

ADMINISTRATIVE PANEL DECISION

Nicoventures Holdings Limited v. Domain Administrator,
See PrivacyGuardian.org / nextdoor2, next door
Case No. DCO2022-0053

1. The Parties

The Complainant is Nicoventures Holdings Limited, United Kingdom, represented by Demys Limited, United Kingdom.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States of America (“United States”) / nextdoor2, next door, United States.

2. The Domain Name and Registrar

The disputed domain name <vuseonlinestore.co> (“Disputed Domain Name”) is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 5, 2022. On July 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 5, 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 the Complainant on July 7, 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 July 7, 2022.

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 July 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on August 17, 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

The Complainant is part of the group of companies affiliated to British American Tobacco (collectively, "BAT"), a multinational company that sells nicotine based products in approximately 190 countries. The Complainant holds registrations for the trademark VUSE in several countries, including, for example, the United Kingdom Trademark Registration No. 910885994 for the mark VUSE, registered on November 27, 2012 in classes 9 and 34, which it uses to designate a line of cigarette alternative 'vaping' products.

The Disputed Domain Name <vuseonlinestore.co> was registered on March 16, 2022. At the time of filing the Complaint, the Disputed Domain Name resolved to an online store that sells vaping products that resemble or compete with the VUSE products.

5. Parties' Contentions

A. Complainant

The Complainant cites trademark registrations including European Union Trademark Registration No. 010885994 registered on November 27, 2012 in classes 9 and 34 as *prima facie* evidence of ownership.

The Complainant submits that the trademark VUSE is well-known and that its rights in that trademark predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the VUSE trademark, and that the addition of the phrase "online store", or the addition the country code Top-Level Domain ("ccTLD") ".co" is not sufficient to avoid a finding of confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because "there is no conceivable use to which the disputed domain name could be put now, or in the future, that would confer any legitimate interest upon the Respondent", and, citing the usual elements of this prong along with a denial of authorized reseller status and provision of evidence of "prominent, misleading and unauthorized use of the Complainant's VUSE figurative mark on (Respondent's) website", contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules having regard to the widespread prior use of the Complainant's trademark.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) The Disputed 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 with respect to the Disputed Domain Name; and
- (iii) The Disputed Domain Name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules requires the panel to: “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any Rules and principles of law that it deems applicable.”

A. Identical or Confusingly Similar

The Complainant has produced evidence to demonstrate that it has registered trademark rights in the trademark VUSE in the United States and in many countries throughout the world. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the VUSE trademark, the Panel observes that the Disputed Domain Name comprises (a) the Complainant’s trademark VUSE, (b) followed by the phrase “online store”, and (c) followed by the ccTLD “.co”.

It is well established that the ccTLD used as technical part of a domain name may be disregarded. (See section 1.11 of the [WIPO Overview 3.0](#)). The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: “vuseonlinestore”.

As the relevant mark is incorporated in its entirety and as such is recognizable in the Disputed Domain Name, in line with previous UDRP decisions, this Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s VUSE trademark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the addition of the phrase “onlinestore” does not avoid a finding of confusing similarity between the Disputed Domain Name and the Complainant’s trademark. “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.” (See [WIPO Overview 3.0](#), section 1.8).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the respondent may demonstrate rights or legitimate interests in the disputed domain name. The Policy also places the burden on the complainant to establish the absence of respondent’s rights or legitimate interests in the disputed domain name. Because of the inherent difficulties in proving a negative, the consensus view is that the complainant need only put forward a *prima facie* case that the respondent lacks rights or legitimate interests. The burden of production then shifts to the respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it is not his name, there is no license from the Complainant to use the Complainant’s trademark, there is no evidence of the Respondent’s use, or demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods and services, and the evidence is that at the time of filing the Complaint it resolved to a webpage selling products that are either the Complainant’s products or compete with products sold by the Complainant. The Complainant also contends that the nature of the Disputed Domain Name and the associated website content fails to meet the tests that apply to *bona fide* offerings of goods or services by resellers or distributors set out in *Oki Data*

Americas, Inc. v. ASD, Inc., WIPO Case No. [D2001-0903](#).

The uncontested evidence is that the Respondent has not made, and is not currently making, a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers pursuant to paragraph 4(c)(iii) of the Policy. Nor, alternatively, does paragraph 4(c)(ii) of the Policy apply.

This Panel accepts that the Complainant has made out a *prima facie* case that the Respondent lack rights or legitimate interests in the Disputed Domain Name and, in the absence of a Response by the Respondent, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that the complainant must also demonstrate is that the disputed domain name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the content of the website it resolved to, the Panel is satisfied that the Respondent knew of the Complainant's trademark VUSE when it registered the Disputed Domain Name (see *Nicoventures Holdings Limited v. Hemag Nova AG*, WIPO Case No. [DCH2021-0015](#) ("the Claimant's VUSE trademark is highly distinctive").

On the issue of use, the Complainant's evidence is that the Disputed Domain Name diverted to a webstore that unlawfully offered the Complainant's VUSE products for sale including, it appears, into the United States where the Food Drug Administration regulatory approvals are required for such products to be offered for sale. The use of a domain name for *per se* illegitimate activity of this sort can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith (see [WIPO Overview 3.0](#), sections 2.13.1, 2.13.2 and 3.1.4).

In a further finding of bad faith, this Panel also accepts the Complainant's uncontested evidence that a DNS 'mail exchange' (MX) record has been activated, allowing email to be routed to a mail server, in further evidence of bad faith under the policy in view of the increased risk of fraud or phishing (see: *Drägerwerk AG & Co. KGaA v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / BLACK ROSES*, WIPO Case No. [D2020-3167](#) ("Furthermore, the certificate and the MX record relating to the disputed domain name suggest that it is or was possibly used for email communication. Under these circumstances, the Panel considers it likely that the Respondent intended to use the disputed domain name as a support for a potential fraudulent email scheme, namely to impersonate the Complainant and extract personal or financial data from persons believing that the communication comes from the Complainant").

In the absence of any evidence to the contrary, this Panel accepts the Complainant's evidence, and finds that the Respondent has taken the Complainant's trademark VUSE, along with the phrase "onlinestore", without the Complainant's consent or authorization, for the purpose of capitalizing on the reputation of the trademark to infringe upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 <vuseonlinestore.co> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: August 24, 2022