

## **ADMINISTRATIVE PANEL DECISION**

Costa Limited v. Withheld for Privacy ehf / Carolina Rodrigues,  
Fundacion Comercio Electronico  
Case No. DCO2022-0001

### **1. The Parties**

The Complainant is Costa Limited, United Kingdom, represented by Bird & Bird LLP, United Kingdom.

The Respondent is Withheld for Privacy ehf, Iceland / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

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

The disputed domain name <mycostalearning.co> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 6, 2022. On January 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 6, 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 January 7, 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 January 7, 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 January 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 2, 2022.

The Center appointed Evan D. Brown as the sole panelist in this matter on February 4, 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 in the coffee business. It owns the mark COSTA, for which it enjoys the benefits of registration, including under EUTM Registration No. 005183355, registered on July 31, 2010.

The disputed domain name was registered on November 22, 2021. The Respondent has used the disputed domain name to redirect to various different websites, including a page containing sponsored links, a page that offers the download of browser extension software, and a page that imitates the Complainant's "Forgot Password" procedures for employees.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (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. The Panel finds that all three of these elements have been met in this case.

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

This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and, second, whether the disputed domain name is identical or confusingly similar to that mark. This element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the COSTA mark by providing evidence of its trademark registrations.

The disputed domain name incorporates the COSTA mark in its entirety, along with the terms "my" and "learning", which do not prevent a finding of confusing similarity between the disputed domain

name and the Complainant's COSTA mark. See [WIPO Overview 3.0](#), section 1.8. The COSTA mark remains sufficiently recognizable for a showing of confusing similarity under the Policy.

The content of a website associated with a domain name is usually disregarded by panels when assessing confusing similarity under the first element. [WIPO Overview 3.0](#), section 1.15. In some instances, however, panels have taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears *prima facie* that the respondent seeks to target a trademark through the disputed domain name. Guided by these principles, the Panel takes note of the content of the website used by the Respondent to imitate the Complainant's "Forgot Password" procedures that its employees use - to confirm the confusing similarity between the disputed domain name and the Complainant's mark.

The Complainant has succeeded under this first element.

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

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant).

On this point, the Complainant asserts, among other things, that the Respondent is not known by the disputed domain name, nor does it hold any trademark or other intellectual property rights in any of the Complainant's trademarks. Additionally, the Complainant asserts that the Respondent's use of the disputed domain name to imitate the Complainant's "Forgot Password" procedures that its employees use is not a legitimate use. The Panel agrees that is not a *bona fide* offering of goods or services in these circumstances. Moreover, as regards the dynamic redirect of the disputed domain name to other websites (*i.e.*, pay-per-click sponsored links, alleged malware installation, or an inactive page), the Panel finds such use does not amount to a *bona fide* offering of goods or services, nor a noncommercial fair use.

The Panel finds that the Complainant has made the required *prima facie* showing. The Respondent has not presented evidence to overcome this *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondent's favor.

Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

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

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [the respondent's] website or location".

Because the COSTA mark is so well known, it is implausible to believe that the Respondent was not aware of it when it registered the disputed domain name. And the Respondent's conduct of using the disputed domain name to imitate the Complainant's password recovery mechanism likewise shows targeting of the Complainant. Similarly, the use of the disputed domain name to redirect to sponsored links through which the Respondent presumably received click-through revenue, or the offer to install

alleged software likely resulting in malware on an unsuspecting user's device, reflect the Respondent's intent to attract users to its website(s) through the confusingly similar disputed domain name.

In the circumstances of this case, the mere registration of a domain name that is confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith registration of the disputed domain name. *Government Employees Insurance Company v. Joel Rosenzweig, RegC*, WIPO Case No. [D2021-1221](#). Moreover, the use of a privacy service and the Respondent's silence in the face of this proceeding, further support an inference of bad faith registration. Lastly, the Panel finds that the disputed domain name appears to be the latest in a long line of bad faith registrations on part of the Respondent, construing a pattern of bad faith registration that further reinforces the overall impression of bad faith. See e.g., *Sidley Austin LLP v. Withheld for Privacy ehf / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-2366](#), and *LEGO Juris A/S v. Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. D2021-1813, among others.

For these reasons, the Panel finds that the Complainant has successfully met this third element.

## 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 <mycostalearning.co> be transferred to the Complainant.

*/Evan D. Brown/*

**Evan D. Brown**

Sole Panelist

Date: February 18, 2022