

ADMINISTRATIVE PANEL DECISION

BJ's Wholesale Club, Inc v. Christophe Messer, BJ's Wholesale Club
Case No. D2024-4841

1. The Parties

The Complainant is BJ's Wholesale Club, Inc, United States of America ("United States"), represented by Nelson Mullins Riley & Scarborough, LLP, United States.

The Respondent is Christophe Messer, BJ's Wholesale Club, United States.

2. The Domain Name and Registrar

The disputed domain name <bjswholesaleclub.store> is registered with Tucows Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 22, 2024. On November 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 25, 2024, 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 (Contact Privacy Inc. Customer 0172242139) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 26, 2024, 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 November 26, 2024.

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 November 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 18, 2024.

The Center appointed William F. Hamilton as the sole panelist in this matter on December 24, 2024. 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 operates membership warehouse clubs located primarily in the eastern United States. The Complainant sells various products and services focused on groceries, general merchandise, and gasoline. The Complainant operates 243 warehouse locations and 174 gas stations. In addition to the Complainant's brick-and-mortar warehouse locations, the Complainant's members can also shop online through the Complainant's website at the domain <bjs.com>.

The Complainant owns United States Registration No. 1,643,993, registered on May 7, 1991, for the trademark BJ'S WHOLESALE CLUB (the "Mark").

The disputed domain name was registered on August 27, 2024. The disputed domain name previously resolved to an e-commerce site offering various products for sale, including the Complainant's branded products. The site featured prominently the Mark. The disputed domain name currently resolves to a website stating, "This store is unavailable."

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Mark because the disputed domain name is comprised solely of the Mark. The Complainant contends that the Complainant has never authorized the Respondent to use the Mark, that the Respondent is not commonly known by the disputed domain name, and has never engaged in any bona fide commercial activity in connection with the disputed domain name. The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name and has registered and used the disputed domain name in bad faith to unfairly compete with the Complainant and attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Mark.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a 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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well-accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves 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 Complainant has shown rights in the Mark for the purposes of the Policy by virtue of the United States registration of the Mark. The disputed domain name is confusingly similar to the Mark because the disputed domain name replicates the Mark only omitting the spaces between the words of the Mark and the apostrophe in the Mark. These minor alterations of the Mark do not prevent a finding of confusing similarity under the first element.

The generic Top-Level Domain ("gTLD") of the disputed domain name, i.e. "store", may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative," requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has never authorized or licensed the Respondent to use its Mark. The Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted this showing and has not provided evidence of any of the circumstances set forth in paragraph 4(c) of the Policy.

The Respondent's website initially displayed the Mark and a copyright notice "BJ'S Wholesale Club", offered for sale competing products together with the Complainant's branded products, and offered visitors to subscribe for emails by soliciting their email addresses. The Respondent's use of the disputed domain name to impersonate the Complainant and offer competing products for sale, including the Complainant's branded products, does not establish any rights or legitimate interests of the Respondent in the disputed domain name. In this regard, the Panel notes that the registrant organization identified in the registration details of the disputed domain name is "BJ's Wholesale Club", however, there is no evidence before the Panel that the Respondent is actually commonly known by the disputed domain name, "BJ's Wholesale Club" or "BJ's Wholesale Club". Rather, it appears most likely that such details were specifically chosen to falsely suggest an affiliation with the Complainant, impersonating use of the disputed domain name reinforces this finding. Panels have repeatedly held that the use of a domain name for illegitimate activity, such as here impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent; this is true even though the terms "wholesale club" are disclaimed in the relevant mark. See [WIPO Overview 3.0](#), section 2.13.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following non-exhaustive scenarios:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Respondent registered the disputed domain name decades after the Complainant's registration of the Mark. Given the reputation of the Mark and the Respondent's use of the nearly identical disputed domain name to offer for sale competing products and services, the Panel finds it implausible that the Respondent was unaware of the Complainant's Mark when registering and using the disputed domain name. Panels have consistently found bad faith registration and use of a domain name where the domain name is used to host a website that impersonates the Complainant. See [WIPO Overview 3.0](#), section 3.1.4. That the disputed domain no longer resolves to an active website is immaterial to the foregoing analysis and reinforces the conclusion that the Respondent has registered and used the disputed domain name in bad faith. See [WIPO Overview 3.0](#), section 3.3.

The Respondent has attempted to create confusion and impersonate the Complainant for commercial gain by using the Complainant's Mark, offering competing products and services, and creating a website that falsely appeared to be associated with the Complainant, notably, displaying a copyright notice "BJ'S Wholesale Club" which corresponds to the Complainant's company name. By using the disputed domain name to offer competing products and services, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's Mark as to source, sponsorship, affiliation, or endorsement of its website. This constitutes evidence of registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

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 <bjswholesaleclub.store> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: January 7, 2025