

ADMINISTRATIVE PANEL DECISION

Société des Produits Nestlé S.A. v. Hosein Mohammadi
Case No. D2022-3328

1. The Parties

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

Respondent is Hosein Mohammadi, Canada.

2. The Domain Name and Registrar

The disputed domain name <nescafeonline.com> is registered with CSL Computer Service Langenbach GmbH dba Joker.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 7, 2022. On September 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 8, 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 Complainant on September 12, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on September 14, 2022.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on September 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 5, 2022. Respondent sent email communications to the Center on September 13, 2022, September 14, 2022, and September 15, 2022, but did not submit a formal response. The Center informed the Parties that it will proceed to panel appointment on October 6, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on October 17, 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

Complainant Société des Produits Nestlé S.A. (“Complainant” or “SPN”) is part of the Nestlé company founded in 1866 by Henri Nestlé. SPN is wholly owned by Nestlé S.A. Complainant is the registered owner of the majority of the trademarks of the Nestlé Group. Today, Nestlé Group 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.

Complainant markets its products worldwide in over 190 countries, including Canada and the Islamic Republic of Iran. Nestlé Group has about 270,000 employees and is present in 79 countries with more than 350 production centers worldwide.

Complainant is the owner of hundreds of national and international trademark registrations worldwide comprising NESCAFE or NESCAFÉ (the “Mark”) for use in connection with products and services in the food industry, with sample registration details as follows:

- NESCAFÉ, International Trademark Reg. No. 189879, registered on January 9, 1956;
- NESCAFÉ, International Trademark Reg. No. 208358, registered on March 22, 1958;
- NESCAFÉ, International Trademark Reg. No. 300360, registered on July 21, 1965.

Complainant has continuously used the Mark in connection with products and services in the food industry since at least as early as 1938. Complainant also owns and operates the <nescafe.com> domain name which was created on October 20, 1996.

The disputed domain name was registered on February 29, 2020. The disputed domain name currently redirects to a Persian-language website featuring the Mark and Complainant’s official images and product visuals and offering for sale Complainant’s and competitors’ products, in the absence of any disclaimer of non-affiliation with Complainant.

5. Parties’ Contentions

A. Complainant

According to Complainant, the disputed domain name is identical or confusingly similar to Complainant’s NESCAFE/NESCAFÉ trademark in which Complainant has rights as demonstrated through its cited registrations. The Mark was adopted and has been continuously used since at least as early as 1938 in connection with products and services in the food industry. Complainant maintains its online presence through multiple websites, including one hosted at its domain name <nescafe.com>.

Complainant argues that the disputed domain name fully incorporates the Mark. Complainant also argues that the addition of the word “online” in addition to the Mark is clearly not sufficient to avoid a finding of confusing similarity with Complainant’s Mark.

Complainant asserts that Respondent lacks any rights or legitimate interests in the disputed domain name. According to Complainant, Respondent does not have any trademark rights to the Mark. Complainant alleges that Respondent is not using the disputed domain name in connection with any legitimate noncommercial or fair use without intent for commercial gain. Complainant argues that the disputed domain name redirected since registration to a commercial website offering Complainant’s and its competitor’s

products without displaying any disclaimer of non-affiliation with Complainant. Complainant also asserts that it has not granted Respondent, by license or otherwise, permission to use the Mark in any way. Complainant asserts that it has never had any contractual relationship with Respondent. Complainant argues that the disputed domain name was registered by Respondent without Complainant's consent.

Complainant argues that Respondent both registered and is using the disputed domain name in bad faith. According to Complainant, Respondent registered and is using the disputed domain name intentionally in an attempt to attract Internet users to its website by creating a likelihood of confusion with Complainant's trademark. Complainant argues that Respondent could not have been unaware of the existence of Complainant's famous trademarks and company name when registering the disputed domain name. Complainant also argues that the mere fact that Respondent has registered the disputed domain name which incorporates the famous NESCAFE/NESCAFÉ trademark is alone sufficient to give rise to an inference of bad faith. Complainant further argues that the content and use of Respondent's website also evidences bad faith on account of the offer of Complainant-branded and competing products for sale. Following the sending of a cease and desist letter from Complainant's representative, the disputed domain name was redirected from one website to another, featuring substantially the same content, including the same telephone numbers as the ones previously displayed. Complainant argues that such actions clearly show the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Center received several email communications from the email address associated with the registration of the disputed domain name regarding appropriate contact details of Respondent. Such details were included in the notification of the Complaint, however, the Respondent did not formally reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

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

The burden of proof is on Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the NESCAFE trademark as referenced above. Therefore, Complainant has established that it has rights in the Mark.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain ("TLD") in which the domain name is registered) is identical or confusingly similar to Complainant's mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the domain name and

the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain name incorporates the entirety of the Mark, adding only the word “online” to the Mark, which does not prevent a finding of confusing similarity. A side-by-side comparison of the Mark and the disputed domain name reveals that the Mark is easily recognizable within the disputed domain name.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its Mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

(i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant’s contention that Respondent is not an assignee or licensee of Complainant and that Respondent has no other business relationship with Complainant. Complainant has contended that Respondent is not commonly known by the disputed domain name and that there is no evidence that Respondent has established trademark rights in the disputed domain name. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights. In addition, Complainant contends that Respondent’s redirection of the disputed domain name to a website offering Complainant-branded and competing products, without any explanation regarding its relationship to Complainant, does not meet the standards set forth in the so-called “Ok Data test” for fair use by resellers or distributors, and constitutes neither a *bona fide* offering of goods or services, nor a legitimate, noncommercial or fair use of the disputed domain name.

Moreover, the Panel finds the inherently misleading nature of the disputed domain name, comprising Complainant’s well-known trademark with the descriptive term “online”, cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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

C. Registered and Used in Bad Faith

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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.

Here, Respondent's actions align with 4(b)(iv) of the Policy. The disputed domain name contains the entirety of the Mark, with the addition of the descriptive word "online". Due to the well-known nature of Complainant's brand, evidenced by its numerous global trademark registrations for the Mark and as determined in prior UDRP decisions, along with the unauthorized use of the Mark in the disputed domain name, and in conjunction with the content on Respondent's website featuring the Mark on Complainant's products, Respondent was undoubtedly aware of Complainant and the Mark when it registered the disputed domain name. Further, the use of Respondent's website, which offers Complainant-branded (and competing) products, can only serve to create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website for commercial gain. Respondent's use of the Mark in the disputed domain name in connection with Respondent's website clearly evidences bad faith on the part of Respondent in the registration and use of the disputed domain name.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain name, intentionally creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website with the purpose of attracting Internet users for commercial gain as per paragraph 4(b)(iv) 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 <nescafeonline.com> be transferred to Complainant.

/Brian J. Winterfeldt/

Brian J. Winterfeldt

Sole Panelist

Date: October 31, 2022