

ADMINISTRATIVE PANEL DECISION

Washington Square Management v. Scott Weiner, Fifty/50 Restaurant Group
and The Fifty/50 Management Group Inc.

Case No. D2024-2097

1. The Parties

Complainant is Washington Square Management, United States of America (“United States”), represented by Fuksa Khorshid, LLC, United States.

Respondent is Scott Weiner, Fifty/50 Restaurant Group, United States, and The Fifty/50 Management Group Inc., United States.

2. The Domain Name and Registrar

The disputed domain name <parlorpizza.com> (the “Domain Name”) is registered with Squarespace Domains II LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 20, 2024. On May 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 21, 2024, 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 to Complainant on May 27, 2024, 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 May 28, 2024.

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 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 24, 2024. The Response was filed with the Center on June 15, 2024. The

Complainant filed an unsolicited supplemental filing on June 20, 2024. In its discretion, the Panel has elected to consider this unsolicited supplemental filing.

The Center appointed Robert A. Badgley as the sole panelist in this matter on July 8, 2024. 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 owns and operates three pizza restaurants in the Near North area of Chicago, Illinois. These restaurants are known as PARLOR PIZZA BAR.

Complainant holds registered trademarks with the United States Patent and Trademark Office (“USPTO”) for the design mark PARLOR PIZZA BAR (USPTO Reg. No. 4888052, registered on January 19, 2016) and the word mark PARLOR PIZZA BAR (USPTO Reg. No. 6535183, registered on October 26, 2021). Both marks are registered in connection with, among other things, “bar services” and “restaurant services” with a September 12, 2014 date of first use in commerce. Both marks disclaim the exclusive right to use “PIZZA BAR” apart from the mark as shown.

Complainant operates a commercial website at the domain name <parlorchicago.com>.

According to the Whois record, the Domain Name was registered on February 21, 2004. According to Complainant:

“Respondents registered the Domain Name in February 2004 and, on information and belief, did not upload content until on or after October 27, 2021, long after Complainant registered the Parlor Marks with the USPTO and long after Complainant began using the Parlor Marks.”

Respondent operates pizza restaurants called “Professor Pizza” and “Roots Pizza,” which are located in Chicago within a few miles of Complainant’s restaurants.

For a time, the Domain Name was redirected to a website featuring an October 27, 2021 news article bearing the headline, “All Three Parlor Pizza Bars Shut Down After Raids from IRS [United States Internal Revenue Service] and Police.” Complainant asserts that this news story is inaccurate and misleading, as well as outdated.

As of June 20, 2024, today, the Domain Name resolves to a parking page stating that the Domain Name is for sale.

Complainant alleges:

“On or around April 4, 2022, Respondents offered to sell, acting through intermediary GoDaddy.com, the Domain Name to Complainant for \$150,000 US. After further negotiations, Respondents asked for \$140,000 US and later \$85,000 US.”

The documents annexed to Complainant’s supplemental filing do not establish whether it was Complainant or Respondent who initiated the discussion about a possible sale of the Domain Name.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent denies registering or using the Domain Name for nefarious purposes, such as impersonating Complainant or trying to disrupt the business of a competitor. Respondent also challenges the validity of Complainant's trademark rights, arguing generally that "pizza parlor" is a generic term for a restaurant serving pizza, and that numerous businesses have referred to their pizza restaurants as "pizza parlors."

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in mark PARLOR PIZZA BAR through registration demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The Domain Name incorporates the mark and deletes the word "bar." In the Panel's opinion, the mark remains recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] 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 Panel need not address this element, given its ruling below in the "Bad Faith" section.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes, on the record presented here, that Complainant has failed to prove that Respondent registered the Domain Name in bad faith. It is undisputed in this record – and expressly alleged by Complainant – that Respondent registered the Domain Name in February 2004. It is also undisputed in this record (based on the USPTO trademark registration documents submitted by Complainant) that Complainant did not first use the mark PARLOR PIZZA BAR until September 2014, which is more than ten years after Respondent registered the Domain Name. The Panel also notes that, notwithstanding Complainant’s USPTO registrations, Respondent is correct in asserting that many restaurateurs and patrons use the term “pizza parlor” descriptively or even generically. The Domain Name, of course, is a mere inversion of these two words.

The fact that Respondent appears to have registered the Domain Name before Complainant ever made use of the trademark PARLOR PIZZA BAR makes it impossible to conclude that Respondent registered the Domain Name with Complainant’s mark in mind. (The Panel makes no finding as to the content temporarily hosted on the site or the offer to sell; they cannot in any event overcome this timing issue.) Absent evidence of trademark targeting, there can be no finding of bad faith registration of the Domain Name. As such, the Complaint must fail.

Complainant has not established Policy paragraph 4(a)(iii).

7. Decision

For the foregoing reasons, the Complaint is denied.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: July 22, 2024