

## **ADMINISTRATIVE PANEL DECISION**

**Cafento Coffee Factory SLU v. Kyoung S Park**  
**Case No. D2023-5248**

### **1. The Parties**

The Complainant is Cafento Coffee Factory SLU, Spain, represented by Naranjo Patentes y Marcas, Spain.

The Respondent is Kyoung S Park, Republic of Korea.

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

The disputed domain name <montecelio.com> is registered with TurnCommerce, Inc. DBA NameBright.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 18, 2023. On December 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 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.

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 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 31, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 8, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on February 16, 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 the manufacturer of the coffee products which was established in 1930 and headquartered in Spain. According to the Complainant, the Complainant has a team of more than 400 professionals. The Complainant has a production capacity that amounts to 21 million kilos per year and has a wide distribution network throughout Spain, and it has established a local presence in France and central Europe.

The Complainant actively participates in international coffee trade fairs with its MONTECELIO trademarked products and is among the 10 best positioned companies in the Spanish ranking of coffee producers.

The Complainant owns a portfolio of the trademark registrations for MONTECELIO, including the following trademark registrations:

- Spanish Trademark Registration No. M2451488 for MONTECELIO & design, registered on November 5, 2002, for services in International Class 43;
- Spanish Trademark Registration No. M2929839 for MONTECELIO CAFÉS, registered on September 13, 2010, for goods in International Class 30;
- European Union Trademark Registration No. 009763483 for MONTECELIO, registered on July 21, 2011, for goods and services in International Classes 30, 35, and 43;
- Spanish Trademark Registration No. M3013798 for CHOCOLATES MONTECELIO GRAND CHOCOLAT, registered on May 18, 2012.

The disputed domain name was created on May 14, 2014. The disputed domain name resolves to a website that leads to a parking page containing pay-per-click ("PPC") advertising links that redirect to websites competing with the Complainant's business.

At the time when the administrative proceedings have been instituted, the disputed domain name resolved to the parking page with the notice that the disputed domain name is offered for sale for EUR 4800.

#### **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.

The Complainant contends that the disputed domain name incorporates the MONTECELIO trademark, and the Respondent's choice of the disputed domain name has created a likelihood of confusion between the disputed domain name and the Complainant's MONTECELIO trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant's contentions, the Respondent is not commonly known by the disputed domain name, has not used or prepared to use the disputed domain name in connection with a bona fide offering of goods or services, and has not been authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain name.

The Complainant submits that the Respondent registered and is using the disputed domain name in bad faith. The Respondent must have been aware of the Complainant's MONTECELIO trademark when it registered the disputed domain name. The Complainant contends that the lack of the actual use of the disputed domain name does not prevent the finding of bad faith.

## B. Respondent

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

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “[a] Panel shall decide a 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.”

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its decision on the statements and documents submitted by the Complainant and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel “shall draw such inferences therefrom as it considers appropriate.”

### 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.

Under the first element, the Complainant must establish that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: (i) the Complainant must demonstrate that it has rights in a trademark and, if so, (ii) the disputed domain name must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the [WIPO Overview 3.0](#), the term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a prima facie evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. Section 1.2 of the [WIPO Overview 3.0](#). The Complainant submitted evidence that the MONTECELIO trademark enjoys protection under national and regional trademark registrations.

Thus, the Panel finds that 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 mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Further, section 1.11.1 of [WIPO Overview 3.0](#) states: “The applicable Top Level Domain (“TLD”) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”. The generic TLD “.com” will therefore be discounted in the Panel’s consideration of confusing similarity.

The Panel finds 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.

Based on the case filing, the Panel establishes that there is no evidence that the Respondent is a licensee of, or otherwise affiliated with, the Complainant, and apparently, it has not been authorized by the Complainant to use its MONTECELIO trademark.

Based on the present case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

There is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a legitimate noncommercial fair use or a bona fide offering of goods or services.

The Panel notes the statements in the [WIPO Overview 3.0](#) on the question of whether “parked” pages comprising PPC links support the Respondent’s rights or legitimate interests. Section 2.9 of the [WIPO Overview 3.0](#) stated that:

“[a]pplying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users. [...] Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant’s (or its competitor’s) trademark.”

In the present case, the Respondent's earlier use of the disputed domain name incorporating the Complainant's MONTECELIO trademark to host a parking page with PPC links referring to the services competing with the Complainant's and offered by third parties does not, absent any further explanation, provide the Respondent with rights or legitimate interests in the disputed domain name as the services advertised on the website to which the disputed domain name resolves do not correspond to any obvious meaning of the phrase comprising the disputed domain name. The Respondent's earlier use of the disputed domain name is not bona fide, but rather evidence of bad faith, seeing as the Respondent presumably receives click-through-revenue by virtue of the misled Internet users drawn to the PPC site because of the confusingly similar disputed domain name.

Hence the Respondent's earlier use of the disputed domain name to host a parking page with PPC links does not, absent any further explanation, provide the Respondent with rights or legitimate interests in the disputed domain name.

The disputed domain name currently resolves to a website that states that the disputed domain name is available for sale to the public at a price likely in excess of out-of-pocket costs, which could not be considered a bona fide offering of goods or services, or justifying rights and legitimate interests on behalf of the Respondent.

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has chosen not to respond to the Complaint and thus has failed to provide any evidence of rights or legitimate interests in the disputed domain name. The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraph 4(a)(ii) of the Policy.

The Panel finds 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.

In the present case, the Panel notes that 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. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The disputed domain name was created well after the MONTECELIO trademark was first used and registered.

The disputed domain name used to resolve to a page offering PPC links for which the Respondent most likely would receive some commercial gain. In these circumstances where the Respondent has offered no plausible explanation for the registration of the disputed domain name, the Panel finds, on the balance of probabilities, that the Respondent was most likely aware of the Complainant at the time of registration and is using the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the MONTECELIO trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

Respectively, the Panel finds that the use of a domain name that is identical or confusingly similar to a trademark to obtain click-through-revenue can amount to bad faith use. *Ifscience Limited v. Domains By Proxy LLC / Dr Chauncey Siemens*, WIPO Case No. [D2016-0909](#); and *AMADEUS IT GROUP, S.A. v. Contact Privacy Inc. Customer 0151133672, Contact Privacy Inc. Customer 0151133672 / Milen Radumilo*, WIPO Case No. [D2018-2192](#)).

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness of the Complainant's trademark and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Furthermore, the existence of the offer to sell the disputed domain name at a price higher than any likely out-of-pocket costs of the Respondent, along with the lack of any evidence supporting any other explanations as to the possible (legitimate) use of the disputed domain name, leads the Panel to conclude that the Respondent registered the disputed domain name for the purpose of selling it for an amount in excess of its out-of-pocket costs.

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 <montecelio.com> be transferred to the Complainant.

*/Kateryna Oliinyk/*

**Kateryna Oliinyk**

Sole Panelist

Date: March 5, 2024