

ADMINISTRATIVE PANEL DECISION

Société des Produits Nestlé S.A. v. Boris Postolov
Case No. D2023-0212

1. The Parties

The Complainant is Société des Produits Nestlé S.A., Switzerland, represented by Studio Barbero, Italy.

The Respondent is Boris Postolov, Uzbekistan.

2. The Domain Name and Registrar

The disputed domain name <nes.cafe> 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 January 17, 2023. On January 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 18, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the disputed domain name.

The Center verified that the 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 January 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 16, 2023. On January 26, 2023, the Center received an email communication from the Respondent requesting for an extension of time to file a response. On January 30, 2023, the Center granted the Respondent the automatic four calendar day extension for response under paragraph 5(b) of the Rules. The Response was filed with the Center on February 4, 2023.

The Center appointed John Swinson as the sole panelist in this matter on February 24, 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, paragraph 7.

4. Factual Background

The Complainant is part of Nestlé company founded in 1866 by Henri Nestlé. The Complainant is a Fortune Global 500 company. The Complainant markets its products worldwide in 186 countries, including Uzbekistan.

The Complainant produces and distributes coffee all over the world under well-established brands, including NESCAFE, which is one of the Complainant's leading brands. The NESCAFE brand was launched in 1938.

The Complainant owns a larger number of trademark registrations for NESCAFÉ, including International Trademark Registration No. 718381 of August 24, 1999, for NESCAFÉ (device mark) in classes 29, 30, 32, 35 and 42 designating, amongst others, Uzbekistan, and International Trademark Registration No. 189879 for NESCAFÉ (word mark) of January 9, 1956 in class 30.

The disputed domain name was registered on July 14, 2015.

The disputed domain name resolves to a parking page with sponsored links.

The Complainant instructed a web agency to contact the Respondent. On November 10, 2022, the web agency contacted the Respondent via the Registrar's online contact form and to the shielded email address in the Whois records. On November 14, 2022, the web agency received a response from the Respondent, who requested that the web agency submit an offer for the disputed domain name. The web agency proposed an amount in line with the estimated out-of-pocket costs associated with the disputed domain name. The Respondent refused that offer and requested USD 150,000. Thereafter, the Complainant's lawyers wrote a cease-and-desist letter to the Respondent. No reply was received to that letter.

5. Parties' Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The disputed domain name incorporates the whole of the Complainant's word trademark NESCAFE. The fact that the disputed domain name differs from the Complainant's trademark only by the addition of a punctuation mark (".") between the words "nes" and "cafe" in the trademark does not affect the identity or confusing similarity.

Previous panels have held that the domain name suffix (*i.e.*, .cafe) can be used for comparison purposes if the inclusion of the suffix lends to the overall similarity of the domain name with the complainant's earlier rights.

The Respondent is not a licensee, authorized agent of the Complainant and is not authorized to use the Complainant's NESCAFE trademark.

The Complainant is not in possession of, nor aware of, the existence of any evidence demonstrating that the Respondent, whose name is Boris Postolov, might be commonly known by a name corresponding to the disputed domain name as an individual, business, or other organization. According to the searches performed by the Complainant's representative, the Respondent does not own any trademark registrations for NESCAFE.

Given the well-known character of the NESCAFE trademark, any use of the name or sign "Nes.cafe", "Nescafe" or "Nes Café" by third parties not authorized by the Complainant would be illegitimate as it would cause a likelihood of association with the Complainant and its famous trademark.

The disputed domain name resolves to a website with sponsored links. Such use is to be considered neither as a *bona fide* offering of goods or services nor as a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain. The Respondent was certainly gaining, for example from the click-through commissions on the sponsored links.

The registration of a domain name identical to the trademark NESCAFE undoubtedly creates an impression of an association with the Complainant and a high risk of implied affiliation.

Because the Complainant's registered trademark is well known and has been used extensively since the late 1930s, it is inconceivable that the Respondent was unaware of the existence of NESCAFE and its worldwide reputation at the time of registration of the disputed domain name. NESCAFE is a trademark with such widespread notoriety that it would be nearly impossible for the Respondent not to have known this.

Given the distinctiveness and reputation of the Complainant's trademark, the Respondent clearly acted in opportunistic bad faith, by registering the disputed domain name with full knowledge of the Complainant's trademark for the purpose of taking commercial advantage of the Complainant's trademark.

The Respondent has pointed the disputed domain name to a web page where Internet users can find several sponsored links. As a result, the Respondent has at least earned commissions whenever an Internet user visited the websites and clicked on one of the sponsored links.

In correspondence, the Respondent requested USD 150,000 for handing over the disputed domain name. This correspondence was in response to email from the Complainant's web agency that expressly mentioned the Complainant as prospective client of the web agency.

The Respondent set up MX records for the disputed domain name. The disputed domain name may have been used for email communication. In view of the identity of the disputed domain name with the Complainant's NESCAFE trademark, such email configuration also amounts to bad faith use.

B. Respondent

In summary, the Respondent makes the following submissions:

The Respondent only owns NES, which is considered a second-level domain. It is not identical or even similar to NESCAFE. The Complainant erroneously positions the combination of two domain names as one domain name.

If a person conducts an Internet search on "NESCAFE" then, in the 1,000 or more search results, one will not be able to find the word "NES.CAFE". This demonstrates that the disputed domain name is not confusingly similar to the NESCAFE trademark.

The Complainant did not write to the Respondent directly, but began with correspondence through an intermediary which was a provocation, an offer to buy the disputed domain name. The Respondent replied that he was not going to sell the disputed domain name. The Respondent never advertised the disputed domain name for sale. The Respondent owned the disputed domain name for seven years and in that period made no attempt to sell the disputed domain name. The Respondent has not made money from the disputed domain name. The parking page is a default registrar generated parking page.

The Respondent intends to use the disputed domain name for a project connected with pop genre Standup. The abbreviation NES stands for New Epoch Standup. The Respondent has no intention to use the disputed domain name in respect of coffee.

The Respondent refused to sell the disputed domain name to the Complainant for the amount offered by the Complainant, because the disputed domain name has a lot more value to the Respondent.

The Respondent requests a two-year postponement of this case.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

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

The *onus* of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns trademark registrations for NESCAFE.

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, disregarding the Top-Level Domain (“TLD”) part of the domain name (e.g. disregarding the “.com” or “.cafe” part of the domain name.)

In some limited circumstances, however, as part of a holistic review of the facts, it may be appropriate to “span the dot” and consider the TLD (see, e.g., *Zions Bancorporation v. Mohammed Akik Miah*, WIPO Case No. [D2014-0269](#); *Mr Green Ltd. v. Alfred Zeiselberger, Mediapool Communications Limited*, WIPO Case No. [D2017-1944](#); and *Confederation Nationale Du Credit Mutuel v. Super Privacy Service LTD c/o Dynadot / Wei Chen*, WIPO Case No. [D2021-0426](#)).

For example, *Tesco Stores Limited v. M.F.*, WIPO Case No. [DCO2013-0017](#) involved the domain name <tes.co>. After considering several prior decisions, the three-member panel stated:

“The only consideration is whether, in registering the Domain Name with a particular TLD suffix, a respondent has sought to incorporate a complainant’s trademark in its entity by making use of that TLD suffix, such that it becomes a key part of the Domain Name. In the Panel’s view, if the TLD suffix is part of the Complainant’s trademark, whether forming part of one word, or a second and distinct word, it may be taken into account for comparison purposes. [...] Thus, we have a ‘low threshold’ test that involves a simple comparison of Domain Name with mark. The Panel has found that a TLD suffix may be included in a comparative review. The Panel’s view is that it should include the TLD suffix for comparison purposes in this case, given that the TLD suffix forms part of the trademark (TESCO) to which the Domain Name (<tes.co>) is being compared.”

After reviewing the prior decisions, including those discussed above and those cited in the Complaint, the Panel finds that the disputed domain name <nes.cafe>, considered in its entirety, is confusingly similar to the Complainant’s NESCAFE trademark.

The Complainant succeeds on the first element of the Policy.

B. Rights or Legitimate Interests

The Complainant's allegations to support the Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above in section 5A.

The Complainant has rights in its trademark which precedes the Respondent's registration of the disputed domain name. There is no evidence that the Respondent is commonly known by the disputed domain name. There is no evidence that the Respondent owns or operates a café.

The Panel finds that the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in the disputed domain name.

The disputed domain name resolves to a registrar-generated parking page. The Respondent states that he does not control the content on the parking page, and that he will instruct the Registrar to remove the parking page. Accordingly, the parking page does not demonstrate that the Respondent has rights or legitimate interests in the disputed domain name.

The Respondent asserts that the Respondent has plans to use the disputed domain name for a project, but he does not have the financial resources "for its rapid implementation". The project is vaguely described in the Response as connected with "pop genre Standup". According to the Respondent, the abbreviation NES stands for New Epoch Standup. This is a term that the Panel does not understand. The Response includes an undated hand-drawn logo that the Respondent asserts is for this project. It is not stated when this logo was created.

The disputed domain name has been registered for over 7 years, and it appears that little progress has been made by the Respondent in respect of this project. No project plans, business plans or other evidence of this project was included in the Response. Compare *Queen Productions Limited, Duck Productions Limited, Queen Music Limited v. Daniel Stanojevic*, WIPO Case No. [D2011-1001](#).

If not independently verifiable by the panel, preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services cannot be merely self-serving statements but should be inherently credible and supported by relevant pre-complaint evidence (see section 2.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Respondent has not provided any documentary evidence to substantiate these assertions beyond the undated hand-drawn logo (discussed above). The hand-drawn logo is not sufficient to demonstrate rights or legitimate interests in the disputed domain name. See also *Pet Plan Ltd. v. Paul Nash*, WIPO Case No. [D2019-1434](#).

Moreover, in correspondence prior to the Complaint, the Respondent initially stated that he would be "glad" to receive an offer for the disputed domain name, and stated nothing regarding his "pop genre Standup" project.

As such, the *prima facie* case established by the Complainant has not been rebutted by the Respondent and the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by the complainant. *Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. [D2014-1747](#).

The Complainant's NESCAFE trademark is very well known. The Respondent does not assert that he was unaware of the Complainant or the NESCAFE trademark when he registered the disputed domain name.

The NESCAFE trademark is sufficiently distinctive and well known such that, noting that the disputed domain name is identical to the NESCAFE trademark apart from one dot, it is difficult to conceive of any use that the Respondent might make of the disputed domain name without the Complainant's consent that would not involve bad faith. Compare *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#). See also *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) (“[The disputed domain name] is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith.”)

The disputed domain name currently resolves to a registrar-generated parking page with pay-per-click links. The Respondent states that this is a default page that he does not control, and that he has not received any income from this page. Even if that is correct, as stated in section 3.5 of the [WIPO Overview 3.0](#) regarding “automatically” generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name. Neither the fact that such links are generated by a third party such as a registrar, nor the fact that the respondent himself may not have directly profited, would by itself prevent a finding of bad faith.

The Panel finds that the Respondent more likely than not registered the disputed domain name to attract Internet users to the Respondent's website for commercial gain or to take an unfair advantage of the similarity between the disputed domain name and the Complainant's trademark.

The Respondent did not actively prompt the disputed domain name for sale. However, when contacted by a web agency, the Respondent was clearly willing to sell the disputed domain name. The Respondent proposed a price of USD 150,000. It appears to the Panel that the value which the Respondent seeks to secure from sale of the disputed domain name is based on the underlying value of the Complainant's trademark. In the present case, while the exchange of correspondence between the parties may not be sufficient of itself to establish bad faith, when looked at holistically in light of all the circumstances of this case, it is unhelpful for the Respondent.

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The Complainant succeeds on 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 <nes.cafe> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: March 8, 2023