

ADMINISTRATIVE PANEL DECISION

Julius Meinl Industrieholding GmbH v. Richard Muller, ORgetUS Inc.
Case No. D2024-1395

1. The Parties

The Complainant is Julius Meinl Industrieholding GmbH, Austria, represented by Freshfields Bruckhaus Deringer, Austria.

The Respondent is Richard Muller, ORgetUS Inc., United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <juliusmeinlcoffeeclub.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 2, 2024. On April 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 3, 2024, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 4, 2024, 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 April 9, 2024.

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 April 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 4, 2024.

The Center appointed Federica Togo as the sole panelist in this matter on May 20, 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

It results from the Complainant's undisputed allegations that it is an Austrian family business with its headquarters in Vienna. It provides high quality coffee, tea and related products, from ground and whole beans to hot and cold drinks, with more than 2 billion cups of coffee being consumed ever year under the "Julius Meinl" trademark. It represents the Viennese coffee house culture around the world and combines tradition with a spirit of innovation and employs roughly 1000 people worldwide.

Furthermore, the undisputed evidence provided by the Complainant proves that the Complainant is the licensee of many trademarks containing and/or consisting of "Julius Meinl", which are owned by Excellent Brands JMI Ltd. (Switzerland), e.g., United States trademark registration No. 2,333,616 JULIUS MEINL registered on March 21, 2000 for goods in classes 29 and 30.

In addition, the Complainant provided relevant evidence of authorization from the trademark owner to file a UDRP complaint to request the transfer of the disputed domain name.

In addition, the Complainant uses the domain name <juliusmeinl.com> for hosting several websites providing details about the Complainant's history as well as the products and services offered.

The disputed domain name <juliusmeinlcoffeeclub.com> was registered on April 18, 2020. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolves to an online shop allegedly advertizing and selling Complainant's products and reproducing without authorization the Complainant's trademark and logo. The following indications are displayed on the website "We are an authorized reseller of Julius Meinl coffee in the United States" and "This is store is still in testing mode. No orders shall be fulfilled yet".

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.

Notably, the Complainant contends that the disputed domain name is identical and/or confusingly similar to the "Julius Meinl" trademark, since it incorporates the entire "Julius Meinl" trademark with the mere addition of the descriptive terms "coffee" and "club". The Complainant further contends that the trademark JULIUS MEINL is internationally well-known.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent holds no license to use the "Julius Meinl" trademarks. Neither the Complainant nor the trademark owner has otherwise permitted the Respondent to use the trademark or apply for or use any domain name incorporating the trademark. The Respondent's choice of the disputed domain name does also not make fair use of the "Julius Meinl" trademark as it does not make clear that it has no official affiliation with the Complainant but rather emphasizes the affiliation with the Complainant and misleadingly diverts consumers and tarnishes the JULIUS MEINL trademark.

Furthermore, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, due to the notoriousness of the "Julius Meinl" trademark internationally, the Respondent must have been aware of the registration of this trademark at the moment of

registering the disputed domain name. Further, by using the disputed domain name, the Respondent has intentionally attempted to attract (for commercial gain) Internet users to the Respondent's website by creating a likelihood of confusion with the "Julius Meinl" trademarks 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. This is evidenced by the fact that the Respondent allegedly claims that it is an "authorized reseller of the Julius Meinl coffee in the United States". Moreover, the Respondent operates on its infringing website an online shop for the distribution of Julius Meinl coffee products.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "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 requires a complainant to prove each of the following three elements in order to obtain an order that each disputed domain name be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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.

The Complainant has rights in a trademark under the Policy for purposes of standing to file a complaint. [WIPO Overview 3.0](#), section 1.4.1. In fact, the undisputed evidence provided by the Complainant proves that the Complainant is the licensee of the United States trademark registration No. 2,333,616 "Julius Meinl" registered on March 21, 2000, for goods in classes 29 and 30 and owned by Excellent Brands JMI Ltd., Switzerland. In addition, the Complainant provided relevant evidence of authorization from the trademark owner to file a UDRP complaint. Therefore, the Complainant has standing to file the UDRP complaint.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "coffee" and "club", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Moreover, the Panel notes that the disputed domain name is clearly constituted by the “Julius Meinl” registered trademark and a term “coffee”, which clearly refer to the Complainant’s core business, tending to suggest sponsorship or endorsement by the Complainant. This is also confirmed by the content of the website to which the disputed domain names resolve, allegedly advertizing and selling the Complainant’s products and reproducing without authorization the Complainant’s trademark and logo and the indication to be an authorized reseller of Julius Meinl coffee in the United States, which it is not.

The composition of the disputed domain name directly targeting the Complainant’s field of activity, enhances the false impression that the disputed domain name is somehow officially related to the Complainant and its official website promoting the Complainant’s business. Such composition of the disputed domain name cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#). This is the case in the present proceeding.

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.

One of these circumstances is that the Respondent by using the disputed domain name, 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy). In the present case, the Panel notes that it results from the Complainant’s documented allegations that the disputed domain name resolves to a website displaying the Complainant’s trademark and logo, and purportedly advertising and offering for sale the Complainant’s products. For the Panel, it is therefore evident that the Respondent positively knew the Complainant’s mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant’s trademark when it registered the disputed domain name.

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.

In this regard, the further circumstances surrounding the disputed domain name's registration and use confirm the Panel's findings that the Respondent has registered and is using the disputed domain name in bad faith:

- (i) the nature of the disputed domain name (incorporating the Complainant's mark plus the addition of descriptive terms within the trademark owner's field of commerce);
- (ii) the content of the website to which the disputed domain name directs, displaying the Complainant's trademark, logo, and purportedly advertising and offering for sale the Complainant's products, and the indication to be an authorized reseller of Julius Meinl coffee in the United States, which the Respondent is not;
- (iii) absence of rights or legitimate interests coupled with no response for the Respondent's choice of the disputed domain name.

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 <juliusmeinlcoffeclub.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: June 3, 2024