

ADMINISTRATIVE PANEL DECISION

Trader Joe's Company v. Martin Dsuza Hallio, RevenueServer LTD
Case No. D2024-2366

1. The Parties

Complainant is Trader Joe's Company, United States of America ("United States"), represented by Byron Raphael LLP, United States.

Respondent is Martin Dsuza Hallio, RevenueServer LTD, United States.

2. The Domain Name and Registrar

The disputed domain name <traderjoesgrocers.com> (the "Domain Name") is registered with Nicenic International Group Co., Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 11, 2024. On June 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 12, 2024, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to Complainant on June 12, 2024, providing the additional registrant information disclosed by the Registrar.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced on June 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 2, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 3, 2024.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on July 10, 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

Complainant owns and operates grocery store services and grocery goods under the TRADER JOE'S brand and has done so since 1967. Currently, Complainant owns and operates over 540 grocery stores under the TRADER JOE'S mark, promotes its stores through: a newsletter, "The Fearless Flyer", which is distributed at Trader Joe's stores; email to more than 850,000 customers throughout the United States; a podcast distributed throughout the United States and the world; social media on numerous online platforms; and its website at "www.traderjoes.com". Complainant's website receives over 4.6 million visitors monthly.

Complainant also owns registered trademarks in numerous jurisdictions worldwide, including in the United States, for example:

- United States registered trademark number 1,422,216 for the TRADER JOE'S word mark, registered on December 23, 1986;
- United States registered trademark number 1,421,310 for the TRADER JOE'S word mark, registered on December 16, 1986; and
- United States registered trademark number 1,420,628 for the TRADER JOE'S word mark, registered on December 9, 1986.

The Domain Name was registered on May 17, 2024, and at the time of the filing of the Complaint, resolved to an inactive site. The Complainant has provided a sworn declaration that Respondent has used a false email address associated with the Domain Name to impersonate a Senior Vice President of Global Procurement in Complainant's company, in an attempt to make purchase from another company in the food industry. At the time of the Decision, the Domain Name resolved to an inactive or error page.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

Complainant contends that (i) the Domain Name is confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has a trademark registration and rights for TRADER JOE'S and that Respondent registered and is using the Domain Name with the intention to attract, for commercial gain, Internet users to its Domain Name and website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website and the purported services on the website.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademarks, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Name, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

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

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case, Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence.

A. Identical or Confusingly Similar

A preliminary issue in the current proceeding is whether Complainant has protectable rights in the mark to which it contends Respondent's Domain Name is confusingly similar.

Complainant has provided evidence of its rights in the TRADER JOE'S trademarks, as noted above. Complainant has also submitted evidence which supports that the TRADER JOE'S trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the TRADER JOE'S trademarks.

With Complainant's rights in the TRADER JOE'S trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant's TRADER JOE'S trademarks. These TRADER JOE'S trademarks are recognizable in the Domain Name. In particular, the Domain Name's inclusion of Complainant's trademark in its entirety, with the absence of a space between "trader" and "joe", the absence of the apostrophe between "e" and "s" in "joe's", and with the addition of the term "grocers" does not prevent a finding of confusing similarity between each of the Domain Name and the TRADER JOE'S trademarks. See sections 1.7 and 1.8 of the [WIPO Overview 3.0](#).

Complainant has provided evidence of its rights in the TRADER JOE'S trademarks, as noted above. Complainant has also submitted evidence which supports that the TRADER JOE'S trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the TRADER JOE'S trademarks.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a prima facie showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a

prima facie showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its TRADER JOE'S trademarks, and does not have any rights or legitimate interests in the Domain Name. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the TRADER JOE'S trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with the TRADER JOE'S trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use. Rather, at the time of the filing of the Complaint, the record shows that the Domain Name resolved to an inactive page. In addition, the Domain Name was used to create an email address to impersonate Complainant's business and employee – in particular, a Senior Vice President of Global Procurement in Complainant's business, in an attempt to make a fraudulent purchase from another company in the food industry, which has not been rebutted by Respondent. Such use does not constitute a bona fide offering of goods or services nor a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#). At the time of the Decision, the Domain Name resolves to an error or inactive page.

Accordingly, Complainant has provided evidence supporting its prima facie claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The Panel finds that Complainant has provided ample evidence to show that registration and use of the TRADER JOE'S trademarks long predate the registration of the Domain Name. Complainant is also well

established and known. Indeed, the record shows that Complainant's TRADER JOE'S trademarks and related products and services are widely known and recognized. Therefore, Respondent was aware of the TRADER JOE'S trademarks when it registered the Domain Name. See section 3.2.2 of the [WIPO Overview 3.0](#); see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

Further, the addition of the term "grocers" to Complainant's TRADER JOE'S trademark in the Domain Name further reinforces Respondent's awareness of Complainant and Complainant's trademarks at the time of registration of the Domain Name, as Complainant operates in the food industry. The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's TRADER JOE'S trademark in its entirety and use of Complainant's TRADER JOE'S trademark to create email addresses to impersonate Complainant's business and employee, which was used in an attempt to induce a third party in the food industry to engage in a fraudulent purchase by Respondent, suggests Respondent's actual knowledge of Complainant's rights in the TRADER JOE'S trademarks at the time of registration of the Domain Name and its effort to opportunistically capitalize on the registration and use of the Domain Name.

Such fraudulent practice is also disruptive to Complainant's business and potentially damaging to Complainant's reputation and good will, and is evidence of bad faith. See *Lennar Pacific Properties Management, Inc. et al v. Automation Contractors*, WIPO Case No. [D2022-1768](#); see also [WIPO Overview 3.0](#), section 3.1.4 ("given that the use of a domain name for per se illegitimate activity such as [...] phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith").

At the time of the Decision, the Domain Name resolved to inactive webpages, which does not change the Panel's finding of Respondent's bad faith.

Further, the Panel also notes the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and the implausibility of any good-faith use to which the Domain Name may be put.

Accordingly, the Panel finds that Respondent registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Domain Name <traderjoesgrocers.com> be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: July 24, 2024