



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2201643
Complainant:	Imiracle (ShenZhen) Technology Co., Ltd.
Respondent:	Tarakanov Ivan Igorevich
Disputed Domain Name:	<elfbarvape.net>

1. The Parties and Contested Domain Name

Complainant is Imiracle (ShenZhen) Technology Co., Ltd., Room 1606, Office Building T5, Qianhai China Resources Financial Center, No. 5035 Menghai Avenue, Nanshan Street, Qianhai Hong Kong-Shenzhen Cooperation Zone, Shenzhen, Guangdong Province, China

The Respondent is Tarakanov Ivan Igorevich of 197348 RU Saint-Petersberg Bogatyrskii prospekt 8.

The domain name at issue is elfbarvape.net, registered by Respondent with Beget LLC, of Beget Ltd, 195027, Russia, Saint-Petersburg, P. O. Box 209, RUSSIA: 8 (800) 700-06-082155; email: manager@beget.com, abuse@beget.com.

2. Procedural History

On 2 August 2022, the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC-HK”). On the same day, the ADNDRC-HK confirmed receipt of the Complaint and requested the Complainant to submit the case filing fee.

On 2 August 2022, the ADNDRC-HK informed Beget, LLC. (“Registrar”) of the Disputed Domain Name of the proceedings by email.

On 3 August 2022, the Registrar acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with the Registrar, that Tarakanov Ivan Igorevich is the holder of the Disputed Domain Name, that the Internet Corporation for Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy (“the Policy”) is applicable to the Disputed Domain Name, the language of the Disputed Domain Name is Russian as provided by the WHOIS information in relation to the Disputed Domain Name and confirmed that the Disputed Domain Name is under Registrar lock status.


On 12 August 2022, the ADNDRC-HK sent a Written Notice of Complaint (“Notification”), together with the Complaint, to the email address of the Respondent’s nominated registrant contact for the Disputed Domain Name (as recorded in the WHOIS database). The Notification gave the respondent twenty (20) calendar days to file a Response (i.e. on or before 1 September 2022).

The Panel comprising of Dr. Shahla F. Ali as a single panelist was appointed by the ADRDRC-HK on 5 September 2022. The papers pertaining to the case were delivered to the Panel by email on the same day.

3. Factual background

According to the documents submitted by Complainant, Shenzhen iMiracle Technology Co., Ltd, is an e-cigarette company based in China since 2007. The Company’s headquarters are located at Shenzhen, and the Company has branches in Shanghai, Hong Kong, the United States, Ireland, Germany among other locations. In May 2022, the Complainant took over the business and trademark rights of ELFBAR.

The Complainant submits that since the beginning of the ELFBAR brand in 2018, ELFBAR has had a global reputation through the promotion of its products. The Complainant’s affiliated company, Shenzhen Weiboli Technology Co., Ltd. (“Weiboli”) was granted registration of the ELF BAR trademark in China on February 21, 2021, and in Russia on April 20, 2021. The class of goods/services included in the registration include e-cigarettes in Class 34: Snuff; tobacco; cigarette cases; cigarette puffs; cigarette lighters for smoking; cigarette filters; cigarette pouches; electronic cigarettes; cigars; cigarettes. According to documents provided by the Complainant, the above trademark was transferred to the complainant on May 13, 2022.

The Complainant further submits that its affiliated company Weiboli registered the Russian trademark ELF BAR on April 20, 2021 and the Russian trademark  on October 1, 2021. The approved trademarks include those in Class 34. The above Russian trademark was transferred to the complainant on July 13, 2022, and is currently in progress. In the LETTER OF AUTHORIZATION from Shenzhen Weiboli Technology Co. Ltd, it states that prior to the successful processing of the transfer, iMiracle (ShenZhen) Technology Co., Ltd. is the exclusive licensee of trademark Nos 831022 and No.808049 for the period from May 31, 2021 to May 30, 2030.

The Respondent, Tarakanov Ivan Igorevich of Saint Petersburg, Russia registered the disputed domain name on 23 April 2021. The Respondent did not file a Reply with the Centre.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:


- i. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant argues that the main part of the disputed domain name "elfbarvape.net" is "elfbar". "Vape" refers to an electronic device, similar to an e-cigarette, that produces vapour, usually containing nicotine. The Complainant further contends that "Vape" is a generic term lacking distinctiveness. Rather, the main distinctive part of the domain name "elfbar" is the same as the Complainant's trademark and official website elfbar.com. The domain name used by the Respondent can easily lead to consumer confusion. Moreover, The Complainant's official website operates globally, and Russia is a key market. The Complainant's official websites www.elfbar.com and www.heavengifts.com sell ELF BAR ® products to Russian consumers. Complainant argues that the domain name registered by the Respondent has caused confusion and infringed upon the Complainant's legitimate rights and interests.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name:

According to documents submitted by the Complainant, the disputed domain name was registered on April 23, 2021. This date was not only later than the first use of the ELF BAR trademark in e-cigarette products and services (in 2018) and the date of the ELF BAR trademark application in Russia and China (2020), but also after the ELF BAR brand products gained, according to the Complainant, a high degree of visibility. As noted by the Claimant, the Respondent doesn't enjoy ELF BAR trademark rights, and the Complainant never permitted Respondent to use the trademark or gave its authorization to Respondent to register any domain name with the ELF BAR name.




Complainant notes that Respondent uses the Disputed Domain Name as a website for the sale of ELF BAR products, thereby misleading consumers to purchase counterfeit goods. Complainant provides evidence showing that the

Respondent uses the Complainant's registered trademark "  " as well as ELF BAR mark on the product images in the website associated with the Disputed Domain Name, leading consumers to believe that the website sells official and genuine products.

- iii. The disputed domain name has been registered and is being used in bad faith:

On the bad faith issue, the Complainant contends that the Respondent was and is clearly aware of the Mark evidenced by the following:

Firstly, Complainant contends that the Respondent's bad faith is reflected by the use of ELF BAR in the Dispute Domain Name. It points out that "elfbar" does not exist in the English vocabulary. It is a fanciful word created by the Complainant. The Disputed Domain Name used by the Respondent only adds the generic word "vape" to Complainant's trademark, which can easily lead to consumer confusion.

Secondly, the Respondent uses the image  that is identical to the trademark  on the Complainant's website page. Complainant argues that the Respondent registered the Disputed Domain Name mainly for the purpose of selling ELF BAR brand electronic cigarette products, and the products displayed on the Respondent's webpage use the Complainant's registered trademark " " and ELF BAR causing consumers to misidentify it as an official website. The style and content of the disputed web site imitate the Complainant's website "elfbar.com".

Complainant alleges that the Respondent must have a good understanding of the Complainant's products and trademark, and is using them to gain illegal profits.

B. Respondent

The Respondent's contentions may be summarized as follows:

The Respondent did not submit a reply.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

Preliminary Issue: Language of Proceedings

Prior to the Panels consideration of the application of Paragraph 4(a) of ICANN's Uniform Domain Name Dispute Resolution Policy to the facts in this case, a preliminary issue must be addressed, namely the language of the proceedings.

With regard to the language issue, according to Article 11(a) of the UDRP Rules, "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

While the Panel observes that the language of the registration agreement is Russian, in accordance with the Rules of UDRP, the Panel has the authority to determine the language of the proceedings, having regard to the totality of circumstances. Having reviewed the Complainant's submission and the language of the Disputed Domain Name, for reasons of efficiency, the Panel determines that the language of the proceedings is English.

A) Identical / Confusingly Similar

The Complainant has established its right to the “ELF BAR” Mark by submitting trademark registration certificates and records of its affiliated company Shenzhen Weiboli Technology Co., Ltd. in Russia and China beginning in September 2020 and February 2021 respectively and subsequent documentation showing a transfer of the trademark from Shenzhen Weiboli Technology Co., Ltd. to Complainant.

The Disputed Domain Name <elfbarvap.net> contains three elements: "elfbar" the word “vape” and the top-level domain ".net". Numerous precedents have established that the top-level domain does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. See *Abt Electronics, Inc. v. Gregory Ricks*, FA 904239 (Nat Arb. Forum Mar. 27, 2007) ("The Panel also finds that Respondent' s <abt.com> domain name is identical to Complainant's ABT mark since addition of a generic top-level domain ('gTLD') is irrelevant when conducting a Policy ¶ 4(a)(i) analysis."); see also *Jerry Damson, Inc. v. Tex. Int' l Prop. Assocs.*, FA 916991 (Nat. Arb. Forum Apr. 10, 2007) (“The mere addition of a generic top-level domain ('gTLD') '.com' does not serve to adequately distinguish the Domain Name from the mark.”).

The only difference between the Disputed Domain Name and the Complainant's “elfbar” mark is the inclusion of the word “vape” as a suffix. It is well-established that in cases where the distinctive and prominent element of a Disputed Domain Name is the Complainant's mark and the only addition is a generic term that adds no distinctive element, such an addition does not negate the confusing similarity between the Disputed Domain Name and the mark. See, for example *LEGO Juris A/S v. Huangderong*, WIPO Case No. D2009-1325; *National Football League v. Alan D. Bachand, Nathalie M. Bachand d/b/a superbowl-rooms.com*, WIPO Case No. D2009-0121; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064.

“elfbar” is the distinctive and prominent component of the Disputed Domain Name and the addition of the word “vape” does not substantively distinguish it from the “elfbar” mark.

The prominence of the Complainant's “elfbar” mark (particularly in Russia where the Respondent is located) is such that the use of the word “vape” in connection with the word “elfbar” does nothing to dispel confusion as to an association with the Complainant and its products. The connection between “elfbar” with the word “vape” as a suffix to the Complainant's mark is such that the relevant Disputed Domain Name considered as a whole would be likely regarded by potential customers of the Complainant as a reference to the Complainant's business. See, for example *eBay Inc. v. SGR Enterprises and Joyce Ayers* (Case No. D2001-0259) where, the Panel held that the domain names in question, namely <ebaylive.com> and <ebaystore.com>, were confusingly similar to the Complainant's trademark.

The only distinctive part of the Disputed Domain Name should be "elfbar", which is identical to the Complainant's "elfbar" mark. This striking resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant.

Therefore, it can be concluded that the Disputed Domain Name < elfbarvape.net > completely incorporates the Complainant’s “elfbar” mark which is the distinctive part of the Disputed Domain Name, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant’s mark.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(i).

B) Rights and Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006).

The Respondent has never been authorized by the Complainant to use the mark “elfbar”. Furthermore the Respondent has no business relationship with the Complainant. Thus, the Respondent does not have any rights with regard to the mark “elfbar.”

Second, the Respondent’s name, address and other identifying information cannot be linked with “elfbar.”

It is also noted that according to the WHOIS search result, the Disputed Domain Name was registered on 23 April 2021, over 1 year after the Complainant’s affiliated company first registered the trademark “elfbar” in Russia in 2020.

Given the general recognition of the Complainant’s “elfbar” mark including in Russia where the Respondent resides, the Respondent must have known of the existence of the “elfbar” marks when registering the Disputed Domain Name.

Given the above reasons alongside a lack of response by the Respondent on its right and/or interest in the Disputed Domain Name, this Panel concludes that the Respondent has no rights and/or legitimate interests in respect of the Disputed Domain Name.

C) Bad Faith

In determining whether the Respondent has registered or used the Disputed Domain Name in bad faith, paragraph 4(b) of the Policy sets down four (4) factors which the Panel will need to examine. The four (4) factors are as follows:

“Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have 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) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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.”

According to information provided by the Registrar, the Respondent registered the disputed domain name on 23 April 2021, and Complainant's earliest registration of its trademark was in 2020.

The Respondent, domiciled in Russia, must have been aware of the Complainant's prior rights and interest in the Disputed Domain Name given the Complainant's reputation in the mark “elfbar” as of the date that the Respondent registered the Disputed Domain Name.

The fact that the website features the name “elfbar” in relation to the provision of e-cigarette products bearing the Complainant's marks, makes it clear that the Respondent knew of the Complainant's mark and registered the Disputed Domain Name in an attempt to attract internet traffic to the website on the mistaken belief that it is associated with the Complainant's business, and to make profit from the sale of e-cigarettes and related services.

No evidence has been provided showing that the Respondent sought the permission of the Claimant to use its mark, nor any evidence showing that the Claimant gave such permission to the respondent.

Given the above findings, the Panel is of the view that the Respondent registered and used the contested domain name in bad faith.

6. Decision

Pursuant to Paragraph 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain name < elfbarvape.net > be transferred to the Complainant.



Dr. Shahla F. Ali
Panelist

Dated: 6 September 2022