# Decision for dispute CAC-UDRP-102565

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| Case number | CAC-UDRP-102565 |
| Time of filing | 2019-07-15 13:05:20 |
| Domain names | barry-caiiebaut.com |

## Case administrator

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

## Complainant

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| Organization | Barry Callebaut AG |
| Organization | Barry Callebaut Belgium NV |

## Complainant representative

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| Organization | Adlex Solicitors |

## Respondent

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| Name | Kenny L |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The first Complainant (Barry Callebaut AG) is the owner of registered trademarks for the term “Barry Callebaut” including the international trademark no 702211 “Barry Callebaut” registered since 1998 in classes 29 and 30. The Barry Callebaut international group of companies also operates the domain name <barry-callebaut.com> since 1997. The disputed domain name <barry-caiiebaut.com> was registered on 7 April 2019.

FACTUAL BACKGROUND

The first Complainant (Barry Callebaut AG) is the holding company of the Barry Callebaut international group of companies (“Group”) and was incorporated in 1994. The second Complainant (Barry Callebaut Belgium NV) is the main trading company for chocolate within the Group and was incorporated in 1989.

The Complainants contend that 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 11,500 employees operating in over 30 countries and maintains over 60 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 “Barry Callebaut” brand 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.

The Group has operated its main website at www.barry-callebaut.com since approximately 1997. By way of example, there were 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 disputed domain name was registered on 7 April 2019. As at 18 April 2019 there was no website available at the disputed domain name, just a technical index page. During April 2019 the Complainant communicated with the disputed domain name registrar, but the registrar ceased communicating with the Complainant’s solicitors.

The Complainant relies on its registered trade marks. The Complainant also relies on common law rights. By virtue of its extensive trading and marketing activities outlined above, the Complainant has acquired substantial reputation and goodwill in the name “Barry Callebaut” such that it is recognised by the public as distinctive of the Complainant’s business.

The disputed domain name differs only by the substitution of the letters “ii” in place of the letters “ll” in the word “callebaut”, thus creating a misspelling of the Complainant’s trade mark “Barry Callebaut”. This has the obvious potential to cause confusion with the Complainant’s trade mark both visually and phonetically. The Complainant’s trade mark remains readily identifiable within the disputed domain name.

The Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its trade marks. There is no evidence that the Respondent has ever actively used the disputed domain name at all. There is no evidence that the Respondent has been commonly known by the names comprised in the disputed domain name. And there is no evidence that the Respondent has ever used the disputed domain name, let alone in a non-commercial or fair manner.

The non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. While panels will look at the totality of the circumstances in each case, factors that have been considered relevant include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In this case the Complainant relies on the following factors as evidencing bad faith by passive holding. The Complainant has a well-known and highly distinctive trade mark. It is inconceivable that the Respondent registered the Domain independently of that trade mark; the Domain is explicable only as a deliberate misspelling of the Complainant’s trade mark. It is impossible to conceive of a good faith use of the Domain.

The Complainant suspects that the disputed domain name has been registered for use as part of a fraudulent phishing exercise. The Complainant and its customers / suppliers have been subject to such attempts before and indeed the

Complainant has won a number of previous domain name cases relating to such fraudulent typosquatting activities.

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 first Complainant has 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) The respondent has no rights or legitimate interests in respect of the domain name; and

(iii) The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainants have established the fact that the first Complainant has valid rights for the international trademark No 702211 “Barry Callebaut” registered since 1998, and that the group of companies to which the Complainants belong use domain name <barry-callebaut.com> including the trademark “Barry Callebaut”. The disputed domain name has been registered on 7 April 2019, i.e. more than 20 years after the trademark registration.

The first element of the disputed domain name (“barry”) fully corresponds to the first element of the trademark.

The second element of the disputed domain name (“caiiebaut”) is not identical to the second element of the Complainant’s trademark (“callebaut”), but the only difference is the use of “ii” letters in the disputed domain name instead of “ll” letters in the trademark. The use of similar letters where the overall height of the letter “i” is the same of the letter “l” and these two letters differs in the small space within the letters only, leads to the conclusion, that the words “callebaut” and “caiiebaut” are visually similar and this could cause confusion with the Complainant’s trademark. Therefore, the use of letters “ii” in the disputed domain name instead of letter “ll” does not change the overall impression of the designation as being connected to first Complainant’s trademark.

Two words of the trademark are divided by the space and by the hyphen in the disputed domain name. The replacement of the space is usually made by the deletion or by the hyphen as the space is not supported character to be used in the domain names. Therefore, the use of the hyphen instead of the space between two parts of the trademark does not distinguish the disputed domain name from the first Complainant's trademark.

The Panel therefore considers the disputed domain name to be confusingly similar to the Complainant's trademark "Barry Callebaut" which the first Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The Complainants have established a prima facie case (not challenged by the Respondent who did not filed any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainants and there is no indication that the Respondent is commonly known by the term "Barry Callebaut" or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

Moreover the disputed domain name resolves to an inactive web page and, therefore, does not constitute a bona fide offering of goods and services or a legitimate non-commercial fair use.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

The Respondent has registered the disputed domain name which consists of an evident misspelling of the first Complainant's trademark. In addition, the trademark is highly distinctive, corresponds to the name of both Complainants and is widely known as proved by the Complainants. It could be therefore concluded that the Respondent had or should have the Complainants and first Complainant's trademark in mind when registering the disputed domain name. Furthermore, the non-use of a disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

Considering the (i) similarity between the first Complainant's trademark and the disputed domain name, (ii) resolving of the disputed domain name to the inactive webpage only, (iii) distinctiveness of the first Complainant's trademark and (iv) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that 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.

The Panel finally considers that the Complainants have shown that the disputed domain name <barry-caiiebaut.com> is confusingly similar to a trademark in which the first Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainants has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

## PANELLISTS

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| Name | **JUDr. Petr Hostaš** |

DATE OF PANEL DECISION 2019-08-12

Publish the Decision