Decision for dispute CAC-UDRP-101872

Case number	CAC-UDRP-101872
Time of filing	2018-02-01 13:38:05
Domain names	barrycallebaut.xyz, , barry-callebaut.xyz , callebaut.xyz

Case administrator

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

Complainant

Organization	Barry Callebaut AG
Organization	Barry Callebaut Belgium NV

Complainant representative

Organization	Adlex Solicitors

Respondent

Name	Wang Xin Zhong

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings relating to the disputed domain names.

IDENTIFICATION OF RIGHTS

The First Complainant is the proprietor of numerous registrations of the mark BARRY CALLEBAUT, including international mark no. 702211 dated 4 September 1998 in classes 29 and 30.

The Complainants also claim common law rights in this mark by virtue of extensive trade and marketing under it.

FACTUAL BACKGROUND

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 high-quality 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.

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

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.

The First Complainant, the Group's holding company, owns an extensive international portfolio of registered trademarks for the term "Barry Callebaut" including, by way of example, an International trade mark no.702211, dated 4 September 1998: word mark for "Barry Callebaut" in classes 29 and 30. The Second Complainant is the main trading company for chocolate within the Group.

The Group's sales volume for 2016/2017 was 1,914,311 tonnes and the total turnover of the Group for the same period was approximately CHF 6,805,000,000. This information covers trading under all of the Group's brands. A breakdown between the brands is not publicly available. However "Barry Callebaut" is the largest of the Complainants' brands in terms of turnover.

The Group's annual total marketing expenditure specifically in relation to the name "Barry Callebaut" is approximately €3 to €4 million. The Group's marketing of its "Barry Callebaut" trade mark has included print media advertising, promotional brochures, attending trade fairs (including Internationale Süsswarenmesse ("ISM") Cologne, Food Ingredients Europe ("FiE"), Institute of Food Technologists ("IFT") Chicago, and PMCA, (US) together with co-sponsorship of the World Chocolate Forum. The Group has also initiated a biennial conference entitled "ChocoVision" which has so far taken place in 2012, 2014 and 2016 in Davos, Switzerland.

The Group has operated its main website at www.barry-callebaut.com since approximately 1997. There have been approximately 2.3 million users and 15.1 million page views of the site over the period 2010-2014, with over one million users and six million page views between January 2013 and December 2014.

The domain names <barrycallebaut.xyz>, <barry-callebaut.xyz> and <callebaut.xyz> ("the Domain Names") were all registered on 10 November 2017. As of 16 November 2017 there were websites available at each of the Domain Names stating that each respective domain was available to purchase for $1000 for each domain.

On 16 November 2017 the Complainants' solicitor sent a cease and desist communication by e-mail to the e-mail address on the registrar's WhoIs data for the disputed domain names. On 17 November 2017 a response was received stating "Dear, pay $500 each, I can quickly transfer these domain names to you Thank you."

On 22 November 2017 the Complainants' solicitor send an e-mail to the Respondent advising that the Complainants were prepared to pay $500 in total to cover any registration / transfer fees incurred by the Respondent in relation to the Domain Names and setting out the basis on which it required the transfers of the Domain Names to take place, in particular that payment was to be made once the Complainants had control of the Domain Names. The Respondent replied the same day stating "I agree" but then setting out its own requirements, in particular that the Complainants should register an account at west.xyz and "recharge $500" to its account.

There then followed a further exchange of e-mails between the Complainants' solicitors and the Respondent in which the Complainants' solicitors reiterated the basis on which the Complainants were prepared to deal with the transfers, culminating in the Respondent unilaterally instigating an escrow.com transaction to deal with the transfers. The Complainants had not consented to this procedure and were unwilling to proceed further with the proposed purchase.

The Respondent has been found to have registered and used domain names in bad faith in another UDRP case: Sanofi, Sanofi Technoflology v Wang Xin Zhong, WIPO Case No D 2017 - 0568. The Respondent also owns other domain names reflecting well known trade marks such as <bobbibrowncosmetics.xyz>, <hiltongrandvacations.xyz>, <haagan-dasz.xyz> and

<imperialleather.xyz>.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Panel finds that the Complainants have rights in the mark BARRY CALLEBAUT by virtue of their registrations and extensive use of this mark. The Panel further finds that the disputed domain names are identical or confusingly similar to this mark.

The disputed domain name <barrycallebaut.xyz> is identical to this mark, apart from the top level domain suffix which does not provide any effective distinction of the domain name from the mark.

The disputed domain name <barry-callebaut.xyz> differs from the mark only by the insertion of a hyphen between the words “Barry“and “Callebaut” and the top level domain suffix.

The disputed domain name <callebaut.xyz> comprises the distinctive word “Callebaut” which is clearly likely to be associated by Internet users with the mark.

Accordingly, the Complainants have, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to the mark BARRY CALLEBAUT in which the Complainants have rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel finds on the undisputed evidence that the Complainants have no association with the Respondent and have never authorised or licensed the Respondent to use their trademark.

It is also clear that the Respondent has not used or made preparations to use any of the disputed domain names for any bona fide offering of goods or services; the Panel does not regard the offer for sale of the disputed domain names themselves as a use of them for a bona fide offering of goods or services for the purposes of the UDRP.

It is evident that the Respondent is not commonly known by any of the disputed domain names or any corresponding name. Nor is the Respondent making any legitimate non-commercial or fair use of the disputed domain names.

There is no other basis on which the Respondent could claim to have any right or legitimate interest in respect of the disputed domain names in the circumstances of this case.

Accordingly, 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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Panel finds that the Respondent registered the disputed domain names primarily for the purpose of sale to the Complainants for valuable consideration in excess of his costs. In accordance with paragraph 4(b)(i) of the UDRP this constitutes evidence of registration and use of the disputed domain names in bad faith.

There is no evidence displacing this presumption. On the contrary, it is supported by a finding of bad faith on the part of the Respondent in a previous decision and by his registration of a number of other domain names reflecting well-known brands.

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

The disputed domain names virtually identical to well-known brand. No use except offer for sale of the domain names themselves. Registration primarily for purpose of sale at a profit - para 4(b)(i) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BARRYCALLEBAUT.XYZ**: Transferred
2. : Transferred
3. **BARRY-CALLEBAUT.XYZ** : Transferred
4. **CALLEBAUT.XYZ**: Transferred

PANELLISTS

Name	**Jonathan Turner**

DATE OF PANEL DECISION 2018-03-22

Publish the Decision