

ADMINISTRATIVE PANEL DECISION

JUUL Labs, Inc. v. Lucky Nazma
Case No. DAE2024-0006

1. The Parties

The Complainant is JUUL Labs, Inc., United States of America, represented by Saba & Co. IP, Lebanon.

The Respondent is Lucky Nazma, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <juulpodsduhai.ae> is registered with AE Domain Administration (.aeDA).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 18, 2024. On March 20, 2024, the Center transmitted by email to AE Domain Administration (.aeDA) a request for registrant verification in connection with the disputed domain name. On March 21, 2024, .aeDA transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the UAE Domain Name Dispute Resolution Policy for – UAE DRP approved by .aeDA (the “Policy”), the Rules for UAE Domain Name Dispute Resolution Policy – UAE DRP (the “Rules”), and the Supplemental Rules for UAE Domain Name Dispute Resolution Policy – UAE DRP (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 28, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was April 17, 2024. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent of the Commencement of Panel Appointment Process on April 26, 2024.

The Center appointed Zoltán Takács as the sole panelist in this matter on May 1, 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

The Complainant is an American electronic cigarette company headquartered in San Francisco, California.

The Complainant makes JUUL branded electronic nicotine delivery systems (“ENDS”), USB charging docks, e-liquid pods with nicotine and other ENDS related products and has become one of the market leaders for the sale of these products since entering the ENDS market in 2015.

Juul Pods are components used in JUUL branded electronic cigarettes, disposable, non-refillable cartridges that contain a proprietary nicotine-containing e-liquid formulation which when heated allow users to inhale the vapor.

The Complainant is owner of a global portfolio of trademark registrations consisting of and or comprising the terms “Juul” and “Juul Pods”, including:

- the International Trademark Registration (“IR”) No. 1494781 for the word mark JUUL registered since September 17, 2019 for electronic cigarettes and related goods, and
- IR No. 1481913 for the word mark JUULPODS registered since June 17, 2019 for electronic cigarettes and related products.

Among others the Complainant owns the domain name <juul.com>, which was registered on June 6, 1997 and resolves to its corporate website.

The disputed domain name was registered on November 29, 2023 and resolves to an online shop that offers for sale the Complainant's, as well as competing third party products of other commercial origin.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- the disputed domain name, which consists of its trademark JUULPODS with addition of the term “Dubai” is confusingly similar to the trademark;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the use of the disputed domain name for a website that offers for sale the Complainant's and competing products of other commercial origin is evidence of the Respondent's awareness of the Complainant and its trademark and indication of bad faith registration and use of the disputed domain name.

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

B. Respondent

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

6. Discussion and Findings

6.1 Nature of the UAE Domain Name Dispute Resolution Policy

The Panel notes that the UAE Domain Name Dispute Resolution Policy is substantially similar to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and will in this case refer to prior UDRP cases and principles as well as the applicable sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), where applicable.

6.2 Substantive Matters

A complainant must evidence each of the three elements required by paragraph 6(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Complainant’s mark JUULPODS is reproduced within the disputed domain name. The addition of the term “Dubai” does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy.

The applicable Top Level Domain (“TLD”), in this case “.ae”, which as a standard registration requirement is disregarded under the first element test. [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 6(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests to the disputed domain name for purposes of Section 6(a)(ii).

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy of otherwise.

The Respondent is not affiliated with the Complainant in any way and the Complainant has not authorized the Respondent to use its marks in a domain name or otherwise.

The disputed domain name resolves to a website promoting a web shop that offers for sale the Complainant's products (inclusive of the Complainant's marks), as well as the competing MYLÉ branded vaping products.

While UDRP panels have recognized the limited rights of reseller to use a third party's trademark, such use must satisfy fair use requirements e.g., as describe in [WIPO Overview 3.0](#), section 2.8.

At the bottom of the website at the disputed domain name the Respondent displays a disclaimer stating that "WWW.JUULPOSDUBAI.AE HAVE NO AFFILIATION WITH JUUL OR MYLE VAPE. THIS IS NOT OFFICIAL WEBSITE OF MYLE OR JUUL VAPE. INC". The Complainant alleges without any supporting evidence that this disclaimer has been added after it sent a cease-and-desist letter to the Respondent.

The Panel notes – without making any determination as to whether the disclaimer is clear and sufficiently prominent within the applicability of the *OKI Data* test - that regardless of whether the Respondent added the cited disclaimer prior to or after receiving the Complainant's cease-and-desist letter in relation to the disputed domain name the Respondent's website does not qualify as fair use under the *OKI Data* criteria because of offering for sale competing third party products (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and [WIPO Overview 3.0](#), section 2.8).

The Panel finds that the second element of the Policy has been established.

C. Registered or is Being Used in Bad Faith

The Panel notes that for the purposes of paragraph 6(a)(iii) of the Policy, paragraph 6(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case the Panel notes that the disputed domain name reproduces the Complainant's marks and that the registration of the disputed domain name occurred years after the Complainant's registration of its marks. The Panel also notes that on the website at the disputed domain name the Respondent offers for sale the Complainant's JUUL branded products (but also the MYLÉ branded competing vaping products) displaying the Complainant's marks, imagery and its distinctive logotype.

Thus, in view of the Panel the Respondent had actual knowledge of the Complainant and its marks at the time of registration of the disputed domain name which it obtained and is using in order to profit from or exploit the Complainant's marks.

As mentioned above the Respondent disclaims any affiliation with the Complainant, however in order for a disclaimer to be considered in the context of good faith conduct under the *OKI Data* test the Respondent would have to have a right or legitimate interest in the disputed domain name, e.g., legitimately provide goods and or services related to the complainant's mark only, which for the reasons discussed above in Section 6.B. is not the case here.

The Respondent is using the disputed domain name to divert Internet users to its website for commercial gain by - beside the Complainant's JUUL branded products - offering for sale competing third party products of other commercial origin, which is indicative of bad faith. [WIPO Overview 3.0](#), section 3.7.

The Panel finds that the Respondent is intentionally attracting for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the website at the disputed domain name within the meaning of paragraph 6(b)(iv) of the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

7. Decision

For the foregoing reasons, in accordance with paragraphs 6(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <juulpodsduhai.ae> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: May 8, 2024