

## **ADMINISTRATIVE PANEL DECISION**

Federación Nacional de Cafeteros de Colombia v. Vince Harasymiak,  
Domain Capital  
Case No. D2022-4022

### **1. The Parties**

The Complainant is Federación Nacional de Cafeteros de Colombia, Colombia, represented by Cavalier Abogados, Colombia.

The Respondent is Vince Harasymiak, Domain Capital, United States of America, represented by ESQwire.com PC, United States of America.

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

The disputed domain name <colombiancoffee.com> (the “Disputed Domain Name”) 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 October 26, 2022. On October 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 31, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 31, 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 amended Complaint on November 4, 2022.

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 November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. The Respondent requested an additional four calendar days for the submission of its Response pursuant to paragraph 5(b) of the Rules and an

additional eleven days pursuant to paragraph 5(e) of the Rules. The Center accepted the Respondent's request and the due date for Response was extended until December 12, 2022. The Response was filed with the Center December 12, 2022.

The Center appointed Nick J. Gardner, Mauricio Jalife Daher, and Alan L. Limbury as panelists in this matter on January 4, 2023. The Panel finds that it was properly constituted. Each member of 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 was founded in 1927. It is not disputed that it is "a non-profit organization that has [for] decades representing the interests of Colombian coffee growers in the country and worldwide in its capacity as administrator of the National Coffee Fund, working for the well-being of Colombian coffee growers through an effective union, democratic and representative organization and promoting consumption of Colombian coffee". The Respondent does not challenge this description and accepts that the Complainant's aims are meritorious.

The Complainant says it owns several trademarks for the term CAFÉ DE COLOMBIA (which translates into "Colombian Coffee" in English). The only trademark it has provided details of is Colombian registration no 204269 registered on October 31, 1997. The trademark is a device or figurative mark containing text, in the form as follows:



The Panel will refer to this trademark as the "CAFÉ DE COLOMBIA mark".

The Complainant uses CAFÉ DE COLOMBIA mark in support of its activity promoting Colombian coffee. It describes this activity as follows; "The 100% Café de Colombia Program is an alliance between coffee brands from all over the world and Colombian coffee producers. This Program is unique in the world because of its dimension and communication capacity: its members agree to comply with ethical codes of conduct and respect the origin of Colombian Coffee. Fulfilling these conditions, they use the "Café de Colombia" Logo as a badge and symbol of a community of interests and values: hard work, quality, and effort, willingness to do things well and bring to the market a superior quality product.

The 100% Café de Colombia Program is designed so that Colombian coffee brands, belonging to industrialists and roasters around the world, are able to join their efforts with Colombian producers and take to their mutual consumers, with packaging and knowledge of local customs, an authentic and relevant product backed by the triangular logo of the coffee grower that symbolizes our coffee".

The term "Café de Colombia" is also protected in Colombia as a Denomination of Origin ("DO"). According to the Complainant's website, the Complainant manages the Café de Colombia DO, which allows it to grant the authorization of its use to those interested in certifying their product.

The Disputed Domain Name was first registered on November 18, 1999. The Respondent acquired it on September 22, 2014 in a transaction with a third party. The Respondent is in business as a reseller of domain names.

The Disputed Domain Name has not been used except for (1) being linked to a webpage indicating that it was for sale; and (2) at times in the past resolving to a webpage which contain links relating to coffee, none of which directly refer to the Complainant's mark.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant has submitted a detailed Complaint citing a large number of previous UDRP decisions. The Panel does not think it necessary to repeat everything the Complainant has said here. Where relevant to the Panel's reasoning previous UDRP cases are discussed below. In summary, the main points the Complainant makes are as follows.

The Complainant says it is widely known in the world.

The Complaint provides considerable detail about Colombian coffee and its merits and how it is produced and by whom. There is no dispute about these matters so the Panel does not propose to consider them in any detail.

The Complainant submits that the Disputed Domain Name is confusingly similar to the CAFÉ DE COLOMBIA mark because the main and dominant part of the Disputed Domain Name is the term "colombiancoffee", which is the English translation of "café de colombia", which "would make it confusingly similar to the CAFÉ DE COLOMBIA mark, in terms of appearance, sound, and impact".

The Complainant also says that it has operated a website linked to the domain name <cafedecolombia.com> since 1996, which comprises the Spanish translation of "colombiancoffee".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. It states that the Respondent has not carried out any preparatory acts prior to the present complaint to properly use the Disputed Domain Name, or to offer goods or services through a website using the Disputed Domain Name. It says that the Respondent is simply trying to profit from a potential premium sale of the Disputed Domain Name, which contains the Complainant's trademark.

The Complainant contends that the Respondent acquired the Disputed Domain Name primarily for the purpose of selling it, and has offered it for sale for approximately USD 15,000 which it says is an "excessively disproportionate amount". It says that there was "no justification for the Respondent to register "Colombian Coffee", the English translation of the Complainant's trademark and controlled DO as a domain name, particularly considering that the website has not been used by the Respondent for any purpose other than selling it for an unjustified amount of money".

The Complainant requests the transfer of the Disputed Domain Name.

### **B. Respondent**

The Respondent has submitted a detailed Response citing a large number of previous UDRP decisions. Its evidence includes a signed statement from the Respondent. The Panel does not think it necessary to repeat everything the Respondent has said here. Where relevant to the Panel's reasoning previous UDRP cases are discussed below. In summary, the main points the Respondent makes are as follows.

It accepts the Complainant owns the CAFÉ DE COLOMBIA mark. It says however that the Complainant does not use this mark as a trademark but as a geographic indicator and DO and that this means it does not have the necessary standing to bring a complaint. It says that DO-related trademarks are not appropriate for the UDRP and do not serve as unique brand identifiers.

It then says that in any event even if the Complainant does hold relevant trademark rights the words “colombian coffee” are not confusingly similar to the CAFÉ DE COLOMBIA mark given that the words in the mark are in Spanish, are in any event entirely non-distinctive and are “indisputably a descriptive combination of words”.

The Respondent says it acquired the Disputed Domain Name as part of its business of acquiring domain names which comprise generic dictionary terms. It says it had no knowledge of the Complainant until it received the present Complaint. It says its business of offering for sale domain names which comprise generic terms establishes a legitimate interest and that its acquisition of the Disputed Domain Name was not in bad faith.

The Respondent admits it has offered the Disputed Domain Name for sale but says it is entitled to do so. It says it has never targeted the Complainant in any way. It says that in the past the Disputed Domain Name has resolved to a parking page containing links which all relate to the descriptive nature of the Disputed Domain Name and concern coffee.

Finally, the Respondent says that the Complainant has chosen to present this claim 23 years after the Disputed Domain Name was first registered and in use, and eight years after all rights and interest were transferred to the Respondent. The Respondent says it would appear that this extremely long delay in taking any action is a clear indication that the Complainant did not believe its “intellectual property” was being infringed or that there was any bad faith by the various owners of the Disputed Domain Name.

## **6. Discussion and Findings**

### **Preliminary Matters**

The Panel notes this is a case where the originally named Respondent (“Domains By Proxy, LLC”) appears to be a privacy or proxy service.

The Panel in this case adopts the approach of most UDRP panels, as outlined in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) at section 4.4.5, as follows:

“Panel discretion

In all cases involving a privacy or proxy service and irrespective of the disclosure of any underlying registrant, the appointed panel retains discretion to determine the respondent against which the case should proceed.

Depending on the facts and circumstances of a particular case, *e.g.*, where a timely disclosure is made, and there is no indication of a relationship beyond the provision of privacy or proxy registration services, a panel may find it appropriate to apply its discretion to record only the underlying registrant as the named respondent. On the other hand, *e.g.*, where there is no clear disclosure, or there is some indication that the privacy or proxy provider is somehow related to the underlying registrant or use of the particular domain name, a panel may find it appropriate to record both the privacy or proxy service and any nominally underlying registrant as the named respondent.”

In the present case, since the Registrar has timely disclosed the underlying registrant upon receipt of the Center’s Request for Registrar Verification, the Panel considers it appropriate to exercise its discretion to record only the underlying registrant as the named Respondent.

## Substantive Matters

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and,
- (iii) that Disputed Domain Name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant has established that it is the owner of the CAFÉ DE COLOMBIA mark. It has not provided any evidence of any other relevant trademarks so the Panel will proceed in relation to this trademark alone.

The Respondent says that the Complainant in fact uses the CAFÉ DE COLOMBIA mark as a DO and not as a trademark indicating the source of the goods in question. It says that means the present Complaint is not admissible. The term “Café de Colombia” is registered as a DO and it does appear to the Panel that the Complainant makes use of the CAFÉ DE COLOMBIA mark as part of its program supporting the DO and its use. It is not however disputed that CAFÉ DE COLOMBIA is a registered trademark in Colombia which would appear to give the Complainant standing to bring the Complaint.

The Respondent also says that assuming the CAFÉ DE COLOMBIA mark provides standing to the Complainant, the Disputed Domain Name is not confusingly similar to this trademark. The Panel does not consider this issue to be as straightforward as the Respondent suggests. The Complainant on the other hand says that “because the main and dominant part of the aforementioned domain name is “COLOMBIAN COFFEE”, which would be the English translation of CAFÉ DE COLOMBIA, which would make it confusingly similar to the CAFÉ DE COLOMBIA trademark, in terms of appearance, sound, and impact”.

It is however well established (1) that a domain name that consists or is comprised of a translation or transliteration of a trademark identical or confusingly similar to a complainant’s trademark can give rise to a finding of identity or confusing similarity (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 1.14); and (2) that confusing similarity can arise between a domain name and textual elements contained within a figurative trademark – see [WIPO Overview 3.0](#) section 1.10:

“How are trademark registrations with design elements or disclaimed text treated in assessing identity or confusing similarity?”

Panel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element. Such design elements may be taken into account in limited circumstances *e.g.*, when the domain name comprises a spelled-out form of the relevant design element.

On this basis, trademark registrations with design elements would *prima facie* satisfy the requirement that the complainant show “rights in a mark” for further assessment as to confusing similarity.

However where design elements comprise the dominant portion of the relevant mark such that they effectively overtake the textual elements in prominence, or where the trademark registration entirely disclaims the textual elements (*i.e.*, the scope of protection afforded to the mark is effectively limited to its

stylized elements), panels may find that the complainant's trademark registration is insufficient by itself to support standing under the UDRP. [See in particular section 1.2.3.]

To the extent the complainant could nevertheless establish UDRP standing on the basis of a mark with design elements, the existence of such elements (or a disclaimer) would be relevant to the panel's assessment of the second and third elements, *e.g.*, in considering possible legitimate trademark co-existence or scenarios where the textual elements correspond to a dictionary term."

In the present case it is perhaps debatable whether the design elements of the Café de Colombia figurative mark do comprise the dominant portion of the relevant mark such that they effectively overtake the textual elements in prominence, noting also that the words "Café de Colombia" are descriptive. It is not in the Panel's opinion significant that the words in the CAFÉ DE COLOMBIA figurative mark are in Spanish whilst the words in the Disputed Domain Name are in English. See *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties*, WIPO Case No. [D2005-1085](#). Even if the Panel were to accept that the design elements of the mark do not overtake the textual elements in significance, an additional difficulty for the Complainant is that in either language those words are descriptive. However it is well established that the assessment of the first element of paragraph 4(a) of the Policy functions primarily as a standing requirement which might lead to a finding that the Complainant should nevertheless prevail on this first element. Ultimately however the Panel does not need to reach a conclusion on this issue given its further reasoning as to legitimate interest and bad faith (see below).

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

The Panel agrees with the Respondent that the offering for sale of a domain name which comprises a generic or descriptive term, with no intent to target a complainant, may establish a legitimate interest. The Panel agrees with the approach taken to this issue in *X6D Limited v. Telepathy, Inc.*, WIPO Case No. [D2010-1519](#) where the panel stated as follows:

"Due to the commercial value of descriptive or generic domain names it has become a business model to register and sell such domain names to the highest potential bidder. Such a practice – including the sale of the domain name – has been found to constitute use of the domain name concerned in connection with a bona fide offering of goods or services provided that the registration of the domain name was not undertaken with intent to profit from or otherwise abuse a complainant's trademark rights."

There is no evidence presented by the Parties the Respondent has targeted the Complainant. There is evidence that establishes the Respondent's business involves holding and offering for sale a range of generic or descriptive domain names. See also [WIPO Overview 3.0](#) section 2.10. In these circumstances, the Panel concludes that the Complainant has failed to establish that the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has not been fulfilled.

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

The Panel finds that there is no evidence to suggest that the Disputed Domain Name has been registered and used in bad faith. The Respondent says (in its own words, under penalty of perjury) it had never heard of the Complainant when it acquired the Disputed Domain Name. The Panel is not in a position to doubt that statement. The Complainant has asserted that it is well known on a worldwide basis. It has not however produced sufficient evidence to support that claim. The Panel readily accepts that "Colombian coffee" is a well-known product likely to be familiar to many people around the world. That is not however the same as the Complainant and its mark being well-known. Conceivably the Complainant might be well-known in Colombia, or well-known to persons involved in the coffee business (though no evidence has been produced to support even these limited forms of recognition). However there is insufficient evidence for the Panel to conclude, in the face of the Respondent's signed statement to the contrary, that the Respondent had the Complainant in mind when the Disputed Domain Name was acquired.

The Panel entirely accepts the Complainant's case that in some circumstances offering for sale a domain name may of itself establish bad faith – the difficulty with the Complainant's case is however that is not necessarily the case where the domain name in question comprises a descriptive term and is likely to be of value for that reason. The case the Complainant relies upon, *Wal-Mart Stores, Inc. v. Kenneth E. Crews*, WIPO Case No. [D2000-0580](#) concerns a domain name clearly invoking the concerned mark and not a descriptive term. It is not correct to say that any offer to sell any domain name at a price greater than the owner's acquisition costs establishes bad faith. See in this regard [WIPO Overview 3.0](#) at section 3.1.1:

"Generally speaking, panels have found that the practice as such of registering a domain name for subsequent resale (including for a profit) would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor).

Circumstances indicating that a domain name was registered for the bad-faith purpose of selling it to a trademark owner can be highly fact-specific; the nature of the domain name (*e.g.*, whether a typo of a famous mark, a domain name wholly incorporating the relevant mark plus a geographic term or one related to the complainant's area of commercial activity, or a pure dictionary term) and the distinctiveness of trademark at issue, among other factors, are relevant to this inquiry".

In the present case the Panel considers the evidence supports a finding that the Respondent acquired the Disputed Domain Name because of its potential value as a descriptive term, and not because of any possible connection to the Complainant, who the Respondent asserts it was not aware of. The subsequent offer for sale of the Disputed Domain Name is again seemingly based on the Disputed Domain Name's possible value as a descriptive term. In the opinion of the Panel the Respondent's actions cannot amount to either registration or use in bad faith.

Given the Panel's reasoning above the Panel does not need to address the Respondent's further arguments based on the length of time that has elapsed since the Disputed Domain Name was first registered.

Accordingly, the Panel concludes the Complainant has failed to discharge its burden of proof and has failed to establish that the third condition of paragraph 4(a) of the Policy has been fulfilled.

## 8. Decision

For the foregoing reasons, the Complaint is denied.

*/Nick J. Gardner/*  
**Nick J. Gardner**  
Presiding Panelist

*/Mauricio Jalife Daher/*  
**Mauricio Jalife Daher**  
Panelist

*/Alan L. Limbury/*  
**Alan L. Limbury**  
Panelist  
Date: January 18, 2023