Decision for dispute CAC-UDRP-104044

Case number	**CAC-UDRP-104044**
Time of filing	**2021-09-30 09:05:42**
Domain names	**arlafoods-group.com**

Case administrator

Organization	**Denisa Bilík (CAC) (Case admin)**

Complainant

Organization	**Arla Foods Amba**

Complainant representative

Organization	**BRANDIT GmbH**

Respondent

Organization	**MATHEW STUART**

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 Complainant is the registrant, among others, of the following trademarks:

- EU trademark registration No. 001520899 "ARLA", registered on May 7, 2001, for goods and services in classes 1, 5, 29, 30, 31 and 32;
- EU trademark registration No. 001902592 "ARLA", registered on March 22, 2002, for goods and services in classes 1, 5, 29, 30 and 32;
- EU trademark registration No. 009012981 "ARLA", registered on September 27, 2010, for goods and services in classes 1, 5, 29, 30, 31 and 32;
- Danish trademark registration No. VR 2000 01185 "ARLA FOODS", registered on March 6, 2000, for goods and services in classes 1, 5, 29, 30, 31 and 32; and
- UK trademark registration No. UK00002226454 "ARLA", registered on March 20, 2000, for goods and services in classes 1, 5, 29, 30, 31 and 32.

The disputed domain name was registered by the Respondent on February 5, 2021.

FACTUAL BACKGROUND

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

Arla Foods is the fifth-largest dairy company in the world and a cooperative owned by more than 12,500 dairy farmers. Arla Foods Amba was constituted in 2000, when the largest Danish dairy cooperative MD Foods merged with its Swedish counterpart Arla ekonomisk Förening. Arla Foods Amba employs 119,190 people across 105 countries and reached a global revenue of EUR 10,6 billion for the year 2020.

The company has operations worldwide, including in the United Kingdom through its subsidiary Arla Foods UK plc, where the Respondent resides. The UK business has a yearly combined milk pool of approximately 3.2 billion litres and a turnover of more than 2 billion GBP. Arla employs around 3,500 people in the UK through its dairies, distributions centres and head offices.

Arla Foods' products are easily recognized by the consumers all over the world due to the significant investments of the company in promoting its products and brands and offering high quality products. It sells its milk-based products under its famous brands ARLA, LURPAK, CASTELLO, APETINA and others.

The Complainant also enjoys a strong online presence via its official website and social medias. Due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world.

The Complainant is the owner of the registered trademarks ARLA and ARLA FOODS in numerous of countries all over the world including in the UK where the Respondent resides.

All these trademark registrations predate the registration of the disputed domain name.

Other panels have pointed out that ARLA and ARLA FOODS are considered as well-known trademarks.

The Complainant has previously successfully challenged several ARLA domain names through UDRP proceedings.

The Complainant has also registered a number of domain names under generic top-level domains and country-code top-level domains containing the term "ARLA" and "ARLA FOODS" like for example <arlafoods.com>, < arla.com>, <arlafoods.co.uk>, <arlafoods.net>. The Complainant is using the domain names to connect to a website through which it informs potential customers about its trademarks and its products and services.

The Complainant owns numerous ARLA and ARLA FOODS trademarks registered many years before the disputed domain name.

The disputed domain name <arlafoods-group.com> incorporates the Complainant's trademarks ARLA and ARLA FOODS, in combination with a generic term "group", separated by the symbol "-", which is closely related to the Complainant and its business operations.

Previous UDRP panels have constantly held that the mere addition of a descriptive term – such as "food" or "foods" – would not prevent a finding of confusing similarity to a trademark.

Furthermore, the generic top-level domain ".com" is a standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

The disputed domain name is therefore confusingly similar to the Complainant's trademarks ARLA and ARLA FOODS.

The disputed domain name was registered many years after the first registrations of the Complainant's trademarks. The Complainant has not licensed or authorized the Respondent to register or use the disputed domain name nor is the Respondent affiliated to the Complainant in any form or has endorsed or sponsored the Respondent.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademark including the terms “arlafoods-group”. When conducting the search regarding the terms “arlafoods-group” on popular Internet search engines, all the top results relate to the Complainant, its official websites and also third parties’ websites – directly referring to the Complainant. When conducting the search by the name of the Respondent along with the terms “arlafoods-group”, there was no returned result showing the Respondent is known by the disputed domain name. When conducting searches on online trademark databases, no information is found in relation with trademarks corresponding to the terms “arlafoods-group”.

The Respondent could have easily performed a similar search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in the UK, where the Respondent resides, and many other countries worldwide. However, the Respondent still chose to register the disputed domain name.

The Respondent's name is not connected to the Complainant nor to the word “Arla” in any form. Therefore, the Respondent is not commonly known by the disputed domain name.

From the Complainant’s perspective, the Respondent deliberately chose to use the trademarks ARLA and ARLA FOODS as the main part of the disputed domain name, very likely with the intention to benefit from the Complainant’s worldwide renown and to confuse Internet users as to the source or sponsorship and therefore cannot be considered as a bona fide offering of goods or services.

The disputed domain name did not resolve to any active website. The Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

In addition, when Internet users, who search for information about the Complainant and/or about the brand ARLA or ARLA FOODS, would very likely be confused and be led to believe that the disputed domain name is somehow related to the Complainant and be disappointed as they would not find the information as expected but only negative information about the disputed domain name – which will lead to trademark tarnishment for the Complainant.

There is no evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name.

The Respondent has therefore no rights or legitimate interests in respect of the disputed domain name.

The Respondent registered the disputed domain name many years after the first registrations of the Complainant’s ARLA and ARLA FOODS trademarks. The ARLA and ARLA FOODS trademarks are widely known trademarks, registered in many countries including in the UK where the Respondent is located and where the Complainant enjoys a strong online presence.

In addition, “arlafoods” in the disputed domain name is a direct reference to the Complainant’s trademark ARLA FOODS but also to the Complainant’s trade name and business - one of the biggest European dairy producers and fifth largest in the world operating under the trade name Arla Foods Amba. It is very likely that the Respondent has registered the disputed domain name having the Complainant in mind.

It is therefore inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the disputed domain name.

Therefore, the Respondent knew the Complainant’s trademarks at the time it registered the disputed domain name and registered the disputed domain name in bad faith.

The disputed domain name did not resolve to active website, which constitutes passive holding. Other panels established that the registration and passive holding of a domain name which has no other legitimate use and clearly refers to the Complainant's

trademark may constitute registration and use in bad faith.

The fact that the Respondent has been using privacy shield service to conceal its identity adds up to the finding of bad faith.

In addition, the Complainant tried to reach the Respondent by sending a cease-and-desist letter. However, the Complainant has not received any response from the Respondent.

In view of the above, the Complainant concluded that the Respondent registered and used the disputed domain name 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

Language of the Proceedings

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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".

The language of the Registration Agreement is French, therefore the language of the proceedings should be French, unless otherwise agreed by the parties. The Complaint, however, was filed in English. The Complainant submitted a request to change the language of the proceedings into English based on the following reasons:

- According to the Registrar Verification, the Respondent resides in the United Kingdom (UK), where English is the official language. Therefore, the Respondent should understand English well;

- The disputed domain name is composed by the Complainant's trademark "Arlafoods" in combination with the English term "group", and both terms are correctly spelt;

- The Respondent chose to register the disputed domain name with the generic top level domain .com. This proves that by registering the disputed domain name the Respondent is trying to target a broad audience, not limited to French speaking visitors;

- Should the language of the Registration Agreement be different from English, a translation of the Complaint in such a language would entail significant additional costs for the Complainant and delay in the proceedings.

The Panel observes that it is well-established that, in deciding whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, the factors that should be taken into consideration include whether the

Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties (see, for example, WIPO Case No. D2008-0400).

The Panel considers that the fact that the Respondent resides in a country where English is the official language and that the disputed domain name includes two English words (namely "foods" and "group") are evidence of the Respondent's knowledge of the English language.

Furthermore, the Panel finds that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into French. In line with other Panels' view on this issue (see, for example, WIPO Case No. D2015-0070), the Panel considers that the language requirement should not cause any undue burden on the parties or undue delay.

For these reasons, having carefully considered the Complainant's submission regarding the language of the proceedings and the overall circumstances of this case, the Panel accepts the Complaint in English and shall render its decision in English.

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

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

(i) The disputed 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 disputed domain name; and

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

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark “ARLA”, identified in section “Identification of rights” above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain name.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant’s trademark.

The disputed domain name differs from the Complainant’s trademark “ARLA” only by the addition of the hyphen, of the word “FOODS” before the hyphen, of the word "GROUP" after the hyphen, and of the top-level domain ".COM".

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be

confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case the word "FOODS" before the hyphen and the word "GROUP" after the hyphen have no impact on the distinctive part “ARLA ”. Furthermore, the word "FOODS", which is also part of the Complainant's Danish trademark "ARLA FOODS", is a generic name in relation with the field of activity of the Complainant, namely the food field. Moreover, the word "GROUP" is a generic word which is insufficient to avoid any likelihood of confusion between the disputed domain name and the Complainant (see, for example, WIPO case No. D2019-0347). It is well established that where the relevant trademark is recognizable within the domain name, the addition of other terms would not prevent a finding of confusing similarity.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- it has not licensed or authorized the Respondent to register or use the disputed domain name nor is the Respondent affiliated to the Complainant in any form or has endorsed or sponsored the Respondent;

- there is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademark including the terms “arlafoods-group”;

- when conducting the search regarding the terms “arlafoods-group” on popular Internet search engines, all the top results relate to the Complainant, its official websites and also third parties’ websites directly referring to the Complainant;

- when conducting the search by the name of the Respondent along with the terms “arlafoods-group”, there was no returned result showing the Respondent is known by the disputed domain name;

- when conducting searches on online trademark databases, no information is found in relation with trademarks corresponding to the terms “arlafoods-group”;

- the Respondent's name is not connected to the Complainant nor to the word “ARLA” in any form, therefore the Respondent is not commonly known by the disputed domain name;

- the disputed domain name did not resolve to any active website;

- there is no evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain name is not used for any website.

Taking into account that the Respondent has no license or authorization to use the disputed domain name, that the disputed domain name does not correspond to the name of the Respondent, that the Respondent is not commonly known by the disputed domain name, that there is no evidence of any fair or non-commercial use of the disputed domain name, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant’s trademark would also satisfy the complainant’s burden.

Taking into account the distinctiveness of the well-known trademark “ARLA", the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark “ARLA” when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel share this view.

The fact that the disputed domain name is not currently used does not prevent a finding of bad faith (see, for example, WIPO Case No. D2018-1264). Previous panels have indeed confirmed that the prerequisites under paragraph 4(a)(iii) of the Policy can be met under the doctrine of passive holding, giving close attention to all circumstances of the Respondent's behaviour (see, for example, WIPO Case No. D2000-0003).

The Panel, having taken into account the distinctiveness of the well-known Complainant's trademark, the fact that no response to the Complaint has been filed, the absence of compliance with the request contained in the Complainant's cease and desist letter, and the passive holding of the disputed domain name, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARLAFOODS-GROUP.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2021-11-15

Publish the Decision