



DISPUTE RESOLUTION SERVICE

D00021352

Decision of Independent Expert

JUUL Labs, Inc

and

Moniker Online Services, LLC

1. The Parties:

Lead Complainant: JUUL Labs, Inc
JUUL Labs, Inc
560 20th Street, Building 104
San Francisco
California
94107
United States

Complainant: JUUL Labs UK Limited
JUUL Labs UK Limited
Suite 1, 3rd Floor 11-12 St. James's Square
London
SW1Y 4LB
United Kingdom

Respondent: Moniker Online Services, LLC
13727 SW 152nd Street #513
Miami
FL
33177
United States

2. The Domain Name:

<juulpod.co.uk>

3. Procedural History:

- 3.1 I have confirmed to Nominet that I am independent of each of the parties and that to the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.
- 3.2 The procedural chronology of this dispute is as follows:

29 April 2019 16:33 Dispute received
30 April 2019 11:53 Complaint validated
30 April 2019 11:58 Notification of complaint sent to parties
20 May 2019 02:30 Response reminder sent
23 May 2019 11:47 No Response Received
23 May 2019 11:48 Notification of no response sent to parties
05 June 2019 02:30 Summary/full fee reminder sent
06 June 2019 10:56 Expert decision payment received

4. Factual Background

- 4.1 The Lead Complainant is a company incorporated under the laws of the state of Delaware, USA whose business is in the design, manufacture, marketing and supply of electronic nicotine delivery systems ("ENDS") (colloquially known as vaporisers and/or electronic cigarettes). The Lead Complainant created a particular form of ENDS that it has marketed and sold under and by reference to the brand name "JUUL".
- 4.2 The Additional Complainant is a company incorporated under the laws of England and Wales and is a wholly owned subsidiary of the Lead Complainant. The Additional Complainant is the operating entity of the Complainant company group in the UK. The Additional Complainant markets and distributes the Complainants' "JUUL" branded ENDS products in the UK and has done so since July 2018.
- 4.3 The Complainants' ENDS system comprises a vaporiser device into which the user inserts an individual disposable pod, which is referred to as a "JUUL pod".
- 4.4 The Lead Complainant has engaged in such activities since 2015. It launched its products in the United Kingdom through the Additional Complainant on 17 July 2018. However, the Complainants had commenced discussions with UK retailers in respect of the sale of these products several months earlier in March 2018. That launch obtained coverage in the UK press, including the Financial Times and The Times. UK Sales within the first 3 months from launch were approximately \$2.3 million.

- 4.5 The Lead Complainant is the registered proprietor of, inter alia, the following trade marks:
- (i) EU trade mark number 012477791 for the word mark JUUL, registered with effect from 11 July 2014 for goods in Class 34; and
 - (ii) EU trade mark number 014944251 registered with effect from 13 April 2016 for goods and services in Class 34 and 35, which takes the following form:



- 4.6 The Additional Complainant is the exclusive licensee of these trade marks in the United Kingdom.
- 4.7 The Lead Complainant operates a website from the <juul.com> domain name, which promotes its products primarily to the US market. The Additional Complainant operates a website from the <juul.co.uk> domain name, which promotes its products primarily to the US market.
- 4.8 The Domain Name was registered on 30 June 2018. It is registered in the name of a United States company, which is the formal Respondent in these proceedings. However, the Respondent is a domain name services provider. Accordingly, it seems likely that some other person or entity has actively controlled the Domain Name since its registration.
- 4.9 Since registration the Domain Name has been used for a website that purports to sell various “Juul Pods”, but these would appear to have always been stated to be “Out of Stock”. The website did not, and does not, identify who is behind the website. The website has “About Us”, “Delivery Information”, “Terms and Conditions” and “Privacy Policy “ pages, but all contain no substantive content.
- 4.10 On 27 February 2019, the Complainants' solicitors sent a letter before action to the Respondent, in respect of the Domain Name and the use that had been made of it. No response was forthcoming in this respect.

5. Parties’ Contentions

The Complaint

- 5.1 In the Complaint, the Complainants describes their business and the registered trade marks identified above. Reference is also made to a further registered EU trade mark, which effectively amounts to a representation of the packaging in which the Claimant’ products are sold. As a result of their activities in the United Kingdom, they also claim unregistered trade mark rights in the terms

“JUUL” and JUULpod”. The Domain Name is said to be similar to the Complainants’ JUUL registered trade marks and identical to its claimed “JUULpod” unregistered trade mark rights.

- 5.2 The Complainants contend that the website operating from the Domain Name “mimics” the Complainant’s marketing content. They claim that this website is attempting to lead visitors to purchase authentic products of the Complainants when in fact that is not the case. Since the products themselves are stated to be “Out of Stock”, the Complainants assert that it “is unclear whether the Respondent is selling, or has sold, counterfeit JUUL products or merely acting as if it does so”. In this respect, the Complainants also contend that the Respondent is not an authorised distributor or reseller of the Complainants’ products.
- 5.3 In light of the date of registration of the Domain Name and the way in which it has been subsequently used, the Complainants also claim that the Domain Name has been registered primarily for the purposes of blocking the Complainants from acquiring a domain name that corresponds to their trade marks and that it is “anticipated” that the Domain Name will be used to unfairly disrupt the business of the Complainants.

The Response

- 5.4 No Response was filed in these proceedings.

6. Discussions and Findings

- 6.1 As no Response was filed in these proceedings, the Complainants could have sought a summary decision. However, as they were entitled to do, they have sought and paid for a full decision (paragraph 12.1 of Nominet’s Dispute Resolution Service Policy).
- 6.2 To succeed under Nominet’s Dispute Resolution Service Policy (the “Policy”), the Complainants must prove first, that they have Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy) and second, that the Domain Name is an Abusive Registrations in the hands of the Respondent (paragraph 2.1.2 of the Policy). The Complainants must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy), and this is so even if a Response has not been filed .
- 6.3 Abusive Registration is defined in paragraph 1 of the Policy as follows:

"Abusive Registration means a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights;

or

- ii. is being or has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainants' Rights

- 6.4 The Lead Complainant is the owner of a registered trade mark for the term "JUUL" as a word mark and I accept that the Additional Complainant is an exclusive licensee of that mark in the United Kingdom. I also accept that the Complainants (or at least the Additional Complainant) have demonstrated unregistered trade mark rights under the Policy in respect of the term "JUULpod". Further, the most sensible reading of the Domain Name is as the terms "Juul" and "pod" in combination, followed by the ".co.uk" suffix.
- 6.5 Given this, the Complainants clearly have rights in respect of a "name or mark" that is identical or similar to the Domain Name. Accordingly, the Complainants have satisfied the requirements of paragraph 2.1.1 of the Policy.

Abusive Registration

- 6.6 I accept that the Domain Name was registered by the person or entity that actually controls it, with knowledge of the Complainants marks. Further, I accept that the website operating from the Domain Name seeks to impersonate the Complainants in order to offer internet users with "JUUL pod " products to be used as part of the Complainants' ENDS system, and that the Domain Name was registered with that purpose in mind.
- 6.7 Relevant here is that the Complainants' products had developed a significant reputation particularly in the United States prior to the date that the Domain Name was registered. There is also the fact that the Domain Name was registered shortly after the Complainants had commenced discussions with UK retailers in respect of the sale of these products. Finally, there is the fact that there is no obvious reading of the Domain Name, other than as involving a direct reference to the Complainants' products.
- 6.8 Further and in any event, there is the content of the website operating from the Domain Name. The look and feel of the website is intended to convey the impression that genuine JUUL products are being offered for sale and these are being offered by the Complainants. The Complainants' JUUL trade mark is prominently displayed at the top of the home page for the website and there is nothing to indicate either on that page or elsewhere on the website that any entity other than the Complainants is involved.
- 6.9 Exactly what are the motives of the person or entity behind this site, is far from clear. The Complainants' concerns that this might be used to promote and sell counterfeit products is understandable, but whether or not this is correct, ultimately does not matter. This is a clear case of impermissible impersonation of a trade mark holder for the purposes of drawing internet

users to a website. Such activity falls, inter alia, within the scope of the paragraph 5.1.2 of the Policy.

- 6.10 In the circumstances, I find that the Domain Name was both registered, and is being held, to take unfair advantage of the Complainants' Rights. Either is sufficient for a finding of abusive registration. Given this, I conclude that the Domain Name in the hands of the Respondent is an abusive registration and that the Complainants have made out the requirements of paragraph 2.1.2 of the Policy.
- 6.11 The fact that the underlying registrant of the Domain Name has availed itself of the services of an entity that has not disclosed the underlying registrant of the Domain Name (and, therefore, who is actually behind the registration and the website remains unknown) is also a factor that indicates abusive registration (see for example, the discussion in *Russam GMS Limited v Identity Protect Limited* DRS 18089). But as this has not formed part of the Complainants' allegations in this case, and given the findings above, it is neither necessary nor appropriate to consider this point further.

7. Decision

- 7.1 I find that the Complainants have Rights in a name, which is similar to the Domain Name, and that the Complainants have shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to the Complainants.

Signed Matthew Harris

Dated 28 June 2019