

ADMINISTRATIVE PANEL DECISION

Future Motion, Inc. v. shane Bruce
Case No. D2022-4100

1. The Parties

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

Respondent is shane Bruce, United States.

2. The Domain Name and Registrar

The disputed domain name <onewheelhome.com> is registered with Realtime Register B.V. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 31, 2022. On November 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 2, 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 Complainant on November 2, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on November 2, 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 Respondent of the Complaint, and the proceedings commenced on November 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 23, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 24, 2022.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on November 29, 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

Complainant is the owner of registrations for the word, and word and design, trademark ONEWHEEL on the Principal Register of the United States Patent and Trademark office (USPTO), including word registration number 5,953,007, registration dated January 7, 2020, in international class (IC) 12, covering vehicles, namely, electronically motorized skateboards; word registration number 4,622,766, registration dated October 14, 2014, in IC 12; word and design registration number 4,715,457, registration dated April 7, 2015, in IC 12, and certain additional ONEWHEEL-formative USPTO registrations. Complainant is owner of registration as an International Trademark under the Madrid System for the word ONEWHEEL, registration number 1,227,105, registration dated August 26, 2014, in IC 12, with designations for 8 countries, and; owns registration as an International Trademark for the word ONEWHEEL+XR.

Complainant designs, promotes and sells electric skateboards under the ONEWHEEL trademark in the United States and other countries. Complainant's electric skateboard products are commercially successful, and these products have been the subject of substantial media reporting, including in well-known online publications. Complainant operates an online retail store at "<https://onewheel.com>", and physical retail locations where its products may be purchased can be located at "<https://onewheel.com/apps/store-locator>".

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to information furnished by Complainant, the record of registration of the disputed domain name was created on August 18, 2022. There is no indication on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain name since its creation date.

Respondent has used the disputed domain name to direct Internet users to a website designed to give the look and feel of originating with Complainant. Complainant's trademarks are prominently displayed on Respondent's website, photographs of Complainant's trademark products replicating those appearing on Complainant's website are displayed, and the biography of Complainant's founder is featured. Respondent's website purports to be offering Complainant's trademark products for sale to the public. Complainant does not supply Respondent with its products, and it is unknown whether Respondent is shipping any products (Complainant's or otherwise) to Internet users.

5. Parties' Contentions

A. Complainant

Complainant alleges that it owns rights in the trademark ONEWHEEL and certain ONEWHEEL-formative trademarks. Complainant argues that the disputed domain name is confusingly similar to its ONEWHEEL trademark.

Complainant contends that Respondent lacks rights or legitimate interest in the disputed domain name because: (1) Complainant has not licensed or otherwise authorized Respondent to use its trademark in the disputed domain name or in any other manner; (2) Respondent has not been commonly known by the disputed domain name; (3) Respondent is not making legitimate noncommercial or fair use of Complainant's trademark in the disputed domain name, including because it Respondent is falsely suggesting an association with Complainant; (4) Complainant believes that Respondent is falsely communicating to Internet users that it is supplying products of Complainant, thereby attempting to defraud Internet users.

Complainant argues that Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent knew or should have known of Complainant's rights in its trademark when it registered the disputed domain name; (2) Respondent is using the disputed domain name for commercial gain to attract Internet users by creating a likelihood of confusion with Complainant's trademark by suggesting that Complainant is the source, sponsor, affiliate or endorser of Respondent's website; (3) the addition of the term "home" to Complainant's trademark in the disputed domain name does not dispel confusion, and; (4) Respondent engaged a privacy service in order to protect its abusive conduct.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical address provided in its record of registration. Courier delivery of the Written Notice to Respondent could not be completed because of inaccurate address information in the record of registration. There is no indication of problems with the transmission of email to Respondent. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant has provided evidence of rights in the trademark ONEWHEEL, including by registration at the USPTO and as an International Trademark under the Madrid System, and by use in commerce. Respondent has not challenged Complainant's assertion of rights. The Panel determines that Complainant owns rights in the trademark ONEWHEEL.¹

¹ For purposes of making its determination in this proceeding the Panel need not address rights of Complainant in its ONEWHEEL-formative trademarks. This is entirely without prejudice to the rights of Complainant.

The disputed domain name directly and fully incorporates Complainant's ONEWHEEL trademark. This is sufficient to establish confusing similarity under the Policy. The addition of "home" to Complainant's trademark does not prevent a finding of confusing similarity. The Panel determines that the disputed domain name is confusingly similar to Complainant's ONEWHEEL trademark.

Complainant has established that it owns rights in the trademark ONEWHEEL, and that the disputed domain name is confusingly similar to that trademark.

B. Rights or Legitimate Interests

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are set out in section 5A above, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not replied to the Complaint and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent has used the disputed domain name to direct Internet users to a website prominently featuring Complainant's trademark, displaying photographs of Complainant's products duplicating photographs on Complainant's retail website, incorporating information concerning Complainant's founder, and offering Complainant's products for sale. Complainant has not authorized Respondent to use its trademark in any manner, nor does it supply its products to Respondent. There is no evidence that Respondent is delivering products of any kind to Internet users.

Respondent is not making a *bona fide* offering of goods or services. Respondent's use of Complainant's trademark to deceptively represent itself as Complainant, displaying Complainant's trademark and information regarding its founder, without any disclaimer of association with Complainant, is not fair or legitimate noncommercial use of Complainant's trademark. Such activity is not authorized by Complainant, and it is likely to damage Complainant's reputation as well as to injure consumers.

Respondent's actions do not otherwise manifest rights or legitimate interests in the disputed domain name.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain name "has been registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that "for the purposes of paragraph 4(a)(iii), 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". These include that, "(iv) 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".

Respondent registered and used the disputed domain name that is confusingly similar to Complainant's trademark after Complainant acquired rights in that trademark, and after Complainant established a substantial online presence under that trademark. Respondent deliberately attempts to create the appearance of being Complainant, including by using Complainant's trademark and photographs of Complainant's products on its website. Respondent knew or should have known of Complainant's trademark rights when it registered and used the disputed domain name.

Respondent is using the disputed domain name confusingly similar to Complainant's trademark for commercial gain to direct Internet users to Respondent's website that gives the appearance of being operated by or on behalf of Complainant. This takes unfair advantage of Internet users and is likely to damage the reputation of Complainant and its brand. Respondent has not replied to the Complaint and has not attempted to provide any justifying explanation for its conduct. There is no indication that Respondent provides Internet users with products made or supplied by Complainant.

The Panel determines that Respondent registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) 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 disputed domain name, <onewheelhome.com>, be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: December 13, 2022