

## **ADMINISTRATIVE PANEL DECISION**

**Costa Limited v. Whois Privacy Protection Service, Inc. / George Washere**  
**Case No. D2022-0051**

### **1. The Parties**

The Complainant is Costa Limited, United Kingdom (“UK”), represented by Bird & Bird LLP, UK.

The Respondent is Whois Privacy Protection Service, Inc., United States of America / George Washere, Panama.

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

The Disputed Domain Name <mycostaelearning.com> is registered with eNom, 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 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 4, 2022.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on February 16, 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**

It results from the Complainant's undisputed allegations that the Complainant has been founded in 1971 and operates over 2,200 coffee shops and therefore the largest coffee house chain in the UK. It also offers Costa coffee products through its "proud to serve" initiative, enabling 150 partners to serve Costa coffee at over 3,500 locations in the UK. The Complainant also provides its products via "Costa Express" machines, with over 8000 machines installed throughout the UK. Finally, the Complainant has over 1,400 further stores across 32 countries beyond the UK. In 2019, the Complainant's net sales revenue amounted to USD 1,776 million.

It further results from the Complainant's undisputed evidence that the Complainant operates a website under "www.mycostalearning.com", providing an online learning portal for its employees.

According to the Registrar's verification response, the Disputed Domain Name was registered on May 31, 2021. The language of the registration agreement at the time of registration was English.

The Complaint is based amongst others on registered European Union Trade Mark ("EUTM") number 005183355 for the word mark COSTA, registered on July 31, 2010 for goods and services in classes 30 and 43.

It results from the undisputed evidence provided by the Complainant that the Disputed Domain Name currently resolves to a parking website showing pay-per-click ("PPC") links for e-learning services for employees. It additionally results from the undisputed evidence that the Disputed Domain Name is publicly offered for sale at a price of USD 299.

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

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

Firstly, the Complainant points out that the Disputed Domain Name is confusingly similar to the registered mark in which the Complainant has rights. The Disputed Domain Name comprises (i) the word "my"; (ii) the word "costa"; and (iii) the word "learning" with an additional "e" between the words "costa" and "learning". When used as a prefix, "e" is often used to refer to online activities (e.g., e-commerce, email) and is therefore purely descriptive. The addition of the words "my" and "elearning" does nothing to distinguish the Disputed Domain Name from the Complainant's trademarks, since the trademarks are associated in the public mind with a large coffee house chain and one that would be expected to host online training for employees.

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name. To the best of the Complainant's knowledge, 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. Given that the Disputed Domain Name incorporates the Complainant's trademarks in full and without any other distinctive element, the Disputed Domain Name is such that it could never be used for a legitimate purpose by any party other than the Complainant.

Thirdly, the Respondent's registration and use of the Disputed Domain Name constitutes – in the Complainant's view – bad faith under several aspects: (i) the Respondent acquired the Disputed Domain Name for the purpose of unfairly disrupting the business of the Complainant by deceiving customers or staff into believing that the website at the Disputed Domain Name is one of the Complainant's official websites;

(ii) furthermore, the Complainant believes it is likely to be used to send phishing emails to its customers or staff; (iii) finally, the Complainant brings forward that the Disputed Domain Name can only have been chosen to intentionally attract, for some kind of commercial gain, users to the website by creating a likelihood of confusion with the Complainant's trademarks and/or website. The Respondent's use of the Disputed Domain Name would, at the very least, cause initial interest confusion because a user of the website will, based on the Disputed Domain Name alone, be visiting the website in the expectation that it is the official website of the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the Disputed Domain Name should be transferred or cancelled:

(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 is satisfied that the registrant of record for the Disputed Domain Name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first of all establish rights in a trademark or service mark and secondly establish that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Complainant is the owner of several trademark registrations consisting of the verbal element COSTA, in particular in the European Union as aforementioned above in section 4.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark for purposes of the first element, where the relevant trademark is recognizable within the disputed domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). This Panel shares the same view and notes that the Disputed Domain Name contains the Complainant's registered trademark COSTA in full and without any other distinctive element, the additionally elements "my" and "elearning" not preventing a finding of confusing similarity. Consequently, this Panel is of the opinion that the trademark COSTA remains recognizable within the Disputed Domain Name.

In the light of the above, the Panel finds that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights.

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

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish 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 to the Disputed Domain Name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

First, it results from the Complainant's uncontested evidence that the Disputed Domain Name resolves to a website containing PPC links for e-learning services for employees. Such use can – in this Panel's view – not be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such links compete with or capitalize on the reputation and goodwill of the Complainant's mark and are therefore likely to mislead Internet users (*cf.* [WIPO Overview 3.0](#) at section 2.9). In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the Disputed Domain Name.

Furthermore, the Panel notes that there is no evidence in the record or Whois information showing that the Respondent might be commonly known by the Disputed Domain Name in the sense of paragraph 4(c)(ii) of the Policy. In particular, the Respondent's name as resulting from the Registrar verification response does not appear to be "COSTA".

Finally, the Panel notes that there is no evidence in the record either showing that the Respondent might be making a noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the Disputed Domain Name is for a parking page with PPC links. Such use is *per se* commercial, so that a noncommercial use is excluded from the outset.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the Disputed Domain Name has been registered and 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. One of these circumstances is that the Respondent has registered or acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the Disputed Domain Name (paragraph 4(b)(i) of the Policy).

It is the view of this Panel that the Respondent has actually registered the Disputed Domain Name primarily for the purpose of selling it either to the Complainant or to third parties, in particular to one of the Complainant's competitors, for valuable consideration in excess of the documented out-of-pocket costs directly related to the Disputed Domain Name. According to the Complainant's uncontested evidence, the Respondent has offered the Disputed Domain Name for sale to the public for a price of USD 299. This

Panel finds that this sum is clearly in excess of any out-of-pocket costs directly related to the Disputed Domain Name (see *Linatex Limited v. Yunkook Jung*, WIPO Case No. [D2019-1784](#); *Skyscanner Limited v. New Ventures Services, Corp.*, WIPO Case No. [D2020-0498](#)).

In addition, this finding of bad faith registration and use is supported by the further circumstances resulting from the case at hand, which are the following:

(i) the Disputed Domain Name being almost identical to the Complainant's existing online learning portal for employees available under the website "www.mycostaelearning.com";

(ii) the Disputed Domain Name resolving to a parking page with PPC links for similar e-learning services for employees (see section 3.5 of [WIPO Overview 3.0](#));

(iii) the Respondent hiding his identity behind a privacy shield;

(iv) the Respondent's failure to submit a response or to provide any evidence of actual or contemplated good faith use; and

(v) the implausibility of any good faith use to which the Disputed Domain Name may be put.

In the light of the above the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

## 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, <mycostaelearning.com>, be transferred to the Complainant.

*/Tobias Malte Müller/*

**Tobias Malte Müller**

Sole Panelist

Date: March 2, 2022