

ADMINISTRATIVE PANEL DECISION

Mrvapes Australia Limited v. John Smith and Jesse Sodhi
Case No. D2023-2880

1. The Parties

The Complainant is Mrvapes Australia Limited, New Zealand, represented by Cooper Mills Lawyers, Australia.

The Respondents are John Smith, Australia, and Jesse Sodhi, Australia, represented by Dmytro Chyrkin, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <mrvapes.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 July 6, 2023. On July 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 7, 2023, 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 (Domains By Proxy, LLC, JESSE JASKIRAT SINGH SODHI) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 14, 2023, 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 July 18, 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 Respondents of the Complaint, and the proceedings commenced on July 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 14, 2023. The Response was filed with the Center on August 13, 2023.

The Center appointed Steven A. Maier as the sole panelist in this matter on September 5, 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. Identity of Respondent

According to the verification response submitted by the Registrar to the Center, the registrant of the disputed domain name is John Smith. However, the Complainant submits in its Complainant that the beneficial holder of the disputed domain name is Jesse Sodhi. The Response in the proceeding having been filed on behalf of both John Smith and Jesse Sodhi, the Panel finds that both such parties are proper respondents. The term Respondent in the remainder of this Decision shall accordingly mean either or both of those parties unless otherwise stated.

5. Factual Background

The Complainant is a company registered in New Zealand. It is an online retailer of vaping supplies.

The Complainant is the owner of Australia trademark registration number 2299339 for the word mark MRVAPES, registered on September 8, 2022.

The disputed domain name was originally registered on February 16, 2012. It was acquired by the Respondent on or around August 16, 2022.

According to evidence submitted by the Complainant, the disputed domain name has resolved to a website headed "MR VAPES #1 VAPE STORE IN AUSTRALIA" and offering vaping products for sale online.

6. Parties' Contentions

A. Complainant

The Complainant submits that it is a well-known online provider of vaping products in Australia and New Zealand. It states that it or its predecessors have traded as MRVAPES since 2018 and provides a history of the individuals and corporate entities trading under that mark. It submits that it has used the domain names <mrvapes.com.au> and <mrvapes.co.nz> continuously in connection with its business since 2018.

The Complainant submits that the disputed domain name is identical or confusingly similar to its trademark MRVAPES.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has no relationship with the Respondent and has never authorized it to use its MRVAPES trademark, that the Respondent has not commonly been known by the disputed domain name and that the Respondent is making neither *bona fide* commercial use nor legitimate noncommercial or fair use of the disputed domain name. The Complainant contends that, instead, the Respondent is using the disputed domain name for the purpose of a website intended to deceive customers into believing they are dealing with the Complainant.

The Complainant submits that the disputed domain name was registered and has been used in bad faith.

The Complainant submits that the Respondent Jesse Sodhi was a customer of the Complainant's, who subscribed to the Complainant's mailing list on March 9, 2021. It contends that the Respondent was therefore clearly aware of the Complainant's MRVAPES trademark when it acquired the disputed domain name.

The Complainant submits that the Respondent has used the disputed domain name for the purpose of an “imitation website” of the Complainant’s own website at “www.mrvapes.co.nz”. It contends that the Respondent’s website has a similar “look and feel” to the Complainant’s website, utilizes a similar colour scheme and contains images which have been directly copied from the Complainant’s website, as well as the Complainant’s Google reviews. The Complainant exhibits a “side by side” comparison of certain of the content which it claims to have been copied.

The Complainant submits evidence that the Respondent Jesse Sodhi is the operator of a competing vaping supplies business named Munchieland. It provides evidence that subscribers to a mailing list on the Respondent’s website has resulted in relevant particulars being shared with Munchieland.

The Complainant exhibits a “cease and desist” letter sent to the Respondent on February 16, 2023. It alleges that, in response to that letter, the Respondent altered the address, bank details and business name registration details shown on the Respondent’s website, and subsequently changed the registration details for the disputed domain name to John Smith, which the Complainant contends is a fictitious name.

The Complainant submits that the Respondent is using the disputed domain name for the purpose of “cybersquatting” and is seeking to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant’s MRVAPES trademark. It contends that the Respondent’s website has caused actual confusion to customers, and provides copies of communications received from customers complaining about “spam” emails received via the Respondent’s website.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent submits that it acquired the disputed domain name in August 2022, while the Complainant only applied for its MRVAPES trademark in September 2022 and obtained a registration in April 2023 (while the registration was entered on the register on April 18, 2023, it is effective from September 8, 2022).

The Respondent denies that the Complainant has established any unregistered trademark rights in the mark MRVAPES. It cites the guidance set out in section 1.3 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) and contends that it is insufficient for the Complainant merely to have produced evidence of company registrations and domain name registrations. It submits in particular that the Complainant has provided no evidence of sales under the mark, the nature and extent of advertising, or the degree of public recognition of the mark.

The Respondent submits that, since it registered the disputed domain name before the Complainant had obtained any relevant registered or unregistered trademark rights, it cannot have registered the disputed domain name in bad faith. It relies on the decision in *Pedro Amador Lopez v. Visel Ce*, WIPO Case No. [D2008-0671](#), for the proposition that a domain name registrant cannot foresee a then non-existent right.

The Respondent states that it is entitled in any event to register a domain name which is comprised of generic or descriptive words and that such domain names are available on a “first come first served” basis. It submits that “vape” is a common word, meaning a device used for inhaling vapour containing nicotine and flavouring and that “mr” is a common abbreviation for “mister”.

The Respondent submits that the disputed domain name was first registered in 2012 (albeit by a different registrant) and that the Complainant is now barred from bringing a complaint about the disputed domain name owing to the doctrine of laches.

The Respondent contends that, since the Complainant had no trademark rights at the time the disputed domain name was registered, this proceeding has been brought in bad faith in an attempt at Reverse Domain Name Hijacking (“RDNH”).

7. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of registered trademark rights in the mark MRVAPES. The disputed domain name is identical to that trademark, ignoring the generic Top-Level Domain (“gTLD”) “.com” which may typically be disregarded for the purpose of comparison under paragraph 4(a)(i) of the Policy. The fact that the disputed domain name may have been registered before the date of the Complainant’s trademark registration is also immaterial to the assessment under paragraph 4(a)(i), although it may be relevant to the issues to be considered under the second and third elements of the Policy.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainant’s submissions set out above give rise to a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent maintains that it has rights or legitimate interests in respect of the disputed domain name because the Complainant had no registered or unregistered trademark rights at the date it acquired the disputed domain name, and/or it is entitled to register a domain name comprised of generic or descriptive words.

For the reasons set out below, the Panel rejects the Respondent’s submission that the Complainant had no trademark rights at the date the disputed domain name was acquired. Furthermore, while the terms “mr” and “vapes” may be dictionary terms when used individually, the Panel finds them to be distinctive when used in combination, that the mark MRVAPES has become a source identifier of the Complainant’s goods and services in Australia and New Zealand in particular, and that the Respondent registered and has used the disputed domain name to target the Complainant’s trademark.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

In order to succeed in establishing the third element of the Policy, the Complainant must demonstrate that the disputed domain name was both registered and has been used in bad faith. The Respondent says that it cannot have been registered in bad faith, since the Complainant had no registered or unregistered trademark rights in the mark MRVAPES when the Respondent acquired the disputed domain name in August 2022.

Since the Complainant’s trademark was not registered until September 2022, the Complainant must establish that it had unregistered trademark rights at that time (or that the Respondent took advantage of “nascent” trademark rights, knowing of the Complainant’s intentions). In this regard, the Respondent rightly points to section 1.3 of [WIPO Overview 3.0](#), which states:

“To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys...

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning...”

The Respondent is correct that the Complainant has failed to provide relevant evidence of sales, advertising or public recognition in connection with its MRVAPES trademark. Nevertheless, the Panel accepts the Complainant's submissions (which the Respondent does not dispute) that it has used the MRVAPES mark in commerce since about 2018 and, significantly, that the Respondent Jesse Sodhi signed up to the Complainant's mailing list in March 2021.

The Panel also has regard to the further guidance provided in paragraph 1.3 of [WIPO Overview 3.0](#) as follows:

"The fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier."

The Panel finds in all the circumstances that the Complainant had obtained unregistered trademark rights in the MRVAPES mark, particularly in Australia and New Zealand, at the date the Respondent acquired the disputed domain name, and that the Respondent did so in the knowledge of the Complainant's mark and with the intention of taking unfair advantage of it.

In this proceeding, the Respondent has based its case exclusively upon the assertion that the Complainant had no relevant trademark rights at the date the Respondent acquired the disputed domain name. It does not, therefore, dispute the Complainant's allegations that the Respondent is a competitor of the Complainant, that Mr Sodhi signed up to the Complainant's mailing list in March 2021, that the Respondent acquired the disputed domain name in the knowledge of the Complainant's use of the MRVAPES mark, or that it has operated a website which includes the MRVAPES mark and content taken from the Complainant's own website and is intended to mislead Internet users. The Panel finds on the evidence that the Complainant's submissions in this regard are established and that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel finds in the circumstances that the disputed domain name has been registered and is being used in bad faith.

D. Respondent's Other Contentions

Concerning the Respondent's contention that the doctrine of laches should prevent the Complainant from prevailing, the Panel notes first that the Respondent acquired the disputed domain name in 2022. While it may have been first registered in 2012, the Panel considers that any reliance the Respondent may place on laches, or any other equitable doctrine, must be viewed by reference to its own conduct, including its date of acquisition of the disputed domain name, and not that of any previous registrant. The Panel finds in particular that the Respondent has not suffered any detriment as a result of the delay upon which it seeks to rely.

Furthermore, as discussed in section 4.17 of [WIPO Overview 3.0](#), panels under the UDRP do not generally accept submissions based on delay in bringing a complaint as barring that complaint from succeeding: the UDRP is injunctive rather than compensatory in nature and its principal concern is to halt ongoing, or avoid future, abuse or damage and not to provide equitable relief.

Concerning the Respondent's allegation that the Complaint represents an attempt at RDNH, no such enquiry arises in circumstances where the Complainant has been successful in the proceeding. There is no evidence in any event that the Complaint was brought improperly or in bad faith.

8. 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, <mr vapes.com>, be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: September 19, 2023