

## **ADMINISTRATIVE PANEL DECISION**

Société des Produits Nestlé S.A. v. Privacy Service Provided by Withheld for Privacy ehf / Ma Chaw  
Case No. D2022-1908

### **1. The Parties**

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Ma Chaw, United States of America.

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

The disputed domain name <nespresso-online.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 May 26, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 28, 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 the Complainant on May 30, 2022 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 amendment to the Complaint on May 30, 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 the Respondent of the Complaint, and the proceedings commenced on June 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 23, 2022.

The Center appointed Keiji Kondo as the sole panelist in this matter on July 1, 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 the owner of trademark registrations worldwide for NESPRESSO. Among the Complainant's trademark registrations are the following:

- International Trademark No. 499589 for NESPRESSO of December 10, 1985, in class 30, claiming priority based on a Swiss application filed on September 3, 1985; and
- Japanese Trademark No. 2049744 for NESPRESSO of May 26, 1988, in classes 30 and 32, the examined application of which was published on October 23, 1987.

In addition to the trademark registrations for the plain word mark NESPRESSO, the Complainant also owns trademark registrations for the logo:



The Complainant is part of the Nestlé company founded in 1866 by Henri Nestlé, and is wholly owned by Nestlé S.A.

The Complainant markets its products worldwide. Nestlé Group is present in more than 80 countries with more than 400 production centers worldwide.

The Complainant is one of the world's largest food consumer products companies in terms of sales. As an example of figures that are indicative of the Complainant's products present in the market, the sales metrics of the group in 2020 were CHF 84.3 billion worldwide.

The disputed domain name was registered on March 23, 2022.

The disputed domain name is used to direct Internet users to a website offering for sale coffee machines and related goods.

#### 5. Parties' Contentions

##### A. Complainant

The disputed domain name has been redirected by the Respondent to a website misappropriating the NESPRESSO and N figurative trademarks, product visuals and *prima facie* advertising images as well as offering for sale unauthorized NESPRESSO coffee machines at discounted prices. Moreover, the copyright line reads "2019 NESPRESSO-ONLINE.COM -全著作権所有", thus clearly generating the impression that the website is an official Nestlé website.

Considering the manner of the Respondent's use of the disputed domain name, and in light of Internet users' presumption of reliability in registrations incorporating trademarks, it is very likely that users could be misled as to the source, sponsorship or affiliation of the Respondent's activity through the corresponding website. Such likelihood is increased by the absence of any disclaimer of non-affiliation with Nestlé on the website and by the fact that the name of the company managing the online store was not disclosed by the Respondent. The company profile disclosed at the Respondent's website contains the same information as a Japanese affiliate company of the Complainant.

The disputed domain name is confusingly similar to the Complainant's trademark NESPRESSO.

The disputed domain name incorporates the whole of the Complainant's trademark. The fact that the disputed domain name differs from the Complainant's trademark by the addition of a hyphen and the non-distinctive element "online" does not affect the confusing similarity. Indeed, as held in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where the relevant trademark is recognizable within the disputed domain name, the addition of generic or descriptive terms would not prevent a finding of confusing similarity under the first element.

Many prior decisions found that the addition of a generic-Top Level Domain ("gTLD") is merely instrumental to the use of Internet and shall thus be disregarded under the first element confusing similarity test, because it is viewed as a standard registration requirement.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

According to paragraph 4(a) of the Policy, the burden of proving the absence of the Respondent's rights or legitimate interests in respect of the disputed domain name lies with the Complainant. It is nevertheless a well-settled principle that satisfying this burden is unduly onerous, since proving a negative fact is logically less feasible than establishing a positive. Accordingly, it is sufficient for the Complainant to produce *prima facie* evidence in order to shift the burden of production to the Respondent (section 2.1 of the [WIPO Overview 3.0](#)).

The Complainant is not in possession of, nor aware of the existence of any evidence demonstrating that the Respondent might be commonly known by a name corresponding to the disputed domain name as an individual, business, or other organization. Indeed, because of the use of the privacy shield to conceal its identity, the Respondent cannot have been commonly known by the disputed domain name before any notice of the dispute.

The Respondent has not provided the Complainant with any evidence of use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services before or after any notice of the dispute herein. The disputed domain name is redirected to a commercial website publishing - in absence of any disclaimer of non-affiliation and failing to provide any detailed information about the real website administrator - the Complainant's trademarks and offering for sale purported NESPRESSO coffee machines at discounted prices. Moreover, a copyright line is displayed at the bottom of a webpage, which reads "2019 NESPRESSO-ONLINE.COM -全著作権所有". In a section under the title "company profile" (会社概要), the address of a Japanese company affiliated with the Complainant is published, thus clearly generating the false impression that the website is operated by Nestlé Group. Such willful conduct clearly demonstrates that the Respondent did not intend to use the disputed domain name in connection with any legitimate purpose and such use cannot certainly be considered a legitimate noncommercial or fair use without intent for commercial gain, because the Respondent is undoubtedly gaining from the sales of the products promoted on its website.

As regards the offer for sale of NESPRESSO coffee machines on the Respondent's website, the Complainant highlights that, irrespectively of the nature of said items, no fair use could be possibly invoked in the present case by the Respondent, since it has undoubtedly failed to accurately and prominently disclose its (lack of) relationship with the Complainant, thus generating a clear likelihood of confusion amongst Internet users. As stated in section 2.8.1 of the [WIPO Overview 3.0](#) "Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case for an offering to be regarded as *bona fide*:

(i) the respondent must actually be offering the goods or services at issue;

(ii) the respondent must use the site to sell only the trademarked goods or services;

(iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and

(iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

In the case at hand, as highlighted above, the Respondent has failed to provide an accurate and prominent disclaimer as to the lack of affiliation with the Complainant and, indeed, the layout, images and text published therein appear to be designed to reinforce the impression that such website is operated by the Complainant.

As final element within the frame of rights or legitimate interest, the Respondent did not reply to the cease and desist letter sent by the authorized representative of the Complainant. See *The Great Eastern Life Assurance Company Limited v. Unasi Inc.*, WIPO Case No. [D2005-1218](#), saying, "By operation of a common sense evidentiary principle, the Panel finds that the Respondent's failure to counter the allegations of the cease and desist letter amounts to adoptive admission of the allegations".

For all of the foregoing reasons, the Complainant concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

The domain name was registered and is being used in bad faith.

As to the assessment of the Respondent's bad faith at the time of registration, the Complainant's trademark NESPRESSO is irrefutably well known and the Respondent could not have been unaware of its existence when it registered the disputed domain name, which is confusingly similar to it. NESPRESSO has been recognized as a well-known trademark *inter alia* in *Société des Produits Nestlé S.A. v. Cess De Los Reyes*, WIPO Case No. [D2011-0020](#), *Société des Produits Nestlé S.A. v. Rova Andrianjohany c/o Locmad*, WIPO Case No. [D2014-0271](#), and *Société des Produits Nestlé S.A. ("Nestlé SA") v. Hayk Asatryan*, WIPO Case No. [DAM2013-0001](#).

The misappropriation of a well-known trademark as a domain name by itself constitutes bad faith registration for the purposes of the Policy. section 3.1.4 of the [WIPO Overview 3.0](#) provides: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See, *inter alia*, *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. [D2005-0556](#). Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the Complainant's (or a competitor's) website, and (vi) absence of any conceivable good faith use".

Furthermore, the actual knowledge of the NESPRESSO trademark by the Respondent at the time of the registration of the disputed domain name is clearly demonstrated by the fact that the website to which it resolves prominently features the Complainant's trademarks, advertising, offering for sale products bearing the Complainant's trademarks. The Respondent's website also publishes the details of the Complainant's Japanese affiliated company.

With reference to the use in bad faith, the disputed domain name is used in connection with a website publishing the Complainant's trademark, offering for sale unauthorized products bearing the Complainant's trademarks and generating the impression to be official. Such a conduct clearly demonstrates that the only purpose of the Respondent is to use the disputed domain name to intentionally attempt to attract, for

commercial gain, Internet users to such website, by creating a likelihood of confusion with the Complainant's trademark as to the source or affiliation of its website and taking unfair advantage from the well-known character of the trademarks for the Respondent's personal profit.

Therefore, it is clear that, by using the disputed domain name, the Respondent has intentionally attempted to attract, likely for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website according to paragraph 4(b)(iv) of the Policy.

As additional circumstances evidencing bad faith, it has also to be taken into consideration the Respondent's failure to respond to a cease-and-desist letter and its use of a privacy protection service to conceal its identity. With regard to the former, see, *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. [D2007-0062](#). As to the latter, even if the use of a shield company per se does not constitute a bad faith use, it can in certain circumstances constitute a factor indicating bad faith, depending on the manner in which such service is used. See [WIPO Overview 3.0](#), section 3.6. In the present case, the use by the Respondent of the privacy shield is certainly a clear indication as to its intentions to evade the consequences of registering a domain name in which it does not have any legitimate interest and that is used for clearly infringing purposes. See *BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#).

In light of the above, the Complainant respectfully submits that the disputed domain name was registered and is being used in bad faith in full satisfaction of paragraphs 4(a)(iii) and 4(b) of the Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainant owns trademark registrations for NESPRESSO, including International Trademark Registration No. 499589, registered on December 10, 1985, and Japanese Trademark Registration No. 2049744, registered in May 1988.

The disputed domain name incorporates the Complainant's trademark in its entirety, with addition of a hyphen and "online". Even with the addition of a hyphen and "online", the Complainant's trademark is recognizable in the disputed domain name.

It is well-established that the gTLD ".com" should typically be disregarded in the confusing similarity test because it is viewed as a standard registration requirement.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark within the meaning of paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

The disputed domain name resolves to a website which is apparently targeted to Japanese consumers. Coffee machines, which appear to be the Complainant's products, are offered for sale at the Respondent's website.

It is obvious that the Respondent's use of the disputed domain name is of commercial nature, and, thus, it does not constitute a legitimate noncommercial or fair use of the disputed domain name. Therefore, whether

the Respondent's use may be regarded as in connection with *bona fide* offering of goods or services is a question here.

Applying the Oki Data criteria, the Panel finds that the Respondent's use does not constitute a use in connection with *bona fide* offering of goods or services, because the Respondent does not disclose its relationship with the Complainant. On the contrary, the Respondent seems to actively attempt to cause confusion by using the Complainant's logo trademark on the topline of the homepage. In addition, the "profile of the company" (会社概要) section of the Respondent's website provides corporate information of Nestle Nespresso Kabushiki Kaisha, which is a true Japanese affiliate company of the Complainant, obviously as an attempt to cause confusion between the Respondent and the Complainant.

Therefore, the use of the disputed domain name by the Respondent is not a legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy, nor a use in connection with a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy.

The name of the Respondent, Ma Chaw, is not at all similar to the disputed domain name. Moreover, the Respondent did not reply to the Complainant's contentions, even though it had been properly given a notification of the Complaint. Under the circumstances, the Respondent's failure to respond to the Complaint may be regarded as evidence showing that the Respondent has never been commonly known by the disputed domain name. Therefore, the Panel concludes that the Respondent has never been commonly known by the disputed domain names within the meaning of paragraph 4(c)(ii) of the Policy.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The Complainant's trademark NESPRESSO is well known. Moreover, Japanese Trademark Registration No. 2049744 for NESPRESSO was registered on May 26, 1988.

The disputed domain name was registered on March 23, 2022. As mentioned above, the Respondent's website is apparently targeted to Japanese consumers, and offers coffee machines and related products for sale. Since the Respondent is in the same business area as the Complainant, it is inconceivable that the Respondent was not aware of the Complainant's trademark NESPRESSO when the disputed domain name was registered.

Furthermore, the Respondent uses the Complainant's logo trademark on the topline of the Respondent's website, and provides in the company profile section of the same website true corporate information of an actual Japanese affiliate company of the Complainant, obviously attempting to mislead consumers to believe that the website is affiliated with the Complainant.

The addition of "online" to the Complainant's trademark further strengthens the confusion between the Respondent between the Complainant because the disputed domain name is used in connection with online trade.

With the above-mentioned facts, the Panel concludes that the Respondent registered the disputed domain name to freeride on the reputation of the Complainant. Therefore, the Panel concludes that the disputed domain name was registered in bad faith.

Using the disputed domain name in a manner causing confusion between the Respondent and the Complainant, the Respondent offers for sale coffee-related products. Regardless of whether the offered-for-sale products originate from the Complainant or not, the Respondent activities through its website, to which the disputed domain name resolves, are of commercial nature and misleading. Therefore, the Respondent uses the disputed domain name intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark as to the

source, sponsorship, affiliation, or endorsement of the Respondent's website. Therefore, the Panel concludes that the Respondent uses the disputed domain name in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) 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 <nespresso-online.com> be transferred to the Complainant.

*/Keiji Kondo/*

**Keiji Kondo**

Sole Panelist

Date: July 15, 2022