



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC  
v. Say Cheesecake**

**Case No. D2005-0766**

#### **1. The Parties**

The Complainant is The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., Calabasas Hills, California, United States of America; represented by Buchalter Nemer Fields & Younger, United States of America.

The Respondent is Say Cheesecake, 3720 W. Tropicana Avenue, Suite 1, Las Vegas, NV 89103, United States of America.

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

The disputed domain name <saycheesecakefactory.com> is registered with Go Daddy Software.

#### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on July 19, 2005, and in hard copy form on July 21, 2005, along with Annexes 1-9.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member

panel.

After receiving the Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether that Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on July 20, 2005, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the disputed domain name; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to the disputed domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain "locked" during the proceeding.

Subsequently, on July 20, 2005, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name, to the extent present in its WhoIS database, confirmed that GoDaddy Software is the registrar of that name and stated that: it had received a copy of the Complaint, the Policy applied to the disputed domain name, the language of the underlying registration agreement for the name is English and the name was then held in a "locked" status. The Registrar also informed the Center that the Respondent, through the registration agreement, had submitted to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes concerning or arising from the use the disputed domain name.

On July 25, 2005, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, by courier and email (the latter being without the Annexes), to the Respondent. Specifically, the Center separately provided its notice along with the Complaint, by email, to the Respondent's domain name registrant, technical, administrative and zone contacts as set forth in the WhoIS record for the disputed domain name. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on July 25, 2005, under paragraph 4(c) of the Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the Registrar, in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on August 14, 2005, to file its Response with the Center and serve a copy of the Response on the Complainant.

As of August 14, 2005, the Center had not received a Response to the Complaint from the Respondent; hence, the Center, in an email letter August 15, 2005, notified the Complainant and Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated

August 18, 2005, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated August 19, 2005, notified the parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before September 2, 2005. However, due to unexpected time conflicts experienced by the Panel – which constituted exceptional circumstances, the Center, upon the Panel’s request, extended the due date to September 12, 2005.

This dispute concerns one domain name, specifically: <saycheesecakefactory.com>.

The language of this proceeding is English.

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

A copy of the WhoIS registration records for the disputed domain name appears in Annex 1 to the Complaint. As indicated on these records, the Respondent registered the disputed domain name on June 17, 2004.

##### **A. Complainant’s CHEESECAKE FACTORY Marks**

The Complainant owns 17 United States trademark registrations along with 73 foreign counterpart registrations for its marks that contain the term “CHEESECAKE FACTORY”, either by itself or with other terms, whether in block letters or stylized, and with and without an accompanying logo (collectively the CHEESECAKE FACTORY Marks) and on which this dispute is based. The Complainant has provided, in Annex 3 to the Complaint, hard-copy printouts of entries of its various marks from Trademark Electronic Search System (TESS) database accessible through the web site of the United States Patent and Trademark Office (USPTO), and, in Annex 4 to the Complaint, copies of the corresponding registration certificates. A sampling of the Complainant’s United States registrations is as follows:

- (a) THE CHEESECAKE FACTORY EXPRESS (stylized with logo)  
United States registration 2,393,307; registered: October 10, 2000  
filed: August 13, 1999

This mark was registered for use in connection with “restaurant services” in international class 42. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of June 19, 1998.

- (b) THE CHEESECAKE FACTORY (stylized)  
United States registration 2,253,746; registered: June 15, 1999  
filed: July 7, 1998

This mark was registered for use in connection with “cakes and bakery products” in international class 30. The registration states that first both use and first use in commerce of this mark in conjunction with these goods commenced as of December 31, 1972.

- (c) THE CHEESECAKE FACTORY (block letters)  
United States registration 1,864,786; registered: November 29, 1994  
filed: January 10, 1994

This mark was registered for use in connection with “clothing; namely, shirts, pants and hats” in international class 25. The registration states that first use and first use in commerce of this mark in conjunction with these goods commenced as of July 31, 1984 and January 31, 1991, respectively.

- (d) THE CHEESECAKE FACTORY (block letters)  
United States registration 1,549,370; registered: July 25, 1989  
filed: April 6, 1988

This mark was registered for use in connection with “cakes” in international class 30, and for “restaurant services” in international class 42. The registration states that both first use and first use in commerce of this mark in conjunction with these goods and services in both classes commenced as of December 31, 1972.

- (e) THE CHEESECAKE FACTORY (stylized)  
United States registration 1,191,891; registered: March 9, 1982  
filed: November 3, 1980

This mark was registered for use in connection with “restaurant services” in international class 42. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of March 1, 1974.

## **B. The Parties and their activities**

As to the parties themselves, The Cheesecake Factory Assets Co., LLC is a subsidiary of The Cheesecake Factory Incorporated and licenses the CHEESECAKE FACTORY Marks to the latter.

Complainants, The Cheesecake Factory Incorporated and The Cheesecake Factory Assets Co., LLC, are collectively a widely known operator of restaurants and bakeries in the United States and a producer and distributor of bakery products and various other products both in the United States and worldwide. For simplicity, both of these organizations will be collectively referred to hereinafter as simply the Complainant unless specifically referenced otherwise.

Since 1972, the Complainant has continuously and substantially used its CHEESECAKE FACTORY Marks in connection with its restaurant services and bakery products. Currently, the Complainant owns at least 87 upscale, casual dining restaurants in the United States and plans to open approximately 16 more restaurants in the United States in 2005, with a 25% increase each year thereafter. In addition, the Complainant sells its bakery products to restaurants in foreign countries, including but not limited to, Canada, England, Kuwait and Saudi Arabia.

Apart from these restaurants, the Complainant also currently sells its bakery products and various other products in the United States at bakeries, supermarkets and warehouse stores such as Costco and Price Club; and via catalogs, mail order, telephone order and a telephone number listed on its web site; and on United States army bases abroad. The Complainant also sells its bakery and various other products in numerous

foreign countries via mail order, a telephone number listed on its web site, wholesale and retail bakeries, warehouses and supermarkets, and through wholesale and direct restaurant sales.

The Complainant operates its web site at <thecheesecakefactory.com>; the Complainant having registered that name on August 24, 1996. This web site became active during April 1998. The Complainant uses its web site to publicize its business, restaurants, and products and to provide a means for customers to order and purchase the Complainant's products via a telephone number listed on that site. Approximately 14,000 unique hosts per day visited the Complainant's web site from January 2004, to October 2004. A host may have multiple users, i.e., a computer at a public library. In addition, the Complainant's site currently averages in excess of approximately 77,000 hits per day.

Since 1972, when the Complainant commenced using its CHEESECAKE FACTORY Marks, it has enjoyed substantial worldwide sales of its branded goods and services. In that regard, from 1989 through 2004, the Complainant's total worldwide revenues generated from the sales of such goods and services amounted to approximately US \$ 4.7 billion, with in 2004 alone, those revenues amounting to approximately US \$ 881 million.

Furthermore, the Complainant advertises and promotes its CHEESECAKE FACTORY Marks on a worldwide basis in conjunction with its branded goods and services. That advertising and promotion includes print media advertising, point of sale materials and radio advertising. In 2004, the Complainant's US advertising expenditures were approximately \$200,000.00 dollars.

The Complainant has also received widespread publicity in numerous trade journals, national magazines, and national newspapers, as evidenced by an article describing the Complainant, The Cheesecake Factory, entitled "The Cheesecake Factory – Bakery specialist whips up a winning recipe that keeps the public coming back for more" which appeared in the newsweekly Nation's Restaurant News, August 14, 2000, Vol. 34, No. 33 – a copy of that article appears (along with another article describing the Complainant, The Cheesecake Factory) in Annex 5 to the Complaint.

The Complainant has two currently operating restaurants under "THE CHEESECAKE FACTORY" name located in Las Vegas, Nevada, which is the same city in which the Respondent is located. These restaurants offer and sell bakery products, including cheesecakes, and are located at: (1) 3500 South Las Vegas Boulevard, Las Vegas, Nevada 89109, located in The Forum Shops at the Caesars Palace casino, and (2) 750 S. Rampart Boulevard, Building 17, Las Vegas, Nevada 89145, located in the upscale planned community of Summerlin. Both of those restaurants are situated at highly visible locations.

As of the date of the Complaint, the disputed domain name does not resolve to an operational web site. In that regard, that name is parked free on the Registrar's web site with the corresponding web page stating "Coming Soon!" – ostensibly meaning that the Respondent's site is under construction and will soon appear. A copy of this web page appears in Annex 6 to the Complaint.

The Respondent's contact email address, in its WhoIs record for the disputed domain name, is "support@fantasyweddingcakes.com". When an Internet search was conducted by the Complainant for <fantasyweddingcakes.com>, an active web site resulted which states "Wedding Cake Concepts owned by Vickie Sullivan". A person

by that same name is listed as the administrative and technical contact in the Respondent's WhoIS record.

On July 12, 2004, the Complainant sent a cease and desist letter (a copy of which appears in Annex 7 to the Complaint) to the Respondent via email and first class mail, at the Respondent's email and postal addresses listed in the WhoIs database. Through that letter, the Complainant demanded, inter alia, that the Respondent transfer the disputed domain name to the Complainant. Not having received any response to that letter, the Complainant, on August 20, 2004, sent a second cease and desist letter (a copy of which appears in Annex 8 to the Complaint) to the Respondent. The Complainant has yet to receive any response to its second letter.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's CHEESECAKE FACTORY Marks.

Specifically, the Complainant states that its CHEESECAKE FACTORY Marks and the disputed domain name both contain the term "CHEESECAKE FACTORY" which is the dominant portion of those marks. The addition of the gTLD (generic top level domain) ".com" and the term "say" do not significantly alter the commercial impression created by those Marks, and in fact the former is to be ignored when assessing confusing similarity.

The Complainant asserts that, since that the similarity is so apparent, confusion of Internet users would be inevitable. Specifically, a user seeking to access the Complainant's web site, but who enters the disputed domain name into a search engine, would be directed to the Respondent's web site (actually the Registrar's parked page) instead.

Lastly, the Complainant asserts that, as a result of that confusion, Internet users will wrongfully associate the disputed domain name with the Complainant's marks which, in turn, will cause the Complainant to suffer a substantial loss of goodwill and will dilute the distinctive quality of those marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

#### **(ii) Rights or Legitimate Interests**

The Complainant contends that, for several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy

First, the Complainant states that the Respondent is not an employee or franchisee of the Complainant and is not affiliated with the Complainant in any way. Moreover, the Respondent does not have a license or other authorization from the Complainant to use its CHEESECAKE FACTORY Marks.

In addition, to the best of the Complainant's knowledge, neither the Respondent nor any business operated by the Respondent has ever been commonly known by the disputed domain name. In that regard, that name does not consist of Respondent's legal name nor a name that it is commonly identified with the Respondent.

Furthermore, the Complainant alleges that the Respondent has not used the disputed domain name in connection with a bona fide offering for goods or services and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. Rather, the Respondent lists, as its contact email, "support@fantasyweddingcakes.com". When a search was conducted on the Internet of the domain <fantasyweddingcakes.com>, an active web site resulted which states "Wedding Cake Concepts owned by Vickie Sullivan" – presumably the same "Vickie Sullivan" listed as the administrative and technical contact in the WhoIs record for the disputed domain name.

Lastly, the Complainant asserts that its trademark registrations establish the validity and right to exclusive use of each of its marks with respect to the services and goods defined in the respective registration. Registration of a domain name in no way trumps federal trademark law; mere registration of a domain name does not itself confer any trademark rights on the registrant. The use, goodwill, and registration of the CHEESECAKE FACTORY Marks was established many years before the date of the disputed domain name was registered (June 17, 2004), and hence the Respondent has no rights to that name.

### **(iii) Registered and Used in Bad Faith**

The Complainant contends that, for several reasons, the Respondent has registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

As to bad faith registration, the Complainant first alleges that bad faith is shown by the Respondent having simply added the term "say" to the Complainant's mark "CHEESECAKE FACTORY" to yield the disputed domain name.

Second, the Complainant alleges that the Respondent registered the name in order to prevent the Complainant from reflecting its mark in a corresponding domain name either to interfere with the Complainant's right to use its marks in commerce or to sell that name to the Complainant, ostensibly for more than the cost of its registration. In that regard, the Complainant contends that, when the Respondent registered the name on June 17, 2004, it had to have been aware of the Complainant's trademark rights in the term "CHEESECAKE FACTORY" – particularly in light of how widely used and well-known that term had then become. To evidence this, the Complainant's registered marks were then on record in the USPTO where the Respondent could have easily discovered them. Second, the Complainant has two currently operating restaurants situated at highly visible locations in Las Vegas, which is the same city in which the Respondent is located. Hence, the Complainant contends that it is not possible to conceive of a plausible situation in which the Respondent, as of June 17, 2004, would not have been aware of the Complainant or its marks.

With respect to bad faith use, the Complainant contends that the Respondent has simply failed to use the disputed domain name, since the date that name was registered, in connection with a bona fide offering of any goods or services nor, to the best of the Complainant's knowledge, has the Respondent made any demonstrable preparations to use that name in connection with any such offering. Specifically, the Complainant

contends that the Respondent has failed to establish any web site or web page under the disputed domain name. In fact, the only web page that comes up when a search is conducted on the Internet for the name <saycheesecakefactory.com> is the Registrar's sponsored web page that states "Coming Soon!" (see Exhibit 6 to the Complaint). Hence, the Respondent is merely parking the name at the Registrar possibly with an intent to "hold such name hostage until TCF [Complainant, The Cheesecake Factory] comes up with an amount of compensation acceptable to Respondent". Citing to *World Wrestling Federation Entertainment, Inc. v. Michael Bosman* WIPO Case No. D1999-0001 (January 14, 2000), the Respondent states that registering a domain name with the intent to sell it to the rightful trademark owner has previously been recognized as evidence of bad faith registration and use under the Policy. The distinctiveness of the Complainant's mark "CHEESECAKE FACTORY" mark supports an inference that the Respondent's primary purpose in registering the name was to sell it to the Complainant should the opportunity arise which is the only party with any legitimate right to and interest in that name.

## **B. Respondent**

The Respondent failed to file any Response to the allegations raised in the Complaint.

## **6. Discussion and Findings**

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings.

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

The Panel finds that confusion is likely to arise as a result of the Respondent's use of the disputed domain name.

The disputed domain name is formed of a generic term, specifically "say", prepended to the Complainant's mark "CHEESECAKE FACTORY" to form the term "saycheesecake" and with ".com" gTLD appended to that term though the addition of any gTLD is completely ignored in assessing identity/similarity under paragraph 4(a)(i) of the Policy.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. "Say" is certainly such a generic word. See, e.g., *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004) and *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004). This result follows from a simple comparison of the disputed domain name against the Complainant's marks.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant's web site, but who were to reach the Respondent's site resolvable through the disputed domain name (were the Respondent to ever establish such an operational site), to think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. See, also, *e.g.*, *Napster*, *Caesars Entertainment, Lockheed v. Skunkworx*, and *Lockheed v. Teramani*, all cited *supra*; *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet et al*, FA208576 (National Arbitration Forum, January 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, FA 173362 (National Arbitration Forum, September 16, 2003); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, FA 123896 (National Arbitration Forum, October 14, 2002); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *L.F.P., Inc. v. B and J Properties*, FA 109697 (National Arbitration Forum, May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*, FA 100492 (National Arbitration Forum, December 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, FA 97186 (National Arbitration Forum, July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092 (National Arbitration Forum, June 4, 2001); *American Home Products Corporation v. Ben Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark's Paint Store, Inc.*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, FA 96101 (National Arbitration Forum, January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, FA 95856 (National Arbitration Forum, December 18, 2000); See also *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution, May 3, 2000).

Therefore, the Panel finds that the disputed domain name sufficiently resembles the Complainant's CHEESECAKE FACTORY Marks as to cause confusion; hence, the Complainant has shown sufficient similarity between the disputed domain name the Complainant's marks under paragraph 4(a)(i) of the Policy.

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

The Panel believes that not only has the Respondent not provided any basis that would legitimize any claim it has to the disputed domain name, but also it is extremely unlikely that the Respondent could ever make such a claim.

The simple reason is that the disputed domain name contains the Complainant's mark "CHEESECAKE FACTORY" under which the Complainant provides its goods and services and has continuously so provided those goods and services since 1972 – which is well prior, by some 32 years, to the date (June 17, 2004) on which the Respondent has registered the name. Moreover, the widespread long-term recognition which the Complainant had developed in its CHEESECAKE FACTORY Marks well prior to July 2004, not the least of which resulting from the existence of the Complainant's two operating restaurants and bakeries situated in highly visible locations in the same city as the Respondent which is also in the cake baking trade, supports this Panel's view that the Respondent was very likely to have been well aware of the Complainant's goods and services and its marks prior to having registered the disputed domain name – and in

the absence of any Response it is quite reasonable for the Panel to infer such knowledge.

Furthermore, the Complainant has never authorized the Respondent to utilize any of its CHEESECAKE FACTORY Marks or any mark confusingly similar thereto in conjunction with the specific goods and services which the Complainant provides under its marks, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the mark “CHEESECAKE FACTORY” or one confusingly similar thereto, in connection with the goods and services provided by the Complainant or those similar thereto would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Napster and Caesars Entertainment, cited supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 18, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp., AT&T Corp., and MPL Communications* FA 97086 and FA 97092, all cited *supra*; *Am. Online, Inc. v. Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms, Inc.*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the mark “CHEESECAKE FACTORY” and hence could never be commonly known or recognized by that mark and thus could never fall within paragraph 4(c)(ii) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

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

The Panel believes that the Respondent’s actions constitute bad faith registration and use of the disputed domain name.

As discussed in the preceding section, the Panel infers – and it strains belief to think otherwise – that the Respondent was fully aware of the Complainant’s mark “CHEESECAKE FACTORY” when the Respondent registered the disputed domain name on June 17, 2004, and particularly the reputation which that mark had attained as a result of the Complainant’s extensive nationwide restaurant and bakery operations starting some 32 years earlier.

In fact, this Panel believes that the Respondent not only knew of the Complainant’s prior and ongoing activities but also intentionally chose the disputed domain name due to its inclusion of the Complainant’s mark “CHEESECAKE FACTORY” in order to trade off the Complainant’s reputation. By so doing, it is clear to this Panel that the Respondent, in selecting the disputed domain name that substantially mirrored the Complainant’s mark intended to either: (a) wait until an opportune time arose when it could attempt to sell that name to the Complainant for a sufficient sum of money which would clearly exceed the cost of obtaining the registration and/or (b) use that name to divert users, seeking the Complainant’s site, to the Respondent’s site instead, whenever the Respondent’s site were to become operational, and implying in the minds of those users that a relationship or affiliation of some sort existed between it and the Complainant – when no such relationship or affiliation then existed in actuality. Such conduct violates paragraphs 4(b)(i) and 4(b)(iv), respectively, of the Policy.

Furthermore, the Panel finds that the Respondent's continued retention and non-use over approximately 13 months (as of the date of the Complaint) of the disputed domain name –particularly in spite of its prior and continuing knowledge of the Complainant's mark "CHEESECAKE FACTORY" if not its other marks, amounts to passive holding which here unquestionably reflects bad faith use. Various panels, including this one, have held that passive holding, coupled with a respondent's knowledge of trademark rights of a complainant in the name being so held – as is clearly the case here, can amount to bad faith use under paragraph 4(a)(iii) of the Policy. In that regard, See, e.g., *Bayer Aktiengesellschaft v. Henrik Monssen* WIPO Case No. D2003-0275 (May 30, 2003); *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.* WIPO Case No. D2002-0758 (October 4, 2002); *America Online, Inc. v. Curtis Woods* WIPO Case No. D2001-0555 (June 13, 2001); *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications* WIPO Case No. D2001-0210 (April 16, 2001); *402 Shoes, Inc. d/b/a Trashy Lingerie v. Jack Weinstock and Whispers Lingerie*, WIPO Case No. D2000-1223 (January 2, 2001) *Liberty Public Limited Company v. Thomas Guarrera* FA 95103 (Nat. Arb. Forum August 17, 2000); *V & S Vin & Spirit Aktiebolag v. Gunnar Hedenlans Peev* FA 95078 (Nat. Arb. Forum August 9, 2000); *Revlon Consumer Prods. Corp. v. Yosef* WIPO Case No. D2000-0468 (July 27, 2000) *Telstra Corporation Limited v. Nuclear Marshmallows* WIPO Case No. D2000-0003 (February 18, 2000); and *Mary-Lynn Mondich and American Wine Biscuits, Inc. v. Shane Brown d/b/a Daddy's Antiques* WIPO Case No. D2000-04 (February 16, 2000).

Hence, the Panel views the Respondent's actions as constituting bad faith registration and use in violation of paragraph 4(a)(iii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **7. Decision**

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now grants the relief sought by the Complainant.

The disputed domain name, <saycheesecakefactory.com>, is ordered transferred to the Complainant.

---

Peter L. Michaelson  
Sole Panelist

Dated: September 12, 2005