

Decision for dispute CAC-UDRP-107605

Case number **CAC-UDRP-107605**

Time of filing **2025-06-03 09:27:44**

Domain names **lostmarydirect.com**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainants

Organization **Dashing Joys Limited**

Organization **Imiracle (Shenzhen) Technology Co., Ltd**

Respondent

Name **Mohammad Zafar**

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 name.

IDENTIFICATION OF RIGHTS

Complainants are the owners, among others, of the following trademark registrations:

1. **International Registration according to the Madrid Protocol No. 1616521A for LOST MARY, registered on 4 August 2021 for goods in the International Class 34 (i.a. cigarettes and oral vaporizers for smokers), designating many countries throughout the world.**

This trademark registration is in the name of Dashing Joys Limited.

Complainants submit evidence of the registration by means of an extract from the Madrid database of WIPO.

2. **Switzerland Trademark No. 787934 for LOST MARY, registered on 14 October 2022, for goods in international classes 34**

Complainants submit two letters, originating from the Swiss Federal Institute of Intellectual Property. The first is in German and is meant to provide evidence for the registration of LOST MARY word mark in Switzerland. The second letter is in French and is meant as evidence of the assignment of the trademark to Dashing Joys Limited on 19 January 2024.

3. **Australia Trade Mark No. 2314349 for LOST MARY, registered on 11 November 2022, for goods in international classes 34. The trademark is registered in the name of Dashing Joys Limited.**

Complainants submit a certificate of registration originating from the IP Office of Australia.

As the language of proceedings is English, the Panel will take into account the International Registration and the Australian registration for the trademark LOST MARY.

Respondent registered the disputed domain name <lostmarydirect.com> on 30 November 2023.

The LOST MARY trademark registrations are older than the registration of the disputed domain name.

FACTUAL BACKGROUND

Complainants are two legal entities belonging to the same group, namely Dashing Joys Limited with domicile in Hong Kong and Imiracle (Shenzhen) Technology Co. Ltd, with domicile in Shenzhen, China. Imiracle (Shenzhen) Technology Co. Ltd was established in 2017. Due to the adjustment of the company's business strategy, Dashing Joys Limited has taken over the main business and trademark rights. Complainants illustrate this by submitting a qualification certificate, but due to the fact that it is in Chinese and no translation is provided, the Panel will disregard this evidence.

Complainants state that LOST MARY was founded in 2022 and is the sister brand of the -according to Complainants- famous disposable e-cigarette brand ELF BAR. Like ELF BAR, it is designed and produced by the original ELF BAR team. LOST MARY is a range of vapes that, despite only being launched in 2022, have become one of the most popular brands on the market.

LOST MARY offers a wide range of flavors based on smokers' preferences and is constantly updating its products based on market feedback. LOST MARY has quickly captured the disposable e-cigarette market with its innovative, modern design and reliable quality, and by utilizing readily available e-cigarette distribution channels. As of today, LOST MARY has a presence in more than 50 markets around the world, serving more than 10 million users and more than 100,000 retail stores worldwide.

As alleged by Complainants, the UK is the second largest consumer market for e-cigarettes in the world, and LOST MARY is one of the leading e-cigarette brands in the UK. Lost Mary BM600 disposable vapes range was launched in the UK in April 2022 and was one of the very first 'box-style' disposables to enter the market. Upon launch, BM600 quickly became popular with existing ELF BAR users and e-cigarette users who were new to the brand, thanks to its unique shape and size, stylish branding and similar ELFBAR-like flavors. Following a successful launch, LOST MARY then added to their offering by releasing a more traditional pen-style disposable range - their AM600 - as well as a modern looking and slightly wider proportioned QM600 vape device range. As of the end of 2023, according to data from Nielsen IQ, ELFBAR and LOST MARY e-cigarette sales account for over half of the disposable e-cigarette market in the UK. Both of these brands are owned by Complainants. Complainants submit evidence of these data originating from the website www.ft.com, belonging to the Financial Times.

Complainants continue by informing that according to TIKTOK data, the three official videos on the official LOST MARY UK account have accumulated over 240,000 views and has millions of views on YouTube. Statistics on TIKTOK and YOUTUBE on this video have been submitted. Further, data provided by Similarweb show that the official website of the LOST MARY brand had about 94,600 visits in November 2023, with visitors coming from, inter alia, the United States, the United Kingdom and France.

Complainants submit media coverage informing that a company called Supreme has become master distributor for ELFBAR and LOST MARY in the UK. Further, Complainant alleges and shows that LOST MARY products are currently available for sale on a number of online e-cigarette retail platforms in the UK. In the United States, Complainants currently have a large number of offline shops, the addresses of which can be found on the Complainants' official website. A print screen is attached to the Complaint.

Based on all the above information, Complainants allege that it has a high level of popularity and influence. The core trademark of Complainants, LOST MARY, has gained high distinctiveness through extensive publicity and use. Further, by searching LOST MARY on Google search engine, one can see that all the results point to Complainants according to Complainants. When checking the evidence, the Panel concludes that indeed all results refer to the brand LOST MARY, but the third hit refers to Respondent advertising for LOST MARY products.

The disputed domain name, after the removal of the top-level domain, which can be disregarded according to standard jurisdiction, is composed entirely of LOST MARY plus the English word DIRECT. Complainants explain that DIRECT is defined by Oxford Languages, as meaning "to control the operations of; manage or govern" and is commonly used, including in contexts that indicate a reliable source of goods. Complainants continue by arguing that DIRECT is a generic or descriptive term and, therefore, should not be subject to a confusion comparison test with Complainants' trademark. For this it cited Article 1.8 of the WIPO Jurisprudential Overview 3.0:

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.

In summary, as Complainants conclude that the disputed domain name completely contains Complainants' LOST MARY trademark and is likely to cause confusion.

Moreover, the disputed domain name misleads consumers for the purpose of commercial gain, causing them to believe that there is an

affiliation between Respondent and Complainants, which does not constitute fair use according to article 4 (a) (ii) of the Policy.

Also, Complainants allege that the disputed domain name was registered in bad faith as Respondent knew about the Complainants' use of LOST MARY. Further, Respondent's use of the disputed domain name is to deliberately imitate the Complainants' LOST MARY brand for profit, and this is use in bad faith according to Complainants.

Complainants request the transfer of the disputed domain name.

PARTIES CONTENTIONS

Complainants' contentions are summarised in the Factual Background section above.

Respondent, Mohammad Zafar, is a reseller and operates the disputed domain name <lostmarydirect.com> to resell genuine LOST MARY vape products lawfully -according to Respondent- purchased from the Complainants' authorized distributors.

Respondent started using the disputed domain name to sell LOST MARY vape products upon its launch on approximately March 11th, 2024. Sales activities for LOST MARY products began *before* Complainants' Complaint and this use was *consistent* and *uninterrupted* since inception for the resale of genuine LOST MARY products. According to Respondent, this pre-dispute use supports a finding of bona fide offering under Policy, Paragraph 4(c)(i).

To substantiate the above, Respondent includes evidence that his website's content was first captured by the Internet Archive Wayback Machine on April 16th 2024 and consequently on December 1st, 2024. According to Respondent, this reflects consistent use for selling genuine LOST MARY products since its inception.

According to Respondent, his use of LOST MARY constitutes a bona fide offering of goods under Policy, Paragraph 4(c)(i). Respondent's website emphasizes the authenticity of the products, stating they are "100% Authentic LOST MARY Disposables Vapes" and "sourced directly from authorized resellers of the manufacturer," reflecting purchases through legitimate supply chains.

Respondent continues by referring to *Oki Data Americas, Inc. v. ASD, Inc.* (WIPO D2001-0903), in which the Panel recognized a reseller's legitimate interest when selling genuine trademarked goods, provided certain criteria are met. Respondent's activities align with these principles according to Respondent. He illustrates this as follows:

- Offering Goods:** Respondent actively sells only genuine LOST MARY vape products through lostmarydirect.com. Respondent submits invoices showing that genuine products have been acquired from authorized distributors. The Panel can not verify whether the distributors Mi-One Brands and Safa Goods are authorized dealers but can verify that the invoices are about LOST MARY products.
- Selling Primarily Trademarked Goods:** The website exclusively sells LOST MARY products, ensuring the domain name is associated with Complainants' goods.
- Disclosure of Relationship:** The website currently has a prominent disclaimer clarifying no affiliation with Complainant in the About Us section.

The term "direct" in the disputed domain name suggests a reseller or direct sales channel, not the official brand. Respondent has added a clear disclaimer to address any potential confusion, as suggested in *Oki Data*, to further align with fair use principles (e.g., "This website is an independent reseller of LOST MARY products and is not affiliated with Dashing Joys Limited or Imiracle (Shenzhen) Technology Co., Ltd.").

- No Market Cornering:** Respondent has registered only the disputed domain name and no other domain names containing the LOST MARY mark or confusingly similar terms and has not attempted to monopolize domain names reflecting the "LOST MARY" trademark.

Respondent further defends himself by mentioning that the resale of genuine products is a lawful commercial activity under trademark law. Respondent's sourcing from authorized distributors, as evidenced by the purchase records submitted in the Response, supports this legitimate interest as alleged by Respondent. These records reflect purchases by Respondent's operating entity, Afroghini, LLC, used to operate the domain name website, from Mipod Wholesale and Safa Goods, authorized distributors of LOST MARY vape products.

Complainants' allegation that Respondent misleads consumers is not supported by evidence of counterfeit goods or intentional deception, as alleged by Respondent. He continues that Respondent's website promotes authentic products, and any perceived similarity to the Complainants' official site is incidental to the nature of reselling branded goods.

Respondent alleges further that Complainants have failed to provide any evidence of actual consumer confusion despite the website's operation. This suggests that consumers understand the site is a reseller, especially given the "direct" element.

Respondent continues by claiming that Respondent's use of the LOST MARY mark in the disputed domain name and logo is a nominative fair use – meaning the mark is used to refer to the product itself, not to suggest endorsement or affiliation. It is necessary that

Respondent uses the trademark in the disputed domain name to identify the genuine products being sold. Respondent's use of the disputed domain name is limited to what is reasonably necessary to identify the goods and does not imply sponsorship or endorsement.

Respondent's website also does not disparage Complainants' products or reputation. In fact, by selling genuine products and promoting their authenticity, Respondent is arguably contributing to the brand's visibility and sales.

Respondent concludes that he has a legitimate interest in using LOST MARY.

With respect to the bad faith assumption, Respondent finds that he has not registered the disputed domain name in bad faith. The choice of "lostmary" reflected the brand of the products to be sold, and "direct" was selected to indicate a direct sales channel, consistent with common reseller practices. The term "direct" in the disputed domain name and in the "lostmary direct" logo, in the context of reselling genuine products, signifies a direct-to-consumer sales model *for the reseller*, not a claim of being the official manufacturer or a direct arm of Complainants. This differentiates it from official brand websites. Generic or descriptive additions to a trademark indicated a function or type of business rather than affiliation. The term "direct" can imply efficiency, speed, or a streamlined purchasing process for the consumer, consistent with an online retail model.

There is no evidence presented that Respondent targeted Complainants' trademark to exploit their goodwill, as required under Policy, Paragraph 4(b). The Complainants' strong market presence does not preclude a reseller from registering a domain to sell their products, provided the use is legitimate, as Respondent states.

On bad faith use Respondent confirms that the use of the disputed domain name is solely in the context of selling genuine LOST MARY products sourced from authorized distributors, as confirmed by purchase records that are submitted in the Response. Further, Respondent argues that Complainants' assertion that the website mimics their official content does not establish bad faith, as the similarity arises from the nature of reselling branded goods. Some similarity is inherent when reselling branded goods. A reseller's site must display the products and their branding, according to the Respondent. Further, Respondent says that any visual similarities are a natural consequence of accurately presenting the genuine products for sale, not an attempt to deceive consumers into believing it's the official site. Also, Respondent continues, Respondent's site does not engage in activities typically associated with bad faith as found by past Panels, such as i) linking to competing products, ii) displaying third-party ads that exploit the Complainants' mark, or iii) providing false contact information. Respondent utilizes a supply chain through authorized distributors and use of the LOST MARY mark is not intended to imply an official relationship. As stated, Respondent has added a disclaimer to clarify no affiliation, mitigating any potential confusion. Respondent has consistently and actively operated the website as an e-commerce platform for genuine LOST MARY products, demonstrating a clear and continuous purpose for the disputed domain name that is antithetical to passive holding or speculative intent. Respondent sells genuine products without deceptive intent.

Respondent's operation aligns with legitimate reseller practices, and no bad faith exists absent proof of unauthorized or deceptive sales.

Lastly, Respondent claims that there is no evidence of cybersquatting. Respondent's commercial gain is derived solely from the resale of legitimate LOST MARY vape products, a standard business practice, and not from attempting to profit from Complainants' trademark by leveraging confusion or demanding ransom for the disputed domain name.

Both parties have filed supplemental arguments and evidence.

Complainants seek to address two issues that could not reasonably have been anticipated at the time of the original Complaint: (i) post-Complaint addition of a disclaimer, and (ii) the Respondent's assertion of a nominative fair use defense.

Complainants allege that Respondent implemented a disclaimer on his website only after receiving the Complaint and submits a screenshot of Respondent's website dated 22 April 2025. The Panel notes that the screenshot as submitted informs about the mission of LOST MARY DIRECT. It is not part of the home page.

Complainants conclude that an ex-post measure cannot negate the inference of bad faith at the time of registration and use of the disputed domain name. As clarified in section 3.7 of the WIPO Overview 3.0, a Respondent cannot rely on actions taken only after the Complaint was filed to demonstrate good faith.

Second, the disputed website is not limited to selling the LOST MARY goods: it also offers products from other brands. This commercial use further undermines any claim of nominative fair use and supports the inference that Respondent is trading off the Complainants' reputation to attract customers and drive traffic to a broader commercial venture. This allegation is though not substantiated with evidence.

Finally Complainants allege that, based on the physical address of Respondent's website, one can find other domain names linked to third-party vaping brands and that is indicative of an intent to commercially exploit the goodwill of those brands. As evidence Complainants submit screenshots of websites for ESCOBARS DIRECT and RAZ VAPE DIRECT.

Respondent consequently, claims that Complainant's filing is baseless and without merit, made with malicious intent by bad actors or competitors attempting to harm his business operations. He continues with claiming that new evidence proves that Complainants are not the owner of the trademark in the United States, which is relevant as Respondent only sells in the United States.

According to Respondent, current Complaint's submission process does not require verifiable evidence or proof of ownership. In this case, the US registration number provided (6932688) and US Serial Number (79322093) do not match the owner information listed in the United States Patent and Trademark Office (USPTO) database, raising serious concerns about the validity of the Complaint. According to Respondent, Complainants name the owner of the trademark LOST MARY in the USA as Dashing Joy Limited and Imiracle (Shenzhen) Technology Co., Ltd, whereas the United States Patent and Trademark Office lists the owner as Imiracle (HK)

Limited.

Further, Respondent informs that only LOST MARY products and products made by LOST MARY are sold on the site. The mention of the brands Quasar and Adjust is in line with it as they are manufactured by LOST MARY as well.

About the disclaimer requirement, Respondent mentions that he not only has a disclaimer on the top of the home page, being under the sentence 'Get \$10 off \$35 promotion' that mentions LOST MARY DIRECT as an independent reseller of LOST MARY products and is not affiliated with Dashing Joys Limited or Imiracle (Shenzhen) Technology Co., Ltd., but also in the 'About Us' section. The Panel could verify the presence of the disclaimer in the submissions of Respondent.

Respondent continues by stating that Complainants do not sell to the public directly. LOST MARY products are widely distributed and sold by thousands of retailers across the United States, including supermarkets and petrol stations. It is important to note that wholesale distributors and retailers are permitted to purchase from Authorized Master Distributors. According to Respondent, the vape distribution model works in the United States as follows:

- Authorized Master Distributors sit at the top of the supply chain and act as national wholesalers.
- Local wholesalers and retailers purchase directly from Authorized Master Distributors.
- Retailers may also purchase from local wholesalers, who in turn obtain their products from Authorized Master Distributors.

Regarding Complainants' allegation with respect to other websites owned by Respondent, Respondent assures that he has full authorization from the brands mentioned to be their authorized online channel, direct to the consumers, as the brands themselves do not sell to the public directly.

Respondent concludes that, given the inconsistencies and potential bad faith behind this Complaint, the arbitration court should conduct a detailed investigation into the origin of the Complaint and verify the identity of Complainant to safeguard the integrity of this process. Protecting legitimate businesses from unfounded and harmful claims is essential for maintaining a fair and competitive marketplace.

Respondent requests that the Complaint is rejected.

RIGHTS

According to the Policy paragraph 4(a)(i) it needs first to be established that:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

Panel findings on identity or confusing similarity of the trademark and disputed domain name

Complainants are two legal entities belonging to the same group. The evidence of the International Registration and the Australian registration for the trademark LOST MARY, both in the name of one of the two Complainants is sufficient evidence that Complainants have rights in the registered trademarks.

The supplemental evidence of Respondent with respect to the United States trademark application and their ownership is irrelevant to the Panel. Moreover, Respondent is referring to allegations of Complainants with respect to these American trademark registrations that the Panel could not find in the Complaint. Therefore, this allegation could be set aside. Lastly, the Policy does not require to invoke trademark registrations that match the use in the territory in which the disputed domain name is active.

The Panel finds that LOST MARY is a strong trademark, meaning that it is not descriptive as to the nature of the goods sold under it. Thus, any domain name using the strong trademark even in combination with a descriptive denomination, will automatically refer the public to the registered trademark. In the particular case the Panel decides that the denomination DIRECT is no more than a clarification of how to obtain the goods sold under the brand, namely directly, just like Respondent has alleged. The addition of DIRECT is therefore of minor value when making the comparison between the trademark LOST MARY and the disputed domain name <lostmarydirect.com>. It is the consensus view amongst panelists that the top-level domain can be disregarded when assessing whether the disputed domain name and the trademark are confusingly similar.

The assessment can thus be limited to whether LOSTMARY and <lostmarydirect> are confusingly similar. Based on the above findings the Panel concludes that the disputed domain name is to be considered confusingly similar to the trademark.

Further, the trademark registrations predate the registration of the disputed domain name and it follows from this that the trademark rights prevail.

Thus, to the satisfaction of the Panel, it is shown that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

According to the Policy paragraph 4(a)(ii) it needs to be further established that:

(ii) Respondent has no rights or legitimate interests in respect of the domain name.

Paragraph 4 (c) of the Policy provides circumstances that could demonstrate that Respondent has no rights to and legitimate interests in the disputed domain name. These circumstances are not exclusive. Circumstances that provide rights or legitimate interests to the domain name are:

(i) before any notice to Respondent of the dispute, the 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) Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if though it has acquired no trademark or service mark rights; or

(iii) Respondent is 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.

Further, according to the WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd., Complainant is required to make out a prima facie case that Respondent lacks rights or legitimate interests. Once such a prima facie case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

According to Complainant Respondent has no rights in the disputed domain name. In fact, he misleads consumers for the purpose of commercial gain, causing them to believe that there is an affiliation between Respondent and Complainant, which does not constitute fair use. Further, Complainant states that Respondent is not Complainants' distributor or partner. Complainant has never directly or indirectly authorized Respondent to use the trademark LOST MARY and the corresponding domain name in any form.

Also Complainant searched various national and regional trademark databases in the names of Respondent and did not find that Respondent had trademark rights in the name of LOST MARY.

Respondent on the other hand, argues to have rights and legitimate interests as he resells genuine LOST MARY products.

Firstly, he submits evidence of his operational website well before the Complaint was filed and argues that this is evidence of meeting the criteria:

(i) before any notice to Respondent of the dispute, the 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

Next, Respondent refers to the OKI Data criteria as created in the case *Ok! Data Americas, Inc. v. ASD, Inc.* (WIPO D2001-0903) in 2001:

A reseller can be making a bona fide offering of goods and services and thus have a legitimate interest in the domain name if the use fits certain requirements. These requirements include, at the minimum, the following:

1. the actual offering of goods and services at issue;
2. the use of the site to sell only the trademarked goods and;
3. the site accurately disclosing the registrant's relationship with the trademark owner.
4. Respondent must also not try to corner the market in domain names that reflect the trademark.

Panel findings on having a website operational before the filed Complaint

With respect to having an operational website well before the Complaint the Panel finds that the invoked article is not applicable in this situation but merely in a situation where the preparations made have no link or relation with the trademark and the trademarked goods of Complainant. This is not the case here.

Panel findings on the necessity to broaden the Oki Data criteria

With respect to the invoked Oki Data Criteria the Panel finds the following.

The Oki Data requirements were created in a case where Respondent was an authorized dealer, having access to the marketing visuals of the trademark owner. Marketing visuals are normally provided by the trademark owner to authorized dealers in order to convey a consistent image of the trademark and its trademarked goods in the market. The disadvantage of this operation is that a likelihood of confusion with respect to the website's origin lurks when using those visuals.

The OKI DATA decision dates back to 2001, during the rise of the Internet. At that time, using the Internet was not yet a part of everyday life for the public. Precisely because of this unfamiliarity with Internet use, the OKI DATA criteria were developed to protect the uninformed public from confusion.

It is therefore logical that the Panel decided in the Oki Data case that an additional requirement should avoid that confusion and inform the public that the website of Respondent is not that of the trademark owner. It is the Panel's belief that for that reason the requirement of a disclaimer was established.

Through times the majority of Panels have applied the Oki Data criteria, also in cases where Respondent is a reseller. This additional safeguard to distinguish a reseller's website from that of the trademark owner is understandable at the beginning of the development of e-commerce, when the Oki Data decision was issued. However, in the meantime, almost 25 years after the Oki Data decision, the public is accustomed to the Internet and is sufficiently wise to distinguish an official trademarked website from that of a reseller.

On a side note: a similar trend can be seen in court decisions worldwide, also with regard to the admissibility of using Google AdWords by unauthorized resellers. There too, it is now assumed that the public can easily distinguish between content offered by the trademark holder and content from third parties, like resellers.

Going back to resellers: a reseller's website, on average, has very clear characteristics:

- It displays the goods for sale very prominently;
- It provides information on pricing and discounts in a dominant way.

The Panel therefore finds that a reseller's website does not need further clarification about the origin by means of a disclaimer. Thus, a disclaimer is not a *conditio sine qua non* for determining whether the reseller's website is of bona fide use. The requirement can thus be less strict on this aspect, even broadened.

This Panel finds that it is time to adjust the Oki Data criteria according to current needs in the e-commerce world.

The adjustment can be done as it should be borne in mind that the Oki Data criteria are not solid law that a Panel should follow. They are part of self regulation rules as developed by ICANN and panelists and agreed to by holders of domain names. Further, the Oki Data doctrine has evolved as the majority view of panelists in domain name disputes, but it is not the only view.

Lastly, it is important to keep in mind that the Policy was designed to prevent the extortionate behavior commonly known as cybersquatting. It cannot be used to litigate all disputes involving domain names. *The Thread.com, LLC v. Poploff*, [WIPO Case No. D2000-1470](#) (WIPO Jan. 5, 2001). If trademark owners wish to prevent the use of their marks by resellers, they should create tighter networks with their authorized dealers through appropriate contractual language. Further, against any reseller, when permitted under the relevant law, trademark owners should seek recovery in classic trademark infringement or dilution litigations. In the absence, however, of some element of illegitimacy, they should not use the Policy to prevent uses that ICANN deemed to be legitimate, including the use of domain names in connection with the bona fide offering of goods and services.

It follows from the above that the Panel may change the criteria in such way that they are better equipped to fulfill the needs in current times. The Panel will do so and change them as such to perceive the disclaimer as an example of a broader rule.

The broader rule is that Respondent should do anything to assure that there is no confusion possible to distinguish its website from that of the trademark owner. This can be done in various ways, e.g. by mentioning a disclaimer on the website. The disclaimer should though not be interpreted as a strict criterion *sine qua non*, as the distinction can also be executed in different ways. Any clarity given about the origin of the website is sufficient for demonstrating fair use. This could, for example, also be done by the creation of a different look and feel of Respondent's website as the public will understand, through his experience with e-commerce on the Internet, that the website is not originating from the trademark owner. Another example is as the Panel mentioned above: that resellers' websites, on average have the same, easily recognizable characteristics that can distinguish the reseller's website from that of the trademark owner. Further, the website can distinguish itself through mentioning the legal entity of the reseller in a dominant way (e.g. through reseller's logo) on top of the website. Any other example may do as long as it is in compliance with the rule: distinction between the reseller's and trademark owner's website is compulsory.

Thus the Panel finds that the Oki Data criteria should (still) be met by any Respondent, but the third criterion can be rephrased through broadening it and in which the disclaimer is an example, not a *conditio sine qua non*. According to the Panel the following assessment should be made to establish bona fide use at Respondent's end:

Revised Oki Data criteria (Lost Mary criteria):

1. There is actual offering of goods and services via Respondent's website at issue;
2. The use of the website is to sell only the specific trademarked goods which have been brought into the market by the trademark owner and;
3. The Respondent's website can be easily distinguished from that of the trademark owner. Aspects that can be decisive to distinguish Respondent's website from that of the trademark owner are *inter alia* (but not limited):
 - i. the placing of a disclaimer disclosing Respondent's relationship with the trademark owner on the home page of the website;

- ii. the creation of a different look and feel of the website of Respondent as compared to the website of the trademark owner;
- iii. the dominant use of resellers' websites specific elements like pricing and depiction of the goods;
- iv. the use of a logo on the top of the home page, not including the trademark as mentioned in the disputed domain name, that addresses the entity of Respondent on the website.

4. Respondent must also not try to corner the market in domain names that reflect the trademark.

Panel findings when applying the Lost Mary criteria

The Panel will apply the above mentioned revised Oki Data criteria (**from now on: the Lost Mary criteria**) to assess whether Respondent in the current Complaint has a legitimate interest or not.

Respondent is not affiliated with Complainants, but he sells genuine goods originating from the trademark owner. This is alleged by Respondent and not contradicted by Complainants. The first two requirements are thus met by Respondent.

In the Complaint, Complainants provide a screenshot of their website as well as that of Respondent.

Complainants' website has a peaceful look and feel in mostly purple, with good quality photos, not necessarily geared to the actual product. LOST MARY is used in different shades of purple and a stylish typographic without further graphical elements. Moreover, the home page starts with a notification of a received award.

Respondent's website, on the other hand, strikes out by the use of a cheap looking logo consisting of the words LOST MARY DIRECT combined with a drawing of a vape and a smoking cloud above the inhaler mouth piece. The logo seems to be hand drawn and is printed crookedly in the top left angle of the home page. Further, Respondent's website shows the pricing information and this catches your attention immediately:

1. 'GET \$10 off Your first Order over \$35' is on the top of the home page; and
2. 'ENJOY FREE SHIPPIN ON ORDER OVER \$99', next to a photo of a vape.

Also, the home page depicts various packaging's of the LOST MARY vapes for sale. The major color of the website is orange.

Complainants are alleging that Respondent is deliberately imitating the LOST MARY brand which Complainants find an indication of bad faith. Respondent, on the other hand, asserts that it is in the nature of the goods and that the similarity arises from the nature of reselling branded goods. A reseller's site *must* display the products and their branding. Any visual similarities are a natural consequence of accurately presenting the genuine products for sale, not an attempt to deceive consumers into believing it's the official site.

The Panel finds that the public will be able to distinguish the two websites immediately: the main color is different and the messages conveyed as well. Complainants have created an experience website, whereas Respondent has created a typical resellers' website where pricing and depiction of the goods are dominant. It follows that the Respondent has done what is necessary to distinguish his website from that of Complainants. Therefore the use of Complainants' trademark in the disputed domain name is bona fide use.

On a site note the Panel would like to mention one detail that might be questioned from the trademark owner's perspective and that is the use of LOST MARY in the logo of LOST MARY DIRECT. This use of Complainants' trademark, when permitted under the relevant law, could establish trademark infringement. But that is beyond the scope of this Complaint, the remedy sought and the applicable law, the Policy.

With respect to the fourth requirement Complainants demonstrate in the supplemental evidence that Respondent has more domain names and websites with respect to third party trademarks for vaping. But these are not with respect to the brand LOST MARY and therefore irrelevant.

The Panel concludes that the second requirement for accepting the Complaint being to show that Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy) is not met.

The Panel concludes that Respondent does have a legitimate interest in respect of the disputed domain name.

BAD FAITH

According to the Policy paragraph 4(a)(iii) it finally needs to be established that:

- (iii) the domain name has been registered and is being used in bad faith.

Paragraph 4 (b) of the Policy provides circumstances that demonstrate that Respondent has registered and used the domain name in bad faith. These circumstances are not exclusive. Those circumstances are for example:

- (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 the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) 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) Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Panel findings on bad faith

The bad faith criterium is cumulative with the second criterium of no legitimate interest at Respondent's end. Now that it has been established that Respondent has demonstrated a legitimate interest and thus the second criterium for accepting the Complaint is not met, it is unnecessary for the Panel to reach this third criterium.

PROCEDURAL FACTORS

In the present Complaint both parties have filed supplemental evidence and further arguments. It is up to the Panel to decide whether it could be accepted or not.

In general, such submissions are appropriate only if they raise new facts or law, not reasonably available (or foreseeable) at the time of the party's initial submission. They are not to be used to simply reply to Respondent's arguments. *Magnum Piering Inc., v. Mudjackers*, WIPO Case No. D2000-1525 (WIPO Jan 29, 2001).

Both parties claim to raise new facts: Complainant submits evidence that Respondent filed a disclaimer on its website only after the receipt of the Complaint and files a defense against Respondent's assertion of nominative fair use. Respondent claims new evidence in the submission of Complainants' United States Trademark applications that are not registered yet and in the name of the wrong applicant. He continues defending his reseller's operation by confirming to use disclaimers on various pages. Further, he explains the reseller procedure as it is accustomed in the United States. Moreover, he requests the Panel to start an investigation against Complainants, claiming that Complainants provide inconsistent information and are potential in bad faith.

Panel findings on procedural aspects

The Panel finds that both parties have submitted irrelevant additional information: whether or not a disclaimer is placed on Respondent's website is irrelevant for the decision in the Complaint. Further, the provision of information on the United States Trademarks of Complainants is irrelevant as Complainants did not base their Complaint on those trademarks.

As the Policy is not created to have a lengthy exchange of arguments, the Panel, in principle, would set aside further arguments in reply and defense. However, as both parties have received equal opportunity to further argue, the Panel has taken them into account but concludes that these arguments do not shed a different light on the Complaint.

The request of Respondent to invite the Panel to start an investigation on the integrity of Complainants is beyond the scope of the Policy and moreover not essential to reach a decision in this Complaint.

PRINCIPAL REASONS FOR THE DECISION

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

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **lostmarydirect.com**: Remaining with the Respondent

PANELLISTS

Name	Marieke Westgeest
------	-------------------

DATE OF PANEL DECISION	2025-07-16
------------------------	------------

Publish the Decision