

ADMINISTRATIVE PANEL DECISION

Sbarro Franchise Co. LLC v. Song He

Case No. D2022-4550

1. The Parties

The Complainant is Sbarro Franchise Co. LLC, United States of America (“United States”), represented by Gottlieb, Rackman & Reisman, PC, United States.

The Respondent is Song He, China.

2. The Domain Name and Registrar

The disputed domain name <sbarrogrimsby.com> (the “Disputed Domain Name”) is registered with Hong Kong Juming Network Technology Co., Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 29, 2022. On November 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 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 the Complainant on December 1, 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 amendment to the Complaint on December 3, 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 the Respondent of the Complaint, and the proceedings commenced on December 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 3, 2023.

The Center appointed Mariya Koval as the sole panelist in this matter on January 9, 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 is a subsidiary of Sbarro LLC, which is an American company, founded in 1956. Sbarro LLC is a world-famous owner and operator of fast-food pizzerias and Italian-style restaurants.

Today, Sbarro LLC owns, operates, licenses, and oversees 644 company-owned and franchised restaurants around the world. Sbarro's LLC tallied global sales in 2021 were in excess of USD 247 million. Sbarro LLC has invested millions of dollars in advertising and promoting of its brand and further supports its franchisors' advertising efforts both domestically and internationally.

The Complainant is the owner of numerous SBARRO trademark (the "SBARRO Trademark") registrations around the globe, among which are:

Trademark	Country/Register	Registration No.	Registration Date	International Class
SBARRO	United States	0985647	June 4, 1974	42
SBARRO	United States	1991581	August 6, 1996	30
SBARRO	Hong Kong, China	199702712AA	March 4, 1996	29, 30, 43
SBARRO	European Union	000113613	September 16, 1998	29, 30, 42

The Complainant has also a significant online presence, operating the main domain name <sbirro.com>, has thousands of followers on Twitter and Instagram, and nearly 300,000 followers on Facebook.

The Disputed Domain Name was registered on May 6, 2022. At the date of this decision, the website under the Disputed Domain Name is inactive. The Complainant also provides evidence that it attempted to settle this dispute amicably, through a cease-and-desist letter of September 8, 2022, to which it received no response.

5. Parties' Contentions

A. Complainant

The Complainant alleges that that the Disputed Domain Name is confusingly similar to the Complainant's SBARRO Trademark in view of the dominant part of the Disputed Domain Name comprising the SBARRO Trademark – which by virtue of the Complainant's decades-long use of the Trademark, substantial advertising and promotion, and enormous sales success is indisputably strong, distinctive, and uniquely associated with the Complainant –, and geographical term "grimsby". The geographic term is one for locations that have either hosted or been in close proximity to the Complainant's locations. The presence of term "grimsby" in the Disputed Domain Name does not inhibit the finding of confusing similarity between the Disputed Domain Name and the SBARRO Trademark.

The Complainant alleges that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name because the Complainant has not licensed, authorized, or otherwise sanctioned the Respondent's use of the Complainant's SBARRO Trademark for any purpose. Moreover, the Complainant's use of its famous SBARRO Trademark predates the Respondent's registration of the Disputed Domain Name by more than five decades. In addition, there is nothing to indicate that the Respondent is now or has ever been known by or referred to by a name wholly consisting of or incorporating the SBARRO Trademark. There is no evidence that the Respondent has made any *bona fide* commercial use of the SBARRO Trademark considering the Disputed Domain Name fails to load any webpage, and thus the Disputed

Domain Name is not associated with a webpage that might indicate that the Respondent has any claim to or interest in the SBARRO Trademark.

The Complainant further asserts that the Respondent has registered and used the Disputed Domain Name in bad faith in view of the following:

- the Disputed Domain Name includes the famous SBARRO Trademark, in which the Complainant has enjoyed exclusive rights in the field of restaurant and food services for more than fifty years;
- the Respondent cannot reasonably dispute that it was unaware of the SBARRO Trademark and its use in connection with restaurant and catering services prior to registering the Disputed Domain Name since the Complainant owns 644 locations worldwide;
- “Sbarro” is an arbitrary word with no significance except as the trademark. By any reasonable analysis, therefore, it cannot be seriously doubted the Respondent devised and registered the Disputed Domain Name with every intention of trading upon the renown of and goodwill reposed in the SBARRO Trademark.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has properly asserted its rights in the SBARRO Trademark due to the long use and number of registrations globally. The Panel notes that the registration of the Complainant’s Trademark predates the registration of the Disputed Domain Name for almost fifty years. The Panel finds that the Complainant has established that the SBARRO Trademark is well recognized and world-famous.

The Disputed Domain Name completely reproduces the Complainant’s SBARRO Trademark in combination with the geographical term “grimsby” and the generic Top Level Domain (“gTLD”) “.com”. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[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. In this case, the addition of the geographical term “grimsby” to the SBARRO Trademark does not prevent a finding of confusing similarity.

According to the [WIPO Overview 3.0](#), section 1.11, the applicable gTLD in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant contends that the Respondent has no relationship with or permission from the Complainant to use the SBARRO Trademark, the Respondent has neither been commonly known by the Disputed Domain Name.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is always on the Complainant, once the Complainant makes out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, the burden of production of evidence shifts to the Respondent.

The Panel finds that the Complainant has made a *prima facie* case. The Respondent registered the Disputed Domain Name more than almost fifty years after the SBARRO Trademark has been registered. Moreover, the Complainant's Trademark is well-known throughout the world. There is no evidence that the Respondent owns any SBARRO Trademarks, nor that it is commonly known by the Disputed Domain Name. Therefore, the Respondent has failed to come forward with any evidence to rebut such *prima facie* case.

The Panel also considers it is more than likely that the Respondent was well aware of the Complainant's SBARRO Trademark when registering the Disputed Domain Name, taking into account the long use and reputation of the Complainant's Trademark.

According to the section 2.5.1 of the [WIPO Overview 3.0](#) UDRP, panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. In this case, the Disputed Domain Name contains the Complainant's Trademark in its entirety, adding the geographic term "grimsby", which is the name of towns in England and Canada, both of which are in proximity to the Complainant's locations. Such composition creates an impression of the Disputed Domain Name being related to the Complainant (that is not consistent with the reality), that, correspondingly, cannot give rise to rights or legitimate interests in the Disputed Domain Name.

The Disputed Domain Name does not resolve to an active website, which gives no grounds for considering the use the Disputed Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

In view of the foregoing, the Panel finds that the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy indicates some circumstances, without limitation, that 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 you [respondent] have registered or you have 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

that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

Taking into consideration that the SBARRO Trademark has been in use for more than 50 years and that the Complainant has spent huge amounts and efforts for promotion of its Trademark, the Panel considers it is clear that the Respondent was well aware of the Complainant and its SBARRO Trademark at the time of registration of the Disputed Domain Name. Moreover, the Disputed Domain Name, incorporating the Complainant's SBARRO Trademark in its entirety, is clearly deceptive for the Internet users. According to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Panel finds that the registration of the Disputed Domain Name was likely intended to take unfair advantage of the Complainant's famous SBARRO Trademark. The Complainant's SBARRO Trademark became well-known many years prior to the Respondent's registration and use of the Disputed Domain Name. Based on these facts, the Panel finds that the Respondent's registration of the Disputed Domain Name constitutes a clearly intentional attempt to target the Complainant's well-known SBARRO Trademark, of which it could not reasonably have been unaware.

In addition, this Panel notes that the Disputed Domain Name does not currently resolve to an active webpage. However, previous UDRP panels have frequently found that the apparent lack of so-called active use of the domain name (*i.e.* passive holding) does not prevent a finding of use in bad faith in specific circumstances, which include the degree of distinctiveness or reputation of the complainant's mark and the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use (section 3.3 of [WIPO Overview 3.0](#) and *e.g.* *Virgin Enterprises Limited v. Cesar Alvarez*, WIPO Case No. [D2016-2140](#); *"Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc.*, WIPO Case No. [D2017-0246](#)).

Finally, the Respondent, not participating in these proceedings, has failed to indicate any facts and/or evidence, which would show the good faith registration and use of the Disputed Domain Name.

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, the Disputed Domain Name has been registered and is being used in bad faith.

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, <sbarrogrimsby.com>, be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: January 29, 2023