

ADMINISTRATIVE PANEL DECISION

Future Motion, Inc. v. Super Privacy LTD c/o Dynadot/ nnin17 nnin17
Case No. D2022-0230

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 Super Privacy Service LTD c/o Dynadot, United States / nnin17 nnin17, United States.

2. The Domain Name and Registrar

The disputed domain name <onewheel-outlet.com> 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 24, 2022. The disputed domain name was initially included in a Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) Complaint filed by the Complainant on January 11, 2022, with two other domain names in *Future Motion, Inc. v. lucky017 lucky017*, WIPO Case No. [D2022-0082](#). In response to the Center’s “Notice of Change – Multiple Underlying Registrants” notification, the Complainant withdrew the disputed domain name from that case via simple amendment on January 12, 2022, to file the present Complaint.

On January 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 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 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 February 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2022. The Respondent did not submit any response.

Accordingly, the Center notified the Respondent of the default on February 23, 2022.

The Center appointed Steven Auvil as the sole panelist in this matter on March 4, 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

According to the Complaint, the Complainant is an electric board sports company that sells electric skateboards under the mark ONEWHEEL in retail shops, at trade shows, and through an online retail store. In addition to the United States, the Complainant also sells its products internationally in Australia, Canada, Central and South America, and Europe. The Complainant's products and the ONEWHEEL mark have received substantial media attention.

The Complainant has been using the ONEWHEEL mark for its electric skateboard since January 2014. The Complainant owns registered trademarks for the ONEWHEEL brand, including *inter alia*, United States Registration No. 4622766 (Registered October 14, 2014). The Complainant also owns the domain name <onewheel.com> in connection with the ONEWHEEL mark.

The disputed domain name <onewheel-outlet.com> was registered on August 20, 2021.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the disputed domain name is confusingly similar to its ONEWHEEL mark because the disputed domain name is the same except that it introduces a descriptive element with the word "outlet". The Complainant contends that the disputed domain name is likely to deceive consumers into believing the disputed domain name's website sells the Complainant's products at discounted rates, as the term "outlet store" refers to a store where a manufacturer sells goods at discounted prices.

Allegedly, on or around September 23, 2021, the disputed domain name resolved to a website that used the Complainant's ONEWHEEL mark and incorporated copyrighted images owned by the Complainant including those used on the Complainant's own website <onewheel.com>. Allegedly, the website looked as though it was associated with the Complainant, however the product prices were significantly lower than the Complainant's. Both at the time the Complaint was filed and at the time of writing this Decision, the disputed domain name no longer resolved to an active website (*i.e.*, the web browser returns a message indicating that that website "refused to connect").

The Complainant also asserts that the Respondent has no rights or legitimate interests in the disputed domain name because the Respondent is not affiliated with the Complainant and has never obtained a license from the Complainant to use the ONEWHEEL mark.

The Complainant further asserts that the Respondent registered or used the disputed domain name in bad faith because the Respondent knew or should have known of the Complainant's rights in the ONEWHEEL mark when it registered the disputed domain name based on the extensive and widespread recognition on the Internet through numerous articles, blogs, posts, and also the Complainant's own website and social media pages. Additionally, according to the Complainant, the Respondent's primary purpose in registering the disputed domain name was to create a false and misleading impression that the Respondent acts in affiliation with the Complainant for commercial gain.

The Complainant requests that the disputed name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or a service in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a Response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed allegations pursuant to paragraphs 5(e), 14(a), and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#).

Based on the foregoing guidance, the Panel makes the following findings and conclusions on the basis of the allegations and evidence contained in the Complaint and reasonable inferences drawn from them.

A. Identical or Confusingly Similar

As noted above, the Complainant is the owner of several registered trademarks for ONEWHEEL. The Panel therefore finds that the Complainant has rights in the ONEWHEEL mark.

As set forth in section 1.11 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the applicable Top Level Domain (e.g., “.com”, “.site”, “.info”, “.shop”) “is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” Therefore, the presence of “.com” in the disputed domain name is irrelevant to the Panel's decision.

Section 1.8 of [WIPO Overview 3.0](#) states that “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

It is further understood that when a disputed domain name fully incorporates a complainant's registered mark, it is indicative of the disputed domain name being identical or confusingly similar. See [WIPO Overview 3.0](#), section 1.7; See also *Razor USA LLC v. Super Privacy Service LTD c/o Dynadot / Lucky017 Lucky017*, WIPO Case No. [D2021-3211](#) (finding the use of the word “-outlet” not preventing a finding of confusing similarity); *Prada S.A. v. Ernesto Lucchese*, WIPO Case No. [D2021-0681](#) (finding the addition of the words “outlet” and “online” not preventing a finding of confusing similarity where the complainant's entire trademark was used in <prada-outlet-online.com>); *Philipp Plein v. OPPP OPPP*, WIPO Case No. [D2015-2377](#) (finding that the addition of the generic word “outlet” not preventing a finding of confusing similarity in <outlet-philipp-plein.com>).

Here, the disputed domain name incorporates the Complainant's entire ONEWHEEL mark and the term "outlet". The Respondent's addition of the word "outlet" and a hyphen to the Complainant's ONEWHEEL mark in the disputed domain name does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to the Complainant's mark. Therefore, the first element of paragraph 4(a) of the Policy is met.

B. Rights or Legitimate Interests

From the Complainant's allegations and evidence as well as the inferences drawn from the evidence, the ONEWHEEL mark is a distinctive and well-known mark registered by the Complainant. As noted, the Complainant has garnered substantial media attention for its products using the ONEWHEEL mark and has a worldwide presence. The Complainant did not license or otherwise authorize the Respondent's use of the ONEWHEEL mark. Therefore, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Section 2.1 of [WIPO Overview 3.0](#) provides that "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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

Here, the Respondent did not respond to the Complaint and thus has failed to rebut the *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that the Respondent in fact has no rights or legitimate interests in the disputed domain name and that the second element of paragraph 4(a) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Section 3.1.4 of [WIPO Overview 3.0](#) provides that "[p]anelists have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Additionally, section 3.2.1 of [WIPO Overview 3.0](#) provides that "[p]articular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion) [...] (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or (vii) other indicia generally suggesting that the respondent had somehow targeted the complainant."

Here, as noted above, the disputed domain name incorporates the entirety of the Complainant's registered ONEWHEEL mark. Further, the disputed domain name resolved to a website page that resembled the Complainant's website and looked as though it was associated with the Complainant, suggesting an intent to defraud the Complainant's customers. The website also used the same images as the Complainant's website and those of the Complainant's authorized retailers. The only difference being that the disputed domain name website offers the products at a steeply discounted price.

The Respondent provided no rebuttal evidence suggesting that it adopted the disputed domain name or used it in good faith. Under the circumstances, the Panel finds that the Respondent knew of the Complainant's ONEWHEEL mark at the time of registration of the disputed domain name and attempted to pass itself off as the Complainant and take unfair advantage of the ONEWHEEL mark for commercial gain.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the third element of paragraph 4(a) of the Policy is satisfied.

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 <onewheel-outlet.com> be transferred to the Complainant.

/Steven Auvil/

Steven Auvil

Sole Panelist

Date: March 18, 2022