Decision for dispute CAC-UDRP-100409

Case number	CAC-UDRP-100409
Time of filing	2012-02-23 16:30:03
Domain names	vanillavisagiftcard.net

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	E2Interactive, Inc.

Complainant representative

Organization	The Pawlak Law Firm

Respondent

Name	Private Registration

OTHER LEGAL PROCEEDINGS

The panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain name

IDENTIFICATION OF RIGHTS

Complainant is the owner of the following US trademark registrations:
- VANILLA no. 3228698 for goods in class 9 registered on April 10, 2007
- VANILLA no. 3644949 for goods in class 16 registered on June 23, 2009
- VANILLA no. 3336174 for services in class 36 registered on November 13, 2007
- VANILLA & design no. 3349536 for goods in class 9 registered on December 4, 2007
- VANILLA & design no. 3750726 for goods in class 16 registered on February 16, 2010
- VANILLA & design no. 3336190 for services in class 36 registered on November 13, 2007

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 “Magntically 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 “Magntically 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.vanillavisagiftcard.net, 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.

THE COMPLAINANT REQUESTS THE LANGUAGE OF THE PROCEEDINGS BE ENGLISH

The Complainant requests that the language of the proceedings be English. The registrar's website is provided in English, a copy of which is provided as Annex 9. The Registration Agreement is provided in English, a copy of which is provided here as Annex 10. The Registrar, as stated on its website, provides services in Chinese, German, and English. The Registrar, as stated on its website, provides customer service in Chinese, German, Dutch, and English. English is the language of the complaint. Most importantly, the domain name is composed of English words, and English is the language used on the relevant domain name's website. No other languages are associated with either the domain name or the relevant website. Therefore it is virtually certain that the Respondent speaks English, and as such these proceedings should be in English.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

See above

RESPONDENT:

No response has been filed

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is confusingly similar to the previous trademarks 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).

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

1) The Panel accepts the Complainant request that the language of the proceedings be English. In particular, Complainant demonstrates that English is a language used in the Respondent's website corresponding to the disputed domain name. Furthermore, the domain name itself is in English. These factors show that Respondent has or should have adequate knowledge of English to understand these proceedings (cfr Walgreen Company v. Jon Reegy, WIPO Case No. D2011-1621).

2) The domain name in dispute is confusingly similar to Complainant's previous US trademark registrations. The Complainant's rights on the word VANILLA were acquired before the registration made by Respondent for the domain name <vanillavisagiftcard.net>. The trademarks VANILLA appear to be registered and used by Complainant especially in connection with a gift card which can be used in locations where Visa debit cards are accepted. "Visa" is one of the most famous trademark in the debit card and "giftcard" is an ordinary dictionary word apt for use in relation to the Complainant's business (cfr. QVC Inc. and ER Marks Inc. v. WhoisGuard, WIPO Case No. D2007-1872; LEGO Juris A/S v. Xianbin Chen, WIPO Case No. D2011-0505). In consideration of the above, the Panel believes that the addition of the wording "visagiftcard" does not negate the confusing similarity created by Respondent's complete inclusion of the VANILLA trademark in the disputed domain name.

3) Regarding Respondent's lack of rights or legitimate interests, the Panel finds that the information related to Respondent does not indicate that Respondent is known by consumers with VANILLA, VANILLAVISAGIFTCARD or similar commercial signs. In these circumstances, Respondent would have been obliged to demonstrate an existing right, or interest, on said signs. The above demonstration was never submitted since no response has been filed in the present case.

4) By failing to file a response, the Respondent has done nothing to contest allegations of the Complainant according to which Respondent has registered and is using the disputed domain name in bad faith. Based on the facts, the registration and use of the domain name <vanillavisagiftcard> in bad faith by Respondent is evident. The Respondent is using a domain

name which corresponds to the trademarks registered and used by the Complainant with the mere addition of generic words and of a famous trademark which is associated with the Complainant's business. Actually Complainant is using its trademarks VANILLA especially in connection with a gift card which can be used in locations where Visa debit cards are accepted. The disputed domain name corresponds to a website in which Respondent is promoting and offering a product called Vanilla Visa Gift Cards. Of course the above behaviour is aimed to the sole purpose of attracting internet users to the Respondent's website for commercial gain by creating a likelihood of confusion with the Complainant's mark and taking advantage of the Complainant's trademarks and the goodwill associated with them.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VANILLAVISAGIFTCARD.NET**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2012-03-30

Publish the Decision