

ADMINISTRATIVE PANEL DECISION

Trader Joe's Company v. zengyi xu, 1
Case No. D2022-4807

1. The Parties

The Complainant is Trader Joe's Company, United States of America ("United States"), represented by O'Melveny & Myers, LLP, United States.

The Respondent is zengyi xu, 1, China.

2. The Domain Name and Registrar

The disputed domain name <traderjoesmerch.com> 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 December 14, 2022. On December 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 16, 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 (Registration Private, Domains By Proxy, LLC), and contact information in the Complaint. The Center sent an email communication to the Complainant on December 19, 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 amended Complaint on January 7, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on January 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 14, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on February 21, 2023. 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 an American chain of grocery stores that has offered grocery services and goods since 1967. The Complainant owns and operates over 530 grocery stores under the TRADER JOE'S trademark. The Complainant also owns and operates a website at "www.traderjoes.com", which receives over 3.4 million visitors per month.

The Complainant owns several trademarks in the United States in numerous international classes, including, but not limited to: TRADER JOE'S, United States Registration No. 1,424,176, registered on January 6, 1987, in international class 30; TRADER JOE'S, United States Registration No. 1,422,216, registered on December 23, 1986, in international class 32; TRADER JOE'S, United States Registration No. 1,421,310, registered on December 16, 1986, in international class 29; and TRADER JOE'S, United States Registration No. 1,420,628, registered on December 9, 1986, in international class 42.

The disputed domain name was registered on August 31, 2022 and is currently not active offering a sign stating: "Sorry, this shop is currently unavailable". At the time of filing the Complaint the disputed domain resolved to a website that claimed to advertise merchandise using the Complainant's trademark.

5. Parties' Contentions

A. Complainant

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

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is identical or confusingly similar to the TRADER JOE'S trademark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

Third, the Complainant submits that the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

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

- (i) the 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 such domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical or confusingly similar to the Complainant's trademark.

The Complainant holds several valid TRADER JOE'S trademark registrations, which precede the registration of the disputed domain name.

The disputed domain name is confusingly similar to the Complainant's trademarks since it merely reproduces the TRADER JOE'S trademark with the addition of the term "merch" that is an abbreviation of "merchandise".

The disputed domain name incorporates the Complainant's TRADER JOE'S trademark in its entirety. As numerous UDRP panels have held, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. The addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

The Panel finds the first element of the Policy has therefore been met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to you 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 (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 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.

There is no evidence of the existence of any of those rights or legitimate interests. The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. The Complainant has prior rights in the trademarks which precede the Respondent's registration of the disputed domain name.

The Respondent's evidenced use of the Complainant's trademark to register a website to offer merchandise using the Complainant's trademark cannot constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use.

Moreover, the Respondent is not currently using the disputed domain name, which cannot constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use. The Complainant has therefore established a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and thereby shifted the burden to the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to rebut the Complainant's *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second requirement of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Complainant's allegations with regard to the Respondent's registration and use of the domain name in bad faith have been considered by the Panel. These allegations have not been contested by the Respondent.

The disputed domain name was registered in 2022, decades after the Complainant first began using its TRADER JOE'S Mark, and several decades after the Complainant first registered the TRADER JOE'S Mark. Therefore, the Panel finds that the Respondent had the Complainant's trademark in mind when registering the disputed domain name.

This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the disputed domain name, as the Respondent included in the disputed domain name the Complainant's TRADER JOE'S trademark with the term "merch" and offered in it merchandise related to the Complaint business. The Panel finds such use indicates an intent to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark.

The Respondent in all likelihood registered the disputed domain name with the expectation of taking advantage of the reputation of the Complainant's trademark.

Furthermore, the disputed domain name is currently not being used by the Respondent. UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). The well-known character of the trademark TRADER JOE'S has been confirmed in previous UDRP cases (see, e.g., *Trader Joe's Company v. Hildegard Gruener*, WIPO Case No. [D2022-3105](#)).

The failure of the Respondent to formally answer the Complainant's Complaint also suggests, in combination with other factors, bad faith on the part of the Respondent (*Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#)).

Therefore, taking all the circumstances into account and for all the above reasons, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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, <traderjoesmerch.com>, be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: March 7, 2023.