

ADMINISTRATIVE PANEL DECISION

Dishoom Limited v. Domains By Proxy, LLC / shatha salem
Case No. D2022-1495

1. The Parties

The Complainant is Dishoom Limited, United Kingdom, represented by Dechert, United Kingdom.

The Respondent is Domains By Proxy, LLC, United States of America (“United States”) / shatha salem, United Arab Emirates (“UAE”).

2. The Domain Name and Registrar

The disputed domain name <dishoomdubai.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 April 26, 2022. On April 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 27, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 28, 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 April 28, 2022.

The Center verified that the Complaint together with the amended 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”).

On April 28, 2022, the Respondent sent two email communications. On May 2, 2022, the Respondent sent an email communication to the Registrar.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 1, 2022. The Response was filed with the Center on May 28, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on June 9, 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 was established in 2010 and explores a restaurant and bar concept based upon the Irani cafes of the early 1900s in India, counting with five locations in London and additional locations in Edinburgh, Manchester and Birmingham.

One of the Complainant's first restaurants, Dishoom Shoreditch, opened in 2012 and, since 2018, a series of pop-up restaurants in Mumbai have also been run by the Complainant, as well as, since 2020, gifts and the DISHOOM cookery book have been sold worldwide from the Complainant's online store available at <store.dishoom.com>, including to the UAE, where the Respondent is reportedly located (Annex D to the Amended Complaint).

The Complainant is the owner, amongst several others, of the following trademark registrations:

- UAE trademark registration No. 283756 for the word mark DISHOOM registered on August 15, 2018 in international class 43; and
- United Kingdom trademark registration No. 907404239 for the word mark DISHOOM registered on June 10, 2009 in international classes 29, 30, 35 and 43.

The disputed domain name <dishoomdubai.com> was registered on January 8, 2022 and it resolves to a parked webpage displaying pay-per-click ("PPC") links.

5. Parties' Contentions

A. Complainant

The Complainant asserts to have been remarkably successful and its reputation rapidly grown, having been appraised and recognised by the general public and the food and restaurant industry alike, as Bloomberg, The Guardian, FT Weekend, CNN Mumbai, amongst other reviews attest.

The Complainant further asserts to have:

- been listed in the Good Food Guide every year from 2012 to 2019;
- been listed in the Michelin Guide every year from 2012 to 2021;
- been named the Most Admired Brand by the CGA, Peach Heroes and Icon Awards in 2018 and 2021;
- won the Restaurant Brand of the Year in the Casual Dining Restaurant and Pub Awards, for 2020;
- been ranked as Best restaurant of 2020 in Manchester by CityLife Awards;
- been named the Restaurateur of the Year (Group) at the Cateys Awards in 2018;
- voted the Food, Beverage or Leisure Operator of the Year at the Revo Gold Awards in 2017;
- listed in Cool Brands in 2015 and 2016;
- voted as the best restaurant in the United Kingdom in the Yelp Top 100 Eateries list in 2015 and 2016.

Having thus built up a substantial reputation and goodwill in the DISHOOM trademark, past UDRP panels have already ascertained the Complainant's "broad reputation for its mark, restaurants and cookbook, including through awards and extensive media coverage" (*Dishoom Limited v WhoisGuard, Inc / Gabriella Garlo*, WIPO Case No. [D2020-3442](#)) as well as found "that the Complainant's trademark is well positioned in its market, and among consumers" (*Dishoom Limited v. Super Privacy Service LTD c/o Dynadot / S Jon Grant*, WIPO Case No. [D2020-2938](#)).

The disputed domain name is, according to the Complainant, confusingly similar to the Complainant's trademark, creating a likelihood of confusion, given that the disputed domain name incorporates the Complainant's DISHOOM trademark together with the addition of the geographic term "dubai", what does not prevent a finding of confusing similarity thereof.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (a) due to the Complainant's business and international presence, it is reasonable to assume that the Respondent was aware of the Complainant at the time of the registration of the disputed domain name;
- (b) the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, given that the disputed domain name is being used in connection with a parked webpage displaying PPC links, unduly generating revenues to the Respondent;
- (c) the Complainant has not licensed or otherwise permitted or authorised the Respondent to use its trademark or to apply for a domain name incorporating the trademark; and
- (d) the Respondent's name does not include the Complainant's trademark or anything similar and it is not commonly known by the disputed domain name.

As to the registration of the disputed domain name in bad faith, the Complainant asserts that the Respondent knew or should have known of the Complainant's trademark rights at the time of the registration of the disputed domain name. In addition to that, the Respondent's use of the disputed domain name in connection with a parked webpage displaying PPC links is a further indication of the Respondent's bad faith, as well as the use of a privacy registration service and the indication of false contact details at the time of registration of the disputed domain name so as to conceal the Respondent's true identity, not being possible to conceive of any plausible use of the disputed domain name that would not be illegitimate, such as by passing off or an infringement of the Complainant's rights under trademark law.

B. Respondent

The Respondent, in her first informal message of April 28, 2022 states that she does not understand the bringing of this dispute given that she asserts not to be the owner of the disputed domain name. In her second message of that date the Respondent claims to have cancelled the disputed domain name from her account in January 2022.

On May 2, 2022, the Respondent exchanged e-mail messages with the Registrar inquiring the reason for the disputed domain name to exist given her request for its cancellation in January 2022. The Registrar responded on May 4, 2022 explaining that unless a domain name is cancelled within five days of its registration it will remain in a pending redemption status until the domain name's expiration date.

On May 28, 2022, the Respondent submitted a further e-mail message as her reply to the Complaint reaffirming that she no longer owns the disputed domain name, which she originally registered in early January 2022 but then later cancelled.

She claims that the disputed domain name sounded similar to a phrase related to her childhood and the location where she had lived as a child, but she did not have the intention to compete with or disrupt the Complainant's business.

Lastly, the Respondent further states not to understand why the disputed domain name is still registered under her name and that she is willing to settle or take any steps to confirm the cancellation of the disputed domain name.

While the Panel notes the Respondent's email communications in relation to the possible settlement, the Panel will proceed to a substantive decision on the merits.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has established rights in the DISHOOM trademark duly registered in several countries around the world.

The Panel finds that the disputed domain name reproduces the Complainant's mark in its entirety. The addition of the geographical term "dubai" does not prevent a finding of confusing similarity. 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". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel notes that given the Factual Background and Parties' Contentions set out above, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Prior UDRP panels have held that the use of a complainant's mark to redirect users (*e.g.*, *vis-à-vis* the PPC

links exhibited on the disputed domain name redirecting users to third-party commercial sites) would not support a claim to rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.3. Moreover, in the instance of this proceeding, the links resolve Internet users to services in direct competition with Complainant (such as “Restaurant Menu” and “Shoreditch Restaurant”), illustrating the intent of Respondent to use the disputed domain name to capitalize on the reputation and goodwill associated with Complainant’s trademark.

Furthermore, where a domain name consists of a trademark plus a geographical term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See [WIPO Overview 3.0](#), section 2.5.1.

Therefore, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name. The second element of the Policy has also been met.

C. Registered and Used in Bad Faith

This case presents the following circumstances which indicate bad faith registration and use of the disputed domain name:

- a) the Complainant’s trademark is registered in several jurisdictions and is well known;
- b) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by her of the disputed domain name; and
- c) the nature of the disputed domain name (reproducing the entirety of the Complainant’s trademark plus the term “dubai”), along with the Respondent’s willingness to cancel the disputed domain name, and the implausibility of any good faith use to which the disputed domain name may be put.

Further, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4. Moreover, the current use of the disputed domain name in connection with a parked webpage displaying PPC links would not prevent a finding of bad faith.

For the reasons above, the Respondent’s conduct has to be considered, in this Panel’s view, as bad faith registration and use of the disputed domain name.

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 <dishoomdubai.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: June 23, 2022