

ADMINISTRATIVE PANEL DECISION

Société des Produits Nestlé S.A. v. Masoud Mohammadi Sichan
Case No. DIR2023-0018

1. The Parties

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

The Respondent is Masoud Mohammadi Sichan, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name <nespressocompany.ir> is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 21, 2023. On December 22, 2023, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On December 26, 2023, IRNIC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. Hard copies of the Complaint were received by the Center on January 3, 2024.

The Center verified that the Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 9, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was January 29, 2024. On January 9 and 19, 2024, the Center received two emails from the Respondent, however, the Respondent did not submit any formal response. Accordingly, the Center notified the commencement of panel appointment process on January 30, 2024.

The Center appointed Mihaela Maravela as the sole panelist in this matter on February 1, 2024. 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

According to information in the Complaint, the Complainant is part of the Nestlé Group, founded in 1866 by Henri Nestlé. The Nestlé Group sells products and services all over the world in various industries, primarily in the food industry, including baby foods, breakfast cereals, chocolate & confectionery, coffee & beverages, bottled water, dairy products, ice cream, prepared foods, food services as well as pet food. The Complainant's group markets its products worldwide in over 190 countries, has about 275,000 employees worldwide, and it is present in over 80 countries with more than 400 production centers worldwide. The Complainant is present in Iran since 1973.

The Complainant is the holder of a number of trademarks for NESPRESSO, including the International trademark No. 777873 for NESPRESSO (word) registered on March 14, 2002 for classes of products and services 7, 9, 11, 21, 30, and 38, or the International trademark No. 499589 for NESPRESSO (word) registered on December 10, 1985 for class 30, or the International trademark No. 995035 for NESPRESSO (transliterated) registered on December 31, 2008 for classes of products and services 11, 21, 30, and 43 (with Iran (Islamic Republic of) as one of the designated countries under the Madrid Protocol).

The Complainant has registered numerous domain names for NESPRESSO, including <nespresso.com>, registered on February 1, 1999, that it uses as its primary web portal for global promotion dedicated to the NESPRESSO brand, and <nespresso.co.ir>.

The disputed domain name was registered on June 18, 2023, and according to evidence with the Complaint, it was used to resolve to a website displaying the NESPRESSO and DOLCE GUSTO trademarks of the Complainant, NESPRESSO product visuals, and offering purported NESPRESSO and DOLCE GUSTO coffee machines for sale, without displaying any disclaimer of non-affiliation with the Complainant. After the Complainant sent a cease-and-desist letter and by the date of the Complaint, the contents published on the website at the disputed domain name have been slightly amended by the Respondent as the NESPRESSO figurative trademark which was previously prominently featured on the top of the home page has been removed. The Respondent continued identifying itself as "Nespresso Company" and was still publishing the Complainant's NESPRESSO and DOLCE GUSTO figurative marks at the bottom of the home page and in other sections of the website. The Respondent has added the following disclaimer at the bottom of the home page: "The Nespresso company site has no connection with Nespresso and its subsidiaries and other related companies". The disputed domain name does not resolve to an active website at the date of the decision.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to the trademark NESPRESSO in which it has rights, as it incorporates the whole of the Complainant's registered NESPRESSO trademark. The fact that the disputed domain name differs from the Complainant's trademark by the addition of the non-distinctive element "company" does not affect the confusing similarity.

As regards the second element, the Complainant argues that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized to use the Complainant's trademarks. The Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the disputed domain name. The Complainant is not in possession of, nor aware of the existence of any evidence demonstrating that the Respondent might be commonly known by the disputed domain name as an individual, business, or other organization. Furthermore, the Respondent has not been found to hold any trademark registration corresponding to NESPRESSO. There is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. The use of the disputed domain name does not satisfy the *Okidata* principles (see *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)), as the Respondent has failed to accurately

disclose its relationship with the Complainant and has, instead, falsely suggested that its website was operated by the Complainant, one of its affiliated companies or authorized resellers, by identifying itself as “Nespresso Company”, also in the generic disclaimer displayed at the bottom of the website after receipt of the Complainant’s cease and desist letter, and reproducing the Complainant’s trademarks and product visuals. Such use does not constitute either a bona fide offering of goods or services or a legitimate noncommercial or fair use. Moreover, the very composition of the disputed domain name suggests that the Respondent’s primary intent was to impersonate the Complainant or one of its affiliated companies to mislead and attract Internet users, for its own commercial gain.

With respect to the third element, the Complainant argues that its trademark NESPRESSO is irrefutably well-known, and the Respondent could not have been unaware of its existence when he registered the confusingly similar disputed domain name. The actual knowledge of the NESPRESSO trademark by the Respondent is clearly demonstrated by the fact that the Respondent has pointed the disputed domain name to a website prominently featuring the Complainant’s trademark NESPRESSO and offering purported NESPRESSO products for sale.

As regards the use, the disputed domain name has been pointed to a website publishing the Complainant’s trademarks and product visuals and offering products bearing the Complainant’s trademarks for sale. Moreover, the Respondent has identified itself as “Nespresso Company”, thus reinforcing the impression that the website at the disputed domain name was, and is, operated by the Complainant, one of its affiliated companies or authorized resellers in Iran. Such a conduct demonstrates that the only purpose of the Respondent was and is to use the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s trademarks as to the source, affiliation, sponsorship or endorsement of the website. After receipt of the Complainant’s cease and desist letter, the Respondent published a disclaimer at the bottom of its website, which is however not clear nor accurate as it only generically indicates: “The Nespresso company site has no connection with Nespresso and its subsidiaries and other related companies”, without providing any precise information about the trademark holder and the Respondent’s actual name and identity. Notably, notwithstanding having been put on notice of the infringement of the Complainant’s rights, the Respondent keeps on identifying itself as “Nespresso Company”, thus clearly impersonating the Complainant or one of its affiliated entities.

B. Respondent

The Respondent did not formally reply to the Complainant’s contentions. In its communication of January 9, 2024, the Respondent indicated that “Hello, We had no intention of misusing this name and have been engaged in marketing and selling coffee related products. We have also mentioned in the footer of our website that we have no connection with the Nespresso company and its branches.” In another communication of January 19, 2024, the Respondent indicated that “Hello. We have changed the domain and site name to prove our good faith.”

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 or is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name.

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))¹, section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. While the addition of other terms here, “company”, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

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. Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests in the disputed domain name.

As established by previous UDRP panels, it is sufficient for the complainant to make a prima facie case demonstrating 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](#)). In the present case, the Complainant has proved it holds rights over the trademark NESPRESSO, and claims that the Respondent has no legitimate reason to register or acquire the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain name. Rather, according to un rebutted evidence with the Complaint, the website at the disputed domain name allegedly has offered for sale the Complainant’s branded products, displaying the Complainant’s trademark NESPRESSO as well as pictures of the Complainant’s products, with no disclaimer as to the relationship or lack thereof with the Complainant. After a cease-and-desist letter having been sent by the Complainant, the website at the disputed domain name displayed a small disclaimer at the bottom of the home page indicating that “The Nespresso company site has no connection with Nespresso and its subsidiaries and other related companies”. Such a statement does not specify the owner of the disputed domain name and gives no information whatsoever as to the identity of the operator of the website or seller of the products, which in the Panel’s view cannot qualify as an accurate disclaimer. Such use does not in the circumstances of this case give rise to any rights or legitimate interests on the Respondent’s part.

There is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

The Panel considers that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that prima facie case. The Respondent’s conclusory assertions, replicated above, regarding “no intention of misusing this name” and having had “changed the domain and site name to prove our good faith” fail to provide any evidence of rights or legitimate interests and, as assessed by the Panel above and below, the retroactive actions by the Respondent still fail to adequately redress the trademark infringement inherent to the disputed domain name composition and use.

¹ Given the similarities between the Policy and the Uniform Domain Name Dispute Resolution Policy (UDRP), the Panel deems the [WIPO Overview 3.0](#) and the UDRP decisions relevant.

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered or Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered or is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith.

According to the un rebutted assertions of the Complainant, its NESPRESSO trademark was widely used in commerce well before the registration of the disputed domain name, including in the Respondent’s country. The disputed domain name is confusingly similar with the Complainant’s trademark and the website at the disputed domain name displayed the Complainant’s trademark and product images. The Respondent does not deny in its informal communication its knowledge of the Complainant and its trademarks. Under these circumstances, the Panel considers that the Respondent was aware of the Complainant’s trademark at the registration date of the disputed domain name and it targeted it.

Registration in bad faith is sufficient under the Policy for the third element to be established. Nevertheless, the Panel will briefly analyze the bad faith use for completeness. The disputed domain name resolved to a website that purported to sell the Complainant branded goods and displaying the Complainant’s trademark NESPRESSO as well as pictures of the Complainant’s products. The Complainant denies extending an authorization for such use. Given the circumstances in the case, the Panel considers that the Respondent must have had knowledge of the Complainant’s rights in the NESPRESSO trademarks when it registered the disputed domain name and it has intentionally created a likelihood of confusion with the Complainant’s trademarks and website in order to attract Internet users for its own commercial gain, as envisaged by paragraph 4(b)(iv) of the Policy and/or to disrupt the business of the Complainant. The website at the disputed domain name contained a disclaimer at a certain date. The Panel is of the view that where the overall circumstances of a case point to the Respondent’s bad faith, the mere existence of a disclaimer cannot cure such bad faith. Moreover, the fact that the disclaimer was added after the Complainant has sent a cease-and-desist letter might be viewed as an admission by the Respondent that visitors to its websites may be confused about their origin and affiliation.

Further, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant’s contentions or provide any evidence of actual or contemplated good-faith use in its informal communications to the Center. In the Panel’s view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name.

Although at the time of the decision, the disputed domain name is inactive, considering the circumstances of this case, the Panel finds that such non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)).

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <nespressocompany.ir> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: February 12, 2024