Decision for dispute CAC-UDRP-101295

Case number	CAC-UDRP-101295
Time of filing	2017-03-22 09:22:27
Domain names	arla-food.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Arla Foods Amba

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	wuyanrong

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademarks containing a word element "ARLA":

(i) ARLA (word), International (WIPO) Trademark, registration date 20 March 2000, trademark no. IR 731917, registered for goods and services in classes 1, 5, 29, 30, 31 and 32; with a designated country of protection China (among other jurisdictions);

(ii) ARLA FOODS (word), Danish national trademark, application date 1 October 1999, registration date 6 March 2000, registration no. VR 2000 01185, registered for goods and services in classes 01, 05, 29, 30, 31 and 32.

besides other national and international trademarks consisting of the "ARLA" denomination.
(collectively referred to as "Complainant's trademarks").

In addition, the Complainant’s company name consist of the denomination “ARLA”, which forms the distinctive part of its company (business) name.

Moreover, the Complainant has also registered a number of domain names under generic Top-Level Domains (“TLD”) and country-code Top-Level Domains containing the term “ARLA” and “ARLA FOODS” as, for example, <arlafoods.com>, <arla.com> and <arlafoods.co.uk> among others.

The disputed domain name was registered on 1 July 2011, i.e. well after the Complainant’s trademarks and thus the Complainant enjoys seniority rights to the “ARLA” denomination.

FACTUAL BACKGROUND

The Complainant (Arla Foods Amba) is a global dairy company and co-operative owned by 12,650 dairy farmers in seven countries. The Complainant has operations worldwide, including throughout the Asia Pacific region and specifically in China, where it has an office in Beijing. The Complainant has over 19,000 employees worldwide and reached global revenue of EUR 10.3 billion in 2015.

The disputed domain name <arla-food.com> was registered on 1 July 2011 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) is currently not used and has no content available to public (i.e. the disputed domain name is not currently associated with any active website).

The Complainant seeks transfer of the disputed domain name to Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

LANGUAGE TRIAL

The Complainant filed a request for a language trial and requests the language of the UDRP proceedings to be English. Such request is based on following facts and reasonings:

- The disputed domain name includes the Complainant’s mark ARLA. Complainant is a Danish company whose business language is English;

- considering that Respondent has registered many domains with words in English, it is unlikely that Respondent is not at least familiar with the English language.

- the email chain between the Complainant’s legal representatives and the Respondent was in English;

- the disputed domain name is in Latin script rather than Chinese characters (script);

- Respondent has chosen to register the domain name under the Top Level domain name “.com” which is the commercial TLD, and is applicable to a broader audience than merely China. A more suitable TLD if only addressing the Chinese market would be the .cn extension.

The Complainant further refers to previous UDRP domain name decisions in this regard.

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains ARLA Complainant's trademarks in its entirety and is almost identical (i.e. confusingly similar) to ARLA FOODS Complainant’s trademarks.

- Neither the addition of the generic Top-Level Domains (gTLD) “.com”, nor the hyphen “-“ adds any distinctiveness to the disputed domain name.

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

The Complainant further refers to previous UDRP domain name decisions in this regard.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name.

- Neither the Complainant has authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.

- Furthermore, the domain name website has been during its existence either inactive and without any content that further implicates that the Respondent neither used nor had an intention to use the domain name for a legitimate purposes.

The Complainant refers to previous UDRP domain name decisions contending that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests; once such prima facie case is made, the burden shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain name registration and such trademarks are well known in relevant business circles.

- The Respondent can be considered to be aware of the Complainant's trademark when registering the domain name due to well-known character thereof.

- In a response to Complainant’s cease and desist letter, the Respondent made a proposal to the Complainant to transfer the disputed domain name for a consideration of USD 1 000. Such conduct has been considered in previous cases as an additional evidence of use and registration in bad faith due to the Respondent´s intention to unduly profit from the Complainant´s rights.

- It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant’s trademarks which enjoys strong reputation, plus other facts, such as above described non-use of the disputed domain name and offering transfer of the domain name to Complainant for a fee, are sufficient to establish bad faith under the 4(a)(iii) of UDRP Policy.

The Complainant refers to previous UDRP domain name decisions in this regard.

The Complainant presents the following evidence which has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from various trademark databases regarding Complainant's trademarks;
- Screenshots of the disputed domain name website;
- Correspondence between the Complainant and the Respondent

RESPONDENT:

The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of UDRP Policy.

For details, see "Principal Reasons for the Decision".

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of UDRP Policy.

For details, see "Principal Reasons for the Decision".

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of UDRP Policy.

For details, see "Principal Reasons for the Decision".

PROCEDURAL FACTORS

Pursuant to paragraph 11 (a) of the Rules for Uniform Domain Name Dispute Resolution Policy (not to be confused with Policy) "…the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". In this case according to the Registrar the language of the Registration Agreement is Chinese. However, the Complainant requested to change the language of the proceedings to English based on the reasons mentioned above.

Although the Panel finds some of the arguments raised by the Complainant to be irrelevant (e.g. a statement that the corporate language of the Complainant is English is clearly immaterial), the Panel accepts the Complaint in English and shall render its decision in English, mostly for the reasons summarised below:

- The communication between the Complainant and the Respondent was in English;

- The disputed domain name contains English denomination “food” and thus is clearly targeted to English speaking audience.

PRINCIPAL REASONS FOR THE DECISION

RIGHTS

Since the domain name and the Complainant’s trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term “ARLA” accompanied by a term “FOOD” is confusingly

similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the dominant “ARLA” element of Complainant’s trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitute confusing similarity between Complainant’s trademarks and such domain name. Addition of a non-distinctive element “FOOD” and the hyphen “-“ to the “ARLA” denomination cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists.

In addition, the disputed domain name is almost identical to the Complainant’s trademark for ARLA FOODS (the only difference being a plural “foods” compared to a singular “food”).

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of UDRP Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

As evidenced by the Complainant and based on general Internet search, the Respondent is not commonly known by the disputed domain name. Given the fact, that (i) the disputed domain name has not been used and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the domain name was intended to be used in connection with a bona fide offering of goods or services as required by UDRP Policy.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of UDRP Policy).

BAD FAITH

The Panel finds it grounded that the Respondent offered the disputed domain name for sale to the Complainant as the Respondent made an active attempt to sell the disputed domain name to the Complainant (trademark holder).

The Respondent has not used the disputed domain name in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com>, Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of so-called active use of the disputed domain name does not as such prevent a finding of bad faith.

Such circumstances indicate that the Respondent has registered and used the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant.

For the reasons described above and since the Respondent failed to provide any explanation in this regard, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith (within the meaning of paragraph 4(a)(iii) of UDRP Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ARLA-FOOD.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2017-04-30

Publish the Decision