

ADMINISTRATIVE PANEL DECISION

J&J Snack Foods Corporation, The ICEE Company v. Contact Privacy Inc.
Customer 0164959674 / Edmond Lecaire, The Icee Company
Case No. D2022-3041

1. The Parties

The Complainants are J&J Snack Foods Corporation (“First Complainant”) and The ICEE Company (“Second Complainant”), United States of America (“United States” or “USA”), represented by The Belles Group, P.C., USA.

The Respondent is Edmond Lecaire, The Icee Company, France.

2. The Domain Name and Registrar

The disputed domain name <the-icee-company.com> (“Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2022. On August 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 18, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 19, 2022, 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 amended Complaint on August 19, 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 the Respondent of the Complaint, and the proceedings commenced on August 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on September 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

The Second Complainant was established in 1967 in the United States. It was acquired by the First Complainant in 1987 and remains a wholly owned subsidiary of the First Complainant. The Complainants produce and sell frozen carbonated beverages, machines for making these beverages and related goods under the trademark ICEE (the "ICEE Mark") and a related red and blue logo ("ICEE Logo"). The Complainants sell more than 500 million frozen beverages each year and trades across the world, including in the United States, China, Western Europe and South Africa.

The Complainants are the owners of trademark registrations for the ICEE Mark in various jurisdictions, including a United States trademark registration number 0872994, registered on July 15, 1969, for refrigerated dispensing machines for beverages.

The Domain Name was registered on August 6, 2022. The Panel has visited the website at the Domain Name and notes that as of September 16, 2022, the Domain Name redirects to a website (the "Respondent's Website") that features the Complainants' ICEE Mark and ICEE Logo and purports to sell the Complainant's ICEE frozen beverage dispensing machines. A Panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent and the use of the domain name, see *Société des Produits Nestlé SA v. Telmex Management Services*, WIPO Case No. [D2002-0070](#).

However, the Complainants have received complaints from third parties that the Respondent's Website is involved in the commission of a fraud, as those third parties had sought to purchase products from the Respondent's Website but did not receive the product they paid for.

5. Parties' Contentions

A. Complainant

The Complainants make the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainants' ICEE Mark;
- (ii) that the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainants are the owners of the ICEE Mark, having registered and used the ICEE Mark in the United States and other jurisdictions. The Domain Name is confusingly similar to the ICEE Mark since it wholly incorporates the ICEE Mark and adds the descriptive words "the-" and "-company".

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known by the Domain Name nor does the Respondent have any authorization from the Complainants to register the Domain Name. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name. Rather the Respondent is using the Domain Name to impersonate the Complainant for the purpose of operating a fraudulent scheme, targeting potential customers of the Complainant.

The Domain Name was registered and is being used in bad faith. The Respondent clearly registered the Domain Name in awareness of the Complainant since the Domain Name is being used to impersonate the Complainant for the purpose of a committing fraud.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Consolidation of Multiple Complainants

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") provides at section 4.11.1, in respect of the issue "Multiple complainants filing against a single respondent" that:

"Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation."

The present proceeding involves two Complainants bringing a single complaint against a common Respondent. The Complainants have made a request for consolidation and bear the onus of establishing that such a consolidation is justified.

The Panel is satisfied, based on the material filed, that the Complainants have a specific common grievance against the Respondent, in that the Complainants have a common legal interest as related entities that hold and use the ICEE Mark. The Panel has considered whether it would be equitable and procedurally efficient to permit the consolidation.

The Panel finds that it is equitable and procedurally efficient to grant the Complainants' request for consolidation.

B. Identical or Confusingly Similar

To prove this element the Complainants must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainants' trade or service mark.

The Complainants are the owner of the ICEE Mark, having registrations for the ICEE Mark as a trademark in the United States.

The Domain Name consists of the ICEE Mark with the addition of the words "the-" and "-company". Other UDRP panels have repeatedly held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the [WIPO Overview 3.0](#).

The Panel finds that the Domain Name is confusingly similar to the Complainants' ICEE Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

C. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent is not affiliated with the Complainants in any way. The Respondent has not been authorized by the Complainants to register or use the Domain Name or to seek the registration of any domain name incorporating the ICEE Mark or a mark similar to the ICEE Mark.

The Whois lists “The Icee Company” as registrant of record. However, given the use to which the Domain Name is put the Panel is not satisfied that the Respondent is actually commonly known under this name as opposed to simply registering the Domain Name under a pseudonym for the purpose of asserting rights or legitimate interests. The Respondent has provided no evidence that an entity known as “The Icee Company” different to the Second Complainant exists and is operating a legitimate business. The mere fact that the name of a respondent appears from the Whois record to match the domain name, without additional affirmative evidence, does not lead to the conclusion that such a respondent is commonly known by the disputed domain name under Policy 4(c)(ii).

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial fair use. Rather the Respondent has used the Domain Name to impersonate the Complainants (by the prominent use of the ICEE Mark and ICEE Logo) for the purpose of engaging in a fraudulent scheme, requesting payment in exchange for the provision of the Complainants’ products, which it then does not provide. As stated in section 2.13.1 of the [WIPO Overview 3.0](#) “[p]anels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent”.

The Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has failed to rebut that *prima facie* case and establish that it has rights or legitimate interests in the Domain Name under the Policy. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location (Policy, paragraph 4(b)).

The Panel finds that the Respondent was aware of the Complainants and their reputation in the ICEE Mark at the time the Domain Name was registered. The Domain Name resolves to a website impersonating the Complainants for the purpose of conducting a fraud. The Respondent does not provide, nor is it apparent to the Panel, any reason why the Domain Name was registered other than by reference to the Complainants. The registration of the Domain Name in awareness of the Complainants and their rights in the ICEE Mark and in the absence of rights or legitimate interests amounts to registration in bad faith.

The Respondent has used the Domain Name to impersonate the Complainants for the purpose of defrauding potential customers of the Complainants, who think they are purchasing a product from the Complainants but are actually transferring their money to the Respondent, who will not provide them with anything in exchange (according to the Complainant's unrebutted allegations, and references to "two customers – one located in the U.S. and one located in France – who were scammed when they tried to purchase the product offered for sale on the offending website"). Such conduct is deceptive, illegal, and in previous UDRP decisions has been found to be evidence of registration and use in bad faith; see *The Coca-Cola Company v. Marcus Steiner*, WIPO Case No. [D2012-1804](#).

In addition, considering the composition of the Domain Name and its use for a website displaying the ICEE Mark and purporting to offer the Complainant's products, the Panel finds that the Respondent has been seeking to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the ICEE Mark.

Accordingly, the Panel finds that the Respondent has registered and used the Domain Name in bad faith under 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 Domain Name, <the-icee-company.com>, be transferred to the Complainants.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: September 22, 2022