

ADMINISTRATIVE PANEL DECISION

e2Interactive, Inc. v. Privacy Administrator, Anonymize, Inc.
Case No. D2022-0791

1. The Parties

Complainant is e2Interactive, Inc., United States of America (“U.S.”), represented by Bates & Bates LLC, U.S.

Respondent is Privacy Administrator, Anonymize, Inc., U.S.

2. The Domain Name and Registrar

The Disputed Domain Name <vanillagiftcard.com> is registered with Epik, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 7, 2022. On March 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. Also on March 8, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on March 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 7, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 29, 2022.

The Center appointed Richard W. Page as the sole panelist (the “Panel”) in this matter on May 11, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant owns registrations of the VANILLA Mark, including without limitation, U.S. Trademark Registration Nos. 3,336,174 and 3,349,536 in classes 9, 16, and 36 related to pre-paid debit and stored value card services.

Complainant, in cooperation with its affiliate, Interactive Communications International, Inc. ("InComm"), provides pre-paid debit and stored value card services through the VANILLA Mark and on its websites "www.vanillagift.com", "www.vanillabalance.com", "www.onevanilla.com", "www.myvanillacard.com", and "www.myvanillabalance.com".

On or about April 2016, Complainant attempted to purchase and register the Disputed Domain Name to use it as part of its VANILLA Mark. However, when attempting to purchase the Disputed Domain Name, Complainant became aware that the Disputed Domain Name was registered to Mr. Stanley Pace, with whom Complainant has no relationship. On May 2, 2016, Complainant promptly sent a Cease and Desist Letter to Mr. Pace putting him on notice of Complainant's trademark rights and that the Disputed Domain Name's use was unauthorized.

The Disputed Domain Name was registered on July 18, 2013, and it redirected to multiple websites, at various points in time.

5. Parties' Contentions

A. Complainant

Complainant contends that the Disputed Domain Name is confusingly similar to the VANILLA Mark, pursuant to paragraph 4(a)(i) of the Policy.

Complainant further contends that the Disputed Domain Name includes the entirety of the VANILLA Mark with the addition of the generic and descriptive phrase "gift card". Complainant further contends that the generic Top-Level-Domain ("gTLD") ".com" can be disregarded for purposes of the confusing similarity analysis.

Complainant submits that Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

Complainant further submits that Respondent can have no rights or legitimate interests where the Disputed Domain Name uses the entirety of the VANILLA Mark and falsely suggests an affiliation to Complainant.

Complainant further submits that Respondent is not affiliated with Complainant and has been granted no license to use the VANILLA Mark in any capacity.

Complainant further submits that, in cooperation with InComm, it also owns many other domain names associated with the VANILLA Mark. Respondent, whose identity it chose to hide, appears to be engaging in an illegal phishing scheme where it is attempting to unlawfully obtain InComm customers' prepaid card, financial information and funds by using the confusingly similar Disputed Domain Name.

Complainant further submits that Respondent's phishing scheme does not constitute a *bona fide* or legitimate use of the Disputed Domain Name.

Complainant alleges that Respondent has registered and is using the Disputed Domain Name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Complainant further alleges that InComm created its legitimate “www.vanillagift.com” website on August 9, 2006, over six years before Respondent created its phishing website on July 18, 2013. Furthermore, InComm created its legitimate “www.myvanillabalance.com” website on May 27, 2008, its “www.myvanillagiftcard.com” website on July 9, 2009, its “www.myvanillacard.com” website on March 26, 2010, its “www.onevanilla.com” website on November 11, 2010, and its “www.vanillabalance.com” website on July 6, 2012; all well before registration of the Disputed Domain Name.

Complainant further alleges that, although the content of the website at issue was unavailable at the time of sending the Cease and Desist Letter to Mr. Pace, the Disputed Domain Name was still making unauthorized use of the VANILLA Mark within the Disputed Domain Name itself.

Complainant notes that the Disputed Domain Name previously redirected to “www.joyonecheck.com”, which not only contained the same alleged phishing scheme content with cited copyright/content owner as “Blackhawk Network,” but is also registered to the registrant contact of “www.acheckhoy.com”. Complainant further alleges that the Disputed Domain Name continuously redirects to multiple websites, at various points in time, which is a sophisticated phishing scheme to aid in avoiding detection by Complainant.

Complainant further alleges that this is particularly problematic not only because Complainant’s customers are being lured into an illegal phishing scheme by Respondent making unauthorized use of the VANILLA Mark, but also because Complainant’s customers may, and likely have already, mistakenly attributed the source and sponsorship of the VANILLA Mark to Complainant’s competitor Blackhawk Network or a third party not affiliated with Complainant.

Complainant further alleges that, after sending the Cease and Desist Letter described above, review of relevant online databases, including WIPO’s Domain Name Dispute Decision records, reveals that Mr. Pace has a pattern and practice of: (1) purchasing and registering domains that make unauthorized use of well-known third party trademarks (or marks confusingly similar thereto), (2) hiding his true identity via privacy services (including the same privacy protection service, Privacy Administrator/ Anonymize, Inc., currently being utilized by Respondent in the present case), and (3) is familiar with the UDRP process as evidenced by the vast number of UDRP decisions involving Mr. Pace.

Complainant further alleges that recently it was brought to Complainant’s attention that the Disputed Domain Name has again become active, that it continues to make unauthorized use of the VANILLA Mark in the Disputed Domain Name, that Registrant contact details are now privacy protected and that it appears to be a phishing website. Interestingly, Respondent’s alleged phishing website redirected to “www.acheckjoy.com” which lists that the copyright/content on the “www.acheckjoy.com” website is owned by Blackhawk Network, Complainant’s direct competitor.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Even though Respondent has failed to file a Response or to contest Complainant’s assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to the VANILLA Mark in which Complainant has rights;
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and,
- iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration of a trademark is *prima facie* evidence of Complainant having enforceable rights in the VANILLA Mark.

Complainant owns registrations of the VANILLA Mark, including without limitation, U.S. Trademark Registration Nos. 3,336,174 and 3,349,536 in classes 9, 16, and 36 related to pre-paid debit and stored value card services.

These registrations are *prima facie* evidence of Complainant's rights and they have not been refuted by Respondent.

Therefore, the Panel finds that, for purposes of this proceeding, Complainant has enforceable trademark rights in the VANILLA Mark.

Section 1.7 of the [WIPO Overview 3.0](#) says that inclusion of the entire trademark in a domain name will be considered confusingly similar. Also, Section 1.8 of the [WIPO Overview 3.0](#) instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity. Also see Section 1.11.1 of the [WIPO Overview 3.0](#) instructs that gTLDs, such as ".com" may be disregarded for purposes of assessing confusing similarity.

The Panel finds that the Disputed Domain Name includes the entirety of the VANILLA Mark with the addition of the phrase "gift card". The Panel further finds that that the gTLD ".com" can be disregarded for purposes of the confusing similarity analysis.

Therefore, the Panel concludes that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant contends that Respondent has no rights or legitimate interest in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

Section 2.1 of the WIPO Overview of [WIPO Overview 3.0](#) states that once Complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of Respondent, Respondent carries the burden of demonstrating it has rights or legitimate interests in the Disputed Domain Name. Where Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Policy paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Name, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the VANILLA Mark.

Complainant submits that Respondent can have no *bona fide* or legitimate noncommercial use of the Disputed Domain Name where the Disputed Domain Name uses the entirety of the VANILLA Mark and falsely suggests an affiliation to Complainant.

Complainant further submits that Respondent is not affiliated with Complainant and has been granted no license to use the VANILLA Mark in any capacity, nor has it been commonly known by the Disputed Domain Name.

Complainant further submits that, in cooperation with InComm, it also owns many other domain names associated with the VANILLA Mark. Respondent, whose identity it chose to hide, appears to be engaging an illegal phishing scheme where it is attempting to unlawfully obtain InComm customers' prepaid card, financial information and funds by using the confusingly similar Disputed Domain Name.

Complainant further submits that Respondent's phishing scheme does not constitute a *bona fide* or legitimate noncommercial use of the Disputed Domain Name.

The Panel finds that these submissions constitute a *prima facie* case that Respondent has no rights or legitimate interests in the Disputed Domain Name. Respondent has failed to contest these submissions.

Therefore, the Panel finds that Complainant has met the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant contends that Respondent registered and is using the Disputed Domain Name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Name:

(i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to Complainant who is the owner of the VANILLA Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or

(ii) you [Respondent] have registered the Disputed Domain Name in order to prevent the owner of the VANILLA Mark from reflecting the VANILLA Mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Disputed Domain name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the VANILLA Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product.

The four criteria set forth in paragraph 4(b) of the Policy are nonexclusive. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) ("Telstra"). In addition to these criteria, other factors alone or in combination can support a finding of bad faith.

Complainant alleges that InComm created its legitimate “www.vanillagift.com” website on August 9, 2006, over six years before Respondent created its phishing website on July 18, 2013. Furthermore, InComm created its legitimate “www.myvanillabalance.com” website on May 27, 2008, its “www.myvanillagiftcard.com” website on July 9, 2009, its “www.myvanillacard.com” website on March 26, 2010, its “www.onevanilla.com” website on November 11, 2010, and its “www.vanillabalance.com” website on July 6, 2012; all well before registration of the Disputed Domain Name.

Complainant further alleges that, although the content of the website at issue was unavailable at the time of sending the Cease and Desist Letter to Mr. Pace, the Disputed Domain Name was still making unauthorized use of the VANILLA Mark with in the Disputed Domain Name itself.

The Panel finds that these allegations support the conclusion that Respondent had actual and constructive knowledge of Complainant’s trademark rights prior to registration of the Disputed Domain Name. See sections 3.2.2 and 3.2.3 of the [WIPO Overview 3.0](#).

Complainant further alleges that Respondent has been hiding his identity using an anonymizing protocol, which constitutes an additional bad faith factor. See section 3.6 of the [WIPO Overview 3.0](#).

Complainant further alleges that Respondent’s use of the entire VANILLA Mark in the Disputed Domain Name constitutes an additional bad faith factor. See section 3.1.4 of the [WIPO Overview 3.0](#).

Complainant further alleges that Respondent has no legitimate purpose in the registration and use of the Disputed Domain Name which constitutes an additional bad faith factor. See section 3.0 of the [WIPO Overview 3.0](#).

Complainant further alleges that Respondent’s phishing scheme constitutes an additional factor of bad faith. See *E2Interactive, Inc. v. Jhonleno Fernandez*, WIPO Case No. [D2021-0645](#).

The Panel finds the existence of the following additional factors of bad faith: (1) actual and constructive knowledge, (2) anonymizing Respondent’s true identity, (3) use of entirety of well-known VANILLA Mark, (4) no plausible legitimate use of the Disputed Domain Name, and (5) use of a phishing scheme.

The Panel finds that Complainant has satisfied the elements of paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <vanillagiftcard.com> be transferred to the Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: May 25, 2022