

ADMINISTRATIVE PANEL DECISION

LT Whitman Inc. v. Orr Stern
Case No. D2024-3908

1. The Parties

Complainant is LT Whitman Inc., United States of America (“United States” or “U.S.”), represented by Faegre Drinker Biddle & Reath LLP, United States.

Respondent is Orr Stern, United States.

2. The Domain Name and Registrar

The disputed domain name <delbuonosbakery.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 24, 2024. On September 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 25, 2024, 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 (Registration Private, Domains by Proxy LLC, Domainsbyproxy.com) and contact information in the Complaint. The Center sent an email communication to Complainant on September 27, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on September 27, 2024.

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 Respondent of the Complaint, and the proceedings commenced on October 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 21, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 22, 2024.

The Center appointed Scott R. Austin as the sole panelist in this matter on October 28, 2024. 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 following facts appear from the Complaint (as amended) and its annexes, which have not been contested by Respondent.

Complainant, a New Jersey corporation having its principal place of business in Haddon Heights, New Jersey, United States, asserts that since 1926 Complainant and its predecessors, which includes the founder of Complainant's bakery business, an individual with the Italian surname "Del Buono", have operated a retail bakery business in the vicinity of its current location with four New Jersey store locations currently as well as taking orders online, that produces a range of bakery goods and dessert items under the trademark DEL BUONO'S BAKERY (the "DEL BUONO'S BAKERY Mark").

Complainant claims ownership of common law trademark rights in the DEL BUONO'S BAKERY Mark for its use of the mark since at least as early as 2013 when Complainant purchased the existing bakery operation from Constantino "Nino" Del Buono, whose father started the bakery in 1926.

Complainant also submits as evidence in support of its unregistered trademark rights reference to a pending application for U.S. Trademark Registration by which Complainant has sought to register its rights in the DEL BUENOS BAKERY Mark with the United States Patent and Trademark Office ("USPTO"):

United States Trademark Application No. 98388910, DEL BUONO'S BAKERY, filed on February 2, 2024, for "Bakery desserts; Bakery goods; Bakery goods and dessert items, namely, cakes, cookies, pastries, candies, and frozen confections for retail and wholesale distribution and consumption on or off the premises; Bakery products; Bakery products, namely, sweet bakery goods", in International Classes 30 and 35, and claiming a first use date of August 9, 2013.

Complainant also shows that as the original owner of <delbuonosbakery.com>, the disputed domain name, it incorporated its DEL BUONO'S BAKERY Mark into that domain name to serve as its official domain name when Complainant registered it on October 18, 2013 and thereafter used it for over nine years to access the official DEL BUONO'S BAKERY Mark website (the "Official DEL BUONO'S BAKERY Mark Website") which along with its social media sites on Facebook, Instagram and other Complainant used to promote Complainant's bakery and dessert products, its online bakery business and its retail stores which have been in continuous commercial operation ever since. On October 30, 2022, Complainant's ownership of <delbuonosbakery.com> ended as its official domain name was inadvertently lost possibly due to a credit card malfunction, but its social media presence continued unaffected. At some time thereafter Respondent obtained the disputed domain name through a process known as "drop catching" Complainant subsequently registered the domain name <delbuonosandcarmens.com> to access the Official DEL BUONO'S BAKERY Mark Website where it continues to promote its bakery goods and services today at, as well as promote a separately branded affiliated business, Carmen's Deli.

Complainant has submitted as evidence in an Annex to its Complaint a declaration signed by its principal owner with sworn statements attesting to the longstanding use of its mark, and its attempts to purchase the disputed domain name through a brokerage service which ended when the seller asked for a purchase price for an amount in excess of the cost of Respondent to acquire the disputed domain name.

Respondent obtained and registered the disputed domain name sometime after October 30, 2022, through drop catching, and the Whois registration data references the most recent "update" for the disputed domain name occurred on August 19, 2024. The Panel's independent investigation of the disputed domain name found that Respondent's disputed domain name resolved to what is generally referred to as a "copycat" website using Complainant's DEL BUONO'S BAKERY Mark, its fanciful logo and copyright-protected images

of bakery products taken from the Official DEL BUONO'S BAKERY Mark Website and social media sites showing Complainant's baked goods and dessert products, with a blog which features articles fraudulently attributed to Complainant's principal owner alongside a fabricated biography of him, which articles include instructions on making baked goods infused with cannabis. ¹

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name: that the disputed domain name is confusingly similar to Complainant's trademark; that 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.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to .transfer a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

¹"Noting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name or accessing trademark registration databases." [WIPO Overview 3.0](#), section 4.8. See e.g., *Humble Bundle, Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2016-0914](#); *Creative NetVentures, Inc. v. Webheads*, WIPO Case No. [D2000-1655](#).

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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

To prove this element, Complainant must first establish that there is a trademark or service mark in which it has rights. Ownership of a nationally or regionally registered trademark constitutes prima facie evidence that Complainant has the requisite rights in a mark for purposes of standing under paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant has not put forward details of any registered trademark rights in the DEL BUONO's BAKERY Mark. Complainant's submissions, however, effectively amount to a claim of unregistered trademark rights in the mark under the Policy.

Prior UDRP panels have held that the Policy does not require that a trademark be registered in order to be invoked under the Policy. See *Askonas Holt Ltd. v. Webocracy, Inc.*, WIPO Case No. [D2000-0392](#). To establish common law trademark rights, however, it has been noted that a complainant must show that the name has achieved secondary meaning or association with the complainant. See *Australian Trade Commission v. Matthew Reader*, WIPO Case No. [D2002-0786](#). Additionally and particularly relevant here in dealing with the mark of a regionally well-known bakery, is that under the Policy, even if secondary meaning had been acquired only in a limited geographical area, essentially a regional market such as Southern New Jersey, Complainant would nevertheless have established sufficient common law trademark rights within the meaning of Paragraph 1(a)(i) of the Policy. See *Australian Trade Commission v. Matthew Reader, supra*. As the UDRP panel there noted, "The Policy makes no distinction between localized and widespread trademark rights and there is no requirement that a Complainant own a famous mark to invoke the protections of the Policy."

Section 1.3 of [WIPO Overview 3.0](#) provides that relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. Specific evidence is required and conclusory allegations, even if undisputed in the case concerned, would not normally suffice to show secondary meaning.

Complainant's evidence submitted in support of unregistered trademarks rights in the DEL BUONO's BAKERY Mark includes reference to its pending application for U.S. Trademark Registration by which Complainant has sought to register its rights in the mark with the USPTO.

Complainant's pending application for U.S. trademark registration submitted in support of its burden under the first element does not carry the day. First, Complainant's pending application does not establish any enforceable rights until registration issues. Second, the Panel's independent research conducted pursuant to paragraphs 10 and 12 of the Rules has shown that the USPTO application has a pending office action that includes a surname refusal under Section 2 (e) (4) of the U.S. Trademark Act that would need to be overcome for registration to issue and as of the date of the Panel's review, November 11, 2024, no response had been filed.

However, based on the remaining evidence presented supporting the facts set forth in Section 4 above, the Panel does not need to rely on the referenced application to find Complainant has met its burden showing the DEL BUONO's BAKERY Mark has acquired distinctiveness. The Panel is satisfied, albeit after additional independent investigation of the mark and Complainant's longstanding use of it for more than five years, a period of time typically recognized as sufficient to claim acquired distinctiveness under U.S. trademark law, that Complainant has established that it has unregistered trademark rights in the DEL BUONO'S BAKERY Mark dating from at least as early as 2013 and pre-dating the date of registration of the disputed domain name by at least nine years.

The Panel notes the sworn statements in the notarized declaration from the principal owner of Complainant, coupled with the evidence put forward supporting third party and consumer recognition, eleven years of use

of its mark substantiated through a number of Internet Archive web page screenshots from its official website showing a history of facility improvements and new equipment expenditures for its stores, expansion and extensive uninterrupted social media advertising and sales of its bakery products on Facebook, Instagram and others spanning the stated time period from 2013 to the present, media coverage in local media and awards for its bakery in regional media for Southern New Jersey and radio programs, user comments remembering visits to the bakery “since childhood”, reference to a YouTube video reviewed by the Panel showing photos of the bakery storefront in the 1970’s as well as biographical information of the namesake prior owner as a boxer and actor, referencing operation at the current location dating back to the 1960’s, and a menagerie of fiberglass animal statues adorning the bakery storefront memorable to consumers as its “animal kingdom” cited in comments and positive reviews by bakery customers leading to recognition of Complainant and its mark on social media with thousands of followers on Facebook, which the Panel considers significant for a local bakery. The declarant’s sworn statements include dates for longstanding use that are consistent with dates presented in its USPTO application for U.S. trademark registration during which time the mark has been used for over 11 years to identify its bakery goods and desserts. These statements in Complainant’s declaration would not necessarily have been accepted by the Panel on their own, had the independent and consistent social media and referenced online evidence not been put forward in addition, which supports them. The Panel is prepared to accept the Declaration and related materials as evidence of the duration and nature of Complainant’s use of the DEL BUONO’S BAKERY Mark, and the nature and extent of advertising using the mark.

Taken as a whole, the evidence before the Panel supports Complainant’s contention that since 2013, for purposes of this element of the Policy, it has established secondary meaning in the DEL BUONO’S BAKERY mark, which has become a distinctive identifier that consumers associate with Complainant’s goods and services.. See [WIPO Overview 3.0](#), section 1.3. Respondent has not sought to oppose Complainant’s arguments or submissions regarding the first element assessment of common law rights. Moreover, the fact that Respondent has used the disputed domain name to target Complainant with a copycat website complete with Complainant’s logo and a blog fraudulently attributed to Complainant’s principal owner with recipes for cannabis cookies purportedly for Respondent’s commercial benefit, supports Complainant’s assertion that its mark has achieved significance as a source identifier. See [WIPO Overview](#), Section 1.3.

Turning to the comparison between Complainant’s mark and the disputed domain name, the generic Top-Level-Domain (“gTLD”) “.com” is typically disregarded, being required purely for technical reasons. The second level of the disputed domain name consists solely of and matches exactly the Complainant’s DEL BUONO’S BAKERY Mark.

In all of these circumstances, the Panel finds that the disputed domain name is identical to Complainant’s DEL BUONO’S BAKERY Mark and that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Complainant contends that

none of the circumstances provided in paragraph 4(c) of the Policy for demonstrating a respondent's rights to and legitimate interests in a domain name are present in this case. Respondent has not rebutted 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.

First, Complainant contends that Respondent has no rights in the disputed domain name. Complainant asserts that it has no commercial relationship with Respondent, Respondent is not sponsored by or affiliated with Complainant in any way, and Complainant has not given Respondent authority or license to register or use Complainant's trademarks in any manner, including in domain names. Prior UDRP panels have held "in the absence of any license or permission from Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed". *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#).

Second, there is no evidence to suggest that Respondent is commonly known by the disputed domain name, which evinces a lack of rights or legitimate interests under Policy paragraph 4(c)(ii). Respondent, as registrant of the disputed domain name, identified as "Orr Stern" is not commonly known by the disputed domain name because it clearly bears no resemblance to it. Prior UDRP panels have held where no evidence, including the Whois record for the disputed domain name, suggests that Respondent is commonly known by the disputed domain name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the disputed domain name within the meaning of Policy paragraph 4(c)(ii). See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#).

Most importantly, Complainant contends Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services because, as Complainant's attached screen shots of the web pages accessed through the disputed domain name show, the disputed domain name resolves to a carefully crafted "copycat" version of Complainant's Official DEL BUONO'S BAKERY Mark Website to create a false association with Complainant.

The Panel notes that evidence submitted persuasively supports Complainant's argument because it shows Respondent's website prominently features the unauthorized use of infringing copies of Complainant's copyright protected digital images of its products and a blog which features articles fraudulently attributed to Complainant's owner, which articles have included instructions on making baked goods infused with cannabis, an impersonation which Complainant contends is damaging to Complainant's reputation. Respondent's activities therefore undermine any claim of rights and legitimate interests. Respondent, therefore, is using the disputed domain name to confuse Internet users and suggest an affiliation with or sponsorship by Complainant to redirect Internet users to its website for its commercial gain. Based on these facts the Panel finds Respondent's actions are clearly not legitimate and clearly are misleading. Respondent, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy. See *Six Continents Hotels v. "m on"*, WIPO Case No. [D2012-2525](#); see also *Frankie Shop LLC v. Jie Wen*, WIPO Case No. [D2022-4197](#).

It is a well-established principle according to a consensus of UDRP Panels that the use of a domain name for illegitimate activity such as the impersonation or fraudulent conduct as found here, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. See also *Frankie Shop LLC v. Domain Protection Services Inc. / My Mo*, WIPO Case No. [D2022-0825](#).

Prior Panels have also found a lack of rights and legitimate interests where a respondent has acquired a disputed domain name through drop catching to potentially profit by mimicking the domain name's previous owner. See *Crystal Cathedral Ministries v. Martina Zammit*, WIPO Case No. [D2023-0219](#)

Having reviewed the record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Complainant contends that because Respondent has registered a domain name that is identical to Complainant's DEL BUONO'S BAKERY Mark, and considering that Respondent replicated the predominant features of Complainant's Official DEL BUONO'S BAKERY Mark Website, it is implausible to believe that Respondent did not have actual knowledge of Complainant's mark when it registered the identical disputed domain name.

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may also be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Complainant contends as evidence of bad faith registration that Respondent acquired the disputed domain name through drop catching in order to resell the disputed domain name to Complainant at an exorbitant price and to profit from Pay-Per Click advertisements. The declaration and related evidence submitted shows Complainant's attempts to purchase the disputed domain name through a brokerage service reached an impasse when the price asked by Respondent reached an amount over 20 times Complainant's bid and clearly far in excess of Respondent's out of pocket costs. Prior UDRP panels have found that registration of a domain name through drop catching, where the domain name conflicts with the rights of the prior registrant, is opportunistic behavior that constitutes registration and use in bad faith under the Policy. See, e.g. *Town of Secaucus, New Jersey v. Martina Zammit, Oring Ltd.*, WIPO Case No. [D2020-0509](#); *Supermac's (Holdings) Limited v. Domain Administrator, DomainMarket.com*, WIPO Case No. [D2018-0540](#).

Complainant contends that Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business by registering a domain name that incorporates the DEL BUONO'S BAKERY Mark in its entirety. Respondent has thereby registered the disputed domain name that is identical to Complainant's trademark. Prior UDRP panels have found a domain name was registered in bad faith where the respondent registered the domain name for the purpose of intentionally attempting to impersonate or mislead in order to commit fraud. See, e.g., *Houghton Mifflin Co. v. The Weatherman Inc.*, WIPO Case No. [D2001-0211](#); *Frankie Shop LLC v. Bgeew Aferg*, WIPO Case No. [D2022-3619](#); *Beam Suntory Inc. v. Name Redacted*, WIPO Case No. [D2018-2861](#).

As discussed in greater detail in Section 6B above, Complainant shows in evidence in the Annexes to its Complaint that Respondent used the disputed domain name to configure a copycat website to impersonate Complainant attempted to attract Internet users seeking Complainant's products to Respondent's website for Respondent's commercial gain constitutes evidence of bad faith use under the well-established principles in the cases decided under the Policy. See [WIPO Overview 3.0](#), section 3.4 and *The Coca-Cola Company v. PrivacyProtect.org/ N/A, Stephan Chukwumaobim*, WIPO Case No. [D2012-1088](#); *Ropes & Gray LLP v. Domain Administrator, c/o DomainsByProxy.com / Account Receivable*, WIPO Case No. [D2020-0294](#).

Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith registration and use under the Policy. The Panel finds that the evidence presented here: Respondent's copycat website using Complainant's trademark as well as content displaying infringing copies of Complainant's copyright protected digital images of its products and a blog falsely attributing articles on baked goods incorporating cannabis to Complainant's owner is sufficient for this Panel to find bad faith registration and use. Under these circumstances, there can be little doubt Respondent had actual knowledge of Complainant, targeted Complainant's mark and used its actual knowledge to configure a mimic website for its commercial advantage. Accordingly, Complainant has established the third element of the Policy.

For these reasons, the Panel finds bad faith registration and use, and Complainant has met its burden 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 disputed domain name <delbuonosbakery.com> be transferred to the Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: November 26, 2024