

ADMINISTRATIVE PANEL DECISION

Trader Joe's Company v. Domain Name
Case No. D2023-5344

1. The Parties

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

Respondent is Domain Name, United States.

2. The Domain Name and Registrar

The disputed domain name <traderjoe.com> (the "Domain Name") is registered with Dynadot Inc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 22, 2023. On December 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 26, 2023, 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 (Registration Private (Unknown)) and contact information in the Complaint. The Center sent an email to Complainant on December 27, 2023, 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 December 28, 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 Respondent of the Complaint, and the proceedings commenced on January 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 25, 2024. The Response was filed with the Center on January 25, 2024.

The Center appointed Robert A. Badgley as the sole panelist in this matter on February 6, 2024. 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 alleges that it “owns the TRADER JOE’S brand and has used TRADER JOE’S and TRADER JOE’S-formative trademarks in connection with grocery store services and grocery goods since 1967.”

Complainant holds several trademark registrations with the United States Patent and Trademark Office (“USPTO”) for the mark TRADER JOE’S, including USPTO Reg. No. 1,420,628, registered on December 9, 1986, in connection with “specialty grocery store services.”

Complainant also owns the domain name <traderjoes.com> and uses that domain name to host its commercial website.

According to Complainant:

“Complainant owns and operates over 530 grocery stores under the TRADER JOE’S mark. Complainant promotes its stores with a newsletter, “The Fearless Flyer,” which is distributed at Trader Joe’s stores, through email to more than 700,000 customers throughout the United States, through a podcast throughout the United States, through social media on numerous online platforms, and through its website at www.traderjoes.com. Complainant’s website receives over 3.4 million visitors monthly—a particularly high number given that customers cannot place orders on the website. Complainant has over 2.7 million followers of its Trader Joe’s Instagram account. As a result of such use, ‘TRADER JOE’S’ has become a distinctive identifier associated exclusively with the Complainant’s goods and services.”

Absent from the record is any evidence of the degree of renown that the TRADER JOE’S mark may have enjoyed back in 1998, when the Domain Name was first registered by Respondent (see below). A brief perusal of Complainant’s website (the “About Us” page) does not provide any probative evidence of the mark’s renown in 1998, either.

The Domain Name was registered on October 11, 1998. This is the date reflected in the Whois database, and Complainant alleges that “Respondent registered the domain in 1998.” As such, there appears to be common ground that Respondent registered the Domain Name in 1998 and has held the registration since then.

The Domain Name currently resolves to a fairly basic website that bears the header, “TraderJoe.com – Stock Market Trading for the Average Joe,” and then states, “TraderJoe.com since 1998.” After a few lines of content related to investment activities, two educational videos concerning investing are purportedly made available.

Complainant alleges:

“The only content on the website is a few lines of text that do not reference any specific goods or services and links to a pair of YouTube videos that also fail to reference any specific goods or services. Respondent owned the traderjoe.com domain for over one year and has displayed only the same, minimal content for at least the last 18 months.”

According to a screenshot made available via the Wayback Machine (www.archive.org) and annexed to the Complaint, Respondent’s website as of March 1, 2000 was a fairly rudimentary site that featured various bullet-point items with apparent hyperlinks, including: “News and Internet Technology Information”; “Online Search Engines”; and “Online Investment Portal (Financial Information/Stocks/Options/Investing) – Send Email”.

Respondent's website as of March 1, 2000 also bore the following disclaimer and copyright notice:

TraderJoe.com is not associated to Trader Joes Health Food Store.
TraderJoe.com and its marks are properties of TraderJoe.com and its associates.
© 1999 - 2000 TraderJoe.com!!
Trader Joe, TraderJoe.com and the TraderJoe.com DESIGN are servicemarks and trademarks of
TraderJoe.com!

There is no disclaimer at Respondent's current website.

Also annexed to the Complaint is a Wayback Machine screenshot showing the website to which the Domain Name resolved as of October 21, 1997. That website was rudimentary, but features a stylized logo for TRADER JOE'S and the phrase "Great Gifts for All Ages!!" This stylized logo does not resemble any of Complainant's stylized logos, at least as far as the record in this case reflects.

Respondent denies that he owned the Domain Name prior to October 11, 1998, and therefore the October 21, 1997 "TRADER JOE'S" website cannot be attributed to him.

Complainant seems to allege that at one point actual confusion has occurred between the Domain Name and Complainant's mark (stating "Complainant's arguments are not only based on past confusion but on the likelihood of future confusion."). Complainant, however, provides no evidence to support this assertion.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name. As indicia of Respondent's bad faith, Complainant cites, among other things, the close similarity of Complainant's TRADER JOE's mark and the Domain Name, the fact that actual confusion has occurred, the fact that Respondent registered the Domain Name under the registrant name "Domain Name," the fact that Respondent's website is fairly rudimentary, and the fact that, in March 2000, Respondent's website bore a disclaimer of affiliation with Complainant.

B. Respondent

Respondent asserts that he has been legitimately using the Domain Name in connection with his own business. According to Respondent:

"The Respondent is using the domain for several years connected to the goods and services, consulting, advisory in the line of Stock Marketing, Trading, Investing, and Advisory. Respondent has had the domain for approximately 25 years." [...]

"The domain was registered to represent a 'trader' that being a 'trader who trades stocks and options' 'joe' being an 'average joe'. In fact, a current and historic archive will show that Respondent's use of the domain referenced 'joe' to being an 'average joe', and not of the complainant whatsoever. The registration of traderjoe.com is singular and refers to an 'average joe' being able to be a trader. It has nothing to do with a joe offering groceries for sale."

Respondent argues that Complainant's criticism of Respondent's website as being rather undeveloped (and, by implication, not reflective of a legitimate business), is "subjective." Respondent also states that he removed the disclaimer of affiliation with Complainant (on the March 1, 2000 site) was because it had become obvious that Respondent's business was unrelated to Complainant's.

6. Discussion and Findings

Policy paragraph 4(a) lists the three elements Complainant must satisfy regarding 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 mark TRADER JOE'S through registration and use demonstrated in the record. The Panel also finds the Domain Name to be confusingly similar to that mark. The entirety of Complainant's mark, except for the apostrophe and the "s," is contained within the Domain Name. Complainant's mark is recognizable within 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 need not address this element, given its conclusion below on the "bad faith" issue.

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.

This is not a straightforward case, in part because the record presented by the Parties leaves some open questions. The UDRP is designed to address clear cases of cybersquatting, and it is Complainant's burden to prove, on a balance of probabilities, that Respondent more likely than not targeted Complainant's trademark for improper purposes. On the record provided here, Complainant has fallen short of meeting its burden in this respect.

There are some reasons to suspect Respondent's bona fides here. First, the use of "Domain Name" as the name of the Domain Name registrant in the Whois record raises an eyebrow. Typically, a legitimate business will not resort to a registrant name like that. Second, although Respondent's website has purported to offer investment-related advice for roughly 25 years, Respondent provides no independent evidence of his business, such as marketing materials, business registration information, correspondence with third parties using "Trader Joe" as a business name or mark, or other documentation not found on his website. Third, Respondent's website, after 25 years of Respondent allegedly conducting a business, is quite undeveloped. Fourth, the disclaimer on the March 1, 2000 iteration of Respondent's website suggests that, at least as of that date, Respondent had become aware of Complainant and its TRADER JOE'S mark.

In sum, Respondent presents a somewhat plausible, if internally consistent, account of his adoption of the term "Trader Joe" and his registration and use of the Domain Name, but does very little to corroborate his story with contemporaneous documentary evidence.

On the other hand, Complainant has not put forward powerful reasons to support a finding of Respondent bad faith. First, Complainant has not shown that its TRADER JOE'S mark, although registered well before 1998, was sufficiently well-known by that time that Respondent would have been aware of it or, even if he had been aware of it, that Respondent would have known the mark is so strong that he should be wary of using "Trader Joe" in connection with his own business.

Second, Complainant argues that Respondent's provision of services totally unrelated to Complainant's services underscores Respondent's bad faith, but this fact actually helps Respondent. A finding of bad faith would have been easier to make if Respondent had been offering goods and services similar to Complainant's.

Third, although Respondent's website is not among the most sophisticated sites on the Internet, the quality of one's website is not necessarily dispositive, and sometimes is not even probative, of a respondent's bad faith. What is apparent from the record is that, as early as March 1, 2000, Respondent's website was purporting to offer investment-related information and services. The final bullet-point on that web page stated: "Online Investment Portal (Financial Information/Stocks/Options/Investing) – Send Email." (This was the only bullet-point which invited the user to send an email.)

Fourth, although Respondent evidently was aware of Complainant's TRADER JOE'S mark as of March 1, 2000, there is no evidence that he was aware of it on October 11, 1998, when he registered the Domain Name. Moreover, knowledge of a trademark is not the same thing as intent to target a mark for improper purposes.

Fifth, Complainant seems to assert that actual confusion between its trademark and the Domain Name has occurred, but Complainant provides no evidence of this. Making bald assertions without evidentiary support can undermine a party's credibility. Even assuming this assertion is true, especially as it is not dated and provides no context or specifics, it would not necessarily answer the question of whether the Respondent targeted the Complainant in bad faith.

Sixth, and above all, Complainant initiated this proceeding 25 years after Respondent registered the Domain Name. Given the similarity of the Domain Name and Complainant's trademark, and the fact that the Domain Name has a gTLD ".com" – the most coveted of gTLDs – Complainant's inaction vis-à-vis this Domain Name for 25 years raises questions. Complainant does not state when it first became aware of the Domain Name, and does not explain why it did not send a cease-and-desist letter to Respondent after learning that the Domain Name had been registered and was being used for 25 years. Although the doctrine of laches is generally not accepted as a viable defense under the UDRP, an extraordinary lapse of time (here, 25 years) may reflect the merits of a Complainant's case.

A review of the four non-exclusive bases for bad faith under the Policy, quoted above, does not yield a favorable outcome for Complainant in the circumstances of this case. Notably, with regard to Policy paragraph 4(b)(i), the record shows that Respondent has owned the Domain name for 25 years, and has never reached out to Complainant with an offer to sell the Domain Name (let alone for a hefty profit).

With reference to Policy paragraph 4(b)(ii), there is no evidence that Respondent has engaged in a pattern of registering multiple domain names with the intent to prevent a trademark owner from reflecting its mark in a domain name.

With reference to Policy paragraph 4(b)(iii), it is common ground that the Parties are not engaged in the same line of business.

With reference to Policy paragraph 4(b)(iv), the Panel does not find, on this record, that Complainant has proven that Respondent targeted Complainant's mark with the intent to trade off the fame of that mark and thereby divert Internet traffic for commercial gain.

Complainant has failed to establish Policy paragraph 4(a)(iii).

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

Here, the Panel declines to make a finding of RDNH. Respondent's main argument in this connection is that Complainant falsely put into evidence the October 21, 1997 website using the TRADER JOE'S mark (i.e., with the final "s"), even though Respondent did not own the Domain Name at that time. The Panel does not view this as legerdemain on Complainant's part. Rather, the Panel interprets Complainant's use of that exhibit as a suggestion that Respondent had reason to be aware of Complainant's mark because this 1997 site used TRADER JOE'S rather than "trader Joe." Notably, Complainant did not expressly assert that this site was put up by Respondent (though Complainant came close to doing so). In these circumstances, the Panel does not believe that Complainant has attempted RDNH.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: February 20, 2024