

ADMINISTRATIVE PANEL DECISION

Sbarro Franchise Co. LLC v. Michael Nava, Domain Nerdz LLC
Case No. DCO2023-0059

1. The Parties

The Complainant is Sbarro Franchise Co. LLC, United States of America (“U.S.”), represented by Gottlieb, Rackman & Reisman, PC, U.S.

The Respondent is Michael Nava, Domain Nerdz LLC, U.S.

2. The Domain Name and Registrar

The disputed domain name <sbarro.co> (the “Disputed Domain Name”) 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 July 6, 2023. On July 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 7, 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 July 10, 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 July 12, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 22, 2023.

The Center appointed Martin Schwimmer as the sole panelist in this matter on August 29, 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

The Complainant is Sbarro Franchise Co., LLC. It has used the trademark SBARRO since 1965, in relation to pizzerias and Italian-style restaurants. It operates a website at “www.sbarro.com”. The Complainant owns registrations covering the SBARRO and SBARRO related marks worldwide (the “Mark”), including in the U.S. (e.g., Trademark Reg. no. 985647, registered June 4, 1974, and Reg. no. 1991581, registered August 6, 1996).

The Respondent registered the Disputed Domain Name <sbarro.co>, on November 28, 2022. The Respondent previously offered the Disputed Domain Name for sale. The Disputed Domain Name currently directs to a parking page.

5. Parties' Contentions

A. Complainant

The Complainant, Sbarro Franchise Co., LLC, is a U.S. corporation. It is a subsidiary of Sbarro LLC (“Sbarro”). Founded in 1959, Sbarro owns, operates, and licenses approximately 700 fast food pizzerias and Italian-style restaurants around the world. Its global sales in 2022 were approximately USD 316 million.

The Complainant has used the SBARRO trademark since 1965. It owns registrations covering the SBARRO and SBARRO related marks worldwide, including in the U.S. (e.g., Trademark Reg. no. 985647, registered June 4, 1974, and Reg. no. 1991581, registered August 6, 1996), and in Colombia.

The Complainant has also registered domain names which contain the SBARRO trademark. For example, Sbarro operates an interactive website accessible at the domain name <sbarro.com>. Additionally, it utilizes the SBARRO mark on social media, incorporating the Mark as part of handles on Twitter, Facebook, and Instagram (e.g., the Twitter handle @Sbarro).

The Complainant asserts that the SBARRO trademark is distinctive and well known. Several UDRP decisions have recognized the Complainant’s rights in the SBARRO mark and considered such mark to be well known. See e.g., *Sbarro Franchise Co., LLC v. Kouwenbin*, WIPO Case No. [D2019-0884](#) and *Sbarro Franchise Co., LLC v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Josephong*, WIPO Case No. [D2020-0604](#).

The Complainant asserts that the Respondent did not register and use the Disputed Domain Name in good faith, as the Complainant did not authorize the Respondent to utilize the Mark in any manner. The Respondent has never been known by or referred to by a name wholly consisting of or incorporating the Mark. The Respondent has only utilized the Disputed Domain Name to offer it for sale.

The Complainant notes that the Respondent’s adoption of the Disputed Domain Name is in bad faith as he SBARRO Mark is famous (and had achieved status as a famous trademark many years prior to the Respondent’s registration and use of the Disputed Domain Name. The Respondent offered the Disputed Domain Name for sale for USD 2,998, an amount described by the Complainant as “exorbitant.” Finally, the Respondent has been subject to prior adverse UDRP decisions by the Center.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it is the owner of trademark registrations for the mark SBARRO in numerous jurisdictions worldwide in connection with food and restaurant services. It owns registrations in the U.S., the domicile of the Respondent, and in Colombia, the country with the right to manage the ".co" country-code Top-Level domain. The Complainant's use of the Mark is demonstrated at its website "www.sbarro.com".

The Disputed Domain Name is identical to the Complainant's mark SBARRO but for the suffix ".co", which the Panel accepts is to be disregarded for the purposes of the present test. Accordingly, the Complainant has established that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant asserts that it has never assigned, granted, licensed, sold, transferred, or in any other way authorized the Respondent to register or use the SBARRO Trademark in any manner. It asserts that the Respondent is not commonly known by the "sbarro" name. As the Disputed Domain Name was not used in connection with an active website offering goods or services, the Respondent is not making fair use nor any other *bona fide* use of the Disputed Domain Name.

Furthermore, the Respondent offered for sale of the Disputed Domain Name for USD 2,998, in excess of ordinary registration fees, is not a *bona fide* offering of goods or services.

Furthermore, the Panel notes the composition of the disputed domain name, being identical to the Complainant's Mark, carries a high risk of implied affiliation (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.5.1).

The Complainant has made a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c), thus shifting the burden of production to the Respondent to come forward with evidence of rights or legitimate interests in the Disputed Domain Name. The Respondent has not submitted a response to the Complaint or otherwise, in the absence of which the Panel may accept all reasonable inferences and allegations in the Complaint as true.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent's bad faith is demonstrated primarily by the Disputed Domain Name's consisting in its entirety 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. See *Sbarro Franchise Co., LLC v. Song He*, WIPO Case No. [D2022-4550](#) (finding that the domain in question was registered in bad faith and ordering transfer thereof after noting that "the SBARRO Trademark has been in use for more than 50 years and that the Complainant has spent huge amounts and efforts for promotion of its Trademark" and thus, "it is clear that the Respondent was well aware of the Complainant and its SBARRO Trademark at the time of registration of the Disputed Domain Name" and that "the Disputed Domain Name, incorporating the Complainant's SBARRO Trademark in its entirety, is clearly deceptive for the Internet users"). UDRP panels

have consistently found that the mere registration of a domain name that is identical to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Here, the Disputed Domain Name differs from the Complainant's primary domain name <sbarro.com> by a single letter.

Moreover, before the Respondent removed the Disputed Domain Name from its aftermarket service provider, Dan.com, the Disputed Domain Name was being offered for sale for the price of USD 2,988. The offer of the Disputed Domain Name for sale at an excessive price is evidence that the Respondent registered the Disputed Domain Name in order to sell it. This offer is additional evidence of bad faith as set forth in UDRP paragraph 4(b)(i). See, e.g., *Gund, Inc. v. CPIC NET/Domain Management*, WIPO Case No. [D2008-0194](#) (finding bad faith where respondent offered to sell domain name for price exceeding its cost in acquiring and using domain name).

Furthermore, the Respondent has engaged in a pattern of registering domain names in order to sell those domain names to the trademark owner and/or to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, as set forth in UDRP paragraph 4(b)(i), (ii). The Complainant identified eight other UDRP proceedings involving this Respondent. See, e.g., *Fedrigoni S.P.A v. Michael Nava, Domain Nerdz LLC*, WIPO Case No. [DCO2021-0094](#) (finding bad faith where the Respondent "engaged in a pattern of [...] register[ing] and offer[ing] for sale '.co' domain names which are identical to the trademarks of others", which constitutes "prototypical cybersquatting").

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, <sbarro.co>, be transferred to the Complainant.

/Martin Schwimmer/

Martin Schwimmer

Sole Panelist

Date: September 11, 2023