

ADMINISTRATIVE PANEL DECISION

Société des Produits Nestlé S.A. v. Registration Private, DOMAIN SHIELD Case No. D2022-3765

1. The Parties

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

The Respondent is Registration Private, DOMAIN SHIELD, Canada.

2. The Domain Name and Registrar

The disputed domain name <nespresso-usa.com> is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 7, 2022. On October 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name(s). On October 10, 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 October 11, 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 October 13, 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 October 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 3, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on November 10, 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 a Swiss multinational food and drink processing conglomerate.

The Complainant is the owner of numerous trademark registrations worldwide for NESPRESSO, such as the international registrations no. 777873, 1054554 and 499589, respectively registered on March 14, 2002, September 13, 2010 and December 10, 1985; the European Union registration no. 2793792, registered on July 13, 2006; and the Canadian registrations no. TMA404720 and TMA908280, respectively registered on November 13, 1992 and July 13, 2015.

The NESPRESSO brand is used in connection with the Complainant's famous products and services line for the preparation of coffee.

The Complainant also registered the term "Nespresso" and variations thereof as domain name in numerous generic Top-Level Domains ("gTLDs") and country code Top-Level Domains ("ccTLDs"), including <nespresso.com>, registered on February 1, 1999

The Respondent registered the disputed domain name on September 16, 2022.

The Panel accessed the disputed domain name on November 20, 2022, which resolved to a webpage offering anti-virus software for sale. The Complainant brought evidence that the disputed domain name was recently used in connection with mobile text messages reproducing the NESPRESSO brand, making references to an alleged promotional campaign whereby the recipient would receive a complimentary coffee maker.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name incorporates the whole of the Complainant's NESPRESSO word trademark. The fact that the disputed domain name differs from the Complainant's trademark by the addition of a hyphen and the non-distinctive geographical element "usa" does not affect the confusing similarity. Indeed, this combination of words may even increase confusion amongst Internet users since the disputed domain name could be considered related to the official NESPRESSO web portal for United States of America. The hyphen has no source-distinguishing value and the Top Level Domain ".com" is merely instrumental to the use of Internet, and shall both be disregarded in the assessment of confusing similarity.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. It is a well-settled principle that it is sufficient for the Complainant to produce *prima facie* evidence in order to shift the burden of production of evidence to the Respondent. The Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademark NESPRESSO. 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. 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 random webpages, including websites for the download of programs, webpages displaying surveys to allegedly win mobile smartphones and third-party commercial websites promoting products not related to the Complainant. Moreover, when connecting from a computer where an antivirus program has been installed, access to the website where the disputed domain name redirects is prevented and a message informs users that the website is a scam. Such use of the disputed domain name certainly

does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent to misleadingly divert consumers or tarnish the Complainant's trademark. Indeed, the Respondent is taking advantage of the association with the Complainant's well-known trademark to attract and divert users looking for the Complainant's NESPRESSO products to websites unrelated to the Complainant, which either promote third-party products or potentially harming users. Finally, the disputed domain name, combining the Complainant's well-known trademark NESPRESSO with the geographical indicator "usa" referring to a country where NESPRESSO products are promoted and sold, carries a high of implied affiliation, which cannot be interpreted as any legitimate interests in respect of the disputed domain name.

- The disputed domain name was registered and is being used in bad faith. The trademark NESPRESSO is irrefutably well-known, and the Respondent could not have been unaware of its existence when it registered the confusingly similar disputed domain name. The misappropriation of a well-known trademark as domain name by itself constitutes bad faith registration for the purposes of the Policy. In addition to the above, given the distinctiveness and reputation of the Complainant's trademark, the Respondent clearly acted in opportunistic bad faith, by registering the disputed domain name with full knowledge of the Complainant's trademark for the purpose of taking commercial advantage of the Complainant's trademark. By using the disputed domain name to redirect user to third parties' suspicious websites, the Respondent is clearly trying to attract and divert users looking for the Complainant's NESPRESSO products to other businesses, in all likelihood for some commercial gain. The Respondent is also intentionally attempting to attract, likely for commercial gain, internet users to the websites to which the disputed domain name resolves, by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the websites and the related contents. Finally, the Respondent's use of the disputed domain name is also apt to disrupt the Complainant's business.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (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.

A. Identical or Confusingly Similar

The Panel has no doubt that "NESPRESSO" is a term directly connected with the Complainant's trademarks.

Annexes 3.1 to 3.6 to the Complaint show trademark registrations for NESPRESSO that date as early as 1985. Exhibit 4 contains a worldwide portfolio of additional registrations consisting of or including the distinctive sign NESPRESSO.

The trademark NESPRESSO is wholly encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark NESPRESSO merely by the by the inclusion of a hyphen ("-") and of the suffix "usa", as well as of the gTLD extension ".com".

Previous UDRP decisions have found that the mere addition of symbols (such a hyphen) or geographical terms (such as the acronym “usa”) to a trademark in a domain name does not avoid a finding of confusing similarity (see, e.g., *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#); and *Allianz SE v. IP Legal, Allianz Bank Limited*, WIPO Case No. [D2017-0287](#)).

It is also already well established that the addition of a gTLD extension such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondents’ default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the domain name in connection with a *bona fide* offering of goods or services. Indeed, the disputed domain name is currently being used to forward Internet users to third parties’ commercial websites. Also, the Complainant brought evidence that the disputed domain name was recently used in connection of alleged promotional campaigns targeting the Complainant’s customers, making references to the Complainant’s coffee makers, without being authorized by the Complainant.

Actually, the Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name. The Respondent has not indicated any reason to justify why it has chosen the specific term “nespresso-usa” to compose the disputed domain name.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged

in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in September 2022) the trademark NESPRESSO was already well-known worldwide and directly connected to the Complainant's coffee services and products.

Also, the disputed domain name was recently used in connection with an alleged promotional campaign directly targeting NESPRESSO consumers.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's famous trademark, as well as that the adoption of the expression "nespresso-usa", containing the Complainant's trademark, together with the gTLD extension ".com" could be a mere coincidence.

In this Panel's opinion, the addition of the term "-usa", (which usually corresponds to the acronym of the United States of America), even enhances the risk of confusion in the present case, suggesting that the disputed domain names refer to the official NESPRESSO website in the United States of America.

Furthermore, by redirecting the disputed domain name to third parties' commercial websites, the Respondent potentially obtains revenue from this practice and deprives the Complainant from selling its products to prospective clients who could be looking for the Complainant.

Finally, the passive and non-collaborative posture of the Respondent, not answering the cease-and-desist letter sent by the Complainant, nor the current Complaint, and not at least providing justifications for the use of a well-known, third party trademark, certainly cannot be used in benefit of the Respondent given the circumstances of the present case.

Such circumstances, associated with the lack of any plausible interpretation for the adoption of the term "nespresso-usa" by the Respondent, are enough in this Panel's view to characterize bad faith registration and use in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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 <nespresso-usa.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: November 24, 2022