

## **ADMINISTRATIVE PANEL DECISION**

MVH I, Inc. v. Privacy service provided by Withheld for Privacy ehf / Kanwal Nawaz

Case No. D2022-2598

### **1. The Parties**

The Complainant is MVH I, Inc., United States of America (“United States”), represented by 101domain.com, United States.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Kanwal Nawaz, United Arab Emirates.

### **2. The Domain Name and Registrar**

The disputed domain name <mylepodsduhai.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 16, 2022. On July 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 18, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 20, 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 July 26, 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 July 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on August 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers, or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules, and the Supplemental Rules and without the benefit of a response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

The Complainant is MVH I, Inc., a United States company operating in the field of electronic cigarettes and vaping products and owning several trademark registrations for MYLÉ, among which the following ones:

- United States Trademark Registration No. 5,652,774 for MYLÉ, registered on January 15, 2019;
- International Trademark Registration No. 1462089 for MYLÉ, registered on March 4, 2019.

The Complainant operates on the Internet at the main website "www.mylevape.com", as well as with many other generic Top-Level Domains ("gTLDs") and country code Top-Level Domains ("ccTLDs") including the trademark MYLÉ, among which <myle-dubai.com> and <myle-vape-dubai.com>, both redirected to the Complainant's main website "www.mylevape.com".

The Complainant provided evidence in support of the above.

The disputed domain name was registered on April 28, 2021, according to the Whois records; and it resolves to a website where electronic cigarettes and relevant devices are offered for sale and the Complainant's trademark is reproduced.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain name <mylepodsduhai.com> is confusingly similar to its trademark MYLÉ, as the disputed domain name wholly incorporates the Complainant's trademark.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use the Complainant's trademark within the disputed domain name. The Complainant asserts the Respondent is offering for sale the same products as the Complainant's as well as competitor's products on the website at the disputed domain name, therefore not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name, but instead disrupting and tarnishing the business of the Complainant's notorious electronic cigarette and vaping company.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademark MYLÉ is distinctive and not commonly used for electronic cigarettes. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain name and the Complainant contends that the use of the disputed domain name to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation and/or endorsement of the Respondent's associated website qualifies as bad faith registration and use.

## **B. Respondent**

The Respondent has made no reply to the Complainant's contentions and is in default. In reference to paragraphs 5(e) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn (see, e.g., *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. [D2000-0441](#); *Microsoft Corporation v. Freak Films Oy*, WIPO Case No. [D2003-0109](#); *SSL International PLC v. Mark Freeman*, WIPO Case No. [D2000-1080](#); *Altavista Company v. Grandtotal Finances Limited et. al.*, WIPO Case No. [D2000-0848](#); *Confédération Nationale du Crédit Mutuel, Caisse Fédérale du Crédit Mutuel Nord Europe v. Marketing Total S.A.*, WIPO Case No. [D2007-0288](#)).

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

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

### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant is the owner of the trademark MYLÉ both by registration and acquired reputation and that the disputed domain name is confusingly similar to the trademark MYLÉ.

Regarding the addition of the term "pods" and the geographical term "dubai", the Panel notes that it is now well established that the addition of dictionary terms or letters to a domain name does not prevent a finding of confusing similarity between the domain name and the trademark (see, e.g., *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. [D2005-0037](#); *Red Bull GmbH v. Chai Larbthanasub*, WIPO Case No. [D2003-0709](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)). The addition of the term "pods" and the geographical term "dubai" does not therefore prevent the disputed domain name from being confusingly similar to the Complainant's trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

It is also well accepted that a generic Top-Level Domain ("gTLD"), in this case ".com", is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

## B. Rights or Legitimate Interests

The Respondent has failed to file a response in accordance with the Rules, paragraph 5.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not using the disputed domain name for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services, but instead on the website at the disputed domain name the Complainant's trademark is reproduced and the same products as the Complainant's are offered for sale.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain name.

Should the Complainant's products sold on the website to which the disputed domain name is directing Internet users be genuine products, legitimately acquired by the Respondent, the question that would arise is whether the Respondent would therefore have a legitimate interest in using the disputed domain name that is confusingly similar to the Complainant's trademark in circumstances that are likely to give rise to confusion.

According to the current state of UDRP decisions in relation to the issue of resellers as summarized in the [WIPO Overview 3.0](#), section 2.8.1:

"[...] resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark."

This summary is based on the UDRP decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

However, even if the products sold by the Respondent were the Complainant's genuine products, from inspection of the Respondent's website, the Panel finds that the use of the Complainant's trademark on the homepage, the insufficient disclosure of the lack of a relationship between the Respondent and the Complainant (limited to the sentence "Mylepodsduhai.com has no affiliation with MYLÉ. This is not official website of MYLÉ" in small letters at the bottom of the homepage), and the fact that also Complainant's competitors, like Tugboat, were displayed on the disputed domain name, is sufficient to support the allegation of the lack of rights or legitimate interests of the Respondent in relation to this disputed domain name under the Oki Data principles (see above).

The Panel therefore concludes that the disputed domain name is not being used in connection with a *bona fide* offering of goods or services.

Moreover, the Panel finds that the composition of the disputed domain name carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that “for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [the respondent has] registered or has 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 the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

(ii) that [the 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 [the respondent has] engaged in a pattern of such conduct; or

(iii) that [the 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, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] 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 [the respondent’s] website or location or of a product or service on [the respondent’s] website or location”.

Regarding the registration in bad faith of the disputed domain name, the Panel finds that the Respondent likely knew of the Complainant’s registered trademark MYLÉ and deliberately registered the disputed domain name, especially because the website at the disputed domain name is reproducing the MYLÉ trademark of the Complainant and is offering for sale the same products as the Complainant, namely electronic cigarettes and relevant devices.

The Panel further notes that the disputed domain name is also used in bad faith since on the relevant website, the Complainant’s MYLÉ trademark is displayed in an attempt to pass off as an agent of the Complainant, and also other electronic cigarettes and relevant devices of the Complainant’s competitors are displayed.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain name in order both to disrupt the Complainant’s business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

Furthermore, the Panel considers that the nature of the disputed domain name, which is almost identical to the Complainant’s trademark with the mere addition of the term “pods” and the geographical term “dubai”, further supports a finding of bad faith and intent to confuse users about a non-existent affiliation trading off of the Complainant’s reputation and goodwill. See [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain name in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been 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, <mylepodsduhai.com>, be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: August 26, 2022