

ADMINISTRATIVE PANEL DECISION

7-Eleven International LLC v. sari BUER

Case No. D2023-2496

1. The Parties

The Complainant is 7-Eleven International LLC, United States of America (“United States”), represented by Archer & Angel, India.

The Respondent is sari BUER, Yemen.

2. The Domain Name and Registrar

The disputed domain name <7-elevenonline.top> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 8, 2023. On June 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 8, 2023, 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 June 9, 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 amended Complaint on June 12, 2023.

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 June 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2023.

The Center appointed Luca Barbero 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 United States company owned by 7, Eleven Inc. (holding 50% of the company shares) and the Japanese company SEJ Asset Management & Investment Company (holding the remaining 50% company shares). 7, Eleven Inc. is owned by SEJ Asset Management & Investment Company, which, in turn, is wholly owned by the Japanese company Seven-Eleven Japan Co., Ltd.

The Complainant, together with its parent and affiliated companies Seven-Eleven Japan Co., Ltd., and 7-Eleven, Inc., own a convenience store chain, operating, franchising and licensing convenience stores under the brand name 7-ELEVEN with over 79.000 stores around the world.

Founded in 1927 in Dallas, Texas, as The Southland Corporation, the Complainant, through its predecessor Southland, pioneered the convenience store concept during its first years of operation, when it began selling milk, bread and eggs as a convenience to guests.

The Complainant's house mark and trading name 7-ELEVEN was developed and adopted in 1946 – when the name of the Complainant's stores was changed to 7-ELEVEN - and has been in use continuously ever since, with various 7-ELEVEN formative trademarks.

The Complainant's affiliated company 7, Eleven Inc. is the owner of several trademark registrations for 7-ELEVEN, including the following, as per trademark certificates submitted in annex 5 to the Complaint:

- United States trademark registration No. 0896654 for 7-ELEVEN (word mark) filed on March 28, 1969, and registered on August 11, 1970, in international class 42;
- United States trademark registration No. 1702010 for 7-ELEVEN (word mark), filed on September 12, 1991, and registered on July 21, 1992, in international class 30;
- Singapore trademark registration No.T0218879F for 7-ELEVEN (word mark), filed on December 10, 2002, and registered on July 15, 2003, in international class 35;
- India trademark registration No. 1305737 for 7-ELEVEN (figurative mark), filed on August 11, 2004, and registered on December 21, 2005, in international class 35.

The Complainant is also the owner of the domain name <7-eleven.com>, registered on October 21, 1997, and used by the Complainant to promote its products and services under the trademark 7-ELEVEN online.

The disputed domain name <7-elevenonline.top> was registered on March 7, 2023, and is currently pointed to an inactive page displaying the message "Sorry, you have been blocked. You are unable to access 7-elevenonline.top". According to the screenshots submitted by the Complainant - which have not been contested by the Respondent - the disputed domain name was previously pointed to a web page requesting login details in the form of a mobile number and provided a link to download a mobile application named "7-eleven". The website also displayed links to articles about the Complainant's entry into India as well as the opening of the first 7-ELEVEN store and documents featuring the 7-ELEVEN logo, such as a Power of Attorney with the Complainant's trademark and the State Emblem of India, a certificate with the Complainant's trademarks along with the logo of an Indian private bank and a certificate with the Complainant's trademarks along with a logo of an Indian state-owned insurance company.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name <7-elevenonline.top> is identical and confusingly similar to the trademark 7-ELEVEN in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term "online" and the generic Top Level Domain ("gTLD") ".top".

The Complainant underlines that the addition of the word "online" as a suffix to the trademark 7-ELEVEN is incapable of lending the disputed domain name any distinctiveness or reduce its similarity with the Complainant's trademarks.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that, considering the Respondent has knowingly adopted the Complainant's trademarks to create a false impression that Respondent was an authorized representative of the Complainant with approvals and support from the Indian government as well as of leading banking and insurance organizations and in view of the fact that the disputed domain name was used to actively conduct fraudulent business seeking money investments from unwary consumers, the Respondent has clearly not made a *bona fide* or legitimate non-commercial or fair use of the disputed domain name.

Moreover, the Complainant submits that it has not assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or make use of its 7-ELEVEN trademarks and concludes that the Respondent has, therefore, no rights or legitimate interests in the disputed domain name.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent is using the website corresponding to the disputed domain name to conduct a fake and illegitimate business by seeking investments on behalf of the Complainant and using the Complainant's trademarks in order to create a false business association.

The Complainant explains that, following repeated reports from India regarding operation of a fake business by the Respondent, conducted via the disputed domain name, for a fraudulent business wherein customers were prompted to invest in renting 7-ELEVEN's online retail stores to earn a daily income from it, the Complainant conducted independent investigations which highlighted that the Respondent was actively operating its physical business despite not revealing its real whereabouts.

The Complainant emphasizes that the Respondent's use of the Complainant's 7-ELEVEN trademarks is of serious concern as it is not only apt to create a likelihood of confusion in the minds of public at large but is deliberately intended to deceive consumers and lead them into believing that they are dealing with the Complainant and its authorized representative and thus providing payment to the Respondent, for the Respondent's personal gain.

The Complainant also underlines that the disputed domain name was registered by the Respondent long after the Complainant's adoption and use of the 7-ELEVEN well-known trademark, and contends that, considering the use of the disputed domain name, the Respondent was clearly well aware of the Complainant's rights and goodwill and acted in bad faith at the time of registering the disputed domain name.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: “A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Complainant relies on trademark registrations for 7-ELEVEN registered by the Complainant’s affiliate 7, Eleven Inc. (holding 50% of the Complainant’s shares) in several countries of the world, as mentioned under Section 4 above.

As indicated in section 1.4.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), a trademark owner’s affiliate, such as a subsidiary of a parent or of a holding company, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint.

As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the trademark is recognizable within the disputed domain name. In addition, as indicated in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element.

The Panel finds that the disputed domain name is confusingly similar to the trademark 7-ELEVEN as it reproduces the trademark in its entirety with the mere addition of the dictionary term “online” and the gTLD “.top”, which can be disregarded when comparing the similarities between a domain name and a trademark (section 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

“(i) before any notice to you 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 (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 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.”

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not submitting a Response, has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s trademarks. Moreover, there is no element from which the Panel could infer the Respondent’s rights and legitimate interests over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

As mentioned above, according to the documents and statements submitted by the Complainant - which have not been challenged by the Respondent - the disputed domain name, currently pointed to an inactive website, was used to conduct a fraudulent business whereby customers were prompted to invest in renting 7-ELEVEN’s online retail stores to earn a daily income from it. According to the screenshots submitted by the Complainant, the disputed domain name was in fact pointed to a web page requesting login details in the form of a mobile number and providing a link to download a mobile application named 7-ELEVEN. Moreover, information about the opening of a 7-ELEVEN store in India were published on the website along with documents using the Complainant’s trademarks and stems or other distinctive signs of Indian private companies or public authorities.

In view of the above-described use of the disputed domain name, the Panel finds that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate non-commercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademarks. Indeed, as indicated in section 2.13.1 of the [WIPO Overview 3.0](#), Panels have categorically held that the use of a domain name for illegal activity, including impersonation/passing off or other types of fraud, can never confer rights or legitimate interests on a respondent.

Moreover, the Panel finds that the disputed domain name is inherently misleading. As stated in section 2.5.1 of the [WIPO Overview 3.0](#), “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”.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to the bad faith at the time of the registration, the Panel finds that, in light of i) the prior registration and use of the Complainant’s trademark 7-ELEVEN in connection with the Complainant’s products and services, ii) the well-known character of the trademark and iii) the confusing similarity of the disputed domain name with the Complainant’s trademarks, the Respondent very likely registered the disputed domain name having the Complainant’s trademark in mind.

Moreover, according to the evidence on record, the disputed domain name is currently pointed to an inactive website but, prior to the present proceeding, it was pointed to a web page featuring the Complainant’s trademarks and displaying information about the Complainant, a circumstance which supports the finding that the Respondent was clearly aware of the Complainant’s trademarks.

Furthermore, in view of the notoriety of the Complainant's trademark, the Panel finds that the Respondent also acted in opportunistic bad faith at the time of registration, since the disputed domain name was so obviously connected with the Complainant that its very selection by the Respondent, who has no connection with the Complainant, suggests the disputed domain name was registered with a deliberate intent to create an impression of an association with the Complainant.

The Panel also notes that, in view of the use of the disputed domain name to divert users to the website described above, featuring the Complainant's trademarks and information on the Complainant and requesting users' contact information to seek investments by passing off as an authorized agent of the Complainant, the Respondent intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the services provided therein, according to paragraph 4(b)(iv) of the Policy.

At the time of the drafting of this Decision, the disputed domain name is pointed to an inactive website. It is well established that passive holding of a domain name could amount to bad faith under certain circumstances as decided *i.a.* in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

In the case at hand, in view of i) the well-known character of the Complainant's trademarks; ii) the confusing similarity of the disputed domain name with the Complainant's prior trademarks; iii) the evidence of the Respondent's prior use of the disputed domain name provided by the Complainant and the failure of the Respondent to submit a Response or to provide any evidence of actual or contemplated good faith use; the Panel finds that the current passive holding of the disputed domain name by the Respondent does not prevent a finding of bad faith. See section 3.3 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and has been using the disputed domain name in bad faith according to 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 disputed domain name <7-elevenonline.top> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: July 28, 2023