

Decision for dispute CAC-UDRP-106942

Case number	CAC-UDRP-106942
Time of filing	2024-10-18 09:56:33
Domain names	elfbar5000bulgaria.com, elfbar5000sverige.com, elfbar600norge.com, elfbarbelgique.net, elfbarbestellenbelgie.com, elfbar600v2bulgaria.com, elfbarokusi.com, elfbarvapeargentina.com, elfbarflavoursireland.com, elfbartyskland.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Imiracle(Shenzhen)Technology Co.,Ltd.
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Complainant representative

Organization	Lei Zhang (Shenzhen ChofnIntellectual Property Agency Co, LTD.)
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Respondents

Name	Isabella Begum
Name	Rosie Hewitt
Name	ALMARCHA FERRANDEZ AARON
Name	Kai Singh
Name	ESCOTE VARGAS ALEJANDRO
Name	GRAU SANCHIS ALEJANDRO
Name	ALONSO ROLO IDALBERTO

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant owns the following trademark registrations:

- EU Trade Mark No. 018365272 for ELFBAR, registered on 19 May, 2021, designating goods and services in international class 34;
- UK Trade Mark No. UK00003646223 for ELFBAR, registered on 15 October 2021, designating goods and services in international class 34;
- WIPO Trade Mark No. 1619099 for ELFBAR and Design, registered on July 22, 2021, designating goods and services in international class 34;
- WIPO Trade Mark No. 1655885 for ELFBAR and Design, registered on March 10, 2022, designating goods and services in international class 34.

FACTUAL BACKGROUND

The Complaint in this case, was established in 2017. At the beginning of 2020, Complainant successfully launched the ELFBAR brand and quickly became a leader in the electronic atomization and e-cigarettes industry. The Complainant now has offices or operations in more than 50 countries, cities, and regions including China, Hong Kong, the United Kingdom, Ireland, Germany, France, Italy, Spain, the United States, and many other places around the world. It serves more than 10 million users around the world and more than 300,000 retail outlets worldwide. The Complainant's authorized distributor has sold more than USD \$132 million worth of ELFBAR e-cigarettes in 2022 alone. The mark is promoted through social media and, for example, the elfbar hashtag on TikTok had 1.5 billion views at the start of 2023. The various e-cigarette product models are identified by specific numerical designations such as Elf Bar 600, Elf Bar 5000, and Elf Bar 600v2.

The websites that resolve from the disputed domain names display the ELFBAR trademark and its graphic logo as well as images of the Complainant's products.

PARTIES CONTENTIONS

COMPLAINANT

The disputed domain names are identical or confusingly similar to terms in which the Complainant has rights as each one copies the ELFBAR trademark and adds words, numbers, or letters that correspond to the Complainant's product models or the geographic locations of its business.

The Respondent has no rights or legitimate interests in the disputed domain names where it has never been authorized to use the ELFBAR trademark and it misleads consumers by hosting websites that make extensive use of the mark as well as images of the Complainant's products and are identical to the content of the programme operated by the Complainant.

The disputed domain names were registered and are used in bad faith as shows by the Respondent's hosting of websites that are identical to those operated by the Complainant. Further, the Respondent's registration of multiple confusingly similar domain names demonstrates a pattern of bad faith conduct and precludes the possibility that the Respondent may have inadvertently chosen these names.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the

disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

Multiple Respondents

The Whois records for the ten disputed domain names identify different registrant names. However, the Complainant names these registrants as the Respondents in this proceeding and requests that the disputed domain names and the named Respondents be consolidated in a single UDRP proceeding.

Paragraph 4(f) of the Policy provides that “[i]n the event of multiple disputes between [a respondent] and a complainant, either [the respondent] or the complainant may petition to consolidate the disputes before a single Administrative Panel....” This is allowed where it “promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, reduces the potential for conflicting or inconsistent results arising from multiple proceedings, and generally furthers the fundamental objectives of the Policy.” See, e.g., *MLB Advanced Media, The Phillies, Padres LP v. OreNet, Inc.*, D2009-0985 (WIPO Sep. 28, 2009); *Instant Brands LLC v. Zhen Sheng Dai, Wen Zhou Fu Jie Jin Rong Xin Xi Fu Wu You Xian Gong Si*, UDRP-105512 (CAC July 7, 2023). Further, paragraph 3(c) of the Rules provides that “[t]he complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.” UDRP panels have looked to a variety of factors in determining whether multiple domain names are, in fact, of common ownership. WIPO Overview 3.0 at par. 4.11.2. Such factors as similarities in the Whois information and similar naming conventions in the disputed domain names, etc. may lead to the conclusion that domain names with some differing registrant names are, nevertheless, owned by a single entity. See, e.g., *Delta Dental Plans Association v. ICS INC., et al.*, D2014-0474 (WIPO June 16, 2014) (Consolidation of 31 domains allowed where “[t]he Panel notes that each of the disputed domain names follows an identical naming convention, namely (DELTA DENTAL marks+ of + state name or two-letter state abbreviation); (“while the names of the registrants of the Domain Names are different”, consolidation allowed where “[t]he Domain Names have a ‘quasi identical structure’” and “[b]oth registrants email addresses include the term ‘gamester’ before the ‘@’ symbol.”).

In the present case, the Registrants of the various disputed domain names are different. However, the disputed domain names use a naming pattern that involves the trademark followed by a geographic location and often the model number of one of the Complainant’s products. Further, the Whois records for the disputed domain names identify the same Registrar for all and very similar email addresses for the Registrants – all following the pattern of the Registrant’s name followed by “@cxtmail.com”. The Registrant postal addresses are also, to a large degree, grouped in pairs, two each in Hamburg, Germany; Alicante, Spain; Sevilla, Spain; and one each in Carabanchel and Valencia, Spain. The disputed domain names were also registered in groups: seven of them on 30 April, 2024, two on 10 May, 2024, and one on 1 August, 2024. Finally, all of the disputed domain names are hosted at various servers at Cloudflare.com and the content of each resolving website is rather similar displaying the ELFBAR trademark and graphic logo as well as photographs of e-cigarette or vaping products that appear to have been copied from the Complainant’s own website. In view of these similarities between the disputed domain names the Panel finds it more likely than not that all of them are owned by the same person and that the Registrant names shown in the Whois records are aliases created by the same individual. Thus, by a preponderance of the evidence presented, the Panel finds sufficient grounds to conclude that it would be equitable and procedurally efficient to permit the consolidation of the ten disputed domain names into this single case.

The Panel is satisfied that all other procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. Confusing Similarity

The Complainant has established its rights to the ELFBAR trademark through its submission into evidence of various trademark registration certificates, the earliest of which is dated on 19 May, 2021.

The disputed domain name combines the Complainant's trademark with various geographic locations and, in some cases, the model numbers of certain of the Complainant's products. Each of them also uses the ".com" gTLD. These additions to the term "ELFBAR" do not dispel the confusing similarity between the disputed domain names and the Complainant's trademark. *Avast Software s.r.o. v. Milen Radumilo*, 102384 (CAC April 19, 2019) ("it is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity.").

Also, the extension ".com" typically adds no meaning or distinctiveness to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. *Novartis AG v. Wei Zhang*, 103365 (CAC December 9, 2020) ("it is generally accepted that the addition of the top-level suffix in the domain name (e.g., '.com') is to be disregarded under the confusing similarity test").

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of geographic terms and product model numbers thereto in the disputed domain names are insufficient to avoid a finding that they are confusingly similar to the Complainant's trademark. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

2. Rights Or Legitimate Interests

Pursuant to Paragraph 4(a)(ii) of the Policy, the complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in the disputed domain name. *Cephalon, Inc. v. RiskIQ, Inc.*, 100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy offers the respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

With reference to Paragraph 4(c)(ii) of the Policy the Complainant states that "the Respondent is not in the identity of the Complainant's distributor or partner. The Complainant has never directly or indirectly authorized the Respondent to use the trademarks ELFBAR and the corresponding domain names in any form." The Respondent has not participated in this case and so it does not contest this. As such, the Panel concludes that the Respondent is not affiliated with the Complainant, nor is it authorized or licensed to use the Complainant's trademark or to seek registration of any domain name incorporating the asserted trademark. Furthermore, the Registrar for the disputed domain names identifies the Registrants variously as "Isabella Begum", "Rosie Hewitt", "Almarcha Ferrandez Aaron", "Kai Singh", "Almarcha Ferrandez Aaron", "Grau Sanchis Alejandro", "Escote Vargas Alejandro", "Alonso Rolo Idalberto", "Khalil Ahmad", and "Escote Vargas Alejandro". There is no evidence that the Respondent is known otherwise and its use of the Complainant's trademark on its website does not, alone, support a different conclusion. *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, D2000-0847 (WIPO October 16, 2000) ("use which intentionally trades on the fame of another" should not be considered. "To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.") Based upon the available evidence in this case, the Panel cannot conclude that the Respondents are commonly known by the disputed domain names.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. The disputed domain names resolve to websites that copy the ELFBAR logo, text, and images from the Complainant's own legitimate website at www.elfbar.com. Using a confusingly similar domain name to impersonate and pass oneself off as a Complainant is not a bona fide offering of goods or services or a legitimate non-commercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy. See *Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund*, FA 1790949 (FORUM July 9, 2018) (no right or legitimate interest found where "the Domain Name, deliberately and inherently impersonates the Complainant and its trade marks."). Here, the Complainant claims that "the websites to which the disputed domain names point are identical to the content of the programme operated by the Complainant". The Complainant provides screenshots of the Respondent's resolving websites and the Panel notes that these, in fact, copy significant elements of the Complainant's site including display of the ELFBAR trademark and logo as well as many photographs of the Complainant's e-cigarette products and other graphic elements. The Complainant's assertion that this use of its trademark is for the purpose of impersonation and illicit commercial gain appears well-founded and the Respondent has not filed a Response or made any other submission in this case to offer an alternative explanation for its actions. As the Complainant has made out a prima facie case that has not been rebutted by the Respondent, upon a preponderance of the evidence before it the Panel finds that the Respondent fails to make a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

3. The disputed domain names were registered and used in bad faith

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. Further guidance on that requirement is found in Paragraph 4(b) of the Policy, which sets out four examples of possible actions by the Respondent that may satisfy this burden of proof.

Inherently prerequisite to a finding of bad faith under Paragraph 4(a)(iii) of the Policy is some attribution of knowledge of the Complainant’s claimed trademark, whether actual or based upon a conclusion that the Respondent should have known of the trademark. See, Domain Name Arbitration, 4.02-C (Gerald M. Levine, Legal Corner Press, 2nd ed. 2019) (“Knowledge and Targeting Are Prerequisites to Finding Bad Faith Registration”); USA Video Interactive Corporation v. B.G. Enterprises, D2000-1052 (WIPO December 13, 2000) (claim denied where “Respondent registered and used the domain name without knowledge of Complainant for a bona fide commercial purpose.”). See also, WIPO Overview 3.0, par. 3.1.1 (when examining whether “circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark”, panels may consider such issues as “the respondent’s likely knowledge of the complainant’s rights”). Here, the Complainant asserts that the Respondent had actual knowledge of the ELFBAR trademark at the time that it registered the disputed domain names based on the number of domain names and the content of their resolving websites. The Panel agrees and finds that the Respondents had actual knowledge of the Complainant’s mark and registered the disputed domain names in bad faith.

Next, the Complainant argues that the Respondents registered and use the disputed domain names in bad faith as the Respondents pass itself off as the Complainant. Using a confusingly similar disputed domain names to pass oneself off as a complainant can demonstrate bad faith under Paragraphs 4(b)(iii) and (iv) of the Policy. See Harley-Davidson Motor Company Inc. v. Liu Peng et al., UDRP-106275 (CAC March 27, 2024) (“use of a disputed domain name to pass off as a complainant and offer competing or counterfeited goods may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv).”). As noted above, the Complainant provides screenshots of the Respondent’s websites and the Panel notes that they copy many elements from the Complainant’s website including the ELFBAR logo, pictures of the Complainant’s products, and other graphic elements. The Respondents have not participated in this case to explain its actions and so, based upon a preponderance of the available evidence, the Panel finds it highly likely that the Respondents registered and use the disputed domain names in bad faith by seeking commercial gain through impersonation of the Complainant and confusion with its trademark, per Paragraph 4(b)(iv).

Finally, Complainant argues that Respondent has exhibited a pattern of bad faith registration and use. Under paragraph 4(b)(ii) of the Policy, registration of multiple disputed domain names which violate the Policy may demonstrate a pattern of bad faith registration and use. See Hoosier Racing Tire Corp. v. Zhang Qiang, UDRP-106828 (CAC November 6, 2024) (“Moreover, the Panel finds that the Respondent has also engaged in a pattern of bad faith conduct of targeting the Complainant’s HOOSIER trademarks by registering 12 domain names including the HOOSIER trademark in its entirety.”). The Panel notes that there are ten confusingly similar disputed domain names at issue in this case. In light of this fact, the Panel agrees that Respondents have registered the disputed domain names in order to prevent Complainant from reflecting its mark in a disputed domain names and that it has engaged in a pattern of such conduct under paragraph 4(b)(ii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

- 1. **elfbar5000bulgaria.com**: Transferred
- 2. **elfbar5000sverige.com**: Transferred
- 3. **elfbar600norge.com**: Transferred
- 4. **elfbarbelgique.net**: Transferred
- 5. **elfbarbestellenbelgie.com**: Transferred
- 6. **elfbar600v2bulgaria.com**: Transferred
- 7. **elfbarokusi.com**: Transferred
- 8. **elfbarvapeargentina.com**: Transferred
- 9. **elfbarflavoursireland.com**: Transferred
- 10. **elfbartyskland.com**: Transferred

PANELLISTS

Name Steven Levy Esq.

DATE OF PANEL DECISION 2024-11-22

Publish the Decision