

ADMINISTRATIVE PANEL DECISION

Future Motion, Inc. v. lucky017 lucky017

Case No. D2022-0082

1. The Parties

The Complainant is Future Motion, Inc., United States of America (“United States”), represented by Kolitch Romano LLP, United States.

The Respondent is lucky017 lucky017, United States.

2. The Domain Name and Registrar

The disputed domain name <onewheel-usa.shop> (“Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 11, 2022. On January 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 13, 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 January 13, 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 amendment to the Complaint on January 13, 2022.

The Center verified that the Complaint together with the amendment to 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 the Respondent of the Complaint, and the proceedings commenced on January 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 3, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 7, 2022.

The Center appointed Ellen B Shankman as the sole panelist in this matter on February 8, 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 company that manufactures and sells electric sports boards.

The date of the Domain Name registration is August 20, 2021.

The trademark ONEWHEEL serves as key brand of the Complainant and is protected as a registered trademark. The Complainant provided evidence of trademark registration for the mark ONEWHEEL, United States Trademark Registration No. 4622766 (registered on October 14, 2014, in International Class 12), that predates the date of the Domain Name registration for a variety of vehicles. The Complainant claims that it has spent a considerable amount of time and money protecting its intellectual property rights, and has used the mark in commerce since as early as January 2014.

The Complainant provided some evidence that the Domain Name at one point resolved to a website containing images belonging to the Complainant, and at the time of the filing of the Complaint the website was deactivated. The Panel conducted an independent inquiry to confirm that the Domain Name currently resolves to an error page that appears to be in Chinese and identified as such in Google translate.

5. Parties' Contentions

A. Complainant

The Complainant is a well-known electric board sports company that sells a very successful line of electric skateboards under the mark ONEWHEEL, including in retail shops, at trade shows, and through its online retail store located at "<https://onewheel.com>". The Complainant has been using its ONEWHEEL mark for its electric skateboards since at least as early as January 2014. The Complainant also offers and sells its products internationally, including Australia, Canada, Central and South America, and Europe, among other locations. Additionally, The Complainant is a recipient of the 2016 ISPO BrandNew award for its ONEWHEEL product, given to the most innovative new products in the global sporting goods industry for 2016.

The Complainant claims that it has invested substantial amounts of time and resources in building, promoting, maintaining, and protecting its rights in its ONEWHEEL mark, including, without limitation, obtaining trademark registrations in the ONEWHEEL mark in the United States and internationally. Due to the Complainant's extensive use and promotion, and the resulting commercial success, the Complainant has built up tremendous and valuable goodwill in its ONEWHEEL mark in connection with its products. Furthermore, given the amount of advertising, sales, and immediate public recognition in connection with the Complainant's ONEWHEEL product, the ONEWHEEL mark is well-known and has become a distinctive identifier which consumers associate with the Complainant.

The Complaint contends that the Domain Name is identical and/or confusingly similar to the ONEWHEEL mark in which the Complainant has rights. The addition of the geographic term "-USA" fails to prevent a finding of confusing similarity. Furthermore, the addition of "-USA" is likely to be understood by consumers to merely identify the website as belonging to a United States company. For example, the addition of "-USA" in <onewheel-usa.shop> could be viewed by consumers as merely signifying the location of the Complainant's headquarters, which is in the United States, thus creating a false impression that the Respondent is affiliated with the Complainant. In any case, the addition of "-USA" does not reduce the likelihood of confusion with the Complainant's ONEWHEEL mark and may even increase the likelihood of confusion. For example, the Domain Name's website prominently displays the Complainant's ONEWHEEL mark in combination with

images of the Complainant's goods.

To the best of the Complainant's knowledge, despite the use of the Complainant's ONEWHEEL mark on the Domain Name's website and the use of identical and/or confusingly similar Domain Name, the Respondent is not offering genuine ONEWHEEL products of the Complainant. Instead, the Respondent offers lower priced, inferior quality similar and/or infringing products (*i. e.*, knockoffs) of the Complainant's ONEWHEEL products and uses the Complainant's ONEWHEEL marks in connection with such products throughout the Domain Name's website. Moreover, the Domain Name's website featured misappropriated copyrighted images owned by the Complainant, all without the authorization or approval of the Complainant. At least eight of the images or graphics that appeared on the Domain Name's website was misappropriated from the Complainant's websites. The Complainant's images were accessible to the Respondent prior to the creation of the Domain Name's website, including on the Complainant's websites at least at "https://onewheel.com/products/xr" and "https://onewheel.com/products/pint".

The Complainant alleges that the Respondent's use of the Complainant's mark, and the Complainant's images throughout the Domain Name's website further demonstrate the Respondent's apparent attempt to misleadingly divert consumers from the Complainant, and for commercial gain, and to capitalize on the reputation and goodwill associated with the Complainant's ONEWHEEL mark. The Domain Name was registered and being used in bad faith for at least the following reasons: (a) based on the popularity and well-known character of the Complainant and its ONEWHEEL mark, the Respondent knew or should have known of the Complainant and its ONEWHEEL mark when the Respondent registered the Domain Name; (b) the Respondent is intentionally attempting to attract Internet users to the Domain Name's website and to divert them from the Complainant's website, by creating a likelihood of confusion with the Complainant's ONEWHEEL mark as to the source, sponsorship, affiliation, or endorsement of the Domain Name's website for commercial gain; and (c) the Respondent is using a privacy service to hide its identity in order to prevent efficient enforcement of legitimate trademark rights by the Complainant. Third, the Respondent's use of a privacy service to register the Domain Names, in conjunction with the Respondent's obvious attempts to falsely imply affiliation with the Complainant for illegitimate commercial gain, further indicates the Respondent's bad faith registration and use of the Domain Name.

To summarize the Complaint, the Complainant is the owner of registration for the trademark ONEWHEEL, in respect of motorized vehicles. The Domain Name is confusingly similar to the trademark owned by the Complainant. By registering the Domain Name that comprises the Complainant's ONEWHEEL trademark in its entirety, with the mere addition of the term "USA" the Respondent has created a domain name that is confusingly similar to the Complainant's trademark. As such, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. The addition of the geographical term does not prevent a finding of confusing similarity. Therefore, the Domain Name could be considered virtually identical and/or confusingly similar to the Complainant's trademark. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Domain Name was registered and is being used in bad faith. The current error page use of the Domain Name does not present a finding of registration and use in bad faith. Thus, the Respondent's registration and use of the Domain Name constitutes bad faith registration and use under the Policy, and the Complainant requests transfer of the Domain Name.

B. Respondent

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

6. Discussion and Findings

The burden for the Complainant under paragraph 4(a) of the Policy is to prove:

- (i) the Domain Name registered by the Respondent 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 Domain Name; and
- (iii) the Domain Name has been registered and used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the Domain Name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint. Since the Respondent did not respond to this Complaint, the supported facts regarding the use and reputation of the Complainant's mark taken from the Complaint are generally accepted as true in the circumstances of this case.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has satisfactorily proven that it has registered trademark rights for ONEWHEEL.

Further, the Panel finds that the Domain Name integrates the Complainant's mark ONEWHEEL in its entirety with the addition of the geographical element "USA", and that the Domain Name is confusingly similar to the Complainant's trademark. Further, the Panel finds that the mere addition of the geographical term "USA" to the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant's trademark. See *Pfizer Inc. v. Asia Ventures, Inc.*, WIPO Case No. [D2005-0256](#). See also *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#).

Accordingly, the Panel finds that the Complainant has satisfied the first requirement that the Domain Name is identical or confusingly similar to the Complainant's registered trademark, under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy in turn identifies three non-exclusive means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often-impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the consensus view is that paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in the disputed domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name and that it is not related to or affiliated in any way with the Complainant, nor has the Complainant authorized the Respondent to use its trademarks, and is not using the Domain Name for a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Domain Name. The fact that the Domain Name currently resolves to an inactive page does not change this.

Based on the available record, the Panel finds that the Complainant has established a *prima facie* case, which was not refuted by the Respondent, and that the Respondent lacks rights or legitimate interests in the Domain Name.

Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the Domain Name, under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel agrees with the Complainant that when considering the balance of probabilities, it is more likely

than not that the Respondent had actual or constructive knowledge of the ONEWHEEL trademark and that registration of the Domain Name would be identical or confusingly similar to the Complainant's trademark. Based on the evidence provided, the Panel finds that it is implausible that there could be any legitimate use of this Domain Name. In light of and on balance of the facts set forth within this Complaint, the Panel finds that it is more likely than not that the Respondent knew of and targeted the Complainant's trademark. The Panel agrees with the Complainant's contention that indeed, the Respondent's purpose in registering the Domain Name was probably to capitalize on the reputation of the Complainant's trademarks.

By registering the Domain Name that comprises the Complainant's ONEWHEEL trademark in its entirety, with the mere addition of the geographical term "USA", and with evidence of the prior appropriated photos of the Complainant's products, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. In light of the facts set forth within this Complaint, the Panel finds that it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware of" the Complainant's brand at the time the Domain Name was registered. See *Telstra Corporation Limited. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). Further, "it defies common sense to believe that the Respondent coincidentally selected the precise domain without any knowledge of the Complainant and its trademarks." See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#).

Furthermore, the lack of current active use of the Domain Name does not prevent a finding of bad faith in the circumstances of this case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.3. In that regard, the reputation of the Complainant's trademarks, the choice of additional term in the Domain Name, the evidence of the earlier appropriated photos, the failure of the Respondent to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the Domain Name could be put, support a finding of bad faith.

In addition, the Panel notes that, at the time of initial filing of the Complaint, a privacy service masked the registrant identity, which past Panels have held serves as further evidence of bad faith registration and use. See *Dr. Ing. H.C. F. Porsche AG v. Domains by Proxy, Inc.*, WIPO Case No. [D2003-0230](#). See also [WIPO Overview 3.0](#), section 3.6 ("Panels have also viewed a respondent's use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual underlying registrant as an indication of bad faith.").

In light of the above, the Panel finds that the Complainant has satisfied the third requirement that the Respondent has registered and is using the Domain Name in bad faith, under paragraph 4(a)(iii) 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 <onewheel-usa.shop> be transferred to the Complainant.

/Ellen B Shankman/

Ellen B Shankman

Sole Panelist

Date: February 22, 2022