

ADMINISTRATIVE PANEL DECISION

Diet Center Worldwide, Inc. v. Domains By Proxy, LLC / Sheri Zillioux
Case No. D2022-0246

1. The Parties

Complainant is Diet Center Worldwide, Inc., United States of America (“United States or U.S.”), represented by Renner, Kenner, Greive, Bobak, Taylor & Weber, United States.

Respondent is Domains By Proxy, LLC, United States / Sheri Zillioux, United States, represented by AW OFFICE OF VINCENT LoTEMPIO, PLLC, United States.

2. The Domain Name and Registrar

The disputed domain name <thedietcenter.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 January 25, 2022. On January 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 27, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 Respondent of the Complaint, and the proceedings commenced on February 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2022. On March 2, 2022, Respondent requested an extension of the Response due date. On March 3, 2022, the Center granted the automatic extension of the Response due date of four calendar days pursuant to paragraph 5(b) of the Rules and confirmed that the new Response due date was March 11, 2022. On March 10, 2022, Respondent emailed the Center to indicate the Parties were in settlement discussions, and asked for a further extension of the Response due date.

On March 11, 2022, Complainant requested a suspension of the proceeding. Pursuant to paragraph 17 of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), the proceeding was suspended on March 14, 2022. On April 8, 2022, Complainant requested an extension of the suspension of the proceeding. On April 11, 2022, the Center confirmed the suspension of the proceeding was extended, and further to Complainant's request on April 29, 2022, for another extension of the suspension period, the Center confirmed the proceeding was suspended through May 30, 2022. On June 9, 2022, the proceeding was reinstated, and the Response due date was set to June 14, 2022.

On June 15, 2022, Complainant sent a settlement form to the Center signed by the Parties. On June 16, 2022, the Center contacted the Parties, noting a deficiency in the signed settlement form, and asked the Parties to send an amended settlement form. The Parties sent further queries to the Center regarding the settlement procedure and suspension of the proceeding throughout June 2022, which the Center answered in the same month. On June 22, 2022, the Center indicated that if the Parties did not submit an amended settlement form or request a suspension of the proceeding, panel appointment would commence. On July 8, 2022, Complainant indicated it did not wish to further suspend the proceeding and asked the Center to reinstitute the proceeding. Pursuant to paragraph 6 of the Rules, the Center sent an email communication to the Parties on July 12, 2022, indicating it would proceed to panel appointment.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on July 20, 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

Complainant is a company based in Akron, Ohio, United States, that offers weight loss-related food and beverage products and educational and consulting services in the field of weight loss and diet programs.

Complainant owns valid and subsisting federal U.S. trademark registrations for DIET CENTER (the "DIET CENTER Mark") and DIET CENTER ESSENTIALS, covering consulting services in the field of weight control and diet programs, educational instruction in weight loss, control, and maintenance, nutritional control and behavior modification, dietary supplements, various food and beverage products, pamphlets, brochures, newsletters, instructional manuals and lesson booklets, and weight loss and/or weight maintenance programs. Such registrations include:

- DIET CENTER, U.S. Trademark Reg. No. 1,419,558, registered on December 2, 1986, for services in the International Class 42;
- DIET CENTER, U.S. Trademark Reg. No. 1,440,999, registered on June 2, 1987, for goods in International Class 5;
- DIET CENTER, U.S. Trademark Reg. No. 1,441,361, registered on June 2, 1987, for goods in International Class 30;
- DIET CENTER, U.S. Trademark Reg. No. 1,442,367, registered on June 9, 1987, for goods in International Class 32;
- DIET CENTER, U.S. Trademark Reg. No. 1,442,042, registered on June 9, 1987, for goods in International Class 16;
- DIET CENTER, U.S. Trademark Reg. No. 1,496,217, registered on July 12, 1988, for services in the International Class 41;
- DIET CENTER ESSENTIALS, U.S. Trademark Reg. No. 2,539,441, registered on February 19, 2002, for goods in the International Class 5.
- DIET CENTER and design, U.S. Trademark Reg. No. 4,409,573, registered on October 1, 2013, for services in the International Class 44.

Complainant has used the DIET CENTER Mark since as early as December 1975.

Complainant's affiliate Health Management Group, Inc. owns Complainant's primary website offering weight loss and diet program services at the domain name <dietcenter.com>, which was registered on April 23, 1996.

The disputed domain name, <thedietcenter.com>, was registered on April 10, 2002. At the time of the submission of the Complaint, the disputed domain name resolved to a website prominently displaying a "The Diet Center" logo, with details on three "THE DIET CENTER" locations within the State of New York, and offering educational and consulting services in the field of weight loss and diet programs and food and beverage products in connection with weight loss and dieting. Currently, the disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

Complainant alleges the disputed domain name is identical or confusingly similar to Complainant's federally registered DIET CENTER Mark, differing only in the addition of the word "the" which does not distinguish the disputed domain name from Complainant's DIET CENTER Mark and instead conveys that Respondent is the most prominent of Complainant's many franchisees. Complainant also argues Respondent chose the disputed domain name to free-ride off the goodwill associated with Complainant's DIET CENTER Mark as the disputed domain name suggests a false origin or sponsorship for the goods and services associated with Respondent's use of the disputed domain name, which are the same types of goods and services provided by Complainant.

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name. According to Complainant, Complainant has not authorized Respondent to use Complainant's name and registered marks, which precede the registration of the disputed domain name by more than fifteen years. Complainant states that to the best of Complainant's knowledge, Respondent did not have any pending trademark application or registration for "THE DIET CENTER.COM" and that there was no evidence of Respondent's use of the name in connection with a *bona fide* offering of goods or services. Complainant argues that Respondent's use of the disputed domain name to host a website advertising and selling weight loss products and educational and consulting services in the field of weight loss and diet programs are not legitimate noncommercial or fair use of the disputed domain name but instead evidence Respondent used the disputed domain name to misleadingly divert consumers intending to find Complainant's website.

Complainant asserts that Respondent registered and used the disputed domain name in bad faith. Complainant alleges Complainant is a leader in the weight loss industry, with a significant online presence and a number of franchisees in the state of New York. Complainant argues Respondent was aware of Complainant and its trademarks when it registered the disputed domain name, having chosen it to free-ride off the goodwill associated with the DIET CENTER Mark in which Complainant has exclusive rights. Complainant argues that Respondent uses the disputed domain name for weight loss products and educational and consulting services in the field of weight loss and diet programs, in direct competition with Complainant, and consumers looking for Complainant's brand would believe Respondent's website was Complainant's website. Complainant asserts that this use shows Respondent uses the disputed domain name for commercial gain by misleadingly diverting consumers intending to find Complainant's website, which could harm the goodwill associated with Complainant's DIET CENTER Mark. Complainant also asserts that Respondent continued to use the disputed domain name in a misleading manner even after Complainant sent a cease-and-desist letter to Respondent putting them on notice of Complainant's rights.

B. Respondent

Respondent did not file a Response or a substantive reply to Complainant's contentions, though Respondent emailed the Center about administrative aspects of the proceeding, such as extensions of the Response due date and the suspension of the proceeding.

6. Discussion and Findings

As a preliminary issue the Panel notes that after the proceeding was suspended from March 14, 2022 through May 30, 2022, the Center received a settlement form signed by the Parties that would have transferred the disputed domain name to Complainant. The consent of a respondent to a complainant's requested remedy can be grounds for a panel to immediately order a decision in a complainant's favor without a traditional 4(a) analysis. Past UDRP panelists have ordered the complainant's requested remedy solely on the basis of such consent. See the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.10.

However, the settlement form signed by the Parties bore a deficiency, and after the Parties were alerted to the settlement form's deficiency by the Center, the Parties did not submit an amended settlement form to correct the deficiency. Instead, Complainant confirmed it did not wish to suspend the proceeding further and asked the Center to proceed to panel appointment. Accordingly, the Panel will proceed to a decision on the merits of a traditional 4(a) analysis.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

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

A respondent's default does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that the complainant's allegations are true. See [WIPO Overview 3.0](#), section 4.3. Thus, even though Respondent has failed to file a formal Response to Complainant's contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *Vente-Privee.Com v. Tang Tang Shang, Tang Shan*, WIPO Case No. [D2021-1350](#).

A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it has rights in the DIET CENTER Mark through its U.S. trademark registrations referenced *supra*.

The remaining question under the first element of the Policy is whether the disputed domain names are identical or confusingly similar to Complainant's DIET CENTER Mark (typically disregarding the Top-Level Domain ("TLD") in which the disputed domain names were registered). It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain name contains the words "diet" and "center" and is thus confusingly similar to Complainant's DIET CENTER Mark. The addition of the term "the" and the use of the TLD ".com" does not prevent a finding of confusing similarity between the disputed domain name and Complainant's DIET CENTER Mark. See, e.g., *Trivago N.V. v. Omar Abdo*, WIPO Case No. [D2019-2523](#) (finding the addition of "the" did not prevent a finding of confusing similarity between the disputed domain name and the complainant's trademark and that for purposes of assessing confusing similarity, the TLD ".com" was typically ignored).

The Panel therefore finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to Complainant's DIET CENTER Mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained their burden under the second element of the UDRP. See [WIPO Overview 3.0](#), section 2.1.

Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. The evidence demonstrates that Respondent used the disputed domain name for a website with a prominent "The Diet Center" logo that offered competing goods to the Complainant's activities, *inter alia*, weight loss food and beverage products and educational and consulting services in the field of weight loss and diet programs. Moreover, the disputed domain name incorporates Complainant's DIET CENTER Mark in its entirety and is almost identical thereto, adding only the word "the", thus further evidencing Respondent was attempting to impersonate or suggest sponsorship or endorsement by Complainant. See [WIPO Overview 3.0](#), section 2.5.1. Respondent's impersonation of Complainant cannot be considered a *bona fide* offering of goods or services. See [WIPO Overview 3.0](#), section 2.13.1.

Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the disputed domain name. Respondent has not contested Complainant's allegations.

Therefore, the Panel concludes that Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have 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) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The evidence on record suggests Respondent was aware of Complainant and its DIET CENTER Mark. Complainant's U.S. trademark registrations for the DIET CENTER Mark predate Respondent's registration of

the disputed domain name by over 15 years, Complainant's registration of <dietcenter.com> through its affiliate Health Management Inc. predates Respondent's registration of the disputed domain name by approximately 6 years, and Respondent has used the disputed domain name, itself confusingly similar to Complainant's DIET CENTER Mark, for a website that uses a prominent "The Diet Center" logo and offers similar, competing weight loss-related food and beverage products and educational and consulting services in the field of weight loss and diet programs. Moreover, Respondent did not contest Complainant's allegations regarding registration and use in bad faith.

The disputed domain name's use for a website offering competing weight loss and diet program services indicates Respondent registered the disputed domain name for the purpose of disrupting the business of a competitor, namely, Complainant, within the meaning of Policy paragraph 4(b)(iii). See [WIPO Overview 3.0](#), section 3.1.3.

The Panel also agrees with Complainant that Respondent's use of the disputed domain name indicates Respondent obtained the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's DIET CENTER Mark as to the source, sponsorship, affiliation, or endorsement of the website or of a product or service on the website, within the meaning of Policy paragraph 4(b)(iv). See [WIPO Overview 3.0](#), section 3.1.4.

Accordingly, the Panel finds that Respondent registered and used the disputed domain name in bad faith under paragraphs 4(b)(iii) and 4(b)(iv) of the Policy, and Complainant succeeds 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 <thedietcenter.com> be transferred to Complainant.

/Brian J. Winterfeldt/

Brian J. Winterfeldt

Sole Panelist

Date: August 3, 2022