Decision for dispute CAC-UDRP-101861

Case number	CAC-UDRP-101861
Time of filing	2018-02-01 09:59:16
Domain names	BARRY-CALLEBAOUT.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Barry Callebaut AG
Organization	Barry Callebaut Belgium NV

Complainant representative

Organization	Adlex Solicitors

Respondent

Name	Tony Green

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The first Complainant owns a number of trademarks, including International Trademark Registration with number 702211 BARRY CALLEBAUT in classes 29 and 30, for many designated countries, including the European Union, which was registered on September 4, 1998 (the "Trademark").

FACTUAL BACKGROUND

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

1. The Complainants are part of the Barry Callebaut international group of companies (“the Group”), which has its headquarters in Switzerland. The Group is one of the world’s leading manufacturers of chocolate and cocoa products. It procures, processes, manufactures and supplies cocoa-based ingredients, e.g. cocoa powder, cocoa butter and chocolate, (as well as nut-based ingredients and decorations) to food manufacturers and it also supplies cocoa-, nut- and fruit-based food ingredients and decorations to food service businesses, including hotels, bakery chains, restaurants and airlines.

2. The Group was established in 1996 following a merger of the French firm Cacao Barry and the Belgian firm Callebaut.

3. Since 1996, the Group has traded under the brand name “Barry Callebaut”. While the Group owns a number of other brands, “Barry Callebaut” is the house brand, used as the branding on many of the Group’s bulk cocoa products such as cocoa powder, cocoa butter and chocolate and it is also generally displayed in conjunction with each of the Group’s other brands.

4. The Group has more than 11,000 employees operating in over 30 countries and maintains over 55 production facilities worldwide, including in China, Canada, Brazil, India, Japan, Ivory Coast, Germany and Russia. In the industrial chocolate market, the Group has a 40% market share in the open market, meaning its products are present in one out of five chocolate products consumed around the world.

5. The First Complainant was incorporated on December 13, 1994 and the Second Complainant on December 15, 1989. The Second Complainant is the main trading company for chocolate within the Group.

6. The disputed domain name was registered on September 29, 2017 and as of October 18, 2017 there was a website available at the disputed domain name comprising a registrars parking page. On October 26, 2017 the Complainants' solicitor sent a cease and desist communication by e-mail to the e-mail address that appeared on the whois. An automated response was immediately received from that e-mail address stating that the e-mail address that appeared on the whois was a dormant e-mail address and no longer used. A new e-mail address was provided together with a mobile phone number. The Complainants' solicitor sent the cease and desist communication to the new e-mail address provided on the same date to which no response was received. The Complainants’ solicitor also tried subsequently to contact the Respondent using the mobile phone number provided, however no reply was received.

7. The Complainants rely on the Trademark and on common law rights. By virtue of their extensive trading and marketing activities, the Complainants have acquired substantial reputation and goodwill in the name “Barry Callebaut” such that it is recognised by the public as distinctive of the Complainants' business. The disputed domain name differs only by the insertion of the letter “O” between the “A” and the “U” plus a hyphen, thus creating a misspelling of the Trademark. This has the obvious potential to cause confusion with the Complainant’s trademark both visually and phonetically.

8. The Complainants have no association with the Respondent and have never authorised or licensed the Respondent to use the Trademark. There is no evidence that the Respondent has ever used the disputed domain name at all , that the Respondent has been commonly known by the name comprised in the disputed domain name, or that the Respondent has ever used the disputed domain name, let alone in a non-commercial or fair manner.

9. In this case the Complainants rely on the following factors as evidencing bad faith by passive holding:

a. The Complainants have a well-known and highly distinctive Trademark. It is inconceivable that the Respondent registered the disputed domain name independently of the Trademark; the disputed domain name is explicable only as a deliberate misspelling of the Trademark
b. The Respondent has failed to respond to the Complainants' pre-action communications
c. It is impossible to conceive of a good faith use of the disputed domain name
The Complainants also rely on the fact that the Respondent has not responded to, let alone denied, the assertions of bad faith in the pre-action communications by the Complainants. It is reasonable to assume that if the Respondent did have legitimate purposes in registering / using the disputed domain name it would have said so.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainants have, 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 Complainants have rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, 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 Complainants have, 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. The disputed domain name includes the entire Trademark with only an insertion of the letter “O” between the “A” and the “U” plus a hyphen, which creates a misspelling of the Trademark. The Panel therefore finds that the disputed domain name is confusingly similar to the Trademark.

b. The Panel finds the Complainants have established that the Respondent was not licenced or authorised to use the Trademark in the disputed domain name. Furthermore, the Panel finds the Complainants successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. The Panel therefore finds the Respondent has no rights or legitimate interests in respect of the disputed domain name.

c. The Panel is satisfied that the Respondent registered the disputed domain name in bad faith as it basically incorporates the entire Trademark, which Trademark is distinctive, so that it is likely that the Respondent was familiar with the Trademark when it registered the disputed domain name. Further, the Panel is satisfied that the Respondent used the disputed domain name in bad faith as the Respondent chose to ignore the Complainants' cease and desist letters and communications and the disputed domain name is actually used to create confusion with the Complainant and/or take unfair advantage of the Trademark for the Respondent's own benefit.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BARRY-CALLEBAOUT.COM**: Transferred

PANELLISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2018-03-16

Publish the Decision