

ADMINISTRATIVE PANEL DECISION

Goppion Caffè S.p.A. v. Jungsemi
Case No. D2022-1241

1. The Parties

The Complainant is Goppion Caffè S.p.A., Italy, represented by Società Italiana Brevetti S.p.A., Italy.

The Respondent is Jungsemi, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <goppioncaffe.com> is registered with Megazone Corp., dba HOSTING.KR (the “Registrar”).

3. Procedural History

The Complaint was filed in Korean with the WIPO Arbitration and Mediation Center (the “Center”) on April 7, 2022. On April 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 11, 2022, 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.

On April 12, 2022, the Center transmitted an email communication to the Parties in English and Korean regarding the language of the proceeding. On April 12, 2022, the Complainant submitted its request for English to be the language of the proceeding. On April 14, 2022, the Respondent requested for Korean to be the language of the proceeding.

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 April 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2022. Aside from the informal response submitted on April 14, 2022, the Respondent did not submit any further response. The Center informed the Parties of the Commencement of Panel Appointment Process on May 16, 2022.

The Center appointed Kathryn Lee as the sole panelist in this matter on May 25, 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 an Italian coffee company, founded in Treviso, Italy in 1948, and named after its founder Luigi Goppion. The Complainant produces around 1.2 million kilograms of coffee annually, with a turnover of around EUR 12 million in 2019. Coffee produced by the Complainant is sold in a number of countries including Italy, Germany, and Poland, and the Complainant operates 13 coffee shop locations in cities across Italy and one in Vienna. The Complainant is a member of “Consorzio Caffè Certificati”, an association that certifies the standards of coffee production in Italy, and is one of the founding members of “Consorzio di Tutela del Caffè Espresso Italiano Tradizionale”, an association organized to promote and preserve traditional Italian expresso coffee. The Complainant owns several trademark registrations to the GOPPION CAFFE logo mark including International Registration No. 1422301 registered on May 11, 2018 which designates, among others, the European Union, Switzerland, Philippines, Russian Federation, and Singapore. The Complainant has owned and used the domain name <goppioncaffe.it> since June 19, 2000.

The Respondent appears to be an individual with an address in the Republic of Korea.

The disputed domain name was first registered on September 11, 2010 and was not connected to any website at the time of filing of the Complaint.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name consists entirely of the phrase GOPPION CAFFE and is therefore identical to the GOPPION CAFFE trademark in which the Complainant has rights.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect. The Complainant asserts that the disputed domain name was at one point linked to a pay-per-click page showing links to coffee related products and pastry which are the exact goods of the Complainant, and currently does not point to any website, and that neither corresponds to *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

Finally, the Complainant contends that the disputed domain name was registered and is used in bad faith. The Complainant asserts that the GOPPION CAFFE mark is well known, and it is unlikely for the Respondent to have chosen these exact terms unless she was seeking to exploit the mark to her benefit. Further, the Complainant asserts that using the disputed domain name to show hyperlinks to goods and services in the pastry and coffee fields that correspond to the business of the Complainant constitutes bad faith. In addition, the Complainant states that the disputed domain name was registered to an individual named JUNGYUNKOOK with an address in the Republic of Korea until the Complainant sent him a cease and desist on November 26, 2021 requesting transfer of the disputed domain name. The Complainant received no reply, and shortly thereafter, the disputed domain name was transferred to the Respondent, also with an address in the Republic of Korea. The Complainant asserts that the prior owner has a long history of negative UDRP decisions against him and suggests that he assigned the disputed domain name to the Respondent in bad faith.

B. Respondent

The Respondent did not submit an official response to the Complainant's contentions. In an informal response submitted on April 14, 2022, the Respondent asserts that the Complainant's arguments are groundless since she newly acquired the disputed domain name in November 2021 and all the assertions raised by the Complainant relates to the prior registrant, not her. As evidence, the Respondent submitted a screenshot showing that there was a change of registrar on November 27, 2021.

6. Discussion and Findings

A. Language of Proceedings

Paragraph 11(a) of the Rules provides that the language of the proceeding shall be the language of the registration agreement, unless otherwise agreed to by the parties, subject to the authority of the panel to determine otherwise. In this case, the language of the Registration Agreement is Korean, and both parties have had an opportunity to argue their positions on this point. The Center issued a notice in Korean and English stating that it would accept the Complaint filed in English, and that the Response would be accepted in either Korean or English. The Respondent subsequently chose not to submit a substantive Response.

Given the fact that the Complainant is based in Italy and the Respondent is based in the Republic of Korea, English would appear to be the fairest neutral language for rendering this decision. Besides, both parties were given the opportunity to submit arguments in the language of their preference, and the language in which to render the decision is reserved for the Panel. The Panel would have considered a Response in Korean, but no Response was submitted. Accordingly, the Panel determines that rendering this decision in English is fair and procedurally efficient given the circumstances of this case.

B. Identical or Confusingly Similar

The Complainant owns registrations to trademarks that consist of the text GOPPION CAFFE and a design. According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.10, design elements are largely disregarded for purposes of assessing confusing similarity, except in limited circumstances such as when the design element comprise the dominant portion of the mark such that it overtakes the textual elements. Here, the disputed domain name corresponds to the text portion of the Complainant's mark exactly and the design element can be disregarded from consideration since it constitutes a minor portion of the mark.

For the reasons mentioned above, the Panel finds that the first element has been established.

C. Rights or Legitimate Interests

On the basis of the present record, the Panel finds that the Complainant has made the required allegations to support a *prima facie* showing that the Respondent has no rights or legitimate interests in the disputed domain name. Once such a *prima facie* basis has been established, the Respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain name. However, the Respondent in this case has chosen to file no substantive Response to these assertions by the Complainant, and there is no evidence or allegation in the records that would warrant a finding in favor of the Respondent on this point.

In addition, according to [WIPO Overview 3.0](#), section 2.5.1, the Panel notes that the composition of the disputed domain name carries a high risk of implied affiliation.

For the reasons provided above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and that the second element has been established.

D. Registered and Used in Bad Faith

It appears from the evidence submitted by the Respondent that the Respondent acquired the disputed domain name sometime around November 27, 2021. Based on the timing, the Panel finds it highly likely for the transfer to have taken place in order to circumvent possible action by the Complainant. Nonetheless, the Panel finds that there are sufficient reasons to find bad faith on the part of the Respondent.

First, considering the visibility of the Complainant and the Complainant's marks and products on the Internet, it is highly unlikely for the Respondent to have not known about the Complainant prior to registering the disputed domain name. Rather, given the identity between the disputed domain name and the textual elements of the Complainant's trademarks, the Panel finds that there can be no rational reason for the Respondent to have registered the disputed domain name other than for bad faith purpose, to unfairly take advantage of the composition of the disputed domain name.

In addition, the Respondent's non-use of the disputed domain name, or "passive holding" does not prevent a finding of bad faith. According to [WIPO Overview 3.0](#), section 3.3, various factors are considered when applying the doctrine of passive holding, such as the distinctiveness of the complainant's mark, any evidence of good faith use by the respondent, and the likelihood that the domain name would be used for any good faith purpose. Here, the Respondent did not submit any explanation for having registered the disputed domain name, and given the distinctiveness of the Complainant's mark to which the disputed domain name corresponds exactly, the Panel can conceive of no good faith reason for the Respondent to have registered it.

For the reasons given above, the Panel finds that the third and final element has been sufficiently established.

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, <goppioncaffe.com>, be transferred to the Complainant.

/Kathryn Lee/

Kathryn Lee

Sole Panelist

Date: June 8, 2022