

ADMINISTRATIVE PANEL DECISION

Sbarro Franchise Co. LLC v. xiao ming chen, chenxiao ming

Case No. D2022-0550

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 xiao ming chen, chenxiao ming, China.

2. The Domain Name and Registrar

The disputed domain name <sbarro-ontario.com> is registered with CNOBIN Information Technology Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 17, 2022. On February 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 21, 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 February 21, 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 February 24, 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 March 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 28, 2022.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on April 4, 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.

On April 8, 2022, the Panel issued Administrative Panel Procedural Order No. 1 requesting the Complainant to submit Annexes that were inadvertently omitted from the initial filing. The Complainant sent the requested Annexes to the Center on the same day. The Respondent was invited, but did not submit any comments on this filing.

4. Factual Background

The Complainant is a subsidiary of Sbarro LLC, which runs 597 fast food pizzerias and Italian-style restaurants around the world, operated under either the Sbarro group's own management or under a franchising arrangement. The Complainant provides evidence that its group's global sales in 2021 were in excess of USD 246 million. The Complainant also claims that its group companies invest millions of US dollars in advertising and promoting the SBARRO brand, and that it has a significant online presence and social media following.

The Complainant provides evidence that it, together with its group companies, owns a trademark portfolio for SBARRO, including, but not limited to, United States trademark number 4982244 for the SBARRO word mark, registered on June 21, 2016, and United States trademark registration number 5185588, for the SBARRO device mark, registered on April 18, 2017. The Complainant also owns a portfolio of domain name registrations, including <sbarro.com>, registered on March 5, 1998.

The disputed domain name was registered on December 9, 2021, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name directs to an active website in Chinese, currently offering gambling services.

The Complainant also provides evidence that it attempted to settle this dispute amicably, through a cease-and-desist letter of January 10, 2022 and a follow-up email of January 24, 2022, to which it received no response.

5. Parties' Contentions

A. Complainant

The Complainant essentially contends that the disputed domain name is confusingly similar to its trademarks for SBARRO, 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.

The Complainant claims that its trademarks are distinctive and well-known, and submits company and marketing information as well as a number of prior UDRP decisions which have recognized the Complainant's rights in the SBARRO marks and considered such marks well-known, see for instance *Sbarro Franchise Co., LLC v. Kouwenbin*, WIPO Case No. [D2019-0884](#) and *Sbarro Franchise Co., LLC v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Josephong*, WIPO Case No. [D2020-0604](#). The Complainant particularly argues that the disputed domain name is confusingly similar to its trademarks, that the Respondent is in no way connected to, or licensed by the Complainant, that there are no other justifications for the use of its trademarks in the disputed domain name, and that the Respondent's abusive use of the disputed domain name does not confer any rights or legitimate interests on it. The Complainant also contends that the disputed domain name was registered in bad faith because the Respondent cannot reasonably dispute that it was unaware of the SBARRO trademarks and its use in connection with the Complainant's restaurant and catering services prior to registering the disputed domain name. Moreover,

the Complainant contends that the fact that the Respondent is using the disputed domain name to redirect Internet users to a commercial gambling website is *per se* evidence of bad faith in registering the disputed domain name.

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

B. Respondent

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

6. Discussion and Findings

The Policy requires the Complainant to prove three elements:

- (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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has shown that it has valid rights in the marks SBARRO based on its intensive use and longstanding registration of the same as trademarks in various jurisdictions.

As to confusing similarity of the disputed domain name with the Complainant's marks, the Panel considers that the disputed domain name consists of the combination of two elements, being the Complainant's SBARRO trademark combined with the geographical term "ontario", connected by a hyphen. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[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". The Panel concludes that the disputed domain name contains the entirety of the Complainant's SBARRO trademark, which remains easily recognizable in the disputed domain name as its only distinctive feature. The Panel considers that the addition of the purely geographical term "ontario" therefore does not prevent a finding of confusing similarity. The Panel also notes that the applicable generic Top-Level Domain ("gTLD") (".com" in this case) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1. Finally, the Panel finds that the hyphen may be disregarded as it is considered merely a punctuation mark (see also *Vente-Privee.Com and Vente-Privee.com IP S.à.r.l. v. 崔郡 (jun cui)* WIPO Case No. [D2021-1685](#)).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark, and that the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a *bona fide* provider of goods or services under the disputed domain name and is not making legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Upon review of the facts and evidence provided by the Complainant, the Panel notes that the disputed domain name directs to a website offering gambling services. In the Panel's view, this shows that the Respondent's intention was not to make any use of the disputed domain name as a *bona fide* provider of goods or services, or to make legitimate noncommercial use or fair use of the Complainant's trademarks in the disputed domain name. Instead, it shows the intention on the part of the Respondent to include the Complainant's trademarks into the disputed domain name to obtain unlawful commercial gains.

Furthermore, the nature of the disputed domain name, incorporating the Complainant's trademark for SBARRO in its entirety, combined with the geographical term "-ontario", carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the registration of the disputed domain name was clearly intended to take unfair advantage of the Complainant's famous trademarks for SBARRO, by using such mark in its entirety in the disputed domain name to mislead and divert consumers to the gambling website hosted at the disputed domain name. The Panel also considers that the Complainant's SBARRO trademarks became well-known years prior to the Respondent's registration and use of the disputed domain name, and that such trademarks are fanciful and distinctive and have no other meaning except as a trademark. 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 trademark, of which it could not reasonably have been unaware. In the Panel's view, the preceding elements establish the bad faith of the Respondent in registering the disputed domain name.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directs Internet users to a website offering gambling services. The Panel accepts that this shows the intention on the part of the Respondent to attract, for commercial gain, Internet users to the website linked to the disputed domain name by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of such website. This constitutes direct evidence of bad faith under paragraph 4(b)(iv) of the Policy. Moreover, the Panel considers that the Respondent also tarnishes the Complainant's trademarks by using them in the disputed domain name which directs Internet users to a website offering commercial gambling services. The Panel accepts this as *per se* evidence of bad faith use of the disputed domain name (see also prior UDRP decisions on this matter such as *Sodexo v. Li Li*, WIPO Case No. [D2015-1018](#)). On the basis of the foregoing elements, the Panel finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

Finally, the Respondent failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third element under 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 disputed domain name <sbarro-ontario.com> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: April 19, 2022