

WAS MARY LOST IN CYBERSPACE?

Case note on [Czech Arbitration Court, 3 June 2025, Dashing Joys Limited, Imiracle \(Shenzhen\) Technology Co., Ltd v. Mohammad Zafar CAC Case No. CAC-UDRP-107605 <lostmarydirect.com>¹](#) – 1 August 2025

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The recent domain name decision <lostmarydirect.com> is a remarkable ruling. In this decision by Marieke Westgeest, domain name panelist³ at the Czech Arbitration Court,⁴ she amends the Oki Data criteria⁵, which have been in existence since 2001 and have been used extensively, and renames them the Lost Mary criteria.

In short, the panelist dismissed the complaint because the complainants, manufacturers of e-cigarettes, were unable to prove that the respondent, Mohammad Zafar, a reseller of these products, had no right or legitimate interest in the domain name. Under the Uniform Domain Name Dispute Resolution Policy (UDRP), the dispute resolution policy applicable to .com domain names, the lack of a right or legitimate interest is the second element that must be proven, in addition to the complainants having to prove that the domain name is identical or confusingly similar to the complainants' trademark (first element) and that the respondent acted in bad faith in registering and using the domain name (third element)⁶.

In this note, I discuss the facts relevant to for deciding this matter, the background of the UDRP, WIPO Overview 3.0 and the Oki Data criteria, the panelist's proposed amendment to these criteria, her considerations for this amendment and her findings. I then make a few comments.

¹ A Dutch version of this case note has been published on the Dutch IP & IT blogs IE-Forum ([IEF 22834](#)) and IT&R (IT [4928](#))

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³ Hereinafter in short referred to as "panelist".

⁴ In her own words, she broadens the Oki Data criteria.

⁵ Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903.

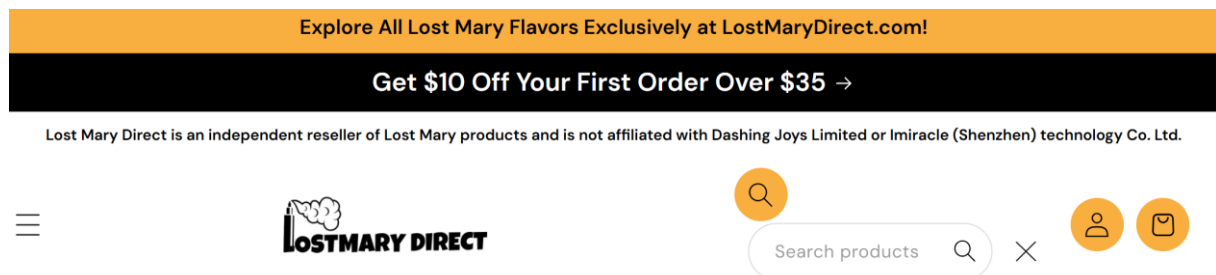
⁶ See Article 4 UDRP.

1. The relevant facts of <lostmarydirect.com>

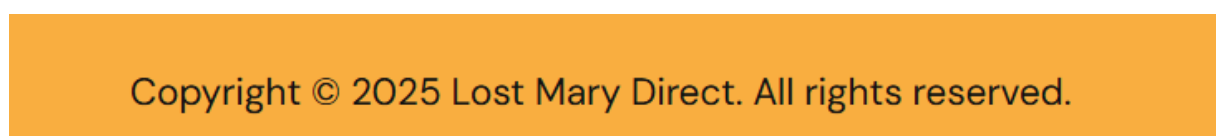
The complainants⁷, affiliated companies from Hong Kong and Shenzhen, China, are the owners of various trademark registrations from 2021 and 2022 for LOST MARY. Under this trademark, e-cigarettes are sold via online platforms in the United Kingdom.

The domain name, <lostmarydirect.com>, was registered on 30 November 2023 by the respondent, who uses the domain name for a website under the name LOST MARY DIRECT to resell original LOST MARY products, which he – undisputedly – purchased from official distributors of the complainant. The complainant does not sell directly to the public.

Prior to the filing of the UDRP complaint, a disclaimer could be found by clicking on "About Us" at the bottom of the homepage, on which separate page it was stated that the website is not affiliated with the complainant. Only after the complaint was filed, the respondent included a disclaimer⁸ at the top of the homepage.



Although this was not discussed in the decision, the website (at least in its current version) includes the copyright notice "*Copyright © 2025 Lost Mary Direct. All rights reserved.*" and no name other than the trade name Lost Mary Direct is listed as the operator of the website.



2. Background to the UDRP, the WIPO Overview 3.0 and the Oki Data criteria

UDRP

The UDRP was established more than 25 years ago because there was a need for a uniform economic solution to enable international action against *cybersquatting*

⁷ For the sake of readability, this note will refer in singular to complainant.

⁸ When consulting the website during the writing of this note, it stated: "Lost Mary Direct is an independent reseller of Lost Mary products and is not affiliated with Dashing Joys Limited or Imiracle (Shenzhen) technology Co. Ltd.".

(sometimes also referred to as *abusive registration*⁹). The World Intellectual Property Organisation (WIPO) proposed this policy to the Internet Corporation for Assigned Names and Numbers (ICANN), which adopted it. Subsequently, through a chain of contract and conditions, this policy became part of every registration agreement that a holder of, for example, a .com domain name enters into when registering that domain name. The UDRP is therefore a form of 'private' legislation that binds domain name holders, regardless of where they are located in the world.¹⁰

In summary, a complainant, usually a trademark holder, can claim the domain name registered by another party, the domain name holder (*registrant*), in an administrative procedure if the complainant proves the following:

- (i) the domain name is identical or confusingly similar to the complainant's trademark;
- (ii) the domain name holder has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith by the domain name holder.

These are usually referred to as the three UDRP elements.

Of course, there is criticism of the UDRP, but in general, the UDRP is praised for its consistency, predictability, efficiency and fairness¹¹. Complaints under the UDRP can be submitted to various dispute resolution providers, with the WIPO Arbitration and Mediation Center (WIPO AMC) handling most cases (6,168 UDRP and similar cases in 2024¹²). There are also various other bodies, such as the Czech Arbitration Court, which has been handling UDRP disputes since 2009 (936 UDRP and .eu cases in 2024¹³).

WIPO Overview 3.0

The case law of the WIPO AMC alone is very extensive. Since there is no right of appeal and predictability was desirable, the WIPO AMC took the initiative at some point to

⁹ Nominet, the organisation for .uk domain names, uses the following definition of *abusive registration*: "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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. See Nominet Dispute Resolution Service Policy, Article 1.

¹⁰ For a more general and detailed description of the system, please refer to Willem Leppink, Michelle Roosma, A practical guide to filing domain name complaints, Journal of Intellectual Property Law & Practice, Volume 17, Issue 11, November 2022, Pages 905–914, <https://doi.org/10.1093/jiplp/jpac100>.

¹¹ Initial Report of the WIPO-ICA UDRP Review Project Team, 17 April 2025, WIPO Arbitration and Mediation Centre and Internet Commerce Association, <https://www.wipo.int/amc/en/domains/resources/wipo-icaudrpreview.html>.

¹² WIPO Domain Name Report 2024: UDRP case filings remain strong, 15 January 2025, wipo.int.

¹³ See <https://www.adr.eu/> - manual count.

compile an overview of case law, providing answers to the most important legal questions. This overview also indicates whether there is consensus among the panelists on the answer, or only a majority or minority. The latest version is the WIPO Overview 3.0¹⁴. It is now common practice among panelists, including those at other dispute resolution institutions, to refer directly to this overview rather than to specific cases.

The majority of complaints submitted under the UDRP concern clear cases of domain name hijacking, such as domain names used for *phishing* or registering a domain name in order to pre-empt or otherwise interfere with another party that has a trademark corresponding to the domain name.

Oki Data

At some point in the application of the UDRP, the question arose as to how to deal with *fair use* of a trademark in a domain name, for example for a criticism site (trademarksucks.tld) or by a reseller, and a clear approach has been developed in UDRP case law, separate from the (supra)national legislation and case law that exists in the EU, for example, such as the BMW/Deenik judgment¹⁵.

The most important UDRP ruling in this regard is Oki Data¹⁶, handed down by the well-known panelist David Bernstein. In that ruling, it was held that there is a *bona fide* offering of goods and/or services of the trademark owner if:

- (i) the domain name holder actually offers the goods/services of the trademark holder via the domain name in question;
- (ii) the domain name holder uses the website exclusively to sell the trademarked goods (no 'bait and switch');
- (iii) the website accurately states the relationship between the domain name holder and the trademark owner (e.g. by means of a disclaimer); and
- (iv) the domain name holder does not occupy all available domain names, as a result of which the trademark holder would be unable to express its own trademark in a domain name.

These four requirements together form the Oki Data criteria.

This ruling ultimately became the most authoritative ruling in WIPO Overview 3.0, more specifically under Article 2.8, on how panelists should deal with fair use by resellers and distributors. The aim is to enable fair use by these resellers, but to prevent '*bait and switch*' and other unfair commercial practices by including a trademark in a domain name. It is also the case that if a reseller registers a domain name that is identical to the

¹⁴ WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition.

¹⁵ CJEU 23 February 1999, BMW/Deenik, ECLI:EU:C:1999:82, case number C-63/97

¹⁶ Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903, specifically under 6.B.b.

complainant's trademark, that reseller is unlikely to have a legitimate interest because such a domain name creates the impression of affiliation¹⁷.

The application of the Oki Data criteria normally concerns domain names in which the trademark is followed by a word that describes the goods or services, as in the case of the Oki Data ruling itself, i.e. <okidataparts.com>, a website where parts for OKI DATA branded printers could be purchased¹⁸. The prevailing opinion is that it depends on that additional (descriptive) term (in the case of Oki Data, 'parts') whether this creates the impression of a connection and that the panelist must assess the facts and circumstances of the case in more detail, including the content of the website¹⁹.

The Oki Data criteria play a role not only in the second element (absence of rights or legitimate interests), but also in the third element (registration and use in bad faith).

Where a defendant appears to have a right or legitimate interest in a domain name, a clear and sufficiently prominent disclaimer ("*the seller is not affiliated with the trademark owner*") will support the circumstances indicating its good faith. Such a disclaimer shows that the defendant has taken reasonable steps to avoid wrongfully presenting itself as someone who has an affiliation with the complainant or to otherwise confuse users²⁰.

Creating a false impression of an affiliation between the domain name and the trademark is not a legitimate interest and will therefore quickly lead to the conclusion that the registration and use are in bad faith. After all, the second and third elements are closely linked. The absence of good faith (second element) will quickly lead to the assumption of bad faith (third element).

In short, whether a reseller may register and use a domain name consisting of a trademark followed by a descriptive term depends on whether the domain name is likely to create the impression of any affiliation with the trademark owner, whereby the descriptive term chosen and the content of the website play a role. Thus, regardless of the content of the website, a domain name such as <volvocars.com> is more likely to give the impression of an affiliation than <volvoarespareparts.com>.

3. The amendment of the third Oki Data criterion in 'lostmarydirect.com'

In <lostmarydirect.com>, the panelist deemed it necessary to make the third Oki Data criterion 'broader'. This concerns the criterion in Oki Data that the website must accurately and prominently disclose the registrant's relationship with the trademark

¹⁷WIPO Overview 3.0, under 2.5.1 and 2.8.2. This concept is somewhat comparable to the appearance of a commercial connection in the CJEU judgment in BMW/Deenik.

¹⁸ WIPO Overview 3.0, under 2.8.2.

¹⁹ WIPO Overview 3.0, under 2.5.1.

²⁰ WIPO Overview 3.0 under 3.7.

holder, which usually refers to the use of a disclaimer stating that the registrant and the trademark owner are not affiliated.

The panelist amends its decision regarding the third Oki Data criterion in the sense that the registrant's (reseller's) website must be easily distinguishable from that of the trademark owner. As aspects (not limited to) that could be decisive in this regard, it mentions:

- (i) the inclusion of a disclaimer;
- (ii) creating a different look and feel of the reseller's website as compared to the website of the trademark owner;
- (iii) the dominant use of the reseller's website's specific elements like pricing and depiction of the goods; and
- (iv) the use of the reseller's own logo at the top of the homepage²¹.

The panelist sees this change to the third Oki Data criterion as a reason to rename the Oki Data criteria to Lost Mary criteria.

4. The panelist's considerations for changing the third Oki Data criterion in <lostmarydirect.com>;

Internet users have become more knowledgeable in the past 25 years

The panelist notes that the Oki Data criteria date from 2001, a time when internet use was not yet widespread. The criteria were intended to prevent confusion among the public, especially when an authorised dealer used the trademark owner's marketing material and the use of that marketing material could lead to confusion about who owned the website. Since the public was not very internet-savvy at the time, it made sense that the Oki Data case ruled that confusion should be avoided and the public should be informed that the defendant's website did not belong to the trademark owner. The panelist in <lostmarydirect.com> believes that this is why the requirement for a disclaimer was included.

Twenty-five years later, according to the panelist, the public has become sufficiently internet-savvy and able to distinguish an official website of a trademark owner from that of a reseller. The panelist refers to court rulings on the admissibility of the use of Google AdWords by unauthorised resellers and that the public can easily make that distinction.

Reseller websites have clear characteristics

²¹ In the text of the decision: "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."

The panelist considers that reseller websites have very clear characteristics: (i) it displays the goods for sale very prominently; and (ii) it provides information on pricing and discounts in a dominant way.

A disclaimer is therefore not *a conditio sine qua non* for determining whether the reseller's website is bona fide.

The purpose of the UDRP is limited to cybersquatting

Finally, the panelist points out that the UDRP was intended to prevent *cybersquatting* and cannot be used to settle all disputes concerning domain names²². In some disputes concerning domain names involving resellers, recourse to the ordinary courts is the appropriate course of action.

In the opinion of the panelist, the general rule remains that the reseller must make every effort to ensure that there is no confusion between the reseller's website and that of the trademark owner. A disclaimer can help in this regard, but clarity can also be provided in other ways, such as a different look and feel or a reseller logo on the site that clearly distinguishes it from that of the trademark owner.

5. Application of the amended third Oki Data criterion to the case

The panelist finds that the complainant's website and the reseller's website are quite different and can therefore be easily distinguished from each other. The complainant's website is calm and stylish, while the reseller's website stands out due to the use of a cheap-looking logo consisting of the words 'LOST MARY DIRECT' combined with a drawing of a *vape* and a cloud of smoke above the mouthpiece of the inhaler. In addition, the price information is presented in a rather garish manner and the different packaging is displayed. The respondent has therefore taken the necessary steps to distinguish its website from that of the complainant.

The panelist does note that the words LOST MARY are included in the defendant's logo and that this could constitute trademark infringement, but that this falls outside the scope of the UDRP.

In summary, the panelist finds that the reseller has a legitimate interest due to the differences between the websites and the way in which products and prices are presented.

The panelist therefore rejects the complaint, and the domain name does not have to be transferred to the complainant.

²² The Thread.com, LLC v. Poploff, WIPO Case No. D2000-1470.

6. Analysis

It is always good when a panelist identifies a sore point and determines that strict application of existing rules is not appropriate.

However, the existing Oki Data criteria are not set in stone. The Oki Data ruling, which was handed down almost 25 years ago, has been embraced by virtually all panelists in cases under the UDRP and also in cases under similar dispute resolution policies, such as the .nl Regulation²³, and has therefore also been included in the WIPO Overview 3.0.

However, the introduction to WIPO Overview 3.0 makes it clear that the overview and previous UDRP decisions are not binding on panelists and that panelists must assess the facts and circumstances of each case in a manner they deem fair. The Oki Data criteria are only considered as the last step. The general stance taken in UDRP case law is that, according to WIPO Overview 3.0, paragraph 2.8, there is no legitimate interest (and bad faith) in reseller cases if there is no fair use and, as already indicated above, the purpose is to prevent unfair trade practices by including a trademark in a domain name.

Oki Data has provided useful guidance in this regard by requiring, among other things, that the reseller's website accurately state the relationship between the registrant and the trademark owner. A clear disclaimer, and not one hidden away on another page, as was initially the case in this case, can explain that relationship (or rather the lack thereof). Nevertheless, it is also conceivable that a panelist could conclude, based on all the facts and circumstances, that *fair use* applies because it is evident that there is no unfair commercial practice. It is not necessary to 'amend' the Oki Data criteria, as the panelist advocates in <lostmarydirect.com>,. In the joint report published on 17 April 2025 by the WIPO AMC and the Internet Commerce Association, which was prepared by experts and stakeholders from all sides, several areas were identified where the UDRP could be amended. The Oki Data criteria were not among them.²⁴

The freedom not to apply the Oki Data criteria rigidly, is also exercised by panelists in appropriate cases, and the question is also raised as to whether a disclaimer is necessary in all cases. Panelists then opt for a more holistic approach, looking, for example, at circumstances such as the composition of the domain name and the content of the website, and thus whether the impression of a connection can be created²⁵. It is precisely

²³ Among others, Aktiebolaget Electrolux v. Beuk Horeca B.V., WIPO Case No. DNL2008-0050, Maison Louis Latour v. Jos Beeres Wijnkoperij, Case No. DNL2011-0074, Seiko EPSON Corporation v. ANEM Computers / ANEM, WIPO Case No. DNL2010-0024, and Bayerische Motoren Werke Aktiengesellschaft v. Linus Geerts, WIPO Case No. DNL2012-0030.

²⁴ Initial Report of the WIPO-ICA UDRP Review Project Team, 17 April 2025, WIPO Arbitration and Mediation Centre and Internet Commerce Association.

²⁵ Panel Reformulates Oki Data Test and Proposes "Lost Mary Criteria", Zak Muscovitch, Internet Commerce Association, <https://www.internetcommerce.org/udrp-case-summaries/panel-reformulates-oki-data-test-and-proposes-lost-mary-criteria-vol-5-30/> and the case law cited therein.

this freedom of panelists that makes it unnecessary to amend the Oki Data criteria (for everyone) as the panelist now intends to do with a somewhat grand gesture in <lostmarydirect.com>.

This is all the more true now that the amended third Oki Data criterion proposed by the dispute resolution service provider, namely that the defendant's website must be easily distinguishable from that of the trademark holder, does not strike me as a correct criterion, and certainly not as a criterion that can be applied in general.

The content of a website linked to the disputed domain name certainly plays a role in the assessment under the legitimate interest requirement (second element) of the UDRP²⁶, but does this also apply to the content of the trademark owner's (official) website? If both websites are very similar, as is often the case in website fraud cases, this is an (additional) circumstance for determining that there is a lack of legitimate interest²⁷ and the existence of bad faith²⁸. However, it is a completely different question whether visitors to a reseller website can and should be expected to know the trademark owner's (official) website and its look and feel (mentioned as two aspects). An internet user looking for a specific product will often use a search engine to find the (official) website for the product and, after selecting one of the search results, will try to determine whether the site is '*legit*' without comparing it to the other websites found.

I therefore disagree with the considerations of the panelist in <lostmarydirect.com>; that consumers have become (relatively) more internet savvy. It is precisely because of AI that creating a slick website has become much easier. For example, following the introduction of the Electronic Travel Authorisation (ETA) for travel to the United Kingdom, countless people have fallen victim²⁹ to slick websites offering this ETA at absurdly high prices, even though the travel authorisation can be obtained from the British government for less than EUR 20. Yet these websites do not resemble the official government website at all.

The same applies, in my view, to the aforementioned (third) aspect of the dominant use of specific elements of the reseller's website, such as the pricing and the image of the goods. How can visitors to the website linked to the disputed domain name know how the trademark owner's distribution system works and that the trademark owner does not sell any products on its official website and therefore will not quote any prices?

The fourth aspect to distinguish the domain name from the trademark owner, namely the use of its own logo at the top of the home page, is certainly not helpful in all cases, for reasons similar to those mentioned in the second and third examples. Does the visitor to the website know what the official logo looks like? In the present case, as the panelist

²⁶ See, for example, WIPO Overview 3.0, under 2.5.1.

²⁷ WIPO Overview, under 2.13.1.

²⁸ WIPO Overview, under 3.4.

²⁹ <https://www.maxvakantieman.nl/artikelen/europa-reizen/een-eta-aanvragen-voor-een-reis-naar-het-verenigd-koninkrijk-pas-op-voor-oplichting-en-identiteitsfraude-via-malafide-websites/>

pointed out, the logo contained the words 'LOST MARY DIRECT'. I agree with the panelist that panelists in general, within the framework of the UDRP³⁰, but WIPO Overview 3.0 under 2.8 has made it clear that it must be a matter of preventing unfair commercial practices, whereby, in my opinion, this concept must be interpreted autonomously from the UDRP and not in the narrow sense of the EU Directive of the same name.³¹ Certainly in this case, the trademark and trade infringement is evident. No other name is mentioned on the site. The logo says LOST MARY DIRECT and even the copyright notice mentions this. An unofficial distributor cannot simply incorporate another's trademark into its trademark or trade name.

Apart from all this, the domain name itself must also be considered, not just the associated website. As I indicated above, the prevailing opinion is that in order to determine whether the impression of an association with the trademark owner is created, the additional (descriptive) term combined with the trademark must also be considered, in this case 'direct'³². I share the opinion of Zak Muscovitch in his earlier comments on this case³³. A domain name such as <lostmarydirect.com>; may in fact indicate a direct Internet sales channel of the trademark holder, a sales channel that can exist alongside the trademark owner's physical layered distribution. In my view, this could have been given decisive weight in the decision.

7. Conclusion

Decisions such as <lostmarydirect.com>; serve a useful purpose. They encourage other panelists and other parties involved in domain name disputes to think carefully.

However, a change to the current Oki Data criteria, as advocated by the panelist in <lostmarydirect.com>, is not necessary and, certainly if not preceded by a thorough public discussion, would undermine the consistency and predictability for which the UDRP is so highly praised. Oki Data criteria are not binding in any case, and panelists have sufficient scope to assess (holistically) whether there is fair use by the reseller, regardless of the Oki Data criteria.

Furthermore, applying the proposed amendment to the Oki Data criteria would have undesirable consequences at a time when, despite years of internet experience, people

³⁰ And in some cases, a trademark owner is clearly better off in such a situation before the ordinary court under trademark law, as is also apparent from the judgment of the Court of Appeal in The Hague (the Netherlands) of 13 August 2013, Koninklijke Talens B.V. v Jurgen V. trading under the name Talensshop.nl and Lijstenmakerij Veldhoven, ECLI:NL:GHDHA:2013:2967, case number 200.110.714/01.

³¹ Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market.

³² WIPO Overview 3.0, under 2.5.1.

³³ Panel Reformulates Oki Data Test and Proposes "Lost Mary Criteria", Zak Muscovitch, Internet Commerce Association, <https://www.internetcommerce.org/udrp-case-summaries/panel-reformulates-oki-data-test-and-proposes-lost-mary-criteria-vol-5-30/>.

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still find it difficult, and perhaps even more so due to AI, to distinguish between fake and genuine, and between official and unofficial.
