



URS | DETERMINATION
(URS Procedure 9, URS Rules 13)

URS DISPUTE NO. 72000F30

Determination DEFAULT

I. PARTIES

Complainant: Illycaffè S.p.A., IT

Complainant's authorized representative(s): Kivial S.r.l., Luca Danelon, IT

Respondent(s): WhoisGuard Protected, WhoisGuard, Inc, PA

II. THE DOMAIN NAME(S), REGISTRY OPERATOR AND REGISTRAR

Domain Name:	Registry Operator:	Registrar:
illy-coffee.bar	punto 2012 s.a.p.i. de c.v.	namecheap
illy-coffee.casa	minds machines group limited	namecheap
illy-coffee.club	.club domains, llc	namecheap
illy-coffee.fun	dotSPACE inc.	namecheap
illy-coffee.host	dothost inc.	namecheap
illy-coffee.icu	shortdot sa	namecheap
illy-coffee.monster	xyz.com llc	namecheap
illy-coffee.online	dotonline inc.	namecheap
illy-coffee.press	dotpress inc.	namecheap
illy-coffee.rest	punto 2012 s.a.p.i. de c.v.	namecheap
illy-coffee.site	dotsite inc.	namecheap
illy-coffee.space	dotSPACE inc.	namecheap
illy-coffee.store	dotstore inc.	namecheap
illy-coffee.uno	dotsite inc.	namecheap
illy-coffee.website	dotwebsite inc.	namecheap
illy-coffee.work	minds machines group limited	namecheap
illy-coffee.xyz	xyz.com llc	namecheap
illy.bar	punto 2012 s.a.p.i. de c.v.	namecheap
illy.best	besttld pty ltd	namecheap
illy.blue	afilias limited	namecheap
illy.cam	ac webconnecting holding b.v.	namecheap
illy.casa	minds machines group limited	namecheap
illy.cymru	nominet uk	namecheap
illy.fun	dotSPACE inc.	namecheap
illy.host	dothost inc.	namecheap
illy.kim	afilias limited	namecheap
illy.monster	xyz.com llc	namecheap
illy.pink	afilias limited	namecheap
illy.press	dotpress inc.	namecheap
illy.red	afilias limited	namecheap
illy.rest	punto 2012 s.a.p.i. de c.v.	namecheap
illy.wales	nominet uk	namecheap

il.ly.yoga	minds machines group limited	namecheap
il.lycoffee.bar	punto 2012 s.a.p.i. de c.v.	namecheap
il.lycoffee.best	besttld pty ltd	namecheap
il.lycoffee.cam	ac webconnecting holding b.v.	namecheap
il.lycoffee.club	.club domains, llc	namecheap
il.lycoffee.digital	binky moon, llc	namecheap
il.lycoffee.email	binky moon, llc	namecheap
il.lycoffee.fashion	minds machines group limited	namecheap
il.lycoffee.fit	minds machines group limited	namecheap
il.lycoffee.fun	dotSPACE inc.	namecheap
il.lycoffee.guru	binky moon, llc	namecheap
il.lycoffee.host	dothost inc.	namecheap
il.lycoffee.life	binky moon, llc	namecheap
il.lycoffee.live	dog beach, llc	namecheap
il.lycoffee.london	dot london domains limited	namecheap
il.lycoffee.miami	minds machines group limited	namecheap
il.lycoffee.press	dotpress inc.	namecheap
il.lycoffee.rest	punto 2012 s.a.p.i. de c.v.	namecheap
il.lycoffee.rocks	dog beach, llc	namecheap
il.lycoffee.site	dotSITE inc.	namecheap
il.lycoffee.space	dotSPACE inc.	namecheap
il.lycoffee.store	dotstore inc.	namecheap
il.lycoffee.today	binky moon, llc	namecheap
il.lycoffee.uno	dotSITE inc.	namecheap
il.lycoffee.website	dotwebsite inc.	namecheap
il.lycoffee.world	binky moon, llc	namecheap
il.lycoffee.xyz	xyz.com llc	namecheap
il.lycoffee.yoga	minds machines group limited	namecheap

III. PROCEDURAL HISTORY

Complaint submitted: 2020-07-08 16:22
Lock of the domain name(s): 2020-07-09 21:41
Notice of Complaint: 2020-07-13 21:49
Default Date: 2020-07-28 00:00
Notice of Default: 2020-07-28 16:54
Panel Appointed: 2020-07-28 16:57
Default Determination issued: 2020-07-30 15:18

IV. EXAMINER

Examiner's Name: Rodolfo Carlos Rivas Rea

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

V. RELIEF SOUGHT

The Complainant requests that the domain name be suspended for the balance of the registration period.

The Respondent has not submitted a Response.



VI. STANDARD OF REVIEW

Clear and convincing evidence.

VII. DISCUSSIONS AND FINDINGS

A. Complainant:

Illycaffè (Complainant) was founded in 1933 and produces and sells, all over the world, a unique blend of high-quality espresso coffee. The “illy” blend is distributed to hotels, restaurants, cafes, and is consumed at home and in the office. It is currently marketed in 140 countries, in all 5 continents, and is served in more than 100,000 commercial businesses.

In 2017 the Complainant, which employs more than 1.200 people, had a consolidated turnover of EUR 547 million.

The Disputed Domain Names have been registered using a “privacy” proxy service (WhoisGuard), so the Complainant is unable to refer to the real Respondent.

However, the Complainant claims all Disputed Domain Names:

- have been registered on the same days (ILLYCOFFEE/ILLY-COFFEE domains on 5 May 2020 and ILLY domains on 2 July 2020);
- have been registered through NameCheap registrar;
- are using WhoisGuard registrant details;
- use ns1.upwatch.co and ns2.upwatch.co DNS servers;
- point at the same IP address (185.66.141.141);
- have the same website content.

Complainant hereby confirms that Respondent has no legitimate right to the Disputed Domain Names. The Complainant has neither licensed the trademark to the Respondent for use.

Complainant trademark is also registered in the Trademark Clearinghouse (TMCH) since 28 November 2013; according to the interaction between the TMCH and the new gTLDs registration process, the Respondent was well aware of the Complainant’s trademark at the moment of registration of the Disputed Domain Names.

16 disputed domain names match exactly Complainant denominative trademark, while 44 disputed domain names explicitly contain the Complainant denominative trademark alongside the word “COFFEE”, a descriptive term relating to the core business of the Complainant.

Numerous panels have considered that the addition of generic or descriptive words to an otherwise distinctive or well-known trademark does not serve to distinguish the domain name from a Complainant’s trademark.

On nearly all domain names, Respondent linked a copy of the Complainant's English homepage website. This leads the visitors to believe to view the Complainant’s website.

The Complainant alleges that the Disputed Domain Names have been configured with a valid MX record, thus indicating that the Respondent has actively configured, or started configuring, email accounts as well using the Disputed Domain Names.

The Complainant strongly believes that these actions could lead to exploiting Complainant identity to counterfeit email communications and/or to perform illegal actions, such as fake order collection, Clients data grabbing, orders to suppliers and third parties exploiting illycaffè identity, so the Complainant started the URS as soon as it became aware of the registrations.

Performing a search on the IP address where the counterfeit site is hosted, it results that the same IP hosts nearly 400 domain names, exploiting other companies' websites and trademarks with the very same technique.

B. Respondent:

The Respondent did not submit a Response.

C. Procedural findings:

The Complainant requests that the Disputed Domain Names be consolidated in a single proceeding because allegedly, the Disputed Domain Names are registered by the same entity. The Examiner, in reviewing the evidence on record finds that, indeed, the Complainant has provided evidence that some of the Disputed Domain Names are subject to common control, but unfortunately for the Complainant, this is not the case for all the Disputed Domain Names.

Based on the evidence on record, the Examiner accepts the consolidation of the following Disputed Domain Names in a single Complaint (first group):

<illy-coffee.bar>	<illy-coffee.work>	<illycoffee.london>
<illy-coffee.casa>	<illy-coffee.xyz>	<illycoffee.miami>
<illy-coffee.club>	<illycoffee.bar>	<illycoffee.press>
<illy-coffee.fun>	<illycoffee.best>	<illycoffee.rest>
<illy-coffee.host>	<illycoffee.cam>	<illycoffee.rocks>
<illy-coffee.icu>	<illycoffee.club>	<illycoffee.site>
<illy-coffee.monster>	<illycoffee.digital>	<illycoffee.space>
<illy-coffee.online>	<illycoffee.email>	<illycoffee.store>
<illy-coffee.press>	<illycoffee.fashion>	<illycoffee.today>
<illy-coffee.rest>	<illycoffee.fit>	<illycoffee.uno>
<illy-coffee.site>	<illycoffee.fun>	<illycoffee.website>
<illy-coffee.space>	<illycoffee.guru>	<illycoffee.world>
<illy-coffee.store>	<illycoffee.host>	<illycoffee.xyz>
<illy-coffee.uno>	<illycoffee.life>	<illycoffee.yoga>
<illy-coffee.website>	<illycoffee.live>	

All the above-mentioned Disputed Domain Names were registered through the same registrar on either May 5 or May 6 of 2020. Additionally to this, all the above-mentioned Disputed Domain Names were registered utilizing WhoisGuard registrant details. Furthermore, and based on the evidence on record, all the above-mentioned Disputed Domain Names point at the same IP address, namely 185.66.141.141. Based on all of this, the Examiner finds that all the above-mentioned Disputed Domain Names are under the same control of the same individual and/or entity, and therefore, the Examiner accepts the consolidation in a single Complaint.



In relation to the following Disputed Domain Names (second group):

<illy.bar>	<illy.fun>	<illy.red>
<illy.best>	<illy.host>	<illy.rest>
<illy.blue>	<illy.kim>	<illy.wales>
<illy.cam>	<illy.monster>	<illy.yoga>
<illy.casa>	<illy.pink>	
<illy.cymru>	<illy.press>	

the evidence on record is not enough to justify the consolidation. Although the registrar and the privacy service used to register the above-mentioned Disputed Domain Names match with the first group, the date for registration of the above-mentioned Disputed Domain Names differs from the first group, namely 2 July 2020. Additionally to this, there is no evidence on record to show that the second group of Disputed Domain Names point to the same IP address, namely 185.66.141.141. Additionally, there is no evidence on record to show that the content of the second group of Disputed Domain Names matches the content of the first group of Disputed Domain Names. Based on this, the Examiner is unable to find sufficient evidence that would warrant the consolidation of the second group of Disputed Domain Names under this Complaint.

This finding is consistent with the indicative views set forth under Paragraph 4.11 of the WIPO Jurisprudential Overview 3.0, which although not binding to the URS procedure, can be informative and persuasive under certain circumstances.

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under the URS Procedure paragraphs 3 and 4 and URS Rules paragraph 4.

Per URS Procedure Paragraph 9(d), in the absence of a Response, the language of the Determination shall be English.

D. Findings of fact:

The Complainant is the owner of the following trademarks: International Trademark “ILLY” no. 600695 since 26.05.1993, to distinguish the goods and services of classes 9, 11, 21, 30, and 33.

International Trademark “ILLY” no. 601688 since 18.05.1993, to distinguish the goods and services of class 42.

International Trademark “ILLY” no. 735764 since 22.02.2000, to distinguish the goods and services of classes 1, 2, 3, 4, 5, 6, 7, 8, 10, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 31, 32, 34, 35, 36, 37, 38, 39, 40, 41.

E. Reasoning:

1. The domain name(s) is(are) identical or confusingly similar to a wordmark

The Complainant has proven through the evidence on record that it owns various trademark registrations for "illy" since at least 1993 for a wide gamut of products and services and which appear to be currently in use.

Having established this, the Examiner now turns to the analysis of the existence or not of confusing similarity between the above-mentioned trademarks and the Disputed Domain Names. In this regard, the Complainant alleges that the totality of the trademark is incorporated in all the Disputed Domain Names subject of this complaint. The gTLDs utilized will not be considered since it has been widely acknowledged to have little bearing in the analysis pertinent to the first requirement of the URS Procedure.

The Disputed Domain Names subject of this complaint, all include the word "coffee", in some cases following the trademark "illy", while in others, separated by a hyphen. The Examiner notes that coffee is one of the elements associated with the business of the Complainant, and as such, is not enough to dispel a finding of confusing similarity with the Complainant's trademark, if anything, the confusing similarity is enhanced since it seems to directly reference the Complainant. However, this will be examined further under the elements below.

Based on the above and the evidence on record, the Examiner finds that the requirements set forth under Paragraph 1.2.6 (i) of the URS Procedure have been satisfied.

2. Respondent has no rights or legitimate interests to the domain name(s)

The Complainant states that it has not authorized the Respondent to use the trademark "illy", and that there is no business relationship between them. Furthermore, the evidence on record shows no evidence that Respondent is commonly known by the Disputed Domain Names subject of this complaint.

Since no Response was submitted in this proceeding, the Respondent has failed to justify any rights or legitimate interests in the Disputed Domain Names subject of this complaint.

Additionally, as per the evidence on record and looking at the broader context of the case, namely, the prominent nature of the trademark in question and the clear evidence that the Respondent was directly alluding to the Complainant and its trademarks by incorporating the term "coffee" in all of the Disputed Domain Names, it is clear that that the respondent was targeting the Complainant to benefit from the perceived association that may be induced from the Disputed Domain Names subject of this complaint.

Based on the above, the Examiner finds that the Respondent lacks any rights or legitimate interests concerning the Disputed Domain Names subject of this dispute as per the requirements set forth under Paragraph 1.2.6 (ii) of the URS Procedure.

3. The domain name(s) was(were) registered and is(are) being used in bad faith

Concerning the third element, the evidence on record indicates that the Disputed Domain Names subject to this Complaint were registered around the same date, namely 5 and 6 May 2020, by the Respondent, and that they all point at the same IP address, namely 185.66.141.141. Further evidence provided, also shows that the same IP address seems to be utilized by a host of domain names that include many other trademarks, some of them prominent, and domain names under a variety of gTLDs. This evidences a pattern of conduct of the Respondent that can be aptly characterized as bad faith.

This evidence leaves no other possible conclusion than the registration of the Disputed Domain Names subject of this complaint was done for no other reason than to deceive



consumers into believing that the source behind the Disputed Domain Names was the Complainant.

This conduct of the Respondent, in this case, falls squarely under the one described in Paragraph 1.2.6.3.d of the URS Procedure, namely, "by using the domain name Registrant has intentionally attempted to attract for commercial gain, Internet users to Registrant's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of Registrant's web site or location or of a product or service on that web site or location".

Based on the above and the evidence on record, the Examiner finds that the Disputed Domain Names subject of this complaint were registered and has been used by the Respondent in bad faith, as per the requirements set forth under Paragraph 1.2.6 (ii) of the URS Procedure.

4. Abusive Complaint

The Examiner finds that the complaint is not abusive and it did not contain deliberate material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Partially demonstrated

B. Complaint and remedy

Complaint: Partially accepts

Domain Name(s):

illy-coffee.bar	Suspends for the balance of the registration period
illy-coffee.casa	Suspends for the balance of the registration period
illy-coffee.club	Suspends for the balance of the registration period
illy-coffee.fun	Suspends for the balance of the registration period
illy-coffee.host	Suspends for the balance of the registration period
illy-coffee.icu	Suspends for the balance of the registration period
illy-coffee.monster	Suspends for the balance of the registration period
illy-coffee.online	Suspends for the balance of the registration period
illy-coffee.press	Suspends for the balance of the registration period
illy-coffee.rest	Suspends for the balance of the registration period

illy-coffee.site	Suspends for the balance of the registration period
illy-coffee.space	Suspends for the balance of the registration period
illy-coffee.store	Suspends for the balance of the registration period
illy-coffee.uno	Suspends for the balance of the registration period
illy-coffee.website	Suspends for the balance of the registration period
illy-coffee.work	Suspends for the balance of the registration period
illy-coffee.xyz	Suspends for the balance of the registration period
illycoffee.bar	Suspends for the balance of the registration period
illycoffee.best	Suspends for the balance of the registration period
illycoffee.cam	Suspends for the balance of the registration period
illycoffee.club	Suspends for the balance of the registration period
illycoffee.digital	Suspends for the balance of the registration period
illycoffee.email	Suspends for the balance of the registration period
illycoffee.fashion	Suspends for the balance of the registration period
illycoffee.fit	Suspends for the balance of the registration period
illycoffee.fun	Suspends for the balance of the registration period
illycoffee.guru	Suspends for the balance of the registration period
illycoffee.host	Suspends for the balance of the registration period
illycoffee.life	Suspends for the balance of the registration period
illycoffee.live	Suspends for the balance of the registration period
illycoffee.london	Suspends for the balance of the registration period
illycoffee.miami	Suspends for the balance of the registration period
illycoffee.press	Suspends for the balance of the registration period
illycoffee.rest	Suspends for the balance of the registration period
illycoffee.rocks	Suspends for the balance of the registration period
illycoffee.site	Suspends for the balance of the registration period
illycoffee.space	Suspends for the balance of the registration period



illycoffee.store	Suspends for the balance of the registration period
illycoffee.today	Suspends for the balance of the registration period
illycoffee.uno	Suspends for the balance of the registration period
illycoffee.website	Suspends for the balance of the registration period
illycoffee.world	Suspends for the balance of the registration period
illycoffee.xyz	Suspends for the balance of the registration period
illycoffee.yoga	Suspends for the balance of the registration period
illy.bar	Unlocks and returns to the full control of the Registrant
illy.best	Unlocks and returns to the full control of the Registrant
illy.blue	Unlocks and returns to the full control of the Registrant
illy.cam	Unlocks and returns to the full control of the Registrant
illy.casa	Unlocks and returns to the full control of the Registrant
illy.cymru	Unlocks and returns to the full control of the Registrant
illy.fun	Unlocks and returns to the full control of the Registrant
illy.host	Unlocks and returns to the full control of the Registrant
illy.kim	Unlocks and returns to the full control of the Registrant
illy.monster	Unlocks and returns to the full control of the Registrant
illy.pink	Unlocks and returns to the full control of the Registrant
illy.press	Unlocks and returns to the full control of the Registrant
illy.red	Unlocks and returns to the full control of the Registrant
illy.rest	Unlocks and returns to the full control of the Registrant
illy.wales	Unlocks and returns to the full control of the Registrant
illy.yoga	Unlocks and returns to the full control of the Registrant

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Rodolfo Carlos

Surname: Rivas Rea

Date: 2020-07-30