

ADMINISTRATIVE PANEL DECISION

Sbarro Franchise Co. LLC v. Name Redacted Case No. D2023-3519

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 Name Redacted.¹

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 18, 2023. On August 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 21, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 30, 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 August 30, 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”).

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST 12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. D2009-1788.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 25, 2023. On August 30, August 31, 2023 and on September 5 and September 6, 2023, the Respondent sent informal communications, but did not provide a formal Response. On September 6, 2023, the Center invited the parties for a possible settlement, but in correspondence of September 11, 2023, the Complainant informed the Center that it does not wish to explore settlement options and would like the proceedings to continue. Accordingly, the Center notified the Notification of Respondent default on September 28, 2023.

The Center appointed Mihaela Maravela as the sole panelist in this matter on October 2, 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

According to information in the Complaint, the Complainant is the owner and operator of fast-food pizzerias and Italian-style restaurants, established in New York, in the United States, in 1959. The Complainant currently owns, operates, licenses, and oversees 699 company-owned and franchised restaurants around the world, including several restaurants in Central America. Its global sales in 2022 were in excess of USD 316 million.

The Complainant is the owner of various registered trademarks that consist of or include SBARRO in various jurisdictions throughout the world, including the following:

- the United States trademark no. 4,982,244 SBARRO registered on June 21, 2016, covering services in class 30;
- the national trademark no. 26025 for SBARRO registered in Taiwan, Province of China as of August 16, 1987 for goods in class 7.

The Complainant also owns the disputed domain name <sbarro.com>, where it operates an interactive website for its products.

The disputed domain name was registered on June 21, 2023, and does not resolve to an active website.

The Complainant has sent two cease-and-desist letters via the Registrar, but it received no response from the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name includes the SBARRO trademark—which by virtue of the Complainant's decades-long use of the mark, substantial advertising and promotion, and enormous sales success is indisputably strong, distinctive, and uniquely associated with Sbarro—inevitably results in confusing similarity. Simply employing a geographic term like "Guatemala" in tandem with another's trademark does not inhibit the finding of confusing similarity.

As regards the second element, the Complainant argues that it has not licensed, authorized, or otherwise sanctioned the Respondent's use of the SBARRO trademark for any purpose. Moreover, the Complainant's

use of its famous trademark predates the Respondent's registration of the disputed domain name by more than five decades. In addition, there is nothing to indicate that the Respondent is now or has ever been known by or referred to by a name wholly consisting of or incorporating "Sbarro." Further, the disputed domain name loads a page that "can't be reached," and thus it is not associated with a webpage that might indicate that the Respondent has any claim to or interest in the name "Sbarro."

With respect to the third element, the Complainant argues that the Respondent's bad faith is demonstrated primarily by the disputed domain name's inclusion of the famous SBARRO trademark, in which the Complainant has enjoyed exclusive rights in the field of restaurant and food services for more than fifty years. "Sbarro" is an arbitrary word with no significance except as a trademark and it cannot be seriously doubted the Respondent devised and registered the disputed domain name with every intention of trading upon the renown of and goodwill reposed in the SBARRO mark.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. In an informal response of August 30, 2023, the Respondent claimed not to have purchased the disputed domain name and that it was purchased by someone who hacked his account. On August 31, 2023, the Respondent sent another informal communication saying that "*[t]he domain has already been cancelled. There is no connection between me and this domain any further. The domain was purchased without my consent. And I've already ask my domain name provider Bluehost to delete it. So please end this case if possible.*" Further, on September 5, 2023, the Respondent sent another informal response stating *inter alia* that "*It's not my intention to use this domain name. The purpose of this letter is to notify you and the Complainant that I'm not related to this domain. I also wish this domain name to be canceled.*" In a subsequent informal communication of September 6, 2023, the Respondent largely reiterated the above statements.

6. Discussion and Findings

No substantive response has been received from the Respondent in this case.

In an email communication of September 11, 2023, the Complainant indicated that it appears from the Respondent's informal communications indicated in section 5.B above, that it "*appears to consent to the transfer of the domain name. We ask that the panel order the transfer on that basis per the WIPO Guide Section 4.10*".

Given the absence of a clear consent for transfer from the named Respondent, who referred to a possible cancellation of the disputed domain name, and also the fact that the named Respondent denied having registered the disputed domain name, the Panel will proceed with an analysis on the merits.

Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules.

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. While the addition of other terms here, “guatemala” may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

There is no evidence in the record that the Respondent is currently using the disputed domain name in connection with a *bona fide* offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraphs 4(c)(i) and (iii) of the Policy. Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

Furthermore, and given the overall circumstances of the case, the nature of the disputed domain name carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

According to the un rebutted assertions of the Complainant, its SBARRO trademark was widely used in commerce well before the registration of the disputed domain name. The disputed domain name is confusingly similar with the Complainant’s trademark. Under these circumstances, the Respondent very likely registered the disputed domain name, after it had expired, having the Complainant’s trademark in mind. The Respondent provided no explanations for why he registered the disputed domain name.

As regards the use, the disputed domain name is passively held.

Section 3.3 of the [WIPO Overview 3.0](#) describes the circumstances under which the passive holding of a domain will be considered to be in bad faith: “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

The Panel finds that passive holding of the disputed domain name does not in the circumstances of this case prevent a finding of bad faith. There is no evidence in the record of a legitimate use of the disputed domain name. The trademark of the Complainant is distinctive and widely used in commerce. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

Moreover, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant’s contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible. Further, the Respondent seems to have impersonated the identity of a third party when registering the disputed domain name.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <sbirroguatemala.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: October 17, 2023