

## **ADMINISTRATIVE PANEL DECISION**

Toast, Inc. v. Domain Protection Services, Inc. / Jeff Bennett, Bennett Global Group, LLC

Case No. DIO2022-0038

### **1. The Parties**

The Complainant is Toast, Inc., United States of America (“United States”), represented Kegler, Brown, Hill & Ritter Co., L.P.A., United States.

The Respondent is Domain Protection Services, Inc., United States / Jeff Bennett, Bennett Global Group, LLC, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <toast.io> (the “Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2022. On August 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 18, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 23, 2022, 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 August 25, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 August 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 21, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on September 26, 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

The Complainant is a cloud-based restaurant software company offering an all-in-one platform including TOAST point of sale (POS) hardware and apps for restaurants to connect restaurant employees and operations with restaurant guests. The Complainant was incorporated in the State of Delaware, United States on December 22, 2011, and it is headquartered in Boston, Massachusetts, United States.

The Complaint explains that the Complainant began pitching its business to investors in early 2012 and started attracting media later that year, citing a December 26, 2012, online article published on Boston.com, "Testing out Toast, new mobile app that helps diners keep an eye on the tab". The Complainant's website is located at "www.toasttab.com", a domain name it registered on May 6, 2012. The Complainant's business grew quickly, and TOAST products are now used in over 68,000 restaurants. The Complainant's stock has been listed on the New York Stock Exchange since September 2021.

The Complainant has obtained several TOAST-formative United States trademark registrations, as follows:

MARK	REGISTRATION NUMBER	REGISTRATION DATE
TOAST (standard characters)	4695692	March 3, 2015
TOAST POS (standard characters)	4802282	September 1, 2015
TOAST TAB (standard characters)	4802283	September 1, 2015
TOAST (standard characters)	4805546	September 1, 2015
TOAST (stylized characters)	5184343	April 18, 2017
TOAST (word and design)	5370557	January 2, 2018
TOAST GO (standard characters)	5853046	September 3, 2019
TOAST (word and design)	6185319	October 27, 2020
TOAST (word and design)	6431277	July 27, 2021
TOAST (standard characters)	6496112	September 28, 2021

The first applications among these were filed in 2014. The Complainant claimed first use in commerce on September 28, 2012, for the word mark TOAST TAB and on June 27, 2013, for the word mark TOAST. The Complaint similarly claims "significant rights" to the TOAST mark dating from "at least" June 2013 but does not furnish evidence of sales, advertising, or contemporary media recognition (apart from the one article cited above) to support a claim for acquired distinctiveness as a common law mark at that time. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.3 ("What does a complainant need to show to successfully assert unregistered or common law trademark rights?"). The Panel notes that the Internet Archive's Wayback Machine includes screenshots of the Complainant's website from September 8, 2012, onward, displaying a TOAST logo with no trademark symbol. The Merchant Agreement published on the Complainant's website on that date was stated as effective July 23, 2012, so it may be presumed that the Complainant's offerings were commercially available by that time. The "Ownership" section of the Merchant's Agreement preserved the Complainant's ownership of "intellectual property rights as may now exist or hereafter come into existence" but did not expressly refer to a TOAST trademark. The "Licensing" section did not mention trademarks. Accordingly, the Panel does not find on this record that the Complainant has established acquired distinctiveness for a TOAST mark as early as 2013. The Complainant certainly had a registered TOAST word mark as of March 3, 2015, but on this record it is impossible to determine how much earlier that mark, or the later-registered TOAST marks incorporating designs or stylized characters, acquired distinctiveness in the restaurant market in the United States.

The Registrar's Whois database shows that the Domain Name was registered on April 17, 2012, and that the Domain Name is registered in the name of a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Jeff Bennett and the organization as Bennett Global Group, LLC, with a postal address in Lincoln, Massachusetts, United States and a contact email address in the domain <bennettglobal.com>. In response to the Center's standard request for registrar verification, the Registrar replied that it "cannot be determined" when the current registrant registered or acquired the registration of the Domain Name.

The website at "www.bennettglobal.com" (the "Bennett Global website") advertises the services of the Respondent Bennett Global Group, LLC ("Bennett Global"), with a contact address in Waltham, Massachusetts, offering "business consulting for corporate development, domain brokerage and the development & execution of dynamic training programs". A page available at "www.bennettglobal.com/about" states that Bennett Global was founded by Jeff Bennett. The "Clients" page on the Bennett Global website lists the Complainant as a client, displaying one of the Complainant's trademarked logos.

The Panel notes that the online database of the Massachusetts Secretary of State does not list Bennett Global Group, LLC as an entity registered to do business in Massachusetts. It does, however, show that Bennett Global Marketing Group, LLC, a Delaware limited liability company managed by the Respondent Mr. Bennett at the same postal address listed in the Domain Name registration, was registered to do business in Massachusetts from 2002-2009, before the Domain Name was registered. The online database of the Delaware Secretary of State shows that Bennett Global Group, LLC (a name exactly corresponding to the organization of the Domain Name registrant) was incorporated in Delaware on March 17, 2015. As no Response has been filed in this proceeding, there is no explanation concerning what legal entity, if any, existed in 2012 when the Domain Name was registered or, indeed, confirmation that Mr. Bennett was the original registrant of the Domain Name (as discussed further below). In any event, Mr. Bennett appears to be the principal in each iteration of a "Bennett Global" company. Mr. Bennett and Bennett Global Group, LLC are referred to collectively hereafter as the "Respondent".

As mentioned on the Bennett Global website (without the Complainant's permission, according to the Complaint), the Complainant was formerly a client of the Respondent. The Complainant engaged the Respondent in 2018 to assist the Complainant in acquiring domain names. The Complaint attaches a redacted copy of the May 1, 2018, letter agreement for such services, signed by Mr. Bennett as manager of Bennett Global Group, LLC. Specifically, the agreement provided that the Respondent "will collaborate with and advise [the Complainant] on the acquisition of the [redacted] or a suitable alternative internet domain name". The Complaint also attaches a heavily redacted memo dated December 13, 2018, purportedly from "the Respondent's broker" to the Complainant, providing an "update" on this effort. The memo reported "good calls" with "the owner of Toast.io":

"We have engaged with owner of Toast.io over the weekend and again yesterday. He had no intentions of selling, though had some inquiries. He has reconsidered and came back last night indicating that he would sell for \$125,000 (USD)."

Ultimately, the Complainant did not reach an agreement to purchase the Domain Name. The Complainant states that the Respondent did not disclose that the Respondent itself was the owner of the Domain Name (or that the Respondent subsequently acquired it), while acting as the Complainant's agent to explore the acquisition of the Domain Name. The Complainant learned this only after filing the Complaint in this proceeding.

Domain Tools reports attached to the Complaint show annual registration renewals since 2012, with frequent updates in registration details (more than 40). However, these reports cannot specify if one of these updates reflects the Respondent's acquisition of the Domain Name, as the registrant information is redacted for privacy.

At the time of this Decision, the Domain Name redirects to the website of a direct competitor of the Complainant, “www.clover.com”. Like the Complainant, Clover offers “all-in-one” retail POS hardware and software, including terminals and mobile apps. The Internet Archive’s Wayback Machine shows that the Domain Name has never been used for an active website of its own. The Wayback Machine has no archived websites associated with the Domain Name until December 2021, nearly a decade after the Domain Name was registered. At that time, the Domain Name was redirected to the website of another direct competitor, Square (“www.squareup.com”), which similarly provides retail POS terminals and apps.

The Complainant observes coincidental treatment of a similar domain name, <toastpos.com>, which is the subject of a separate, pending proceeding the Complainant initiated before the FORUM under the Uniform Domain-Name Dispute-Resolution Procedure (UDRP). That domain name was registered in the name of a domain privacy service on February 26, 2014. Like the Domain Name in this proceeding, the domain name <toastpos.com> was inactive for many years and then redirected to a competitor’s website in December 2021, within a day of the redirection of the Domain Name to a competitor’s website.

## 5. Parties’ Contentions

### A. Complainant

The Complainant asserts that the Domain Name is identical to its TOAST mark, which the Respondent has no permission to use in the Domain Name and for which it otherwise lacks rights or legitimate interests. The Respondent is not known by a corresponding name. The Domain Name was inactive for years and then redirected to competitors’ websites, which cannot be considered use in connection with a *bona fide* offering of goods or services.

The Complainant argues that the Respondent has used the Domain Name in bad faith. The Complainant emphasizes that while a panel deciding a case under the .io Policy can draw on principles established under the similar UDRP as appropriate, the Policy requires establishing that the Domain Name was registered or used in bad faith, not both (as the UDRP does). See, e.g., *International Business Machines Corporation v. Murat Satir*, WIPO Case No. [DIO2021-0001](#) (“*International Business Machines*”). Thus, it is not necessary to establish that the Respondent acquired the Domain Name later than 2012, after the Complainant had established trademark rights. The Complainant argues that the Respondent acquired the Domain Name either originally or in one of those recorded renewals or ownership updates, likely with knowledge of the Complainant and its TOAST mark. But in any event, the Respondent has acted in bad faith since by agreeing to act on the Complainant’s behalf to acquire the Domain Name, concealing its conflict of interest if it actually owned the Domain Name at that time or subsequently acquired the Domain Name itself, seeking an extortionate sum for the Domain Name, ostensibly at the behest of a third-party owner, and then applying pressure by redirecting the Domain Name successively to the websites of two of the Complainant’s direct competitors.

The Complainant advances other arguments as well for bad faith:

The Complainant speculates that the Respondent, if it was the original registrant of the Domain Name or acquired it early in its history, might be guilty of “passive holding” (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)), becoming aware of the Complainant’s successful start-up and holding the Domain Name without a developed website while hoping eventually to sell it to the Complainant or a competitor.

The Respondent concealed its identity as the owner of the Domain Name through a domain proxy service.

The Respondent had “constructive notice” of the United States trademark registrations beginning in 2015.

The Respondent “registered” the Domain Name in bad faith with each annual renewal of the Domain Name.

## B. Respondent

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered or is being used in bad faith.

Under 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”.

As noted above, the .io Policy is very similar to the UDRP but differs in that the latter requires a demonstration of bad faith both at the time of registration and in subsequent use. Consequently, in the discussion below the Panel will refer frequently to the WIPO Overview of UDRP jurisprudence and decisions under the UDRP as appropriate. See *International Business Machines*, above.

### A. Identical or Confusingly Similar

As with UDRP complaints, the first element of a Policy complaint is essentially a standing requirement. In this case, it is easily satisfied: the Domain Name is identical to the Complainant's registered TOAST word mark and confusingly similar to other registered TOAST-formative marks. As usual, the Top-Level Domain “.io” is disregarded as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel concludes that the Complainant has established the first element of the Complaint.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating 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.”

Under the UDRP, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1. The same rationale should apply under the Policy, as the Respondent is in the best position to assert rights or legitimate interests in the Domain Name. The Respondent has not done so here, and no such rights or legitimate interests are apparent. The Respondent does business under a wholly different name, “Bennett Group”, and has not published its own website associated with the Domain Name. Instead, after years of inactivity, the Domain Name has been used since December 2021 only to redirect Internet users to the websites of the Complainant's direct competitors. This cannot be considered a use by the Respondent in connection with a

*bona fide* offering of goods and services. Rather, it reflects bad faith, as discussed further in the following section.

The Complainant has established trademark rights, a lack of permissive use, and the Respondent's use of the Domain Name only for redirection to competitors' websites. The Panel finds that the Complainant has made a *prima facie* case on the second element and that the Respondent has failed to meet its burden of production in rebuttal. The Panel concludes, therefore, that the Complainant prevails on the second element of the Complaint.

### **C. Registered and Used in Bad Faith**

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that "shall be evidence of the registration and use of a domain name in bad faith", including the following (in which "you" refers to the registrant of the domain name):

(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 web site or location or of a product or service on your web site or location."

The Complainant points out that these examples are non-exclusive and cites other indicia of bad faith as recounted above. Not all of these are apt in the present circumstances, and the WIPO Overview suggests that some of the Complainant's arguments for bad faith are problematic (for example, relying on constructive notice or bad faith in the renewal of a domain name registration, see [WIPO Overview 3.0](#), sections 3.2.2, 3.9). A particular difficulty is the lack of certainty concerning the timing of the Respondent's acquisition of the Domain Name.

But the Policy requires only a demonstration of bad faith in the use of the Domain Name, and that is surely evident on this record. The Respondent contracted with the Complainant to help the Complainant acquire domain names in May 2018 and specifically acted as the Complainant's representative in negotiating for the purchase of the Domain Name later that year. If the Respondent already owned the Domain Name or acquired the Domain Name for itself during this engagement, without informing the Complainant and while acting as the Complainant's broker and pretending that it was negotiating with a third party, then this deceptive practice must be considered bad faith under the Policy. On the other hand, if the Respondent did not own the Domain Name in 2018, it undeniably became aware of the Complainant and its marks at that time (the Respondent publishes the Complainant's name and trademarked logo on the "Clients" page of the Respondent's website), as well as the Complainant's interest in the Domain Name. The Respondent subsequently redirected the Domain Name to competitors' websites. This would be consistent with the Respondent acquiring the Domain Name after 2018 with the purpose of selling it to the Complainant or a competitor for an amount in excess of out-of-pocket costs (Policy paragraph 4(b)(i)). In either case, it is indisputable that the Respondent has at least since December 2021 redirected the Domain Name to competitors' websites. Whether or not the Respondent is paid for this is immaterial. This conduct is consistent with the example of bad faith in the Policy, paragraph 4(b)(iv), because Internet users are

misdirected to other websites for commercial gain, using a Domain Name that is identical to the Complainant's trademark.

To summarize: the Respondent unquestionably has actual knowledge of the Complainant's TOAST mark and has used the identical Domain Name to direct Internet users to the websites of direct competitors of the Complainant, the Respondent's former client. This is bad faith use under the Policy, and it is unnecessary to consider the alternative theories proposed by the Complainant.

The Panel concludes that the Complainant has established the third element of the Complaint.

## **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 Domain Name, <toast.io>, be transferred to the Complainant.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: October 10, 2022