

ADMINISTRATIVE PANEL DECISION

Starbucks Corporation v. Nolan Hicks
Case No. D2024-2602

1. The Parties

The Complainant is Starbucks Corporation, United States of America (“United States” or “U.S.”), represented by Focal PLLC, United States.

The Respondent is Nolan Hicks, United States.

2. The Domain Name and Registrar

The disputed domain name <starbucksstudios.com> 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 June 26, 2024. On June 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 27, 2024, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 2, 2024, 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 July 4, 2024.

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 July 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 5, 2024.

The Center appointed Gregory N. Albright as the sole panelist in this matter on September 6, 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

The Complainant Starbucks Corporation, along with its predecessor-in-interest, has used its STARBUCKS mark since the opening of its first store in 1971. In the 50 years of its existence, STARBUCKS has developed into a brand that is known worldwide. The Complainant currently has approximately 38,951 stores in 86 markets around the world.

The Complainant owns trademark registrations for its STARBUCKS mark in numerous countries around the world, including the United States, Australia, Canada, the European Union, Israel, New Zealand, and Singapore. These trademark registrations including the following, issued by the United States Patent & Trademark Office:

U.S. Reg. No. 1,372,630, issued November 26, 1985, in International Class 021;

U.S. Reg. No. 1,452,359, issued August 11, 1987, in International Class 030; and

U.S. Reg. No. 1,444,549, issued June 23, 1987, in International Classes 035 and 043.

The disputed domain name was registered on July 23, 2015. According to the Complaint, the disputed domain name currently resolves to a parking page with an indication that it may be available for sale.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant asserts that it indisputably owns the rights to the famous STARBUCKS mark, including its U.S. registrations for the mark. The Complainant also contends that the disputed domain name is confusingly similar to the Complainant's STARBUCKS mark because it incorporates the STARBUCKS mark in its entirety. The Complainant cites numerous previous UDRP panel decisions holding that the addition of generic or descriptive terms like "studios," does not prevent a finding of confusing similarity. The Complainant also cites WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant also asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. First, the Respondent was undoubtedly aware of the Complainant's STARBUCKS mark when the disputed domain name was registered on July 24, 2015, because the Complainant has consistently used the mark since it opened its first store in 1971 and now has thousands of stores worldwide. Second, there is no evidence that the Respondent is commonly known by the disputed domain name. Third, the Complainant has never licensed or otherwise authorized the Respondent to use the STARBUCKS mark in any domain name.

Fourth, the Respondent is using the disputed domain name in connection with the parking page that also references the STARBUCKS mark. The Complainant asserts that a parking page does not confer rights or legitimate interests in a domain name, especially when the Respondent is using the parking page for commercial gain. The Complaint cites *Rich Products Corporation v. Cynthia*, WIPO Case No. [D2007-0871](#) for the proposition that the use of a domain name that merely offers links to other websites is not a bona fide offering of goods and services.

The Complainant also asserts that the Respondent registered and used the disputed domain name in bad faith. First, the Complainant's use and registration of its STARBUCKS mark long predated the Respondent's registration of the disputed domain name. Second, where "a domain name is so obviously connected with a Complainant, its very use by a registrant with no connection to the Complainant suggests 'opportunistic bad faith.'" *Tata Sons Ltd. v. TATA Telecom Inc./Tata-telecom.com, et al.*, WIPO Case No. [D2009-0671](#). Further, even if the Respondent derives "no immediate commercial benefit, it is still taking unfair advantage of the reputation of the Complainant's mark to divert Internet users to [his] website through confusion." *Wal-Mart Stores, Inc. v. WalMart Careers, Inc.*, WIPO Case No. [D2012-0285](#).

B. Respondent

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

6. Discussion and Findings

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 3.0](#), section 1.7.

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 entirety of the mark is reproduced within the disputed domain name. This is ordinarily enough to make a disputed domain name confusingly similar to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.7 ("While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."). Further, "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element." [WIPO Overview 3.0](#), section 1.8.

While the addition of other terms (here "studios") may bear on assessment of the second and third elements, the Panel finds the addition of "studios" to the Complainant's STARBUCKS mark in the disputed domain name 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.

The first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#) section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. In this regard, the Panel notes that the term "studios" can refer to motion picture or music recording services. But the Respondent has neither claimed nor produced evidence that the Respondent has ever used or intended to use the disputed domain name in connection with the dictionary meaning of "studios." Nor has the Respondent accounted for how the inclusion of the STARBUCKS mark would factor into any such plans. The Respondent also has not argued let alone offered any evidence that the Respondent intended to reference "Starbuck" (a fictional character in the famous novel *Moby Dick*, by Herman Melville) instead of the Complainant's STARBUCKS mark, which is well known in connection with coffee and related goods and services. Nor has the Respondent come forward to claim that "Starbuck" is the Respondent's surname; that the Respondent is otherwise known as "Starbuck"; or that Respondent has any established trademark rights in the disputed domain name. And there is no evidence of the Respondent's detrimental reliance during the period between registration of the disputed domain name and the filing of the Complaint in this case.

The second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

As the Complainant asserts, it may be inferred that the Respondent registered the disputed domain name with knowledge of the Complainant's STARBUCKS mark, because the Complainant's use and trademark registrations long predate the Respondent's registration of the disputed domain name in 2015. The Respondent had a duty to avoid a trademark-abusive domain name registration. There is sufficient evidence that the Respondent registered the disputed domain name in bad faith, particularly in view of the Respondent's failure to come forward to offer evidence of any bona fide offering of goods or services in connection the disputed domain name.

The third element of the Policy requires a complainant to show both bad faith registration and bad faith use. The Complainant asserts that the Respondent is using the disputed domain name in bad faith because the disputed domain name resolves to a parking page that references the Complainant's mark. But the only reference to the Complainant's mark on the parking page at issue is the disputed domain name itself, which incorporates the Complainant's mark in its entirety. No other use of the Complainant's STARBUCKS mark is apparent.

The website to which the disputed domain name resolves does offer the domain name for sale, however. The printout from the website annexed to the Complaint shows the disputed domain name, and states: "This domain is registered, but may still be available." Below that is a link to "Get this domain." Clicking that link leads to a broker who offers to negotiate with the owner for a commission and a broker's fee.

Together with other circumstances indicative of bad faith, an offer to sell the disputed domain name at a profit can constitute evidence of bad faith use. See [WIPO Overview 3.0](#), section 3.1.1; see also *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, WIPO Case No. [D1999-0001](#) (offer to sell disputed domain name for valuable consideration in excess of any out-of-pocket costs directly related to the domain name constituted use of the domain name in bad faith as defined in the Policy). The Complainant has not offered evidence that it attempted to buy the disputed domain name, and the Respondent responded by demanding a price for the sale of the disputed domain name that exceeds the Respondent's costs of registering and holding the disputed domain name. This leaves a somewhat speculative inference that the Respondent, having registered the disputed domain name in bad faith in the first instance, has also held the disputed domain name for nine years in the hope of exacting a substantial profit upon selling it.

There is no other evidence in the record of any other ways the Respondent has used the disputed domain name.

To the extent the Respondent has held the disputed domain name without using it (other than to offer it for sale), the Panel finds some guidance from the passive holding doctrine. See [WIPO Overview 3.0](#), section 3.3. “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.” *Id.*

The first factor strongly favors the Complainant: the STARBUCKS mark is very well known, especially in the United States where the Respondent is located. The second factor also favors the Complainant because the Respondent did not respond to the Complaint. The third factor does not appear to be relevant in this case. The fourth factor favors the Complainant on balance. It does not seem completely implausible to imagine that a person might be inspired by the Starbuck character in *Moby Dick* to adopt a descriptive name and related domain name for use in connection with creating and distributing motion pictures, *i.e.*, Starbuck’s Studios. But there is no evidence, especially in view of the Respondent’s default, that this is what motivated the Respondent.

In sum, the Panel finds sufficient evidence of the Respondent’s bad faith use of the disputed domain name.

The third element of the Policy is 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 <starbucksstudios.com> be transferred to the Complainant.

/Gregory N. Albright/

Gregory N. Albright

Sole Panelist

Date: September 20, 2024