

ADMINISTRATIVE PANEL DECISION

Kopitiam Asia Pacific Sdn Bhd and White Café Sdn Bhd v. fong ching yee
Case No. D2024-4827

1. The Parties

The Complainants are Kopitiam Asia Pacific Sdn Bhd and White Café Sdn Bhd, Malaysia, represented by Ploum, Netherlands (Kingdom of the).

The Respondent is fong ching yee, China.

2. The Domain Name and Registrar

The disputed domain name <oldtownwhitecoffe.com> 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 November 22, 2024. On November 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 22, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainants on November 25, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on November 25, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on November 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 23, 2024.

The Center appointed Vincent Denoyelle as the sole panelist in this matter on January 2, 2025. 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 Complainants are coffee manufacturers and distributors operating many stores in the Asia Pacific region.

The Complainants own several OLDTOWN WHITE COFFEE trade marks, including the following:

- Chinese trade mark registration OLDTOWN WHITE COFFEE with registration number 14793490 applied for on July 17, 2014, and registered on September 7, 2015; and
- New Zealand trade mark registration OLDTOWN WHITE COFFEE with registration number 1096900 applied for on July 4, 2018, and registered on January 8, 2019.

The disputed domain name was registered on October 18, 2024. The disputed domain name does not currently point to any website, and it used to point to a website mimicking the website of the Complainants, passing itself off as the Complainants including with a misspelt reference to the Complainants' parent company ("Jacors Duowe Egberts" instead of "Jacobs Douwe Egberts").

The only information known about the Respondent is as disclosed by the Registrar.

5. Parties' Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that the disputed domain name is confusing similar to their OLDTOWN WHITE COFFEE trade mark given that the only difference between the disputed domain name and the Complainants' trade mark is that the last letter ("e") of the trade mark is omitted in the disputed domain name.

The Complainants assert that the Respondent is not commonly known under the name "oldtownwhitecoffee", "oldtownwhite", "oldtown", or any other variation thereof, nor has the Respondent acquired any corresponding trade mark or service mark rights. The Complainants add that the Respondent is not affiliated with the Complainants and the Complainants have not licensed or otherwise permitted the Respondent to use their trade mark. The Complainants also point to the content of the Respondent's website which deliberately misleads Internet users into believing that the Respondent's website is operated by or affiliated with the Complainants.

Finally, the Complainants argue that their OLDTOWN WHITE COFFEE trade mark is well-known and that the Respondent registered the disputed domain name to target the Complainants. The Complainants add that the Respondent relies on a risk of confusion with Complainants' activities and the OLDTOWN WHITE COFFEE trade mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name and associated website. The Complainants are concerned that the disputed domain name could be used for fraudulent purposes given that the Respondent has activated MX records for the disputed domain name and that it uses the Complainants' parent company's name on the checkout page of the Respondent's website.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Preliminary question: Multiple Complainants

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.11.1

Having reviewed the case, it appears that the two Complainants are two related businesses, part of the same group of companies and they both own trade marks in OLDTOWN WHITE COFFEE. As such, the Panel finds that they have a specific common grievance against the Respondent and accepts the consolidation of the Complainants in this case.

6.2 Substantive issue

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 Complainants' trade mark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainants have shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the OLDTOWN WHITE COFFEE trade mark is recognizable within the disputed domain name as it reproduces the entire trade mark with the mere omission of the last letter ("e"). Accordingly, the disputed domain name is confusingly similar to the trade mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.9.

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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants' 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.

Panels have held that the use of a domain name for illegitimate activity, here, claimed impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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, at the time of registration of the disputed domain name, must have been aware of the Complainants' trade mark OLDTOWN WHITE COFFEE given the reputation and longstanding use of the OLDTOWN WHITE COFFEE trade mark.

The Panel notes that the disputed domain name has been used to point to a website mimicking the Complainants' official website and impersonating the Complainants and their parent company and the Panel finds that the purpose of the Respondent's website was clearly to fraudulently mislead Internet users into believing that it was operated by or affiliated with the Complainants.

Panels have held that the use of a domain name for illegitimate activity, here, claimed impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under 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 <oldtownwhitecoffe.com> be transferred to the Complainant.

/Vincent Denoyelle/

Vincent Denoyelle

Sole Panelist

Date: January 16, 2025