

ADMINISTRATIVE PANEL DECISION

Trader Joe's Company v. Roberto Leslie
Case No. D2022-3967

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 Roberto Leslie, United States.

2. The Domain Name and Registrar

The disputed domain name <traderjoescbd.com> (the "Disputed Domain Name") is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 22, 2022. On October 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 25, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, 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 October 29, 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 October 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 21, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on November 24, 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 national chain of grocery stores that has offered grocery services and goods since 1967. The Complainant owns and operates over 530 grocery stores under the TRADER JOE'S trademark. The Complainant also owns and operates a website at "www.traderjoes.com", which receives over 3.4 million visitors per month.

The Complainant owns dozens of trademarks in the United States in numerous international classes, including, but not limited to: TRADER JOE'S, United States Registration No. 1,424,176, registered on January 6, 1987, in international class 30; TRADER JOE'S, United States Registration No. 1,422,216, registered on December 23, 1986, in international class 32; TRADER JOE'S, United States Registration No. 1,421,310, registered on December 16, 1986, in international class 29; and TRADER JOE'S, United States Registration No. 1,420,628, registered on December 9, 1986, in international class 42. The Complainant also has established common law rights to the TRADER JOE'S trademark through extensive and continuous commercial use and owns and has registered numerous trademarks in jurisdictions worldwide.

The foregoing trademarks will hereinafter collectively be referred to as the "TRADER JOE'S Mark".

The Disputed Domain Name was registered on October 8, 2018, and resolves to a website entitled "The Sun Palace Hotel", that offers Cannabidiol ("CBD") oil as a way to rest and relax. The Disputed Domain Name resolving website purports to be a "CBD company" according to its "About Us" page. However, no CBD product is available for purchase on the website nor is any information provided on the website with instructions on how to purchase the CBD oil. The "www.traderjoescbd.com" website features a single disclaimer on the "About Us" webpage stating in tiny font that it is "not affiliated, associated, authorized, endorsed by, or in any way officially connected with [the Complainant]".

The Complainant's counsel sent letters to the Respondent on July 28, 2022, and September 2, 2022, demanding that the Respondent cease and desist its infringing use of the Complainant's TRADER JOE'S Mark. The Respondent did not reply.

5. Parties' Contentions

A. Complainant

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's TRADER JOE'S Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- the Disputed Domain Name was registered and is being used in bad faith.

The Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (i) the Disputed 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 Disputed Domain Name; and
- (iii) the Disputed Domain Name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry, a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the TRADER JOE'S Mark.

It is uncontroverted that the Complainant has established rights in the TRADER JOE'S Mark based on its fame as well as its registered trademarks for the TRADER JOE'S Mark in the United States and other jurisdictions worldwide. The registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. As stated in section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case". Thus, the Panel finds that the Complainant satisfied the threshold requirement of having rights in the TRADER JOE'S Mark.

The Disputed Domain Name consists of the TRADER JOE'S Mark in its entirety, followed by the term "CBD", and then followed by the generic Top-Level Domain ("gTLD") ".com". The Disputed Domain Name is confusingly similar to the TRADER JOE'S Mark since the trademark is incorporated in its entirety in the Disputed Domain Name. It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms {...} would not prevent a finding of confusing similarity under the first element". For example, numerous UDRP decisions have reiterated that the addition of a term to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as ".com" in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#), and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant's TRADER JOE'S Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed

domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Name. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the Complainant's TRADER JOE'S Mark. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name nor has the Respondent made any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

Moreover, the Complainant does not have any business relationship with the Respondent and based on the use made of the Disputed Domain Name to resolve to a website to advertise a CBD product using the TRADER JOE'S Mark, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name. Moreover, the Respondent's use of the Disputed Domain name does not indicate fair use because the use of the Complainant's TRADER JOE'S Mark followed by the term "CBD" falsely suggests sponsorship by or an affiliation with the Complainant. In addition, the Panel finds that the use of a disclaimer on the Respondent's website may be considered as an admission by the Respondent that users may be confused.. See *Instagram, LLC v. Sergey Petrov*, WIPO Case No. [D2021-0482](#).

In sum, the Panel finds the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, the Respondent's registration and use of the Disputed Domain Name indicate that such registration and use has been done for the specific purpose of trading on the name and reputation of the Complainant and its TRADER JOE'S Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark").

Second, the Disputed Domain Name was registered in 2018, decades after the Complainant first began using its TRADER JOE'S Mark, and several decades after the Complainant first registered the TRADER JOE'S Mark. Therefore, the Panel finds that the Respondent had the Complainant's trademark in mind when registering the Disputed Domain Name. The disclaimer on the Respondent's "About Us" webpage is further evidence that the Respondent was aware of the Complainant's TRADER JOE'S Mark and acted in bad faith.

Moreover, the Panel finds that the Respondent had actual knowledge of the Complainant's TRADER JOE'S Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. The Respondent was seeking to drive traffic from the Complainant's customers to its own website, yet another indication of bad faith.

Finally, the Respondent did not respond to the cease-and-desist letters sent by the Complainant. Past UDRP panels have held that failure to respond to a cease-and-desist letter may be considered a factor in finding bad faith registration and use of a domain name. See *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/k/a Country Walk a/k/a Cupcake Party*, WIPO Case No. [D2000-0330](#).

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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, <traderjoescbd.com>, be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: December 6, 2022