

## **ADMINISTRATIVE PANEL DECISION**

e2Interactive, Inc. v. Adam Cohen

Case No. D2022-4310

### **1. The Parties**

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

Respondent is Adam Cohen, Türkiye.

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

The disputed domain name <vanillacard.net> is registered with EuroDNS S.A. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 11, 2022. On November 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 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 (Whois Privacy, Whois Privacy (enumDNS dba) and contact information in the Complaint. The Center sent an email communication to Complainant on November 15, 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 November 15, 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 November 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 8, 2022.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on December 15, 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 a company organized under the laws of the United States that offers prepaid debit and stored value card services.

Complainant has documented to be the registered owner of numerous trademarks relating to its brand VANILLA, *inter alia*, but not limited to the following:

- word mark VANILLA, United States Patent and Trademark Office (USPTO), registration number: 3,228,698, registration date: April 10, 2007, status: active;
- word mark VANILLA, USPTO, registration number: 3,336,174, registration date: November 13, 2007, status: active.

Moreover, Complainant has demonstrated to be entitled to use numerous domain names worldwide which are owned by a company affiliated with Complainant, but directly relate to Complainant's VANILLA trademark, e.g., the domain names <vanillacard.com> (since 2005) as well as <vanillagift.com> (since 2006). The latter resolves to a website at "www.vanillagift.com", where Complainant and its affiliate offer, *inter alia*, debit (gift) cards issued pursuant to a license from Visa U.S.A., Inc. and bearing the well-known VISA trademark for online sale.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of Türkiye who registered the disputed domain name on July 30, 2020. The latter resolves to a website purportedly offering debit (gift) cards under among others the VISA trademark for online sale.

Complainant requests that the disputed domain name be transferred to Complainant.

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

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

Complainant contends that its VANILLA trademark has gained fame and notoriety, with Complainant being the sole owner of the VANILLA trademark with the USPTO relating to prepaid debit and stored value card services.

Complainant submits that the disputed domain name is confusingly similar to its VANILLA trademark, as it includes the latter identically and the presence of the word "card" does nothing to alleviate any confusing similarity. Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent is not affiliated with Complainant, and Complainant did not authorize Respondent to create and use the confusingly similar disputed domain name, (2) Respondent created a confusingly similar disputed domain name over 13 years after Complainant created its domain names <vanillacard.com> as well as <vanillagift.com>, and (3) Respondent is using the disputed domain name to engage in a phishing scheme, demonstrating it has no legitimate rights therein. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) Respondent is using Complainant's well-known VANILLA trademark in its entirety without authorization to do so, (2) Respondent is using the disputed domain name as part of a phishing scheme, and (3) Respondent is attempting to trade-off the goodwill and reputation Complainant has established in the VANILLA trademark.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (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.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

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

The Panel concludes that the disputed domain name is confusingly similar to the VANILLA trademark in which Complainant has rights.

The disputed domain name incorporates the VANILLA trademark in its entirety, simply added by the term "card". Numerous UDRP panels have recognized that where a domain name incorporates a trademark in its entirety, 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 to that trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7). Moreover, it has been held in many UDRP decisions and has become a consensus view among UDRP panelists (see [WIPO Overview 3.0](#), section 1.8), that the addition of other terms (whether e.g. descriptive or otherwise) would not prevent the finding of confusing similarity under the first element of the UDRP. Accordingly, the addition of the term "card" (which even refers to Complainant's core business of selling debit (gift) cards) is not in contrast to find confusing similarity arising from the incorporation of Complainant's entire VANILLA trademark in the disputed domain name.

Therefore, Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

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

The Panel is further convinced on the basis of Complainant's undisputed contentions that Respondent has not made use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor has Respondent been commonly known by the disputed domain name, nor can it be found that Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain.

Respondent has not been authorized to use Complainant's VANILLA trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the term "Vanilla" on its own. To the contrary, Respondent is running a website under the disputed domain name reproducing Complainant's VANILLA trademark and offering debit (gift) cards bearing the VISA trademark for online sale just as Complainant and its affiliate do. Such making use of the disputed domain name neither qualifies as *bona fide* nor as legitimate noncommercial or fair within the meaning of the Policy.

Moreover, the nature of the disputed domain name is inherently misleading and carries a risk of an implied affiliation as it effectively suggests sponsorship or endorsement by Complainant, which is not the case (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, Complainant has established a *prima facie* case that Respondent has no rights or legitimate interests in respect of the disputed domain name. Now, the burden of production shifts to Respondent to come forward with appropriate allegations or evidence demonstrating to the contrary (see [WIPO Overview 3.0](#), section 2.1). Given that Respondent has defaulted, it has not met that burden.

Therefore, the Panel finds that Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

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

The Panel finally holds that the disputed domain name was registered and is being used by Respondent in bad faith.

The circumstances of this case leave no serious doubts that Respondent was fully aware of Complainant's rights in the VANILLA trademark when registering the disputed domain name and that the latter is clearly directed thereto. Moreover, using the disputed domain name, which is confusingly similar to Complainant's undisputedly well-known VANILLA trademark, to run a website reproducing such trademark and offering debit (gift) cards bearing the VISA trademark just as Complainant and its affiliate do, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with Complainant's VANILLA trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Therefore, the Panel concludes that Complainant has also satisfied the third element under the Policy set forth by paragraph 4(a)(iii).

## **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 <vanillacard.net> be transferred to Complainant.

*/Stephanie G. Hartung/*

**Stephanie G. Hartung**

Sole Panelist

Date: December 29, 2022