



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

URS DISPUTE NO. E0CE177A

Determination DEFAULT

I. PARTIES

Complainants: Illycaffè S.p.A. (IT)
Complainants' 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 Names: ILLY.BLUE, ILLYCOFFEE.ICU, ILLYCOFFEE.MONSTER
Registry Operators: Afilias Limited, Shortdot SA and XYZ.COM LLC
Registrar: Namecheap, Inc.

III. PROCEDURAL HISTORY

Complaint submitted: 2020-08-19 11:31
Lock of the domain name(s): 2020-08-24 01:16
Notice of Complaint: 2020-08-24 15:04
Default Date: 2020-09-08 00:00
Notice of Default: 2020-09-08 11:30
Panel Appointed: 2020-09-08 11:57
Default Determination issued: 2020-09-08 12:43

IV. EXAMINER

Examiner's Name: Wilson Pinheiro Jabur

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 Complainants request that the disputed domain names 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. Complainants:

The Complainant was founded in 1933. The Complainant asserts to produce and sell a unique blend of high-quality espresso coffee distributed in 140 countries, employing more than 1,200 people and having had a consolidated turnover of EUR 547 million in 2017.

According to the Complainant, the disputed domain names, registered under a privacy proxy service so as to conceal the true identity of the Respondent, all incorporate the Complainant's trademark and share the same (i) registrar, (ii) Registrant details, (iii) DNS servers, (iv) same website content, pointing to the same (v) IP address.

Also according to the Complainant, one of the disputed domain names is identical to the Complainant's trademark (not taking into account the TLD) whereas the other 2 disputed domain names, in addition to reproducing the Complainant's trademark include the word 'coffee', a descriptive term directly related to the Complainant's business.

On the Complainants' point of view the Respondent does not have any legitimate right or interest in the disputed domain names since that the webpages that resolve from the disputed domain names characterize a servile copy of the Complainant's homepage and the Respondent appears to have actively configured or started configuring email accounts that may lead to unduly exploiting the Complainant's identity for unlawful purposes, what is corroborated by the fact that a search on the IP address where the counterfeit site is hosted indicates nearly 400 domain names are also hosted there (Annex 5 to the Complaint).

As to the registration and use of the disputed domain names in bad faith, the Complainant asserts that the Respondent, by using the disputed domain names, intentionally attempts to attract for commercial gain, Internet users to the websites, by creating a likelihood of confusion with the Complainants' mark as to source, sponsorship, affiliation, or endorsement of its websites.

B. Respondent:

The Respondent did not reply to the Complaint.

C. Procedural findings:

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.

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

With regard to the disputed domain name ILLY.BLUE having already been subject to a past dispute (URS DISPUTE NO. 72000F30 - https://urs.mfsd.it/system_data/source_pdf/72000F30.pdf), the Panel accepts the refiling, since the partial refusal determination in the previous case regarded a procedural issue (consolidation) and not the merits and, therefore, was on a "without prejudice" basis.

D. Findings of fact:

The disputed domain names <ILLY.BLUE>, <ILLYCOFFEE.ICU>, <ILLYCOFFEE.MONSTER > were registered on July 2, 2020, May 5, 2020 and May 5, 2020, respectively. The disputed domain names are being used in connection with webpages that copy the Complainant's homepage.



The Complainant has shown trademark rights over the expression “ILLY”, duly registered in several jurisdictions around the world.

E. Reasoning:

In spite of Respondent’s default, URS Procedure 1.2.6 requires the Complainant to make a *prima facie* case, showing clear and convincing evidence for each of the three elements so as to have the disputed domain name suspended.

1. The domain name is identical or confusingly similar to a word mark

The Complainant is the owner, among others, of the International trademark registration No. 600695 for the word mark “ILLY” registered on May 26, 1993 and successively renewed, to cover goods in classes 9, 11, 21, 30 and 33.

The disputed domain names incorporate the Complainant’s trademark *in totum*, not taking into account the TLDs. The addition of the “coffee” expression in the second and third disputed domain names can even add likelihood of confusion since related to the Complainant and its well-known products.

The Examiner thus finds that the complaint meets the requirement of the URS 1.2.6 (i).

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

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to the URS, any rights or legitimate interests in the disputed domain names. Nevertheless, the burden of proof is still on the Complainants to make a *prima facie* case against the Respondent.

In that sense, the redirection of Internet users to webpages that characterize a servile copy of the Complainant’s homepage and the indication of potential email accounts that may lead to unduly exploiting the Complainant’s identity for unlawful purposes cannot be considered a *bona fide* offering of goods or services under the Policy.

Also, the lack of evidence as to whether the Respondent is commonly known by the disputed domain names or the absence of any trademarks or trade names registered by the Respondent corresponding to the disputed domain names, corroborate with the indication of the absence of a right or legitimate interest.

Under these circumstances and absent evidence to the contrary, the Examiner finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain names and has therefore met the requirement of the URS 1.2.6 (ii).

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

The disputed domain names, sharing the same (i) registrar, (ii) Registrant details, (iii) DNS servers, (iv) same website content, pointing to the same (v) IP address were all registered using the same privacy protection service what indicates common control and undoubtful prior

knowledge of the Complainant and its famous trademark, considering that the webpages that resolve from the disputed domain names are a copy the Complainant's official webpage.

Such use in this Examiner's point of view may create a likelihood of confusion with the Complainants' mark as to source, sponsorship, affiliation, or endorsement of the Respondent's websites and therefore does not qualify as a *bona fide* use.

4. Abusive Complaint

The Examiner finds that the Complaint was neither abusive nor contained material falsehoods.

VIII. DETERMINATION

A. Demonstration of URS elements

Demonstrated

B. Complaint and remedy

Complaint: Accepts

Domain Names:

ILLY.BLUE Suspends for the balance of the registration period.

ILLYCOFFEE.ICU Suspends for the balance of the registration period.

ILLYCOFFEE.MONSTER Suspends for the balance of the registration period.

C. Abuse of proceedings

Finding of abuse of proceedings: Not finds

D. Publication

Publication: Publish the Determination

SIGNATURE

Name: Wilson

Surname: Pinheiro Jabur

Date: 2020-09-08