

ADMINISTRATIVE PANEL DECISION

Early Warning Services, LLC v. Privacy service provided by Withheld for
Privacy ehf / luca nora
Case No. D2022-1980

1. The Parties

Complainant is Early Warning Services, LLC, United States of America (“United States” or “U.S.”), represented by Bryan Cave Leighton Paisner LLP, United States.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / luca nora, United States.

2. The Domain Name and Registrar

The disputed domain name <zelletrading.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 31, 2022. On June 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 1, 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 June 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on June 10, 2022.

The Center verified that the Complaint together with the amended 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 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 5, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on July 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

Without contest by Respondent, Complainant asserts in its Complaint as amended, and its Annexes attached provide evidence sufficient to support that:

Complainant together with its related and affiliated entities and licensees (collectively “Complainant”), operates one of the world’s leading and fastest-growing digital payment networks to provide electronic payment services under the service mark ZELLE (the “ZELLE Mark”). Complainant’s services enable individuals and companies to safely transfer money between bank accounts. Complainant’s services under the ZELLE Mark target a wide consumer base, and more than 1,700 financial institutions worldwide currently use such services. Some of the world’s largest banks offer Complainant’s services to their customers, including United States banking institutions Bank of America, U.S. Bank, Citi, Ally Bank, HSBC, and Wells Fargo. In the second Quarter of 2021, Complainant’s services under the ZELLE Mark processed 436 million transactions totaling USD 20 billion in payments.

Complainant holds numerous trademark registrations for the ZELLE Mark and variations thereof in the U.S. and around the world including:

1. U.S. Registration No. 5,277,307, ZELLE, filed on March 9, 2016, registered on August 29, 2017, for “financial transaction services, namely, providing secure payment and money options and permitting account holders to make payment requests”, in International Class 36 and claiming a first use date of June 14, 2017.
2. U.S. Registration No. 5,449,233, ZELLE, filed on August 9, 2016, registered on April 17, 2018, for “communication and telecommunication services, namely, delivery of messages by electronic transmission, over local or global communication networks”, in International Class 38 and claiming a first use date of February 22, 2017.
3. U.S. Registration No. 5,938,276), ZELLEPAY, filed on March 9, 2016, registered on December 17, 2019, for “financial transaction services, namely, providing secure payment and money transfer options and permitting account holders to make payment requests” in International Class 36.
4. U.S. Registration No. 5,302,986, ZELLE NETWORK filed on August 15, 2016, and registered on October 3, 2017, for “financial transaction services, namely, providing secure payment and money transfer options and permitting account holders to make payment requests”, in International Class 36 and claiming a first use date of June 12, 2017.

Complainant has also registered numerous domain names that incorporate the ZELLE Mark, including <zellepay.com>, used to access the Official ZELLE Website where it promotes its money transfer services in connection with the ZELLE Mark, as well as owning <zellepay.financial> and <zellepay.exchange>. Complainant’s ZELLE Mark services are also provided through Complainant’s own mobile computer application, which has millions of enrollments.

The disputed domain name was registered on November 12, 2021, and resolves to a copycat website configured to impersonate Complainant by prominently displaying Complainant’s ZELLE Mark, its purple color scheme, and its business contact information with no evidence of disclaimers, leading consumers to reasonably believe it originates with or is affiliated with Complainant. Respondent’s website also advertises investment management, cryptocurrency, and wealth management services, all of those services are not offered by Complainant.

A. Complainant

Complainant contends that the disputed domain name is identical or confusingly similar to Complainant's trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

5. Discussion and Findings

There are no exceptional circumstances within paragraph 5(e) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint (as amended), notwithstanding the failure of any person to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall "draw such inferences therefrom as it considers appropriate".

Where no substantive Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied.

The Panel will address its findings on each of these requirements in more detail below.

The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant claims trademark rights in the ZELLE Mark for its payment networks to provide electronic payment services dating back to February 2017. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting international trademark registration documents in the name of Complainant and therefore, Complainant has demonstrated it has rights in the ZELLE Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

Further, Complainant has provided a citation to prior UDRP decisions which support the recognition of Complainant's trademark rights established in the ZELLE Mark as distinctive and well known. See *Early Warning Services, LLC v. Contact Privacy Inc. Customer 1242726540 / Andy Bang, Amer Group Inc*, WIPO Case No. [D2020-2572](#); *Early Warning Services, LLC v. Privacy service provided by Withheld for Privacy ehf / Zeller Trappa, Cheap Toolie, Ken Zoe, and Jason Bourne*, WIPO Case No. [D2021-2846](#).

With Complainant's rights in the ZELLE Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's ZELLE Mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7.

Prior UDRP panels have held the fact that a domain name which wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the

addition of other words to such marks. [WIPO Overview 3.0](#), section 1.8 (“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”); see also *BNP Paribas v. Ronan Laster*, WIPO Case No. [D2017-2167](#).

The disputed domain name incorporates Complainant’s ZELLE Mark in its entirety and adds the descriptive term “trading”. Respondent’s addition to Complainant’s Mark of this descriptive term commonly found in Complainant’s financial services industry to form the disputed domain name would not prevent a finding of confusing similarity as noted in the UDRP precedents cited above. Complainant also contends Respondent’s selection of this term is to enhance confusion of consumers, an issue more appropriately considered under the second and third elements of the Policy. The addition of the generic Top-Level Domain (“gTLD”) “.com” is irrelevant in determining whether the disputed domain name is confusingly similar. See, *Research in Motion Limited v thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#); [WIPO Overview 3.0](#), section 1.11.

Based on the above, this Panel finds that the added term “trading” does not prevent a finding of confusing similarity between the disputed domain name and Complainant’s ZELLE Mark. Complainant’s well-known ZELLE Mark remains fully recognizable as incorporated in its entirety into the disputed domain name. Accordingly, the Panel finds the disputed domain name confusingly similar to the ZELLE Mark in which Complainant has rights and Complainant has thus satisfied its burden under Paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, the complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, and if successful the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the disputed domain name. If the respondent fails to come forward with such evidence, a complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or legitimate interests.

The first example, under paragraph 4(c)(i), is where “before any notice to you of the dispute, your 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”.

Here, the annexes to the Complaint show that the disputed domain name resolves to a copycat website configured by Respondent to pass its business off as Complainant or sponsored or endorsed by Complainant through prominently displaying Complainant’s ZELLE Mark, its purple color scheme, and its business contact information with no evidence of disclaimers. Complainant contends such configuration and content was created by Respondent to lead consumers to reasonably believe Respondent’s copycat website originates with or is affiliated with Complainant. Respondent’s website also advertises investment management, cryptocurrency, and wealth management services, which are not offered by Complainant.

Prior UDRP panels have held that the use of disputed domain names to confuse and attract Internet users through misuse of a well-known trademark, and the provision of content which promote goods and services impersonating and competitive to Complainant cannot be considered use in connection with a *bona fide* offering of goods or services under Paragraph 4(c)(i). See *The Clorox Company v. WhoisGuard Protected, WhoisGuard, Inc. / Enos Villanueva, Melissa Rosenberg, Yang Ming*, WIPO Case No. [D2021-0603](#).

Prior UDRP panels have also held that the use of a domain name for illegal activity involving impersonation and fraud (e.g., phishing, unauthorized account access/hacking, impersonation/passing off, or other types of

fraud) can never confer rights or legitimate interests on a respondent. See, [WIPO Overview 3.0](#), section 2.13. See also, *Springer Nature Limited v. Registration Private, Domains By Proxy, LLC / Collections Springer Nature*, WIPO Case No. [D2020-0955](#).

Applying the foregoing decision to these facts this Panel finds the disputed domain name is not being used in connection with a *bona fide* offering of goods or services sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraph 4(c)(i) of the Policy.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant states that Respondent is not related in any way with Complainant, does not carry out any activity for, nor have any business with Respondent. Neither has Complainant granted any license or authorization to Respondent to make any use of Complainant's ZELLE Mark or apply for registration of the disputed domain name. Complainant has never authorized Respondent to use the ZELLE Mark, or any marks confusingly similar thereto for any purpose, including as a domain name. Prior UDRP panels have found a lack of rights or legitimate interests under the second element of the Policy based on such circumstances. See, e.g., *Charles Schwab & Co., Inc. v. Josh Decker d/b/a I GOT YOUR TIX*, WIPO Case No. [D2005-0179](#); *Guerlain S.A. v. H I Investments*, WIPO Case No. [D2000-0494](#).

Complainant also shows that Respondent is not commonly known by the disputed domain name because the original Respondent listed in the Whois record submitted with the initial Complaint displayed "Privacy service provided by Withheld for Privacy ehf" of Iceland. The Registrar identified the underlying registrant in its verification process, "luca nora" of the United States, who has been added in the amended Complaint as a co-Respondent. Neither bears any resemblance to the disputed domain name whatsoever. Thus, there is no evidence in this case to suggest that Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, the Panel finds this sub-section of the Policy is of no help to Respondent and the facts presented here support a lack of rights or legitimate interests in the disputed domain name. See *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. [D2002-0433](#).

In light of the above, and with no Response or other submission in this case to rebut Complainant's assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#).

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, Complainant contends and prior UDRP Panels have found that the ZELLE Mark is a distinctive and well-known trademark. See e.g., *Early Warning Services, LLC v. Contact Privacy Inc. Customer 1242726540 / Andy Bang, Amer Group Inc, supra*.

Complainant further contends that given its ZELLE Mark is well known, and the disputed domain name incorporates the ZELLE Mark in its entirety, shows both Respondent's actual knowledge of the ZELLE Mark and widespread recognition, especially in the United States where Respondent is located, and the mark has been in use for at least four years before Respondent registered the disputed domain name. Prior UDRP

panels have found that where, as here, it would be implausible to believe that Respondent selected and was using the disputed domain name for any other purpose than to trade on Complainant's trademark rights and reputation, establishes a fact pattern that repeatedly has been held to constitute bad faith registration and use. See *Houghton Mifflin Co. v. Weathermen, Inc.*, WIPO Case No. [D2001-0211](#); see also *Philip Morris Inc. v. Tsytkin*, WIPO Case No. [D2002-0946](#).

Prior UDRP panels have also held that a respondent's selection of a disputed domain name that comprises the complainant's mark in its entirety demonstrates a respondent's actual knowledge to support a finding of bad faith in registering and using the domain. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v Mark Lott*, WIPO Case No. [D2000-1487](#). Moreover, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Finally, as noted in 6B. above, the disputed domain name, which Respondent has intentionally configured to enhance confusing similarity to Complainant's ZELLE Mark by adding a descriptive term common to Complainant's financial services industry, "trading", and using the disputed domain name to direct or redirect consumers to Respondent's copycat website providing financial services in competition with Complainant's services. Prior UDRP Panels have found these facts demonstrate a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant's ZELLE Mark as to the source, sponsorship, affiliation or endorsement of respondent's website, and, therefore, evidence of registration and use of the disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy. See, e.g., *Microsoft Corporation v. Zerbo*, WIPO Case No. [D2005-0644](#); *Royal Bank of Canada v. China Capital Investment Limited*, WIPO Case No. [D2017-1025](#); *Travelscape, LLC v. WhoisGuard Protected, WhoisGuard, Inc. / Irwin Periola*, WIPO Case No. [D2020-2741](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied paragraph 4(a)(iii) of the Policy.

6. 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, <zelletrading.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: August 5, 2022