

ADMINISTRATIVE PANEL DECISION

Cappuccine Specialties, INC. v. Domain Administrator, NameFind LLC
Case No. D2023-3244

1. The Parties

The Complainant is Cappuccine Specialties, INC., United States of America, represented by Novagraaf France, France.

The Respondent is Domain Administrator, NameFind LLC, United States of America, represented by Levine Samuel, LLP, United States of America.

2. The Domain Name and Registrar

The disputed domain name <cappuccine.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 July 27, 2023. On July 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 8, 2023, 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.

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 August 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2023. The Response was filed with the Center on September 5, 2023.

The Center appointed Flip Jan Claude Petillion, Alexandre Nappey, and The Hon Neil Brown K.C. as panelists in this matter on October 3, 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, Cappuccine Specialties, INC., is a company based in California, United States of America, and is active in the beverage business.

The Complainant invokes two registered trademarks:

- CAPPUCINE, International word mark registered under No. 1655753 on March 9, 2022, in class 30.
- CAPPUCINE, United States wordmark registered under No. 3465373 on July 15, 2008, in class 30.

The Complainant also appears to operate a website linked to the domain name <cappuccine.net>.

The Disputed Domain Name was registered on May 22, 2002. According to the Complainant's evidence, the Disputed Domain Name resolved to a parking page including sponsored links. The Panel observes that the Disputed Domain Name currently resolves to a parking page without any sponsored links and mentioning that the Disputed Domain Name might be for sale.

5. Parties' Contentions

A. Complainant

The Complainant considers the Disputed Domain Name to be identical or confusingly similar to its company name, trademarks and domain name in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant, the identity of the Respondent is hidden, and the Complainant never authorized the Respondent to register the Disputed Domain Name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, the website associated to the Disputed Domain Name resulted in a parking page with links related to the Complainant's activity and it is very likely that this parking page provides revenues to the Respondent, who is trading off the reputation of the Complainant's trademarks.

B. Respondent

The Respondent does not question that on a side-by-side comparison the Disputed Domain Name is identical to the CAPPUCINE trademark of the Complainant. However, the Respondent claims that the Disputed Domain Name predates the registration of the Complainant's CAPPUCINE trademark and that there is no evidence of common law rights in the Complainant's favour, which means, according to the Respondent, that the Complainant has no actionable claim for cybersquatting against the Respondent. The Respondent further questions the Complainant's standing.

The Respondent contests the fact that its identity was hidden in the Registrar's Whois directory. The Respondent admits it did not seek an authorization to register or use the Disputed Domain Name but, in the Respondent's view, there is no legal duty compelling it to obtain such authorization. The Respondent claims rights or legitimate interests in the Disputed Domain Name as a reseller of domain names based on dictionary words.

The Respondent also asserts that the Complainant has failed to prove that the Disputed Domain Name has been registered and is being used in bad faith because of lack of evidence adduced by the Complainant. According to the Respondent, it lawfully acquired the Disputed Domain Name through its parent company's acquisition of UniRegistry in 2020. The Respondent claims that the Complainant did not provide any proof of common law rights prior to the registration of the Disputed Domain Name, nor any proof of reputation that would have called it to the Respondent's attention in 2020.

Finally, the Respondent requests a finding of Reverse Domain Name Hijacking based on the Complainant's total failure to prove the allegations made in the Complaint.

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out his case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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.

The Panel will therefore deal with each of these requirements.

A. Identical or Confusingly Similar

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has established that there is at least one trademark in which it has rights. The Complainant's CAPPUCCHINE trademark has been registered as an international trademark and in the United States of America in connection to the Complainant's beverage business.

The Disputed Domain Name is identical to the Complainant's CAPPUCCHINE trademark. It is well established that the generic Top-Level Domain ("gTLD"), here ".com", may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

The Panel observes that the Disputed Domain Name predates the registration of the Complainant's CAPPUCCHINE trademarks. However, the fact that a domain name may have been registered before a complainant has acquired trademark rights does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element (see section 1.1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

In light of the above, the Panel considers that the Complainant has established the first requirement under the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Complainant presents two arguments in that regard: the fact that, according to the Complainant, there is no way to verify whether the Respondent has legitimate interests in holding the Disputed Domain Name because “the identity of the Respondent is hidden” and the fact that, according to the Complainant, the Complainant has never authorized the registration of the Disputed Domain Name.

Regarding the first argument, the Panel observes that, contrary to what the Complainant claims, the identity of the Respondent is disclosed in the Whois record of the Disputed Domain Name.

As to the second argument, the Panel finds it irrelevant for the following reasons.

Generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be *bona fide* and is not per se illegitimate under the UDRP (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Disputed Domain Name consists of the word “cappuccine”. As confirmed by the Respondent, the Panel notes that the word “cappuccine” is a dictionary word, being *i.a.* the feminine plural of the coffee drink cappuccino.

Moreover, the Panel observes that the Disputed Domain Name predates the registration of the Complainant’s trademarks. In these circumstances, the Panel would expect the Complainant to come forward with specific evidence showing unregistered or common law trademark rights.

To establish unregistered or common law trademark rights for purposes of the UDRP, a complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint. Conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on a complainant to present evidence of acquired distinctiveness/secondary meaning (see section 1.3 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant claims it is specialized in the field of coffee drinks since 1991 but merely provides the following:

- A recent screen capture of the Complainant’s website linked to the domain name <cappuccine.net>; and
- Whois records of the domain name <cappuccine.net> registered in 2000.

The Panel finds this is obviously insufficient for the Complainant to show any unregistered or common law trademark rights.

The Respondent states it acquired the Disputed Domain Name in 2020 as part of a portfolio which used to belong to a third party. The Panel is not convinced by the Respondent’s arguments suggesting that such acquisition should not be considered as a new registration of the Disputed Domain Name. However, given the nature of the Disputed Domain Name and the lack of evidence regarding the reputation of the Complainant’s (registered or unregistered) trademarks, the Panel still finds that the Complainant did not make a *prima facie* showing that the Respondent lacked rights or legitimate interests in the Disputed Domain Name.

In view of the above, the Panel finds that the Complainant has not established the second requirement under the Policy.

C. Registered and Used in Bad Faith

Given the Panel's findings regarding the second requirement, it is not necessary to address the third one. In the Panel's view, the nature of the Disputed Domain Name and the lack of evidence regarding the reputation of the Complainant's (registered or unregistered) trademarks do not allow to conclude that the Disputed Domain Name was registered in bad faith.

For the sake of completeness, the Panel adds the following regarding the alleged bad faith use of the Disputed Domain Name.

According to the Complainant's undated evidence, the Disputed Domain Name appeared to resolve to a parking page with 3 sponsored links, including one reading "Coffee Shops". For the reasons set out above, the Panel finds that the Complainant does not show that this link capitalizes on any reputation or goodwill of its marks or otherwise mislead Internet users. Even if the Panel would consider such parking page as detrimental to the Complainant, this is only due to the generic acceptance of the word "cappuccine".

The Panel observes that the Disputed Domain Name currently resolves to a parking page without any sponsored links.

In view of the above, the Panel finds that the Complainant has not established that the Disputed Domain Name has been registered and is used in bad faith.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at RDNH or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding".

For this purpose, paragraph 1 of the Rules defines "Reverse Domain Name Hijacking" to be "using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name".

Reasons articulated by panels for finding RDNH as stated in the WIPO Overview include: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant's lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the WhoIs database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which *prima facie* justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant's failure to disclose that a case is a UDRP refiling, (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence (see section 4.16, [WIPO Overview 3.0](#)).

The mere lack of success of a complaint is not in itself sufficient for a finding of RDNH. In the present case, however, the Panel finds the following circumstances to be particularly relevant.

The Complainant is professionally represented in this matter and, in the opinion of the Panel, knew or ought to have known that it could not succeed as to the second and third elements of the Policy for the reasons set out above, In particular:

- the Complainant knew that the Disputed Domain Name predated its trademarks, and still provided almost no evidence about any alleged unregistered trademark rights;
- the Complaint ignored to address the obvious dictionary meaning of the word “cappuccine” and the impact on the Respondent’s rights or legitimate interests in respect of the Disputed Domain Name.

In these circumstances, the Panel finds that the Complaint has been brought in bad faith. Accordingly, the Panel finds that the Complainant has abused the administrative proceeding and engaged in reverse domain name hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Presiding Panelist

/Alexandre Nappey/

Alexandre Nappey

Panelist

/The Hon Neil Brown K.C./

The Hon Neil Brown K.C.

Panelist

Date: October 17, 2023