

## **ADMINISTRATIVE PANEL DECISION**

Société des Produits Nestlé S.A. v. Privacy Service Provided by Withheld for Privacy ehf / Trent Taylor  
Case No. D2022-0854

### **1. The Parties**

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Trent Taylor, Australia.

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

The disputed domain name <nescafe.email> (“Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 11, 2022. On March 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 14, 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 March 17, 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 March 21, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 13, 2022.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on May 5, 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 is the owner of numerous international and national trademark registrations worldwide comprising NESCAFE/ NESCAFÉ including:

International Registration No. 718381 for NESCAFÉ (figurative mark), registered August 24, 1999, in classes 29, 30, 32, 35 and 42;

International Registration No. 189879 for NESCAFÉ (word mark), registered January 9, 1956, in class 30;

International Registration No. 208358 for NESCAFÉ (figurative mark), registered March 22, 1958, in class 30;

International Registration No. 300360 for NESCAFÉ (figurative mark), registered July 21, 1965, in classes 5, 29, 30, 31, 32;

International Registration No. 638767 for NESCAFÉ (word mark), registered June 28, 1995, in classes 35, 39, 41, 42;

International Registration No. 1206213 for NESCAFÉ (figurative mark), registered February 28, 2014, in classes 7, 11, 29, 30, 32;

European Union Registration No. 003346053 for NESCAFE (word mark), registered September 10, 2003, in classes 9, 11, 14, 16, 18, 21, 24, 25, 28, 29, 30, 32, 35, 41, 43.

The Complainant sells products and services all over the world in various industries, primarily in the food industry, including baby foods, breakfast cereals, chocolate & confectionery, coffee & beverages, bottled water, dairy products, ice cream, prepared foods, food services as well as pet food.

The Complainant markets its products worldwide in over 190 countries, has about 328,000 employees, is present in more than 80 countries with more than 400 production centers worldwide. The Complainant's sales in 2019 were CHF 92.6 billion worldwide.

The NESCAFE brand was initially launched in Switzerland on April 1, 1938 and then exported in France, Great Britain, and the United States. When the United States entered World War II in 1941, the entire production of NESCAFE facilities in the U.S. – approximately one million cases per year – was dedicated to the servicemen.

According to Interbrand's annual Best Global Brands ranking for 2021, the trademark NESCAFE is worth USD14,466 million, making it the 40th most valuable trademark in the world.

The Disputed Domain Name was registered on June 30, 2021.

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

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

The Respondent has been redirecting the Disputed Domain Name since the registration to a website where Internet users can find several sponsored links to various commercial websites related to NESCAFE

trademark and coffee products, *i.e.* the products manufactured and sold by the Complainant under the trademark NESCAFE. These “sponsored links” are generating revenues for the registrar and/or for the domain name holder. By clicking on the pay-per-click (“PPC”) links available on the home page of the website at the Disputed Domain Name, Internet users are redirected to internal pages of the website displaying additional sponsored links related to third-party online stores offering for sale products of the Complainant’s competitors.

On September 27, 2021, the Complainant’s representative sent a data disclosure request to the concerned Registrar and to the privacy shield company used by the Respondent. In absence of any reply, a reminder was sent on October 7, 2021. On the same date, the Registrar replied to the Complainant’s representative, refusing to disclose the identity and contact details of the underlying registrant “in absence of a U.S. state or federal court order or subpoena.”

On September 27, 2021, the Complainant’s representative sent a Cease and Desist letter to the registrant’s shielded email addresses indicated in the Registrar’s Whois records at that time, requesting Respondent to cease any use of, and transfer, the Disputed Domain Name to the Complainant. Reminders were sent on October 7, 2021, October 18, 2021, and November 11, 2021. The Respondent replied neither to the original letter nor to the reminders.

Complainant’s verifications highlighted that mail exchanger records (MX records) are displayed in the current DNS configuration of the Disputed Domain Name. Said configuration of MX records in the zone files at the time of the filing of the present Complaint suggests the possible use of the Disputed Domain Name in connection with the receipt as well as the sending of emails from email addresses based on the Disputed Domain Name.

The Disputed Domain Name registered by the Respondent is identical to the trademarks NESCAFE and NESCAFÉ in which the Complainant has rights. With specific regard to the omission in the Disputed Domain Name of the accent from the last letter of NESCAFÉ, previous panels have considered that the addition or deletion of grammatical marks such as hyphens, apostrophes and circumflexes are irrelevant changes, insufficient to reduce the identity or confusing similarity, as set out in paragraph 4(a)(i) of the Policy. The addition of the TLD “.email” to the Complainant’s trademark in the Disputed Domain Name is not sufficient to prevent a finding of identity between the Disputed Domain Name and the Complainant’s trademark.

Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant’s trademarks.

The Complainant is not in possession of, nor aware of the existence of any evidence demonstrating that Respondent might be commonly known by a name corresponding to the Disputed Domain Name as an individual, business, or other organization. Indeed, also in light of the use of the privacy protection service to conceal its identity, the Respondent cannot have been commonly known by the Disputed Domain Name before any notice of the dispute.

The Respondent has not provided the Complainant with any evidence of use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services before or after any notice of the dispute. In addition, the Respondent has clearly not made a legitimate noncommercial or fair use of the Disputed Domain Names without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark.

Moreover, the registration of a domain name identical to the trademark NESCAFE in the TLD “.email” undoubtedly creates an impression of an association with the Complainant.

In light of the fact that 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 indeed 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 Disputed Domain Name has been pointed since the registration to a web page where Internet users can find a number of sponsored links related to coffee products, including links making explicit reference to NESCAFE and to the Complainant's competitors coffee products such as Illy and leading users to other commercial websites promoting also competitors' products. 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 featured therein.

The Respondent has also set up MX records for the Disputed Domain Name, meaning that currently it might be used for, or in the future may be used for, email communication. In view of the identity of the Disputed Domain Name with the Complainant's trademark NESCAFE, it is submitted that also the configuration of the Disputed Domain Name for use in connection with email communication amounts to bad faith use.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

The Complainant has demonstrated it owns registered trademark rights in the famous NESCAFE mark, and has shown that no other entity has rights in or uses the Complainant's Marks. The TLD ".email" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Accordingly, the Disputed Domain Name is identical to a mark in which the Complainant has rights.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, and *Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

Accordingly, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

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

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent obtained the Disputed Domain Name decades after the Complainant had begun using its globally famous NESCAFE mark indicates the Respondent sought to piggyback on the mark for illegitimate reasons, namely to receive pay-per-click revenue to users clicking through to third party sites. Further, the presence MX records particularly for a domain name which contains the TLD ".email" indicates to the Panel that the Respondent does not have a legitimate interest in the Disputed Domain Name.

After a complainant has made a *prima facie* case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name.

In the absence of any evidence rebutting the Complainant's *prima facie* case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

The Disputed Domain Name was registered many years after the Complainant first registered and used its globally famous NESCAFE trademark. The evidence on the record provided by the Complainant with respect to the extent of use and global fame of its NESCAFE trademark, combined with the absence of any evidence provided by the Respondent to the contrary, is sufficient to satisfy the Panel that, at the time the Disputed Domain Name was registered, the Respondent undoubtedly knew of the Complainant's NESCAFE trademark, and knew that it had no rights or legitimate interests in the Disputed Domain Name.

There is *prima facie* no reason for the Respondent to have registered the Disputed Domain Name containing the entirety of the NESCAFE trademark with the TLD ".email".

Further, the use of the Disputed Domain Name by the Respondent is clearly in bad faith. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location. The Complainant has submitted evidence that the Respondent has used the Disputed Domain Name in order to direct users to a parked website which includes links to both the Complainant's website and that of its competitors. Given the fame of the Complainant's NESCAFE mark, the obvious inference is that the Respondent hoped to mislead customers of the Complainant to visit the website at the Disputed Domain Name trading on the Complainant's trademark and reputation in order to obtain pay-per-click revenue. In addition, the Disputed Domain Name has been configured for email servers, which may indicate the Disputed Domain Name could be used for possible phishing attempts or some other illegitimate use especially given that the Disputed Domain Name incorporates the ".email" TLD. This is a textbook example of bad faith use on the part of the Respondent.

In the absence of any evidence or explanation from the Respondent, the Panel finds that the only plausible basis for registering and using the Disputed Domain Name has been for illegitimate and bad faith purposes.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 <nescafe.email> be transferred to the Complainant.

*/Colin T. O'Brien/*

**Colin T. O'Brien**

Sole Panelist

Date: May 18, 2022