

Decision for dispute CAC-UDRP-100407

Case number **CAC-UDRP-100407**

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Domain names **vanilla-visa.com**

Case administrator

Name **Tereza Bartošková (Case admin)**

Complainant

Organization **E2Interactive, Inc.**

Complainant representative

Organization **The Pawlak Law Firm**

Respondent

Organization **Technical Contact**

OTHER LEGAL PROCEEDINGS

The panel is not aware of the existence of other proceedings concerning the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant registered in its favor different U.S trademarks registrations, as follows:

- VANILLA, Reg. No. 3,228,968, registration date April 10, 2007.
- VANILLA, Reg. No. 3,664,949, registration date June 23, 2009.
- VANILLA, Reg. No. 3,336,174, registration date November 13, 2007.
- Vanilla (& Design), Reg. No. 3,349,536, registration date December 4, 2007.
- Vanilla (& Design), Reg. No. 3,750,736, registration date February 16, 2010.
- Vanilla (& Design), Reg. No. 3,336,190, registration date November 13, 2007.

Likewise the Complainant consider that the mark "VANILLA" has become well known in the USA and has built significant consumer recognition and goodwill in its "VANILLA" mark as a result of extensive marketing and sales efforts.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

This Complaint is based on the following grounds:

A. The domain name is identical or confusingly similar to trademarks and service marks in which the Complainant has rights;

- The Complainant has ownership in the following U.S. trademark registrations:
 - VANILLA, for “Magnetically encoded prepaid debit and stored value cards”, Reg. No. 3,228,698, Registration date April 10, 2007.
 - VANILLA, for “Non-magnetically encoded pre-paid debit and stored value cards” Reg. No. 3,644,949, Registration date June 23, 2009.
 - VANILLA, for “Pre-paid debit and stored value card services, namely, activation, deactivation, processing electronic payments through prepaid debit and stored value cards using a computer-based network”, Reg. No. 3,336,174, Registration date November 13, 2007.
 - VANILLA (& Design), for “Magnetically encoded prepaid debit and stored value cards”, Reg. No. 3,349,536, Registration date December 4, 2007.
 - VANILLA (& Design), for “Non-magnetically encoded pre-paid debit and stored value cards” Reg. No. 3,750,726, Registration date February 16, 2010.
 - VANILLA (& Design), for “Pre-paid debit and stored value card services, namely, activation, deactivation, processing electronic payments through prepaid debit and stored value cards using a computer-based network”, Reg. No. 3,336,190, Registration date November 13, 2007.
 - Copies of certificates for the above registrations are provided as Annex 1-6
- The domain name in dispute, www.vanilla-visa.com, uses VANILLA in attempting to sell pre-paid debit and stored value cards.
- Therefore the domain name is identical to the trademarks and service marks and is used for the identical services for such trademarks in which the Complainant has rights.

B. The Respondent has no rights or legitimate interests in respect of the domain name;

- The Respondent has no rights or legitimate interests in respect of the domain name that is the subject of the Complaint.
- * There is no evidence of the Respondent's 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;

- the Respondent (as an individual, business, or other organization) has not been commonly known by the domain name;

- the Respondent is not making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trademark or service mark at issue.

C. The domain name was registered and is being used in bad faith.

- The domain name was registered and used in bad faith by the Respondent. The Respondent intentionally attempts to attract Internet users to the Respondent's web site or other on-line location, for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Respondent never accessed the online platform although there is confirmation that he became aware of the Complaint after its remittance to his electronic mail address (contact@myprivateregistration.com). A confirmation that the brief was properly served is attached to the records of the case, which means that the due date for the submitting the reply was the 21st of March 2012.

Since no reply was filed by the Respondent, on the 22nd of March 2012 the Czech Arbitration Court declared him in default, in accordance with the Rules for UDRP and the Supplemental UDRP Rules of the Czech Arbitration Court, and advised him accordingly.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

If we take into account the brief filed by the Complainant as well as the documents attached thereof, it is clear that the disputed domain name ("vanilla-visa.com") is identical or confusingly similar to the Complainant's prior United States Trade Marks ("VANILLA" / "Vanilla (&Design)", on which it holds exclusive rights.

Regarding the need to prove that the disputed domain name is identical or confusingly similar to the registered Trademarks in which the Complainant has rights, the truth is that the Complainant has demonstrated that it is the holder of the United States Trade Marks:

- VANILLA, for "Magnetically encoded prepaid debit and stored value cards", Reg. No. 3,228,968, registration date April 10, 2007.
- VANILLA, for "Non-magnetically encoded prepaid debit and stored value cards", Reg. No. 3,664,949, registration date June 23, 2009.
- VANILLA, for "Pre-paid debit and stored value card services, namely, activation, deactivation, processing electronic payment through prepaid debit and stored value cards using a computer-based network", Reg. No. 3,336,174, registration date November 13, 2007.
- Vanilla (& Design), for "Magnetically encoded prepaid debit and stored value cards", Reg. No. 3,349,536, registration date December 4, 2007.
- Vanilla (& Design), for "Non-magnetically encoded prepaid debit and stored value cards", Reg. No. 3,750,736, registration date February 16, 2010.
- Vanilla (& Design), for "Pre-paid debit and stored value card services, namely, activation, deactivation, processing electronic payment through prepaid debit and stored value cards using a computer-based network", Reg. No. 3,336,190, registration date November 13, 2007.

Taking into account that the disputed domain name registered by the Respondent is "vanilla-visa.com", the Panel understands that the Complainant has demonstrated that such name is not only confusingly similar to its trade marks, but practically identical.

The Respondent has no rights or legitimate interest in respect of the domain name, and that the disputed domain name has been registered and is being used in bad faith by the part of the Respondent in order to attract internet users to its web site, creating a likelihood of confusion with the Complainant's trade marks and services.

Furthermore and besides all of the above, this Panel equally must point out that (i) the Respondent appears "protected" by the register firm where the domain name was registered and it makes impossible to know its real identity and (ii) it is not known by the domain name in dispute; both are something that without any doubt must be taken into account.

PROCEDURAL FACTORS

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.

PRINCIPAL REASONS FOR THE DECISION

With reference to the grounds of the present resolution, and in agreement with the provisions of Paragraph 4 (a) of the Policy, there are three elements the Complainant must prove in order to have the domain name registered by the Respondent assigned in his favor. These elements are:

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

If we take into account the brief filed by the Complainant as well as the documents attached thereof, it is clear that the disputed domain name ("vanilla-visa.com") is identical or confusingly similar to the Complainant's prior United States Trademarks ("VANILLA" / "Vanilla (&Design)", on which it holds exclusive rights.

Regarding the need to prove that the disputed domain name is identical or confusingly similar to the registered Trademarks in which the Complainant has rights, the truth is that the Complainant has demonstrated that it is the holder of the United States Trademarks:

- VANILLA, for "Magnetically encoded prepaid debit and stored value cards", Reg. No. 3,228,968, registration date April 10, 2007.
- VANILLA, for "Non-magnetically encoded prepaid debit and stored value cards", Reg. No. 3,664,949, registration date June 23, 2009.
- VANILLA, for "Pre-paid debit and stored value card services, namely, activation, deactivation, processing electronic payment through prepaid debit and stored value cards using a computer-based network", Reg. No. 3,336,174, registration date November 13, 2007.
- Vanilla (& Design), for "Magnetically encoded prepaid debit and stored value cards", Reg. No. 3,349,536, registration date December 4, 2007.
- Vanilla (& Design), for "Non-magnetically encoded prepaid debit and stored value cards", Reg. No. 3,750,736, registration date February 16, 2010.
- Vanilla (& Design), for "Pre-paid debit and stored value card services, namely, activation, deactivation, processing electronic payment through prepaid debit and stored value cards using a computer-based network", Reg. No. 3,336,190, registration date November 13, 2007.

Taking into account that the disputed domain name registered by the Respondent is "vanilla-visa.com", the Panel understands that the Complainant has demonstrated that such name is not only confusingly similar to its trade marks, but practically identical.

On the other side and as far as the second requirement is concerned, this is to demonstrate that the Respondent does not have any right or legitimate interest with respect to the domain name in question, this Panel has proceeded:

- a) To introduce in several searches of Internet the expression vanilla-visa having realized that on every occasion the first result obtained invites us to visit a web page of the Complainant, <https://www.vanillavisa.com/> with the message "one card, a million options", and it appears as a registered trademark, with the copyright symbol.
- b) To repeat the same operation using the expression vanilla.visa.com we obtain the same result as before.
- c) To repeat the same operation using the expression vanilla-visa.com in which case the first result obtained is the web page of the Respondent, showing the message established in the Annex 7 of the claim, but the info showed is a clear indication that the domain name is being used in business form offering a number of products or services identical to the products offered by the Complainant, which allows to affirm that the good faith has been damaged. Besides, one of the links showed in the website goes to workface.com, where we can find the next message: "It appears this page doesn't exist (and perhaps never did). Don't panic!

Just use the handy menu up top to get your bearings and try again.”

The above means that behind the domain name in dispute, “vanilla-visa.com”, (i) uses VANILLA in attempting to sell prepaid debit and stored value cards; (ii) it is identical to the trademarks and service marks and (iii) it is used for the identical services for such trademarks in which the Complainant has rights since many years ago.

The Respondent has no rights or legitimate interest in respect of the domain name and the disputed domain name has been registered and is being used in bad faith by the Respondent in order to attract internet users to its web site, creating a likelihood of confusion with the Complainant’s trade marks and services.

Furthermore and besides all of the above, this Panel equally must point out that (i) the Respondent appears “protected” by the privacy/proxy firm where the domain name was registered and it makes impossible to know its real identity and (ii) it is not known by the domain name in dispute; both are something that without any doubt must be taken into account.

Based on the above the Panel believes that the Complainant has demonstrated that each and every one of the requirements demanded for an application of the provisions of Paragraph 4 (a) are met and consequently considers that the Complaint must be admitted and the disputed domain name transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VANILLA-VISA.COM**: Transferred

PANELLISTS

Name	Enrique Batalla
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DATE OF PANEL DECISION 2012-04-02

Publish the Decision