

ADMINISTRATIVE PANEL DECISION

Papa John's International, Inc. v. Hemin
Case No. DTM2023-0001

1. The Parties

The Complainant is Papa John's International, Inc., United States of America ("United States"), represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Hemin, China.

2. The Domain Name and Registry

The disputed domain name <papajohns.tm> is registered with NIC.TM (the "Registry").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 30, 2023. On March 30, 2023, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain names. On March 31, 2023, the Registry transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On May 22, 2023, the Center requested clarification from the Complainant regarding the transmission of hard copies of the Complaint to the Respondent. On May 26, 2023, the Complainant confirmed that the Complaint was communicated to the Respondent.

The Center verified that the Complaint satisfied the formal requirements of the Domain Name Dispute Resolution Policy for Domain Names registered with NIC.TM (the "Policy"), the Rules for Domain Name Dispute Resolution for .TM Names (the "Rules of Procedure"), and the WIPO Arbitration and Mediation Center Supplemental Rules for Domain Name Dispute Resolution Policy for .TM Names (the "Supplemental Rules").

In accordance with the Rules of Procedure, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced May 26, 2023. In accordance with the Rules of Procedure, paragraph 5(a), the due date for Response was June 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 23, 2023.

The Center appointed Andrea Mondini as the sole panelist in this matter on July 13, 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 of Procedure, paragraph 7.

4. Factual Background

The Complainant was founded over 30 years ago and has today more than 5,000 Papa John's restaurants in 50 countries of the world. The Complainant is one of the largest take-out and pizza delivery restaurant in the world and is listed on Nasdaq.

The Complainant owns numerous trademarks for PAPA JOHN'S, *inter alia*, the United States Trademark No. 1383735 registered on February 18, 1986, and the Chinese Trademark No. 768 054 registered on September 21, 1995.

The Complainant also holds several domain names, including its main domain name <papajohns.com>.

The disputed domain name was registered on October 21, 2013.

The record shows that the disputed domain name resolves to an inactive site.

5. Parties' Contentions

A. Complainant

The Complainant contends as follows:

The disputed domain name is identical or at least confusingly similar to the PAPA JOHN'S trademark in which the Complainant has rights, because it incorporates this trademark in its entirety, and the omission of the apostrophe and the addition of Top-Level Domain ".tm" are not sufficient to avoid confusing similarity.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has not been authorized by the Complainant to use this trademark, is not commonly known by the disputed domain name, and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain name in connection with a *bona fide* offering of goods and services.

The disputed domain name was registered and is being used in bad faith because it is obvious that the Respondent had knowledge of both the Complainant and its well known trademark PAPA JOHN'S at the time it registered the disputed domain name, and because the lack of use of a domain name that coincides with a well-known trademark owned by someone else constitutes use in bad faith. Furthermore, the Respondent failed to reply to a cease and desist letter sent by the Complainant on January 20, 2023.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the trademark or service mark in which the complainant has rights;

- (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 or is being used in bad faith.

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has trademark rights, by virtue of the registrations it owns for PAPA JOHN'S.

The Panel notes that the disputed domain name incorporates the PAPA JOHN'S trademark. The omission of the apostrophe is due to technical constraints in registering a domain name and does not prevent a finding of confusing similarity. Furthermore, the addition of the generic Top-Level Domain ".tm" in the disputed domain name is a standard registration requirement and as such is disregarded under the confusing similarity test under Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), section 1.11.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's mark PAPA JOHN'S.

The first element of paragraph 4(a) of the Policy has been met.

B. Rights or Legitimate Interests

The Complainant states that it has not authorized the Respondent to use the trademark PAPA JOHN'S, that the Respondent is not commonly known by the disputed domain name, and that before notice of the dispute, there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain name in good faith. The Panel does not see any contrary evidence from the record.

In the view of the Panel, the Complainant has succeeded in raising a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. For its part, the Respondent did not provide a Response and thus failed to provide any explanations as to any rights or legitimate interests.

Furthermore, the nature of the disputed domain name, comprising the Complainant's trademark PAPA JOHN'S, carries a risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

Therefore, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name.

The second element of paragraph 4(a) of the Policy has been met.

C. Registered or Used in Bad Faith

The Complainant has shown to the satisfaction of the Panel that its PAPA JOHN'S trademark is well-known.

In the view of the Panel, noting that the Complainant's trademark predates the registration of the disputed domain name, and also noting the extensive use of the Complainant's trademark, it is inconceivable that the Respondent could have registered the disputed domain name without knowledge of the Complainant's well-known trademark. In the circumstances of this case, this is evidence of registration in bad faith.

The disputed domain name resolves to an inactive site. However, the Respondent's passive holding of the disputed domain name does not prevent a finding of use in bad faith in this case (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). In this regard, the Panel notes the reputation of the Complainant's trademark, and the Respondent's failure to respond to the Complainant's cease and desist letter and to submit a response in these proceedings or provide any evidence of actual or contemplated good-faith use, and the Respondent's apparent provision of false contact information when

registering the disputed domain name given that the courier was unable to deliver the Center's written communication.

The Panel thus finds that the disputed domain name was registered in bad faith and its non-use does not prevent a finding of bad faith use.

The third element of paragraph 4(a) of the Policy has been met.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(h) of the Policy and 15 of the Rules of Procedure, the Panel orders that the disputed domain name, <papajohns.tm>, be transferred to the Complainant.

/Andrea Mondini/

Andrea Mondini

Sole Panelist

Date: July 27, 2023