

## **Alternative Dispute Resolution Proceeding**

### **Case No. DSE2023-0028**

#### **1. Petitioner**

The Petitioner is Five Guys Holdings, Inc., United States of America, represented by Novagraaf Nederland B.V., Netherlands (Kingdom of the).

#### **2. Domain Holder**

The Domain Holder is P.L., Engboms Network Solution AB, Sweden represented by SALC Advokatbyrå AB, Sweden.

#### **3. Domain Name and Procedural History**

This Alternative Dispute Resolution proceeding relates to the domain name <fiveguys.se> the “Domain Name”).

This Petition was filed under the Terms and Conditions of registration (the “.se Policy”) and the Instructions governing Alternative Dispute Resolution proceeding for domain names in the top-level domain .se (the “.se Rules”).

The WIPO Arbitration and Mediation Center (“the Center”) verified that the Petition satisfied the formal requirements of the .se Policy and the .se Rules. The Center sent an email communication the Petitioner an invitation to amend its Petition on October 20, 2023. The Petitioner filed an amended Petition on October 23, 2023. In accordance with Section 13 of the .se Rules, the Center formally notified the Domain Holder of the Petition on October 25, 2023. The Domain Holder submitted a response in Swedish on November 24, 2023.

The Center appointed Peter Hedberg as the sole Arbitrator in this matter on November 29, 2023. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with Section 1 of the .se Rules.

On December 4, 2023, the Petitioner requested to suspend the proceeding in order for the Parties to reach a settlement in the present matter. On December 6, 2023, the Arbitrator allowed the proceeding to be suspended for three weeks, i.e., until December 27, 2023, so that the Parties could enter a settlement discussion. The Petitioner informed the Arbitrator on December 22, 2023, that the Parties had not reached a settlement.

#### **4. Factual Background**

The Petitioner is an American restaurant chain and the owner of several trademark registrations for FIVE GUYS, e.g., the European Union trademark (“EUTM”) registration no. 006893549, FIVE GUYS, registered on October 21, 2008.

The Domain Name was registered by the Domain Holder on June 1, 2011. At the time the Petition was submitted, the Domain Name resolved to an inactive website.

#### **5. Claim**

The Petitioner claims that the Domain Name shall be transferred to the Petitioner.

The Domain Holder has contested the request.

#### **6. Parties’ Contentions**

##### **A. Petitioner**

The Petitioner is the owner of EUTM registration no. 006893549 for the word mark FIVE GUYS. This trademark was filed on May 7, 2008, and registered on October 21, 2008. The Petitioner furthermore holds many other FIVE GUYS trademark registrations in several jurisdictions.

The Petitioner has used the FIVE GUYS trademark intensively in commerce for 37 years and still continues to do so. Licensees are, of course, active under their own websites, which can be found via the domain name <fiveguys.com> and many others such as <fiveguys.nl>, <fiveguys.be> and <fiveguys.de>. The Petitioner is continuously looking into expanding its operations across the globe, and grants to qualified persons the opportunity to own and operate FIVE GUYS restaurant(s), and utilization of the Petitioner’s system and marks.

The Petitioner claims that the Domain Name was registered in 2013<sup>1</sup>. Meaning five years after the registration of the Petitioner’s identical EU trademark. In 2013 the Petitioner was already a well-known company around the world. The Petitioner has opened more than 1,700 locations worldwide since 1986, proving the well-known status of the trademark in question. Thus, the registration of the Domain Name was in bad faith.

Furthermore, since the Domain Name has not been actively used since it was registered in 2013, and it is identical to the Petitioner’s registered EUTM from 2008 which is valid in Sweden, the Domain Holder prevents or makes it difficult for the Petitioner to register and use the Domain Name, meaning that the current use, or actually the absence thereof, is also in bad faith.

The fact that the Domain Name has not been taken in use since it was registered in 2013 shows that the Domain Holder does not have a legitimate reason in respect to the Domain Name nor is using it for a noncommercial purpose.

##### **B. Domain Holder**

The Domain Holder recognizes that the Petitioner has registered an EU-trademark named FIVE GUYS.

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<sup>1</sup> The Arbitrator notes that the Domain Name was registered in 2011 and not in 2013.

The Domain Name has neither been registered nor been used in bad faith. The Domain Name was registered in 2011 and not in 2013 as the Petitioner states. The Domain Name was registered in relation to a business regarding five guys working with IT, a completely different business than the business conducted by the Petitioner. The Petitioner does not have exclusive rights to the words “five” and “guys”, as these are generic both separately and as a combination. The Petitioner’s right is limited to the goods and services (trademark classes) the said mark is registered for. The Domain Holder conducts business in a different industry, i.e., IT industry.

The Petitioner did not conduct any business in Sweden in 2011 and to the Domain Holder’s knowledge, the Petitioner is still not conducting any business in Sweden.

The Domain Holder had no knowledge about the Petitioner when registering the Domain Name in 2011.

There is another Swedish company name holding the term “five guys”, namely Five guys Transport AB, which conducts business in the transport industry since 2017.

The Domain Holder has not yet decided how to use the Domain Name (in business). Furthermore, the five persons that agreed upon registering the Domain Name are still interested in the Domain Name and are now in an active startup stage with the purpose of using the Domain Name.

Both Parties have an equally legitimate interest in the Domain Name since none of them has yet started any businesses in Sweden using the Domain Name or the trademark FIVE GUYS.

## **7. Discussion and Findings**

### **A. The Domain Name is identical or similar to a name which is legally recognized in Sweden and to which the Petitioner can prove its rights**

The Panel finds that the Petitioner’s FIVE GUYS EUTM (the “Trademark”) is legally recognized in Sweden.

The Domain Name incorporates the Petitioner’s FIVE GUYS Trademark with the addition of the country code Top-Level Domain (“ccTLD”) “.se”. The ccTLD is not relevant for the purposes of establishing if the Domain Name is identical or confusing similar to the Trademark. Thus, the Arbitrator finds that the Domain Name is identical to the Petitioner’s Trademark and the Petitioner fulfills the requirement in 7.2 of the .se Policy.

### **B. The Domain Name has been registered or used in bad faith**

When assessing whether the Domain Name was registered or used in bad faith, the Arbitrator will make an overall assessment shall be made of all the relevant circumstances in the present case. The burden of proof is on the Petitioner to demonstrate the existence of bad faith on the part of the Domain Holder.

The Petitioner’s claim of the Trademark being well-known has not been substantiated in the case even if the Arbitrator does not question that there has previously been an overall extensive use of the Trademark.

The Arbitrator cannot find that the Domain Holder has registered the Domain Name in bad faith just because of the mere existence of the Petitioner or rather, the Trademark. Further arguments, facts and evidence presented by the Petitioner are needed to prove that the Domain Holder had a knowledge of the Trademark in 2011 and then used this knowledge when registering the Domain Name.

The Domain Holder has put forward an explanation of the background in relation to the registration of the Domain Name and possible future use. The Arbitrator cannot evaluate the actual truth of the statements, but through this decision the Arbitrator shall decide if the Domain Name shall be transferred to the Petitioner or not, based on the findings in the case. The Arbitrator cannot find that there are enough reasons to decide

that the lack of use of the Domain Name shall constitute bad faith (however lack of use of a domain name sometimes can be found to be in bad faith).

The Petitioner has so far not shown that it has conducted any business in Sweden using the Trademark and it seems that a desire to registers the Domain Name is recent due to establishing new business in Sweden.

In summary, the Petitioner has not shown any evidence indicating that the Domain Holder knew about the Petitioner, nor its Trademark, when registering the Domain Name. There are not any other convincing arguments why the Domain Holder shall be considered to have been registered or used the Domain Name in bad faith.

In the Arbitrator's view, the Petitioner has failed to prove that the Domain Holder has either registered or used the Domain Name in bad faith.

### **C. The Domain Holder has no rights or justified interest in the Domain Name.**

Since it has been established that the Domain Name has neither been registered nor used in bad faith there is no need to make a finding under the third element.

## **8. Decision**

On the basis of the foregoing, the Petition is denied.

The Arbitrator's decision is without prejudice to the Petitioner's rights to file a new Petition in respect of the Domain Name in the event the Petitioner develops new information not reasonably available at the time of the filing of the Petition in this proceeding showing that the Domain Holder is using the Domain Name in bad faith.

## **9. Summary**

The Arbitrator has found that the Domain Name <fiveguys.se> and the Petitioner's registered EUTM FIVE GUYS to be identical. However, the Petitioner has not established that its Trademark is well-known, nor provided any evidence of the Domain Holder acting in bad faith when registering the Domain Name. Furthermore, the Arbitrator did not find that the lack of use of the Domain Name to constitute bad faith in accordance with the .se Policy. Based on said findings, the Petition is denied.

**Peter Hedberg**

Date: December 29, 2023