

ADMINISTRATIVE PANEL DECISION

VAP Licensing s.r.o. v. MOSES DAROCHA

Case No. D2022-4188

1. The Parties

The Complainant is VAP Licensing s.r.o., Czech Republic, represented by NOTOS Partnerschaft von Rechtsanwälten mbB, Germany.

The Respondent is MOSES DAROCHA, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <vapianospizza.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 4, 2022. On November 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 4, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 9, 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 November 15, 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 November 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 9, 2022.


The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on December 28, 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 Complainant is the licensing company of the VAPIANO Group, which is a restaurant chain that offers Italian-style food in 134 restaurants across 25 countries.

The Complainant is the owner of the following trademark registrations in the United States:

Trademark	No. Registration	Date of Registration
VAPIANO	3275305	August 7, 2007
VAPIANO 	5298651	October 3, 2017

The Complainant owns the domain name <vapiano.com>, where the Complainant has used the VAPIANO trademark since at least 2002.

The Respondent registered the disputed domain name on March 29, 2022, which redirects to the domain name <pizzatatiana.com>, which in turn resolves to a website of a pizza restaurant.

5. Parties' Contentions

A. Complainant

I. Identical or Confusingly Similar

That the Complainant is part of a restaurant franchise group founded in 2002 that offers Italian-style food.

That the Complainant is the owner of trademark registrations in the United States with priority rights dating back to at least as early as 2003.

That the disputed domain name is confusingly similar to the VAPIANO trademark, since it is included entirely, plus the addition to the letter "s", and the term "pizza".

That the disputed domain name is likely to cause consumers to be confused or mistaken about a possible affiliation or association with the Respondent.

That the disputed domain name is used in connection with an Italian-style fast-food restaurant, which directly competes with the Complainant.

II. Rights or Legitimate Interests

That the Respondent has no rights to or legitimate interests in respect of the disputed domain name, since no circumstances listed under paragraph 4(c) of the Policy are present.

That the disputed domain name redirects to the domain name <pizzatatiana.com>, which is not connected to the Complainant in any way.

That the use of the VAPIANO trademark in the disputed domain name carries a risk of a tacit association of the restaurant's website to which the disputed domain name resolves, with the Complainant's restaurants.

That the Complainant did not allow the use of, nor granted authorization to the Respondent to use the Complainant's trademark.

That there is no legitimate relationship between the Respondent and the Complainant.

That the Complainant has made a *prima facie* case that the Respondent does not have rights to or legitimate interests in the disputed domain name.

III. Registered and Used in Bad Faith

That the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website to which the disputed domain name redirects, by creating a likelihood of confusion with the Complainant's trademark.

That, at the time when the disputed domain name was registered, the Respondent should have been aware of the VAPIANO trademark.

That use in bad faith is indicated by the illegitimate commercial interest of the Respondent. That the Respondent originally ran his restaurant under the name "Vapiano Pizza". That, however, after a cease-and-desist letter sent by the Complainant, the Respondent changed the restaurant's name to "Pizza Tatiana", but refused to cease using the disputed domain name.

That this suggests that the Respondent registered the disputed domain name with the intention to trade on the reputation of the Complainant's trademark.

That the disputed domain name is being used for commercial gain and creating a likelihood of confusion with the Complainant's trademark and business as to the source, sponsorship affiliation or endorsement of the website to which it resolves.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant is required to prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

Given the Respondent's failure to submit a formal Response, the Panel may decide this proceeding based on the Complainant's undisputed factual allegations, in accordance with paragraphs 5(f), 14(a), and 15(a) of the Rules (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#)).

A. Identical or Confusingly Similar

The disputed domain name is confusingly similar to the Complainant's trademark VAPIANO, as it incorporates said trademark entirely, with the addition of the letter "s", and the term "pizza", which do not

prevent confusing similarity from said trademark (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

The addition of the generic Top-Level Domain (“gTLD”) “.com” to the disputed domain name constitutes a technical requirement of the Domain Name System. Therefore, it has no legal significance in the present case (see *CARACOLITO S SAS v. Nelson Brown, OXM.CO*, WIPO Case No. [D2020-0268](#), and *Société Air France v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues* WIPO Case No. [D2019-0578](#)).

In light of the above, the first element of the Policy has been met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets forth the following examples as circumstances where a respondent may have rights or legitimate interests in the disputed domain name:

- (i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it did not acquire trademark or service mark rights; or
- (iii) the respondent is 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 Complainant has proven to be the owner of trademark registrations for VAPIANO in the United States, where the Respondent has declared to reside.

The Complainant has asserted that there is no relationship or affiliation between the Complainant and the Respondent, and that it has not granted any authorization to the Respondent to use its trademark VAPIANO (see *Beyoncé Knowles v. Sonny Ahuja*, WIPO Case No. [D2010-1431](#); and *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#)). The Respondent did not contest these allegations.

According to the evidence filed by the Complainant, the disputed domain name redirects to <pizzatatiana.com>, which resolves to a website of a pizza restaurant. Therefore, and considering that the disputed domain name entirely incorporates the Complainant’s trademark VAPIANO, plus the term “pizza”, the Panel notes that the composition of the disputed domain name carries a risk of implied affiliation since Internet users may think that the website to which the disputed domain name resolves is the Complainant’s official website or is otherwise affiliated to or sponsored by the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#), see also *Euro Sko Norge AS v. Whoisguard Inc. / Shier Dede, Shier Dede*, WIPO Case No. [D2020-0194](#), *Bechtel Group, Inc. v. Raman Shuk*, WIPO Case No. [D2020-1469](#), *Biofarma v. Dawn Mason*, WIPO Case No. [D2019-1952](#)).

Moreover, the disputed domain name resolves to a website that operates an Italian-style restaurant that competes with those of the Complainant. Thus, previous UDRP panels have found that using a complainant’s mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests. See section 2.5.3 of the [WIPO Overview 3.0](#), see also *Roberto Federico Wille Buschmann and Industrial Esco-will, S.A. de C.V. v. STX – Dominios, STX* WIPO Case No. [D2017-2581](#) (“Further, in the Panel’s view, the redirecting of the disputed domain name to a website offering similar and competing products to those marketed by the Complainant, is neither a *bona fide* offering of goods nor a legitimate noncommercial or fair use of the disputed domain name under subparagraphs (i) and (iii) of Policy paragraph 4(c).”).

The Complainant has made a *prima facie* case asserting that there is no evidence of the Respondent's use of the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent has not submitted evidence to prove otherwise.

In light of the above, the Panel finds that the Respondent has no rights to or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Bad faith under the Policy is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, shall be evidence of registration and use 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 that complainant, for valuable consideration in excess of your 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 its website or location.

As previously stated, the Complainant has proven that it owns registrations for the VAPIANO trademark in the United States, where the Respondent has declared to reside.

The fact that the Respondent chose to register the disputed domain name that incorporates the trademark VAPIANO, which registrations cover the same services as those offered by him in his restaurant, and which has a relevant presence in the global and United States market in the food industry, suggests that the Respondent knew the Complainant, its trademarks, and its business when registering said disputed domain name. Therefore, the Panel finds that the Respondent has targeted the Complainant, which constitutes opportunistic bad faith (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#); and *Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot*, WIPO Case No. [D2019-0980](#)).

The facts also show that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to his website by creating the impression among Internet users that said website was related to, associated with, or endorsed by the Complainant, which conduct constitutes bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#); see also *trivago GmbH v. Whois Agent, Whois Privacy Protection Service, Inc. / Alberto Lopez Fernandez, Alberto Lopez*, WIPO Case No. [D2014-0365](#); and *Jupiter Investment Management Group Limited v. N/A, Robert Johnson*, WIPO Case No. [D2010-0260](#)).

According to the evidence submitted by the Complainant and not contested by the Respondent, the Respondent's business used to be called "Vapiano Pizza", but as a result of a cease-and-desist letter sent by the Complainant to the Respondent, he changed the name of the restaurant to "Pizza Tatiana", however, he refused to cease using the disputed domain name.

The disputed domain name redirects to a website that offers the same Italian-style restaurant services in competition with those of the Complainant, which amounts to bad faith under paragraph 4(b)(iv) of the Policy. Section 3.1.4 of the [WIPO Overview 3.0](#), states that Panels have found that “redirecting the disputed domain name to the [C]omplainant’s (or a competitor’s) website” is evidence to support that the Respondent registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademarks (see also *AllianceBernstein LP v. Texas International Property Associates*, WIPO Case No. [D2008-1230](#) (“It is well-established that use of a domain name to redirect Internet users to websites of competing organizations constitutes bad faith registration and use under the Policy.”), and *Carvana, LLC v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2020-1533](#) (“(ii) By using the Disputed Domain Name to divert Internet users away from the Complainant’s website towards the Respondent’s website or third-party websites in competition with the Complainant, the Panel finds the Respondent is likely to be improperly reaping commercial profit through diverted sales, and is likely to derive a benefit from the suspicious malware offerings.”)).

Moreover, the Complainant submitted evidence showing that the disputed domain name has been used under a “bait and switch” model, and that this is a case of initial interest confusion. Internet users looking for the Complainant’s restaurant services that come across the disputed domain name are redirected to a website linked to the domain name <pizzatatiaana.com>, which is related to a pizza restaurant which offers services that are in direct competition to those of the Complainant. This conduct translates into bad faith use of the disputed domain name (see *Merrell Pharmaceuticals Inc. and Aventis Pharma SA. v. Lana Carter* WIPO Case No. [D2004-1041](#), and *Swarovski Aktiengesellschaft v. Susan Kelly* WIPO Case No. [D2013-0709](#) “In fact, the disputed domain name was also used in bad faith since in the redirected website, the Respondent was offering various purported Complainant’s products knowingly taking advantage from the initial interest confusion.”).

In light of the above, it can be deduced that the Respondent has intentionally attempted to attract Internet users to his website, for commercial gain, by creating a likelihood of confusion with the Complainant’s trademark VAPIANO as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website and restaurant, which constitutes bad faith use under paragraph 4(b)(iv) of the Policy.

Therefore, the third element of the Policy has been met.

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 <vapianospizza.com> be transferred to the Complainant.

/Kiyoshi Tsuru/

Kiyoshi Tsuru

Sole Panelist

Date: January 11, 2023