

ADMINISTRATIVE PANEL DECISION

Jaxxon, LLC v. Jaxxon & Company, Inc., d/b/a Jaxxon Watches / Brent Lofton
Case No. D2022-0934

1. The Parties

Complainant is Jaxxon, LLC, United States of America (“U.S.”), represented by K&L Gates, U.S.

Respondent is Jaxxon & Company, Inc., d/b/a Jaxxon Watches, U.S. / Brent Lofton, U.S.

2. The Domain Name and Registrar

The disputed domain name <jaxxonwatches.com> (the “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 March 16, 2022. On March 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 18, 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 to Complainant on March 22, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 23, 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 Respondent of the Complaint, and the proceedings commenced on March 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 13, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 14, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on April 21, 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

Since 2017, Complainant has been a retailer of jewelry under the trademark JAXXON. Complainant holds various trademark registrations, including the stylized mark JAXXON (the second X is stylized) under United States Patent and Trademark Office (“USPTO”) Reg. No. 5,902,618, registered November 5, 2019, in connection with precious metals, jewelry, precious and semi-precious stones, and related accessories, in International Class 14. The USPTO registration indicates an October 6, 2017 date of first use in commerce of the JAXXON mark.

Complainant has also filed an application with the USPTO to register the word mark JAXXON. That application is pending.

Complainant has owned the domain name <jaxxon.com> since 2017, and uses that domain name to host a commercial website at which Complainant’s JAXXON jewelry and related items are offered for sale.

The Domain Name was registered on August 3, 2020. The Domain Name resolves to a website at which Respondent offers for sale Jaxxon watches. According to the record in this case, Respondent filed articles of incorporation in California, under the name Jaxxon & Company, Inc., on September 16, 2020, six weeks after registering the Domain Name. There is no evidence in the record that “Jaxxon” is a name that has any relation to Respondent’s principal, such as a family name.

It is not clear from the record when Respondent began offering for sale Jaxxon watches at his website. Complainant appears to allege that Respondent first offered “Jaxxon” watches for sale at his Instagram page on March 26, 2021.

Complainant alleges that it first discovered Respondent’s use of the Domain Name later in 2021. On December 20, 2021, Complainant’s counsel sent Respondent a cease-and-desist letter, asserting Complainant’s rights in the JAXXON trademark and demanding that Respondent cease using the JAXXON mark in a Domain Name or otherwise. The letter included the statement: “As you may be aware, Jaxxon, LLC is a leading global brand selling premium precious metal bracelets, necklaces, rings, and other jewelry.”

On January 31, 2022, Respondent replied by email to Complainant’s cease-and-desist letter, the substance of which was as follows:

“We, Jaxxon & Co, categorically deny all the allegations in your Notice, including, but not limited to, violating your client’s rights protected under the trademark laws of the United States. To avoid unnecessary and protracted litigation, we will provide the following brief statement of our response to your Notice: We, Jaxxon & Co do not use a stylized X on any of our products, packaging, websites etc. Your client Jaxxon, LLC filed a federal application for a plain font non-stylized JAXXON after our appearance on Instagram, the internet, & establishment of our company. In the light of the foregoing, it has been concluded that the merit of the claims made in your cease and desist letter are incorrect.”

In its email reply, Respondent did not deny having knowledge of the JAXXON trademark.

On February 15, 2022, Complainant’s counsel replied to Respondent’s January 31, 2022 email. Complainant disputed Respondent’s assertion that the stylized X in Complainant’s registered trademark negated any possible trademark infringement. Complainant also pointed out that International Class 14 for trademarks includes both “jewelry” and “watches.”

Respondent did not respond to Complainant's February 15, 2022 letter. As noted above, Complainant initiated this proceeding on March 16, 2022.

5. Parties' Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark JAXXON through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to the JAXXON mark. The entire mark is incorporated within the Domain Name, and the additional word "watches" does not prevent a finding of confusing similarity between the mark and the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name. Respondent has not come forward in this proceeding to articulate or prove any legitimate reason for registering the Domain Name, which is identical to Complainant's mark. Respondent's reply to Complainant's cease-and-desist letter is scarcely convincing. As noted above, Respondent did not deny having knowledge of Complainant's JAXXON trademark. It does not appear that "Jaxxon" constitutes a common surname or common dictionary word. The Panel also notes that jewelers often sell watches, and horologers sometimes sell jewelry. Respondent's use of Complainant's JAXXON mark to sell products closely associated with products sold by Complainant cannot vest Respondent with a legitimate interest vis-à-vis the Domain Name. In addition, the Panel notes that while Respondent's company name seems to include "Jaxxon" within its name, no credible explanation has been provided for its adoption. Noting the proximity of Complainant's and Respondent's products, and that Complainant's use of the JAXXON mark predates the registration of the Domain Name, the Panel finds that in the circumstances of this case, such company name is not sufficient to establish that Respondent has rights or legitimate interests in the Domain Name under the Policy.

The Panel concludes that Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

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

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. On the record here, the Panel finds it more likely than not that Respondent registered the Domain Name with Complainant's distinctive JAXXON trademark in mind with the intention of taking unfair advantage of Complainant's goodwill attaching to that trademark. As Complainant has pointed out, "watches" are in the same International Class as "jewelry," which is Complainant's primary product line. The similarity of the Parties' product lines reinforces this conclusion.

This appears to be a fairly straightforward case of trademark infringement. More importantly, for purposes of the UDRP (which is not coextensive with trademark law), this appears to be a fairly clear case of abusive domain name registration and use. Specifically, the Panel finds Respondent in bad faith here under the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

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 <jaxxonwatches.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: April 29, 2022