

ADMINISTRATIVE PANEL DECISION

Sbarro Franchise Co. LLC v. Shi Lei

Case No. D2023-2459

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 Shi Lei, China.

2. The Domain Name and Registrar

The disputed domain name <sbarroreward.com> (the “Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2023. On June 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 8, 2023, 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 (REDACTED FOR PRIVACY, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 13, 2023, 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 June 14, 2023.

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 June 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 7, 2023.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on July 14, 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 (“Sbarro”). Sbarro is an owner and operator of fast food pizzerias and Italian-style restaurants.

The first Sbarro restaurant was established in Brooklyn, New York in 1959. Today, Sbarro owns, operates, licenses and oversees 693 restaurants around the world. As of 2022, Sbarro’s tallied global sales amounted to over USD 316,200,000.

The Complainant is the owner of numerous SBARRO trademark registrations, including:

- the United States Trademark Registration for SBARRO No. 5185588, registered on April 18, 2017;
- the United States Trademark Registration for SBARRO No. 4982244, registered on June 21, 2016;
- the Chinese Trademark Registration for SBARRO No. 33006636, registered on May 7, 2019; and
- the Chinese Trademark Registration for SBARRO No. 33006639, registered on May 7, 2019.

The Complainant is also the owner of the domain name <sbarro.com> which incorporates its SBARRO trademark.

The Domain Name was registered on March 10, 2023.

On April 14, 2023, the Complainant sent the cease-and-desist letter to the Respondent via the Registrar. The Complainant requested the transfer of the Domain Name to the Complainant. On April 15, 2023, the Respondent sent an email communication to the Complainant offering to sell the Domain Name for “\$5,199”. On April 17, 2023, the Registrar directed the Complainant to file an UDRP complaint.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has resolved to a parking page featuring pay-per-click (the “PPC”) links.

5. Parties’ Contentions

A. Complainant

The Complainant requests that the Domain Name be transferred to the Complainant. According to the Complainant, each of three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Name is confusingly similar to the trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant submits that the Domain Name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the 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 the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid SBARRO trademark registrations. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term “reward” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant’s SBARRO trademark. UDRP panels have consistently held that 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. See section 1.8, [WIPO Overview 3.0](#).

The Top-Level Domain (“TLD”) “.com” in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant’s trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second requirement, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the Domain Name, even if it has not acquired any trademark rights; or
- (iii) that it 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.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainant's SBARRO trademark registrations predate the Respondent's registration of the Domain Name. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the SBARRO trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it does not result from the evidence in the record that the Respondent makes use of the Domain Name in connection with a *bona fide* offering of goods or services, or it makes a legitimate, noncommercial or fair use of the Domain Name without intent for commercial gain.

While specific case factors have led previous panels to find that fair use need not always be categorically noncommercial in nature, unambiguous evidence that the site is not primarily intended for commercial gain, e.g., the absence of commercial or PPC links, would tend to indicate a lack of intent to unfairly profit from the complainant's reputation. See section 2.5.3, [WIPO Overview 3.0](#). In the present case, the Domain Name resolves to the parking page hosting PPC sponsored links. These links allow the Respondent to profit from the attracted web traffic and collect click-through revenue. Such use demonstrates that the Respondent has used the Domain Name to derive a commercial benefit.

Moreover, as of the date of this Decision, some of the PPC links displayed on the website connected to the Domain Name appear to redirect users to the websites competing with the Complainant's business. It is well accepted that a respondent's use of a complainant's mark to redirect users to a competing site would not support a claim to rights or legitimate interests. See section 2.5.3, [WIPO Overview 3.0](#).

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

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

As indicated above, the Complainant's rights in the SBARRO trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the Domain Name. This finding is supported by the content of the parking page featuring PPC links to the sites of the Complainant's competitors. Moreover, it has been proven to the Panel's satisfaction that the Complainant's SBARRO trademark is well known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of products and services under this trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's SBARRO trademark.

Next, the Respondent sent an email communication to the Complainant offering to sell the Domain Name for valuable consideration likely in excess of the documented out-of-pocket costs directly related to the Domain Name, namely "\$5,199". Generally speaking, UDRP panels have found that the practice as such of registering a domain name for subsequent resale (including for a profit) would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor). See section 3.1.1, [WIPO Overview 3.0](#). However, the Panel considers that such circumstances as the composition of the Domain Name wholly incorporating the Complainant's SBARRO trademark, the distinctiveness of the SBARRO trademark, or the failure of the Respondent to present a credible evidence-backed rationale for registering the Domain Name, indicate that the Domain Name could have been registered for the bad-faith purpose of selling it to the Complainant.

Moreover, the Domain Name is used by the Respondent to attract Internet users to a parking page featuring PPC links. With respect to "automatically" generated PPC links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name. Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith. See section 3.5, [WIPO Overview 3.0](#).

Finally, the Respondent's use of a privacy service that concealed registrant information is a further evidence of bad faith.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements 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 <sbarroreward.com> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: July 28, 2023