

ADMINISTRATIVE PANEL DECISION

Kaizen Corporation d/b/a Anna's Taqueria v. Piyush Bhateja, Grabull Inc
Case No. D2022-4210

1. The Parties

Complainant is Kaizen Corporation d/b/a Anna's Taqueria, United States of America ("United States" or "U.S."), internal represented.

Respondent is Piyush Bhateja, Grabull Inc, United States.

2. The Domain Names and Registrar

The disputed domain names <annastaqueriaboston.com>, <annastaqueriaboylston.com>, <annastaqueriabrookline.com>, <annastaqueriamit.com>, <annastaquerianewton.com>, <annastaqueriaporstersquare.com>, and <annastaqueriasomerville.com> (the "Domain Names") are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 7, 2022. On November 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On November 8, 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 November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on November 30, 2022.

The Center appointed John C. McElwaine as the sole panelist in this matter on December 5, 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.

On January 3, 2023, the Panel issued a Procedural Order, requesting the following:

1. The Complainant is invited to clarify – with evidence, in the form of emails or otherwise – the Parties' understanding as to the creation/registration of the disputed domain names, *i.e.*, was the Respondent authorized by the Complainant to register the domain names, on or before January 10, 2023;
2. The Complainant is further requested to provide copies of any written agreements between the Complainant and the Respondent relating to the services provided by the Respondent to the Complainant, on or before January 10, 2023; and
3. The Respondent is invited to comment on the Complainant's submission (if any), on or before January 13, 2023.

On January 3, 2023, prior to Complainant's submission, Respondent sent an email to the Center with information related to subject matter of the Procedural Order's requests.

On January 11, 2023, Complainant submitted its response to the Procedural Order.

On January 23, after the proscribed deadline, Respondent submitted an email stating (in full): "I will have the terms & conditions Sent out to you guys shortly". Given the Panel's finding below, it is not necessary to address this or to extend the time for a reply to the Procedural Order or the decision itself.

4. Factual Background

Complainant operates several restaurants in Commonwealth of Massachusetts, United States. Relevant to this matter, Complainant owns the following trademarks registered with the United States Patent and Trademark Office:

- ANNA'S TAQUERIA, U.S. Reg. No. 2410601, registered on December 5, 2000 in Class 42;
- ANNA'S TAQUERIA (stylized), U.S. Reg. No. 2410602, registered on September 12, 2000 in Class 42; and
- ANNA'S TAQUERIA BURRITOS & TACOS TO GO!, U.S. Reg. No. 2428307, registered on February 13, 2001 in Class 42.

Collectively these trademark registrations are referred to as the "ANNA'S TAQUERIA Mark".

The Domain Names were registered with the Registrar on the following dates: <annastaqueriaboston.com>, registered February 7, 2019; <annastaqueriaboylston.com>, registered February 15, 2019; <annastaqueriabrookline.com>, registered February 15, 2019; <annastaqueriamit.com>, registered January 3, 2019; <annastaquerianewton.com>, registered February 15, 2019; <annastaqueriaportersquare.com>, registered January 3, 2019; and <annastaqueriasomerville.com>, registered February 15, 2019.

5. Parties' Contentions

A. Complainant

As background, Complainant operates several restaurants at the following locations in United States:

- 242 Cambridge Street, Boston, MA 02114
- 800 Boylston Street, Boston, MA 02199
- 446 Harvard St, Brookline, MA 02446
- 1412 Beacon St #1, Brookline, MA 02446
- 84 Massachusetts Avenue, Cambridge, MA 02139
- 27 Lincoln Street, Newton, MA 02461
- 822 Somerville Ave, Cambridge, MA 02140
- 236 Elm St, Somerville, MA 02144.

With respect to the first element of the Policy, Complainant contends that it owns three long-standing trademarks registrations containing the words, "Anna's Taqueria", and it operates locations at each of the locations represented by the location modifiers in each of the Domain Names. For instance, Complainant points out that the Domain Names all contain the ANNA'S TAQUERIA Mark and the locations of Complainant's businesses, namely, Boston, Boylston, Brookline, MIT, Newton, Porter Square, and Somerville. Thus, Complainant asserts that the Domain Names are confusingly similar to its ANNA'S TAQUERIA Mark.

With respect to the second element of the Policy, Complainant asserts that Respondent provides restaurant ordering services to Complainant and was aware of Complainant's tradename when it developed the websites that resolve from the Domain Names. As evidence of Respondent's awareness of Complainant's trademark, Complainant provided a copy of an email string where Complainant requested a return of the Domain Names. Respondent allegedly responded:

"We have been building them on the Seo for a long time, and run a lot of ads for you. Why don't you hire us for Organic SEO.

I know you want the orders to fall through your side directly, which is fair but for long association you have to give me a fair chance to prove my work. You can choose any SEO company but what we do is probably no one has a reach to.

I want you to trust our services, we can really beat all top links of 3rd parties and run organic & paid ads in a perfect way that we will ensure you show up everywhere and there is a Good Hype of Anna's Name, and every link flows direct to your website.

Think about it & accept my request for a fair chance & i will put my heart into it., we handle over 4700 stores now and we can beat any company for SEO & online."

As a result, Complainant alleges that Respondent will be unable to establish that it has any rights or legitimate interests in the Domain Names.

With respect to the third element of the Policy, Complainant alleges that Respondent's refusal to transfer the Domain Names upon its request, knowing that they contain Complainant's ANNA'S TAQUERIA Mark, establishes Respondent's bad faith. Complainant further alleges that Respondent's unwillingness to transfer the Domain Names directly prevents Complainant from using the Domain Names and that Respondent deducts a commission fee from all orders that are transmitted to Complainant, which is a commercial gain to Respondent.

In its response to the Procedural Order, Complainant asserts that there is no evidence that any consent was ever provided to Respondent for the registration of the Domain Names and that Respondent never disclosed

to Complainant that it would register the Domain Names.

Complainant further alleges that the only written agreements between Complainant and Respondent are forms labeled as "SIGN UP APPLICATION RESTAURANT" (the "Sign Up Application"), which make no disclosure that Respondent would register the Domain Names. Complainant admits that the closest reference is a clause in the Sign Up Application (copies submitted with the Response to Procedural Order) stating that "[i]n case of Non Pamyent [sic] Grabull Reserves the Right to shut down the Hosting for website from all partner services". However, Complainant argues that this clause is ambiguous as to what website is being hosted, much less the Domain Names being used or the ownership of the Domain Names in question. Complainant asserts that the Sign Up Applications make no reference to terms of service, a master service agreement, or any other similar document. Complainant also points out that the Domain Names were all registered prior to the March 14, 2019 execution of the applications. Complainant concludes by asserting that it takes the position that the Domain Names were registered by Respondent and "rented" to Complainant in bad faith, without any contractual obligation or consensual agreement to do so.

B. Respondent

Respondent's only response in this proceeding is an email sent in response to the Procedural Order. In this response, Respondent makes three assertions relevant to this matter:

First, Respondent contends that it has had an association with Complainant's "stores" for years and that Respondent send orders to them from Respondent's marketplace based on Respondent's terms and conditions. Second, Respondent contends that any domain names that they register are to promote their restaurant partners and that Respondent owns such domain names per an agreement. Lastly, Respondent asserts that the content displayed by such domain names mentions that orders are placed with Respondent.

6. Discussion and Findings

Paragraph 4 of the Policy requires that, in order to succeed in this UDRP proceeding, Complainant must prove its assertions with evidence demonstrating:

- (i) the Domain Names are 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 Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

Complainant bears the burden of establishing each of the three elements by a preponderance of the evidence. See, e.g., *F. Hoffmann-La Roche AG v. Relish Enterprises*, WIPO Case No. [D2007-1629](#). Having considered the Complaint, the parties responses to the Procedural Order, the Policy, the Rules, the Supplemental Rules and applicable principles of law, the Panel's findings on each of the above cited elements are as follows.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires Complainant show that the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights. Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2. On this point, Complainant has provided evidence that it is the owner of three trademark registrations for the ANNA'S TAQUERIA Mark.

It is well-established that the addition of other terms to a trademark in a domain name does not avoid a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8 (“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.”); *Mastercard International Incorporated v. Dolancer Outsourcing Inc.*, WIPO Case No. [D2012-0619](#); *Air France v. Kitchkulture*, WIPO Case No. [D2002-0158](#); *DHL Operations B.V., and DHL International GmbH v. Diversified Home Loans*, WIPO Case No. [D2010-0097](#). In this matter, the Domain Names all contain Complainant’s ANNA’S TAQUERIA Mark in its entirety, as the dominant element followed by a location of Complainant’s restaurants. The addition of these geographic descriptors does not avoid a finding of confusing similarity between the Domain Names and the ANNA’S TAQUERIA Mark.

Accordingly, the Panel finds that the Domain Names are confusingly similar to Complainant’s ANNA’S TAQUERIA Mark in which Complainant has valid trademark rights. Therefore, Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in the Domain Names. Complainant needs to make a *prima facie* showing on this element, at which point the burden of production shifts to Respondent to present evidence that it has rights or legitimate interests in the Domain Names. If Respondent has failed to do so, Complainant is deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name:

- “(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.”

Complainant admits that it has an ongoing business relationship with Respondent whereby Respondent is providing ordering services for Complainant’s restaurant via websites operated by Respondent that resolved from the Domain Names. In fact, Respondent acknowledged in its submission that the Domain Names were rented (allegedly in bad faith) by Respondent to Complainant. Complainant admitted and provided evidence that Respondent has provided online restaurant ordering and delivery services for Complainant pursuant to Sign Up Applications dated March 14, 2019. Respondent asserts that the terms and conditions on its website further govern the contractual and business relationship between Respondent and Complainant.

Based on the evidence in this record, Complainant has failed to prove by a preponderance of the evidence that Respondent has no rights or legitimate interests in the Domain Names. The admissions and evidence submitted by Complainant establishes that Complainant and Respondent have an ongoing business relationship with either an express or implied agreement defining the terms of restaurant ordering services provided by Respondent to Complainant, which may or may not include the ability for Respondent to utilize Complainant’s ANNA’S TAQUERIA Mark for these services, including in connection with the Domain Names. The Signup Application is silent on any such permission or license to use the ANNA’S TAQUERIA Mark, yet the evidence submitted by Complainant shows that such trademark usage is occurring in the context of Respondent providing services to Complainant.

It is hard to know the full extent and terms of the relationship between the Parties based on the record in this proceeding. The Panel notes that, except in cases involving “abusive registrations,” the Policy leaves the resolution of such legal disputes to the courts. See Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy, paragraph 4.1(c). In similar situations, other panels have found such disputes to be outside the scope of the Policy. See e.g., *Clinomics Biosciences, Inc. v. Simplicity Software, Inc.*, WIPO Case No. [D2001-0823](#) (“To decide this issue would require additional evidence and an evaluation of the commercial law of liens. Accordingly, [...] such as dispute is outside the scope of proceedings under the Policy and is properly decided by traditional means”); *Juno Healthcare Partners Ltd v. Registration Private, Domains By Proxy, LLC / Tom Hickman, IVF Professionals Ltd.*, WIPO Case No. [D2021-4143](#) (Finding assertions of an unwritten license implied through a course of dealing between the parties are issues “better left to an alternative (court) forum”). Applying these principles here, Complainant’s arguments concerning a lack of legitimate interests and bad faith registration and use of the Domain Names involve determinations of implied contractual terms and trademark infringement issues requiring more evidence than has been presented by the Parties, and which are instead appropriate for the courts where there may be the opportunity to conduct discovery, take oral testimony, and cross-examine witnesses, none of which are available under the Policy.

Lastly, it should be noted that the fact that Respondent registered the Domain Names prior to the execution of the Sign Up Applications is not determinative of a finding of a lack of *bona fide* offering of services. There is no evidence in the record as to the use of the specific bad faith or unlawful use of these Domain Names at this earlier stage and Sign Up Applications for these locations were subsequently entered and the Parties have for years since had an ongoing business relationship. As discussed above, UDRP proceedings are not appropriate for the resolution of factually intensive business disputes or trademark infringement claims.

Accordingly, the Panel finds that Complainant has failed on this record to satisfy paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant has alleged that Respondent failure to transfer to Complainant the Domain Names knowing that they contain Complainant’s ANNA’S TAQUERIA Mark establishes Respondent’s bad faith. However, in light of the Panel’s determination on the issue of rights or legitimate interests under the second element of the Policy, it is not necessary to address whether the Domain Names were registered and used in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: January 23, 2022