

## **ADMINISTRATIVE PANEL DECISION**

JHO Intellectual Property Holdings, LLC v. Privacy Service Provided by Withheld for Privacy ehf / paul tom  
Case No. D2022-1834

### **1. The Parties**

Complainant is JHO Intellectual Property Holdings, LLC, United States of America (“United States”), represented internally.

Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / paul tom, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <bangenergyadverts.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 9, 2022. On May 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 23, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on May 24, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on May 24, 2022.

The Center verified that the Complaint together with the amendment to 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 June 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 4, 2022.

The Center appointed Phillip V. Marano as the sole panelist in this matter on July 12, 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 is the licensor for the energy drink company Vital Pharmaceuticals, Inc., dba Bang Energy, founded in 1993 and based in the United States. Complainant owns valid and subsisting registrations for the BANG ENERGY trademark in numerous countries, including the trademarks for BANG ENERGY (Reg. No. 6,255,043) in International Classes 5, and 32, registered on January 26, 2021, and BANG (Reg. No. 5,884,629) International Class 30, registered on October 15, 2019 in the United States, with the earliest priority dating back to December 9, 2008.

Respondent registered the disputed domain name on May 1, 2022. At the time this Complaint was filed, the disputed domain name resolves to a website displaying Complainant's trademarks and with an advertisement to "Get \$500 Weekly Paid To Drive Concept By BangEnergy Drinks", wherein consumers are offered the opportunity receive advertising revenue by wrapping their cars with advertisements for Complainant's products.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant asserts ownership of the BANG ENERGY and BANG trademarks (collectively "the BANG ENERGY trademarks"), and has adduced evidence of registrations in numerous countries and regions around the world, including Singapore, Costa Rica, Peru, and the United States, with the earliest priority in the United States dating back to December 9, 2008. The disputed domain name is confusingly similar to Complainant's BANG ENERGY trademarks, according to Complainant, because it entirely incorporates both trademarks, and the added term "advert" does not change the likely source of the domain name in the minds of consumers.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on Respondent's use of the domain name for an illegal car wrapping scam to impersonate Complainant and deceive consumers into believing that Complainant is associated with Respondent's illegal activities.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: Respondent's use of the disputed domain name to resolve to a website that misappropriates Complainant's trademarks, slogans, design marks, copyrighted website content, and official website trade dress, all to impersonate Complainant and perpetrate an illegal car wrapping scam whereby victims send Respondent funds to wrap their cars in advertisements for Complainant based on the false promise of each victim generating advertising revenue.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

#### **6. Discussion and Findings**

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;

- ii. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. The disputed domain name has been registered and is being used in bad faith.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3 ("A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true [...] UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent."); see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)")

#### **A. Identical or Confusingly Similar**

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the BANG ENERGY trademarks have been registered in the United States with priority dating back to December 9, 2008. Thus, the Panel finds that Complainant's rights in the BANG ENERGY trademarks have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's BANG ENERGY trademarks. In this Complaint, the disputed domain name is confusingly similar to Complainant's BANG ENERGY trademarks because, disregarding the ".com" generic Top-Level Domain ("gTLD"), the trademarks are contained in their entirety within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".com" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

Respondent's combination of Complainant's BANG ENERGY trademarks with the suffix term "adverts" does not prevent a finding of confusing similarity. WIPO Overview, section 1.8 (Additional terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element"); See *OSRAM GmbH v. Cong Ty Co Phan Dau Tu Xay Dung Va Cong Nghe Viet Nam*, WIPO Case No. [D2017-1583](#) ("[T]he addition of the letters 'hbg' to the trademark OSRAM does not prevent a finding of confusing similarity between the Disputed Domain Name and the said trademark.").

In view of Complainant's registrations for the BANG ENERGY trademarks and Respondent's incorporation of those trademarks in their entities in the disputed domain name, the Panel concludes that Complainant has established the first element of the Policy.

#### **B. Rights or Legitimate Interests**

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1. It is evidence that Respondent, identified by Whols

data for the disputed domain name as “Privacy Service Provided by Withheld for Privacy ehf / paul tom,” is not commonly known by the disputed domain name or Complainant’s BANG ENERGY trademarks.

UDRP panels have categorically held that use of a domain name for illegal activity—including the impersonation of the complainant and other types of fraud—can never confer rights or legitimate interests on a respondent. Circumstantial evidence can support a credible claim made by Complainant asserting Respondent is engaged in such illegal activity, including that Respondent has masked its identity to avoid being contactable. [WIPO Overview 3.0](#), section 2.13. See e.g. *Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. [D2009-1017](#) (“Respondent has used the domain name to pretend that it is the Complainant and in particular to create false emails pretending that they are genuine emails coming from the Complainant and one of its senior executives”). In this Complaint, Complainant has proffered strong evidence to establish that Respondent registered and used the disputed domain name in a clear attempt to impersonate Complainant and defraud potential victims. Specifically, Respondent created a fraudulent website offering consumers the opportunity to wrap their cars with advertisements for Complainant. Respondent falsely offers to pay to wrap each victim’s car, but ultimately each victim ends up transferring funds to Respondent. To this end, the second and third elements of the Policy may be assessed together where clear indicia of bad faith suggests that there cannot be any Respondent rights or legitimate interests. [WIPO Overview 3.0](#), section 2.15.

In view of the absence of any evidence supporting any rights or legitimate interests in the disputed domain name, and Complainant’s clear-cut evidence that the disputed domain name has been used to perpetrate an illegal car wrapping scam, the Panel concludes that Complainant has established the second element of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has 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 trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

UDRP panels have categorically held that registration and use of a domain name for illegal activity including impersonation and other types of fraud is manifestly considered evidence of bad faith within paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.3. Use of the disputed domain name by Respondent to pretend that it is Complainant or that it is associated with Complainant “brings the case within the provisions of paragraph 4(b)(iii) of the Policy, for it shows Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor, namely Complainant.” See *Edelman, Inc. v. Devteam Meetey*, WIPO Case No. [D2016-0500](#) (“The bad faith of the Respondent follows from the uncontested fact that the Respondent impersonated employees of the Complainant and even used the

disputed domain name in requesting a third party to pay a large amount of money to the Respondent. This can only be seen as a very clear fraudulent behavior. Registering a domain name which is confusingly similar to the trademark of a complainant and subsequently using such domain name to impersonate employees of the Complainant in an attempt to commit fraud is a clear example of registration and use in bad faith. This Panel considers such behavior as an attempt to disrupt the business of the Complainant as well as an attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark"). In this Complaint, as discussed above, Complainant has provided strong evidence and uncontroverted allegations regarding Respondent's bad faith, including: screengrabs of Respondent's website falsely advertising "Get \$500 Weekly Paid To Drive Concept By BangEnergy Drinks"; an FAQ on Complainant's official website warning potential victims about Internet car wrapping scams similar to the one perpetrated by Respondent; and independent social media posts and news reports describing the same.

Furthermore, where it appears that a respondent employs a privacy or proxy service merely to avoid being notified of a UDRP proceeding filed against it, UDRP panels tend to find that this supports an inference of bad faith. [WIPO Overview 3.0](#) section 3.6. Use of a privacy or proxy registration service to shield a respondent's identity and elude or frustrate enforcement efforts by a legitimate complainant demonstrates bad faith registration and use of a disputed domain name. See *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#) (the use of a proxy registration service to avoid disclosing the identity of the real party in interest is also consistent with an inference of bad faith when combined with other evidence of evasive, illegal, or irresponsible conduct).

In view of Respondent's impersonation of Complainant, Complainant's uncontroverted allegations that Respondent is perpetrating an illegal car wrapping scam, and Respondent's use of a proxy registration service to obfuscate its illegal conduct, the Panel concludes that Complainant has established the third element 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 <bangenergyadverts.com> be transferred the Complainant.

*/Phillip V. Marano/*

**Phillip V. Marano**

Sole Panelist

Date: August 2, 2022