

ADMINISTRATIVE PANEL DECISION

Société des Produits Nestlé S.A. v. Shahram Heidari
Case No. DIR2022-0001

1. The Parties

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

The Respondent is Shahram Heidari, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name, <nespressotehran.ir> (the “Domain Name”), is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2022. On January 31, 2022, the Center transmitted by email to IRNIC a request for registrar verification in connection with the Domain Name. On February 9, 2022, IRNIC 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 .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 February 10, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was March 2, 2022. On March 3, 2022, the Center notified the Respondent’s default.

The Center appointed Tony Willoughby as the sole panelist in this matter on March 15, 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 a wholly owned subsidiary of Nestlé S.A., the Swiss company heading the Nestlé group of companies (“Nestlé”).

Nestlé was founded in 1866 and has traded under the Nestlé name ever since. In 1986 Nestlé launched its NESPRESSO brand of coffees and coffee dispensing machines.

Nestlé first started trading in Iran (Islamic Republic of) in the 1970s.

The Complainant holds the majority of Nestlé’s trade mark registrations covering the group’s trade marks. For present purposes it is only necessary to mention two of those registrations, namely: International Trade mark Registration No. 777873 registered on March 14, 2002 NESPRESSO (word) for a variety of goods and services in classes 7, 9, 11, 21, 30 and 38, and International Trade mark Registration No. 1122907 registered on June 18, 2012 N (figurative) for a variety of goods and services in classes 7, 11, 16, 21, 29, 30, 35, 37, 39, 40, 41, 42 and 43. Both these registrations have been extended to Iran (Islamic Republic of).

Nestlé’s primary web portal for its NESPRESSO brand is connected to the domain name <nespresso.com> created on February 1, 1999.

The Domain Name was registered on June 11, 2021 and is connected to a Persian language website seemingly devoted primarily to the sale of the Complainant’s NESPRESSO products.

On July 20, 2021 the Complainant’s representative sent a letter by email to the Respondent at the email address registered with the Registrar. The letter drew the Respondent’s attention to the Complainant’s trade mark rights and sought *inter alia* immediate transfer of the Domain Name to the Complainant. In the absence of any reply, the Complainant’s representative sent ‘chasers’ on August 6, 2021, September 9, 2021 and September 24, 2021, but to no avail. Similarly, letters to the company hosting the Respondent’s website dated September 27, 2021, October 4, 2021 and October 18, 2021 failed to elicit a response.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Complainant’s NESPRESSO registered trade mark; that the Respondent has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name was registered with full knowledge of the Complainant’s trade marks and is being used in bad faith.

The essence of the Complainant’s case is that the Respondent registered the Domain Name for the purpose for which he is using it, namely to attract visitors to his website for commercial gain in the mistaken belief that they are visiting an official Nestlé website or the website of an authorised representative or licensee of the Complainant.

B. Respondent

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

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered or is being used in bad faith.

Given the similarities between the Policy and the Uniform Domain Name Dispute Resolution Policy (“UDRP”), the Panel takes note of the applicable sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), where relevant.

B. Identical or Confusingly Similar

The Domain Name comprises the Complainant’s registered trade mark NESPRESSO, and the geographic term, “Tehran”, followed by the “.ir” country-code Top-Level Domain.

Section 1.7 of [WIPO Overview 3.0](#) explains the test for identity or confusing similarity under the first element of the UDRP and includes the following passage:

“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.”

The Complainant’s NESPRESSO registered trade mark is readily recognizable in its entirety in the Domain Name. The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights.

C. Rights or Legitimate Interests

The Complainant recites the circumstances set out in paragraph 4(c) of the Policy, any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, and contends that none of them is applicable.

The Complainant contends that the Respondent registered the Domain Name without any authority from the Complainant to use the Complainant’s trade marks and with a view to establishing a website appearing on its face to be an official Nestlé website. The Complainant contends that such a use cannot constitute a *bona fide* offering of goods or services for the purpose of paragraph 4(c)(i) of the Policy. Self evidently, the Respondent is not commonly known by the Domain Name, rendering paragraph 4(c)(ii) of the Policy inapplicable. Finally, the Complainant contends that the use being made of the Domain Name is a commercial use, is not fair and is not covered by paragraph 4(c)(iii) of the Policy.

The Panel accepts the Complainant’s assertion that it has not authorized the Respondent’s use of the NESPRESSO trade mark in this or any other way. However, there are circumstances where the unauthorized use of a third party’s trade mark in a domain name may give rise to the acquisition by a respondent of rights or legitimate interests in respect of that domain name. The issue frequently falls to be considered where, as here, the respondent is using the domain name to connect to a website selling the goods of the complainant.

The issue is addressed in section 2.8.1 of [WIPO Overview 3.0](#):

“Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the ‘Oki Data test’ [a test derived from the decision in *Oki Data Americas, Inc. v. Asdinc.com* WIPO Case No. [D2001-0903](#)], the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to ‘corner the market’ in domain names that reflect the trademark.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark.”

Here the Respondent’s use of the Domain Name fails the Oki Data test in two respects. First, other products such as Jacob’s biscuits having no connection with the Complainant are being offered for sale through the Respondent’s website. Secondly, there is nothing on the website accurately and prominently disclosing the Respondent’s relationship with the Complainant. Indeed, the reverse is the case. Prominent use of a variant of the Complainant’s figurative N registered trade mark, combined with (i) a wide use of images similar if not identical to images appearing on the Complainant’s “www.nespresso.com” website, (ii) a copyright notice identifying the copyright owner as “Nespresso Tehran” and (iii) the absence of anything to indicate the true operator of the website renders it overwhelmingly likely that visitors to the website will believe it to be a website of the Complainant or an authorised licensee of the Complainant.

For completeness, the Panel adds that the nature of the Domain Name is itself calculated to lead to confusion. Companies trading in more than one area commonly combine their names in domain names and business names with the names of the various areas in which they trade. Visitors to the Respondent’s website are likely to be attracted to it believing that a website connected to a domain name featuring NESPRESSO and “Tehran” without further qualification is likely to be an official Nestlé website for its Tehran-based business.

The Respondent has not sought to answer the Complainant’s contentions despite several opportunities to do so both prior to the commencement of this proceeding and in the course of this proceeding. The Panel finds on the evidence that the Respondent’s purpose was to impersonate Nestlé in one shape or form, an objective that cannot on any basis give rise to rights or legitimate interests in respect of the Domain Name in the hands of the Respondent.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

D. Registered or Used in Bad Faith

The Complainant contends that the Respondent registered and has been using the Domain Name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. Paragraph 4(b)(iv) of the Policy provides that registration of a domain name for the purpose of using it to attract Internet users to the registrant’s website for commercial gain by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the registrant’s website constitutes bad faith registration or use for the purposes of paragraph 4(a)(iii) of the Policy.

The Panel finds that the Complainant's contentions are well-founded. In the view of the Panel, the Respondent's use of the Domain Name as described in C above amounts to impersonation of the Complainant. Had there been any justification for the Respondent's selection and use of the Domain Name, one would have expected the Respondent to have responded to the Complainant's representative's letters in July, August and September 2021.

The Panel finds that the Domain Name has been registered or is being used in bad faith within the meaning of paragraphs 4(a)(iii) and 4(b)(iv) 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 Domain Name, <nespressotehran.ir>, be transferred to the Complainant.

/Tony Willoughby/

Tony Willoughby

Sole Panelist

Date: March 23, 2022