademark when it registered the disputed domain name. The copying of the Complainant's website content by the Respondent is incontrovertible proof of this. The fact that the Respondent has used the disputed domain name in connection with an online store offering the same type of products as those offered by the Complainant via its online stores, plainly demonstrates that the Respondent has targeted the Complainant. Even if it is determined that the Complainant's reputation did not extend to Australia (which is not admitted), this does not preclude a finding of bad faith on the part of the Respondent.

Further, the Respondent's registration and use of the disputed domain name in circumstances where he had knowledge of the Complainant and its trademark, and his use of the disputed domain name to publish copyright-infringing material copied from the Complainant's website, plainly breaches the warranty given by the Respondent in paragraph 2 of the Policy.

B. Respondent

The Respondent informed the Center that he would not be available for any correspondence until he returned from his Australian tour. His return to Brisbane is scheduled for the middle of August 2023. When he returns home, he will properly respond regarding this incorrect accusation. Despite being off the road and in the outback without Internet access, he is not ignoring the matter. He is on a long-planned trip and cannot make any changes.

6. Discussion and Findings

6.1 Preliminary Issues

A. Due Date for Response

The Respondent informed the Center that he was unavailable for any correspondence as he is on a tour, which he expected to last at least six months. He did not request an extension of the due date to submit a Response and did not submit any formal Response.

The Panel recalls that paragraph 10(c) of the Rules obliges the Panel to ensure that the administrative proceeding takes place with due expedition. Although that same paragraph of the Rules permits the Panel to extend, in exceptional cases, a period of time fixed by the Rules or by the Panel, the Panel sees no exceptional circumstances in this case, and no justification under the auDRP or the Rules for a delay as lengthy or open-ended as the Respondent envisages. However, the Panel will take into account the Respondent's informal communication *de bene esse* pursuant to paragraph 10(a) of the Rules.

B. Language of the Proceeding

The Complaint was filed in English. The Respondent submits that he is a person from a non-English speaking background and that he will require assistance with translation and to seek legal advice if necessary. The Registrar confirmed that the Registration Agreement is in English.

Paragraph 11(a) of the Rules provides that "[u]nless otherwise agreed by the Parties, or specified otherwise in the Registrant Agreement, the language of the administrative proceeding shall be the language of the Registrant Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". Paragraph 11(b) of the Rules provides that "[t]he Panel

may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding”.

The Panel notes that the Respondent entered into the Registration Agreement in English, that his website is in English, and that his informal communication was in English, all of which gives rise to the reasonable inference that he is able to communicate in that language. Translation of the Complaint would create unnecessary expense and delay the proceeding. Therefore, the Panel determines that the language of this proceeding is English and does not order that any document be accompanied by a translation.

C. Other Legal Proceedings

The Respondent requests the full name and contact details of the Complainant to take legal action against it.

The Panel recalls that, according to paragraph 4(k) of the auDRP, this mandatory administrative proceeding shall not prevent either Party from submitting the dispute to a court of competent jurisdiction for independent resolution before this proceeding is commenced or after it is concluded. The Complainant's name and contact details are set out in paragraph 3 of the Complaint. The Panel has received no notice of the commencement of other legal proceedings in connection with or relating to the disputed domain name.

6.2 Substantive Issues

Paragraph 4(a) of the auDRP provides that a complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;
- (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 or subsequently used in bad faith.

The burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

The Complainant provides evidence of its European Union trade mark registration for MAGICVAPORIZERS. Despite the fact that it occurred outside Australia, the Panel considers that registration sufficient to demonstrate rights in a trademark for the purposes of the first element of paragraph 4(a) of the auDRP. See *Mass Nutrition, Inc. and Todd Rosenfeld v. Mass Nutrition Pty. Ltd. now known as Tweed Holdings Pty Ltd, Luke McNally*, WIPO Case No. [DAU2010-0002](#). The Panel notes that the first element of paragraph 4(a) of the auDRP is phrased in the present tense and considers it sufficient for the purpose of this element that a complainant's trademark registration was in effect as of the date of filing the Complaint, as it was in the present case. See further *Corporate Mobile Recycling Limited v. Mazuma Mobile Pty Ltd*, WIPO Case No. [DAU2011-0034](#). Therefore, the Panel finds that the Complainant has rights in the MAGICVAPORIZERS mark.

The disputed domain name wholly incorporates the Complainant's MAGICVAPORIZERS mark. Its only additional element is a Second-Level Domain (“2LD”) extension. This element may be disregarded in an assessment of confusing similarity between the disputed domain name and the trademark for the purposes of the auDRP. See *BT Financial Group Pty Limited v. Basketball Times Pty Ltd*, WIPO Case No. [DAU2004-0001](#).

Therefore, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the auDRP.

B. Rights or Legitimate Interests

Paragraph 4(c) of the auDRP sets out circumstances which, without limitation, if found by the Panel to be proven based on its evaluation of all evidence presented, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the auDRP:

- (i) before any notice to [the respondent] of the subject matter of the dispute, [the respondent's] *bona fide* use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with an offering of goods or services (not being the offering of domain names that [the respondent has] acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no 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.

As regards the third circumstance set out above, the disputed domain name resolves to an online store. That is a commercial use, not a legitimate noncommercial or fair use.

As regards the second circumstance set out above, the Respondent is named "Emir Joldic". The Respondent has registered the Australian business name "Magic Vaporizers Australia", which is not an exact match with the disputed domain name. In any case, the administrative act of registering a business name does not create in itself rights or legitimate interests in a domain name for the purposes of the Policy and there are few instances on the record where the Respondent has used his business name as registered. One instance was in the former title of his website but the website, at the same time, identified his business as the "Magic Vapo Shop". Another instance is at the bottom of his website's current homepage but that appears under the "Magic Vaporizers" logo. Although the Respondent uses "Magic Vaporizers" as a business name on his website, there is no evidence on the record that he has been known by that name anywhere else. Accordingly, the Panel is unable to find that the Respondent has been commonly known by the disputed domain name.

As regards the first circumstance set out above, the disputed domain name, which is identical to the Complainant's MAGICVAPORIZERS mark, resolves to an online store prominently displaying "Magic Vaporizers" as a business name. There is no other evidence that that name actually is the Respondent's business name. However, that name is aurally identical and visually almost identical to the Complainant's MAGICVAPORIZERS mark (to which it adds only a space), even though the Parties' respective logos contain different figurative elements. The Respondent's website has also claimed that "MagicVaporizers" (as one word, identical to the Complainant's mark) is his online shop based in Brisbane. The Parties sell goods of an identical type, including identical brands. The evidence presented shows that the Complainant's websites have generated considerable traffic, including visits from Internet users based in Australia, for years before the Respondent registered the disputed domain name. In these circumstances, the Panel considers that the Respondent's use of the disputed domain name is likely to lead to confusion as to whether an affiliation exists between the Respondent's website and the Complainant. The Complainant submits that it has no association, affiliation or other relationship with the Respondent and that it has not consented or granted any license to the Respondent to use its trademark or register the disputed domain name. The Panel takes note that the Respondent registered the disputed domain name in July 2021, three months before the Complainant filed its first trademark application in October 2021, and eight months before that trademark was registered in March 2022. Nonetheless, the Panel infers that the Respondent has been well aware of the Complainant all along because the archived screenshot in evidence shows that in December 2021 the Respondent's website reproduced lengthy portions of text from the Complainant's website, including embedded hyperlinks to pages on the Complainant's website. In all these circumstances, the Panel infers that the Respondent has used the disputed domain name with the intention of exploiting the value of the Complainant's reputation and its mark. In view of these circumstances, the Panel considers that

the Complainant has demonstrated that the Respondent's use of the disputed domain name in connection with an offering of goods is not *bona fide*.

The Panel notes that the disputed domain name contains two dictionary words, *i.e.*, "magic" and "vaporizers". However, the Respondent's website only uses "vaporizers" in a descriptive sense when it is not qualified by "magic". The combination "magic vaporizers" is not a common or dictionary phrase.

Even if the Respondent's online store is a sham, which the Complainant merely suggests, that would not generate rights or legitimate interests in respect of the disputed domain name.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent claims that the Complaint contains an incorrect accusation but he does not allege any specific rights or legitimate interests that he has in respect of the disputed domain name. The Respondent's website claims that Magic Vaporizers Australia has been selling herb vaporizers for 10 years but there is no evidence that he has used that or any similar name prior to 2021, and no evidence besides the website associated with the disputed domain name since that time. Accordingly, the Panel finds that the Respondent has not rebutted the Complainant's *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the auDRP.

C. Registered or Subsequently Used in Bad Faith

Paragraph 4(a)(iii) of the auDRP uses the conjunction "or", which indicates that the Complainant may satisfy this element by showing either that the disputed domain name has been registered in bad faith, or that it has been subsequently used in bad faith, without necessarily demonstrating both.

Paragraph 4(b) of the auDRP provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, although it is not an exhaustive list of such circumstances. The fourth circumstance is as follows:

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location.

As regards use, the disputed domain name is identical to the Complainant's MAGICVAPORIZERS mark, which is registered. The disputed domain name resolves to an online store that prominently and repeatedly displays a business name that is aurally identical and visually almost identical to the Complainant's mark and that is not the Respondent's business name. The online store offers for sale goods of a type identical to those sold by the Complainant, including identical brands. Even though the Complainant's mark is not registered in Australia, the Respondent is clearly aware of the Complainant because his website displays lengthy portions of text cut and pasted from the Complainant's website, including embedded hyperlinks to pages on the Complainant's website. Given these circumstances and the Panel's findings in section 6.2B above, the Panel finds that the Respondent, by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's mark as to the affiliation of that website and the products on that website within the terms of paragraph 4(b)(iv) of the auDRP.

Therefore, the Panel finds that the disputed domain name has been used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) of the auDRP.

7. Decision

For all 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 <magicvaporizers.com.au> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: February 6, 2023