

ADMINISTRATIVE PANEL DECISION

Honey's Place, Inc. v. Stanley Pace

Case No. D2023-2108

1. The Parties

The Complainant is Honey's Place, Inc., United States of America ("United States"), represented by Matheson & Associates, PLLC, United States.

The Respondent is Stanley Pace, United States, represented by John Berryhill, United States.

2. The Domain Name and Registrar

The disputed domain name <viben.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 11, 2023. On May 12, 2023, the Complainant filed an amended Complaint, having rectified certain information. On May 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 15, 2023, 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 (PRIVACY ADMINISTRATOR/ANONYMIZE, INC., REGISTRATION PRIVATE/DOMAINS BY PROXY, LLC) and contact information in the Complaint and amended Complaint. The Center sent an email communication to the Complainant on May 17, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on May 22, 2023.

The Center verified that the Complaint together with the amended Complaint and 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 the Respondent of the Complaint, and the proceedings commenced on May 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 14, 2023, which was extended to June 18, 2023 pursuant to paragraph 5(b) of the Rules.

The Response was filed with the Center on June 15, 2023.

The Center appointed Evan D. Brown as the sole panelist in this matter on June 29, 2023. 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

The Complainant sells sex toys. It claims ownership of the trademark VIBEN which is registered with the United States Patent and Trademark Office (“USPTO”) (Reg. No. 6195548, registered on November 10, 2020, with an alleged date of first use of December 1, 2019). The Respondent points out a discrepancy as to whether the Complainant owns this trademark registration, observing that the USPTO registration certificate lists “Honey’s Place” (with no “Inc.”) as the owner of the registration. The Panel observes that the application in this USPTO file identifies the applicant as a California limited liability company.¹

The Whois information shows that the disputed domain name was first registered on March 25, 1999, but the Respondent asserts that it registered the disputed domain name in 2016. The Complainant has not provided any argument or evidence indicating that the Respondent acquired the disputed domain name later than 2016. The disputed domain name directs Internet users to a page indicating that although the disputed domain name is not actively for sale, the Respondent would consider reasonable offers to purchase it. The Complainant has submitted evidence showing that in the past the disputed domain name resolved to a pay-per-click (“PPC”) landing page on which it hosted hyperlinks to third-party websites unrelated to the Complainant, with an option offering the disputed domain name for sale.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical to the Complainant’s trademark; that the 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

The Respondent generally disputes each of the Complainant’s assertions. As it relates to the element of bad faith registration and use, the Respondent emphasizes that it registered the disputed domain name prior to the existence of any of the Complainant’s rights in the VIBEN mark and that accordingly, the disputed domain name could not have been registered in bad faith.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the 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. The Panel finds that the Complainant has not met some of these elements.

A. Identical or Confusingly Similar

This first element under the Policy functions in effect as a standing requirement. WIPO Overview of WIPO

¹ Ultimately, this discrepancy does not matter because, as explained below, there is no dispute that the Respondent acquired the disputed domain name prior to the existence of any purported rights of the Complainant in the VIBEN mark. That sequence is fatal to the Complainant’s assertions of bad faith registration and, by extension, fatal to the Complaint.

Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). Despite the discrepancy concerning ownership of the asserted trademark registration, the Panel credits the Complainant's claim of ownership for purposes of evaluating this element. Accordingly, the Panel finds that the Complainant has demonstrated its rights in the VIBEN mark.

The disputed domain name incorporates the VIBEN mark in its entirety. This is sufficient for showing confusing similarity under the Policy.

Accordingly, the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant's arguments consist of an account of how the Complainant's search of the USPTO records revealed no active registrations or applications other than ones connected to the Complainant, and a conclusory statement that the disputed domain name is not being used for any commercial gain other than to advertise the disputed domain name for sale.

The Panel finds these assertions – also noting the failure under the third element – insufficient to make a *prima facie* showing, and accordingly, the Panel finds that the Complainant has failed to establish this second element under the Policy.

C. Registered and Used in Bad Faith

The Policy requires that a successful complainant establish that a disputed domain name was both registered and used in bad faith. Subject to certain limited and somewhat exceptional scenarios not present in this case, where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent. [WIPO Overview 3.0](#), Section 3.8.1; *Consumer Safety Analytics, LLC v. Andre Auguste, Advanced Nutrients*, WIPO Case No. [D2021-1972](#).

The record shows that the Respondent acquired the disputed domain name in May 2016, and that the Complainant began using the VIBEN mark no earlier than 2019 (and did not obtain the full benefits of a national registration until 2020).

The Complainant did not submit any evidence that the Respondent obtained the disputed domain name via transfer subsequent to the date on which the Complainant's trademark rights came into existence or that the Respondent would have somehow been aware of the Complainant's nascent trademark rights when registering the disputed domain name. The fact that the Respondent procured the disputed domain name before the Complainant first used its trademark in commerce undermines the Complainant's assertions that the disputed domain name was registered in bad faith.

Accordingly, the Panel finds that the Complainant has not met its burden under this third element.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: July 13, 2023