

## **ADMINISTRATIVE PANEL DECISION**

E.A. Sween Company v. Samuel Chan  
Case No. D2024-2959

### **1. The Parties**

The Complainant is E.A. Sween Company, United States of America (“United States”), represented by Greenberg Traurig, LLP, United States.

The Respondent is Samuel Chan, Hong Kong, China.

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

The disputed domain name <sanluismexicanrestaurant.net> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 19, 2024. On July 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 22, 2024, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 24, 2024, 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 July 25, 2024.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 16, 2024.

The Center appointed Zoltán Takács as the sole panelist in this matter on August 21, 2024. 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 family owned and operated ready-to-eat sandwiches business located in Minnesota, United States.

The Complainant produces a range of products under established brand names such as San Luis Burritos.

Among others the Complainant owns the United States Trademark Registration No. 1665521 for the word mark SAN LUIS, registered since November 19, 1991, for burritos.

Since May 5, 2017, the Complainant owns the domain name <sanluisburritos.com> which resolves to its website used for the promotion of its products (hereinafter referred to as the "San Luis website").

The Complainant's San Luis website features product information, a promotional video and a form for customers or prospective customers for collection of their personal information such as names, postal addresses, email addresses and phone numbers.

The disputed domain name was registered on June 11, 2024, and has resolved to a website that was the exact copy of the Complainant's San Luis website inclusive of a contact form for the collection of personal information.

Based on the Complainant's abuse complaint of July 17, 2024, the Registrar suspended the disputed domain name on July 18, 2024, and currently the disputed domain name does not resolve to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- the disputed domain name, which incorporates in full its SAN LUIS trademark with the addition of terms "mexican" and "restaurant" directly related to the nature of its goods is confusingly similar to the trademark;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name since it is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy;
- the Respondent registered the disputed domain name long after it established rights in the SAN LUIS mark and used the disputed domain name to divert Internet traffic to its website that was the exact copy of the Complainant's San Luis website inclusive of a contact form for collection of personal information which is evidence of bad faith.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainant's SAN LUIS mark is reproduced and is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "mexican" and "restaurant", which are descriptive and closely related to the nature of the Complainant's goods, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds that the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Complainant has not authorized, licensed, or allowed the Respondent to use its SAN LUIS trademark through the disputed domain name or in any other way that would confer validity or legitimacy upon such usage.

According to the documentary evidence submitted by the Complainant, the Respondent has impersonated the Complainant by using the disputed domain name to divert Internet users to its website that was the exact copy of the Complainant's San Luis website inclusive of a contact form for collection of personal information.

Such websites, mimicking the official website of the complainant are often referred to as imposter website created with the intent of collecting sensitive personal customer information for malicious purposes, typically in a phishing scam. Panels have held that the use of a domain name for illegal activity, here claimed impersonation/passing off and potential phishing, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, the inherently misleading nature of the disputed domain name, incorporating the Complainant's trademark and descriptive terms closely related to the nature of the Complainant's goods, carries risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds that the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

In the present case, the Panel notes that the priority of the Complainant's SAN LUIS trademark long predates the date of registration of the disputed domain name.

The website at the disputed domain name not only displayed the Complainant's SAN LUIS trademark, it was actually the exact copy of the Complainant's San Luis website.

Thus, in view of the Panel it is clear that the Respondent had actual knowledge of the Complainant and its trademark and registered the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark. Paragraph 4(b)(iv) of the Policy.

The Respondent's intent to target the Complainant and its SAN LUIS trademark can be readily inferred from the Respondent's diversion of Internet traffic to its imposter website to potentially defraud unsuspected Internet users by creating the illusion of a legitimate site belonging to the Complainant.

Panels have held that the use of a domain name for illegal activity, in this case impersonation/passing off and potential phishing, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

While the disputed domain name has ultimately been suspended by the Registrar, the current inactive use of the disputed domain name does not prevent a finding of bad faith given the impersonating nature and prior use of the disputed domain name.

The Panel finds that the Complainant has established the third element of the Policy.

## **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 <sanluismexicanrestaurant.net> be transferred to the Complainant.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: September 4, 2024