Decision for dispute CAC-UDRP-101765

Case number	CAC-UDRP-101765
Time of filing	2017-11-09 10:10:31
Domain names	arla.systems

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Arla Foods Amba

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	steve gay

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on the following trademarks:
- ARLA (word) EU registration No. 001520899, registered on February 24, 2000;
- ARLA (figurative) EU registration No. 001902592, registered on October 13, 2000;
- ARLA (figurative) EU registration No. 009012981, registered on April 8, 2010;
- ARLA FOODS (word mark), Danish registration No. VR 2000 01185, registered on March 6, 2000;
- ARLA (word mark), UK registration No. UK00002226454, registered on October 04, 2002.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is a global dairy company and co-operative owned by 12,650 dairy farmers in seven countries.

The company has operations worldwide, including the UK through its subsidiary Arla Foods UK plc, where the Respondent resides. The company has over 19,000 employees worldwide.

According to the Complainant, Arla is the UK's number one dairy company by turnover and milk pool, and is also the country's largest supplier of butter and spreads and cheese.

The Complainant states that its UK business has a yearly combined milk pool of circa 3.2 billion litres and a turnover in excess of £2 billion and the Complainant employs around 4,000 people in the UK through its dairies, distributions centres and head offices.

The Complainant owns a number of trademarks and domain names that include the word "ARLA". The Complainant states that "ARLA" and "ARLA FOODS" are considered well-known trademarks by previous UDRP panels and refers to numerous UDRP decisions where It successfully challenged domain names registered by others.

The disputed domain names were registered on September 23, 2017.

The Complainant claims that the disputed domain names are confusingly similar with its "ARLA" trademarks since they both incorporate the mark and the addition of the new generic top-level domains ".systems" and ".cymru" does not add any distinctiveness to these domain names.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAMES

The Complainant states that there is no evidence that the Respondent is commonly known by the disputed domain names or that the Respondent has a history of using, or preparing to use, the disputed domain names in connection with a bona fide offering of goods and services. The disputed domain names are pointing to parking pages.

The Respondent has not by virtue of the content of the websites, nor by the use of the disputed domain names shown that they would be used in connection with a bona fide offering of goods or services, the Complainant had never authorized the Respondent to use its "ARLA" trademark in any form and there is no proof of legitimate, non-commercial use of the disputed domain names by the Respondent.

The Complainant argues that the intention of the disputed domain names is to take advantage of an association with the Complainant's business.

THE DOMAIN NAMES WERE REGISTERED AND BEING USED IN BAD FAITH

The Complainant contends that its trademarks predate the registration of the disputed domain names and it is inconceivable that the unique combination of "ARLA" and the applicable domain name extensions is not a deliberate and calculated attempt to improperly benefit from the Complainant's rights.

The Complainant sent a cease and desist letter to the Respondent on October 2, 2017 and later reminders but received no response.

The Complainant argues that the inaction in relation to a domain name can also constitute a bad faith use and any attempt to actively use the disputed domain names would lead to confusion as to the source, sponsorship of the Respondent´s website among the internet users who might believe that the website is owned or is somehow associated with the Complainant.

The concept of passive holding may apply even in the event of sporadic use, or of the mere "parking" of a domain name.

The confusingly similar nature of the disputed domain names to the Complainant's trademarks, the lack of any explanation from the Respondent as to why he registered the disputed domain names indicates bad faith registration.

According to the Complainant, the Respondent registered the disputed domain names due to the value and reputation of the Complainant's marks and business in the UK where the Respondent is located.

Therefore, the Respondent should be considered to have registered and to be using the disputed domain names in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

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 the Policy).

BAD FAITH

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

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar with Complainant's trademark

The Complainant is the owner of numerous trademark registrations incorporating the "ARLA" element.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain names entirely incorporate the "ARLA" element and are confusingly similar with the Complainant's trademarks listed above. Furthermore, the disputed domain names are identical to the "ARLA" word marks as they contain no other elements or words.

The suffixes .systems and .cymru shall be disregarded under the confusing similarity test as they do not add anything to the distinctiveness of the disputed domain names.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110 and CAC Case No. 101284).

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095, Forum).

The disputed domain names are pointing to parking pages.

It has been generally recognized that such use is legitimate where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's trademark (see par. 2.9 of the WIPO Overview 3.0).

In the present case the situation is different.

The Complainant provided sufficient evidence of its rights in the "ARLA" marks and that such marks are famous and recognizable and evidence that the Complainant is well-known in the UK, the country of Respondent's residence.

It is well established by previous panels that parking pages built around a trademark do not constitute a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy, nor do they constitute a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii) (see e.g. Facebook, Inc. and WhatsApp, Inc. v. Domain Manager, NA, WIPO Case No. D2016-0394).

There is no evidence that there is some sort of connection between "ARLA" and the Respondent and in the absence of any explanations from the Respondent it is unclear why the Respondent chose the disputed domain names.

The Panel also notes that the disputed domain names are identical to the Complainant's "ARLA" marks and it is generally accepted that domain names identical to a complainant's trademark carry a high risk of implied affiliation thus denying any fair use rights in respect of the disputed domain names (see par. 2.5.1 of the WIPO Overview 3.0).

There is nothing in the present case, including content of the websites under the disputed domain names, that would demonstrate rights or legitimate interests of the Respondent in the disputed domain names.

The Panel finds that the Complainant has shown a prima facie case that has not been rebutted by the Respondent and, therefore, satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

The Panel finds that in the present case the following circumstances indicate registration and use in bad faith:
- The Complainant's trademark registrations predate registration of the disputed domain names;
- The disputed domain names entirely incorporate the Complainant's distinctive and strong "ARLA" marks;

- Failure of the Respondent to respond to a cease and desist letter of the Complainant and file a response in this proceeding and explain why he chose the disputed domain names that incorporate “ARLA” marks (see e.g. CAC Case No. 101621);
- A fact that the Respondent is based in the UK where the Complainant has a strong business presence. One of the disputed domain names is arla.cymru that directly indicates connection with the UK (.cymru is one of two geographic top level domains for Wales). Therefore, it is highly unlikely that the Respondent was not aware of the rights the Complainant has in the trademarks and the value of said trademarks;
- Taking into account all of the above it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would not be illegitimate, in particular in the absence of any response and clarifications from the Respondent.

In the present case, the disputed domain names are not actively used as they are pointing to parking pages provided by hosting providers of the respective web sites (One.com and 123-reg Limited).

It is well established that the non-use or passive holding of a domain name does not prevent the panel from finding bad faith registration and use (see par. 3.3 of WIPO Overview 3.0).
One has to look at the circumstances of a case taking into account, in particular, the degree of distinctiveness or reputation of the Complainant’s mark and the implausibility of any good faith use to which the domain name may be put (see e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246; CAC Case No. 101435, CAC Case No. 101691 and CAC Case No. 101640).

The Panel finds that, in addition to other bad faith considerations, this case falls within the provisions of paragraph4(b)(iv) of the Policy especially if the disputed domain names are put into active use.
Since the disputed domain names fully incorporate the “ARLA” mark the Respondent would be taking advantage of the ARLA trademark by intentionally attempting to attract visitors to the Respondent’s websites by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or a product or service on the Respondent’s website or location (see CAC Case No. 101486).

A totality of circumstances in the present case demonstrate registration and use of the disputed domain names in bad faith.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARLA.SYSTEMS**: Transferred
2. **ARLA.CYMRU**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2017-12-30

Publish the Decision