

Decision for dispute CAC-UDRP-104046

Case number CAC-UDRP-104046

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Domain names lurpakbutter.com

Case administrator

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

Complainant

Organization Arla Foods Amba

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization UK FROZEN FOOD LTD

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 bases its Complaint on the UK trademark "LURPAK", registration number: UK00910657385, having the date of entry in register: June 29, 2012, registered for classes 29, 30, 31, 32, IR TM "LURPAK", no. 1167472, registration date October 30, 2012, registered for goods in classes 01, 05, 29, 30, 31, 32, designating several countries for protection, IR TM "LURPAK", no. 1142736, registration date October 30, 2012, registered for goods in class 29, designating several countries for protection.

FACTUAL BACKGROUND

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

The Complainant is the fifth-largest dairy company in the world and a cooperative owned by more than 12,500 dairy farmers. It was constituted in 2000, when the largest Danish dairy cooperative MD Foods merged with its Swedish counterpart Arla ekonomisk Förening. It employs 119,190 people across 105 countries. The Complainant reached a global revenue of EUR 10,6 billion for the year 2020. The Complainant 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 circa 3.2

billion litres and a turnover in excess of £2 billion. The Complainant employs around 3,500 people in the UK through its dairies, distributions centres and head offices.

The Complainant has made significant investments 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 owns official website of LURPAK® products dedicated to the UK market:
<https://www.lurpak.co.uk/>.

The Complainant is the owner of the registered trademark LURPAK® as a word mark in numerous countries all over the world including in the UK where the Respondent resides. For example, the UK trademark "LURPAK", registration number: UK00910657385, having the date of entry in register: June 29, 2012, registered for classes 29, 30, 31, 32.

The trademark registration predates the registration of the disputed domain name.

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "Lurpak", for example, <LurPak.co.uk> (created on May 13, 1997), <LurPak-Butter.com> (created on September 10, 2010), <LurPak.com> (created on October 30, 1996) and <LurPakBreakfast.co.uk> (created on April 4, 2005). 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 disputed domain name <lurpakbutter.com> has been registered on August 7, 2021 and currently resolves to a parked page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant's contentions are the following:

The disputed domain name <lurpakbutter.com> is confusingly similar to the Complainant's earlier trademarks LURPAK.

The Complainant sustains that the disputed domain name incorporates, in its second-level portion, the Complainant's trademark LURPAK in combination with a generic term "butter", which is closely related to the Complainant's business activities under the brand LURPAK.

The Complainant underlines that 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 (see *Minerva S.A. v. Domain Administrator, Fast Serv Inc. d.b.a. QHoster.com*, WIPO Case No. D2019-2767 and *Bouygues Travaux Publics v. Christian Gazaigues*, CAC Case No. 101690).

The Complainant asserts that the generic Top-Level Domain ".com" in the second-level portion 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 (see *Arcelormittal S.A v. James*, supra and *Credit Mutuel Arkea v. Domain Administration*, CAC Case No. 102345).

Thus, the Complainant asserts that the disputed domain name is confusingly similar to the Complainant's LURPAK trademarks.

Further, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

To this end, the Complainant underlines that the disputed domain name was registered on August 7, 2020, many years after the first registrations of the Complainant's LURPAK trademarks.

The Complainant asserts 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.

The Complainant mentioned that he sent the Respondent a cease-and-desist letter on December 24, 2020, notifying it the potential violation of the Complainant's rights and requesting a voluntary transfer of the disputed domain name. The Respondent replied on the same day, claiming to be Arla distributor and that it had "permission from Arla to list the Arla brands on our websites so we can promote these to our customers; we didn't list these brands before consulting Arla."

The Complainant also mentioned that the Respondent also mentioned that:

"Please note we did seek permission before we started uploading the Arla products onto our websites and there were no objections [...]" and that

"no objections" does not necessarily mean that the Respondent has had the Complainant's permission to register and use the disputed domain name. The Complainant asserts that the Respondent did not provide any evidence that the registration and use of the disputed domain name has been authorized.

Further, the Complainant mentions that, according to the Respondent, the reason why it registered the disputed domain name was to avoid customers being "distracted" by its other products on its official website <http://www.ukfrozenfood.com/>.

The Complainant also asserts that, on its official website, the Respondent has not mentioned that the LURPAK products were sold on a separate domain name, nor did the Respondent inform the public that the LURPAK products were sold separately on the disputed domain name.

Also, it mentioned that the Respondent also claimed that:

"We have made it very clear on www.lurpakbutter.com and co.uk that we are a distributor of these products and not the manufacturer or the original website; you can see this at the bottom of each landing page; [...]"

Further, the Complainant asserts that on the website associated to the disputed domain name ("the Website"), as captured by the Complainant in 2020 by the time it sent the cease-and-desist letter, the logo LURPAK was displayed in prominent position and in the middle of the page it said "Our Products" with the LURPAK products listed beneath. Further below, the term that the Website used was "About UKFF Lurpak Butter", in large font size, prominent position. On the contrary, the disclaimer, "Please note this landing page belongs to UK Frozen Food (<http://www.ukfrozenfood.com/>) we are a distributor for these products, this is not the original brand website we are wholesalers reselling these products." was only displayed in very small font size and in black colour with dark background colour – almost invisible for general consumers. Thus, the Complainant sustains that it is not manifest for general consumers that the Website is not associated with / authorized by the Complainant and that, considering that the disclaimer is not clear and not sufficiently prominent, the so-called disclaimer cannot support the Respondent's good faith.

The Complainant also mentions that it wrote back to the Respondent on April 20, 2021, emphasizing that "our consent to listing our products DOES NOT entitle you to register or own domain names that include our brand names" and requested again a voluntary transfer of the disputed domain name.

The Respondent replied to the Complainant on April 30, 2021. In its response, it agreed to remove the content from the Website but insisted on keeping the disputed domain name as the disputed domain name “could generate tens of thousands in revenue for us in the future even without an active website” and that “we believe the long term potential of these domains could earn us significantly more”:

“Regarding domain transfers, we have every intention of opening our London depot in the next few weeks as we’re almost at the finishing line with the new warehouse and selling the Arla products and although you don’t want us to have brand specific landing pages with the Lurpak products on there, we do believe that the domains could generate tens of thousands in revenue for us in the future even without an active website on there so we wouldn’t be comfortable with transferring the domains to anyone or selling them as we believe the long term potential of these domains could earn us significantly more.”

Therefore, the Complainant mentions that the Respondent rejected the Complainant’s request of transfer and kept the disputed domain name for its own benefit, and not necessarily for the sales of the Complainant’s products, which is neither a bona fide offering of goods and services, nor making fair use of the disputed domain name.

Also, the Complainant underlines that the Respondent is not known by the disputed domain name or does not own any corresponding registered trademark including the terms “lurpakbutter.com” or “lurpakbutter”.

The Complainant asserts that when such conducted the search regarding the term “lurpakbutter.com” or “lurpakbutter” on popular Internet search engines such as “Google.com”, all the top results relate to the Complainant’s, it’s official websites and also third parties’ websites directly referring to the Complainant and when such conducted the search by the name of the Respondent (UK FROZEN FOOD LTD) along with the term “lurpakbutter”, there was no returned result showing the Respondent is known by the disputed domain name.

From the Complainant’s perspective, the Respondent deliberately chose to use the trademark LURPAK as the main part of the disputed domain name and has used the Disputed Domain Name to resolve to an active website selling the LURPAK butter products with the LURPAK logo in prominent position, very likely with the intention to benefit from the Complainant’s worldwide renown and to confuse Internet users as to the source or sponsorship, especially when the Complainant owns its official domain names LurPak.co.uk and LurPak-Butter.com, with which the disputed domain name are very similar. Therefore, the Complainant asserts that the Respondent’s registration and use of the disputed domain name cannot be considered as a bona fide offering of goods or services.

The Complainant also mentioned that by the time such prepared the amended Complaint in this case on October 7, 2021, the disputed domain name resolved to a parked page and that the Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

In addition, the Complainant asserts that, when Internet users, who search for information about the Complainant and/or about the brand LURPAK, see the disputed domain name and the error page, 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.

Therefore, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Further, the Complainant further asserts that the disputed domain name was registered and is being used in bad faith.

The Complainant mentions that it has never authorized the Respondent to register the disputed domain name and has not found that the Respondent has legitimate interest in the disputed domain name.

The Complainant contends that the Respondent registered the disputed domain name many years after the first

registrations of the Complainant's LURPAK trademarks and that LURPAK is a widely known trademark registered in many countries – including in the UK where the Respondent is located and the Complainant enjoys a strong online presence.

Further, the Complainant contends that the disputed domain name incorporates the Complainant's LURPAK trademark in combination with the term "butter", which clearly refers to the Complainant's business activities and products. In the Complainant's view, by registering the disputed domain name which is very similar in its structure to the Complainant's trademarks and domain names, the Respondent's intent was likely to mimic the Complainant's official domain names.

The Complainant asserts also that the fact that the Respondent insisted on keeping the disputed domain name as it "could generate tens of thousands in revenue for us in the future even without an active website" further demonstrates the Respondent's bad faith registration of the disputed domain name.

Therefore, in the Complainant's view, the Respondent knew the Complainant's trademark at the time it registered the disputed domain name and thus, it registered the disputed domain name in bad faith.

Further, the Complainant contends that, despite the cease-and-desist letter and the subsequent communications from the Complainant, the Respondent insisted on keeping the disputed domain name for the below reasons:

"Regarding domain transfers, we have every intention of opening our London depot in the next few weeks as we're almost at the finishing line with the new warehouse and selling the Arla products and although you don't want us to have brand specific landing pages with the Lurpak products on there, we do believe that the domains could generate tens of thousands in revenue for us in the future even without an active website on there so we wouldn't be comfortable with transferring the domains to anyone or selling them as we believe the long term potential of these domains could earn us significantly more."

Therefore, the Complainant asserts that, the fact that the Respondent, upon receiving notification from the Complainant and explicit rejection of the Complainant of it using the disputed domain name but still insisted on keeping the disputed domain name for its own benefit, demonstrates the Respondent's registration and use of the disputed domain name in bad faith.

Later on, the disputed domain name resolved to a parked page, which constitutes passive holding.

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

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

I. Confusing Similarity

The Panel agrees that the disputed domain name <lurpakbutter.com> is confusingly similar to the Complainant's earlier LURPAK trademarks. The disputed domain name incorporates entirely the Complainant's earlier LURPAK trademark and the addition of the generic term "butter", which is closely related to the Complainant's business activities under the brand LURPAK, is not sufficient to escape the finding that the domain name is confusingly similar to the Complainant's trademark and it does not change the overall impression of the designations as being connected to the trademark LURPAK.

Moreover, the extension ".com" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain name (WIPO Case No. D2005-0016, *Accor v. Noldc Inc.*). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, *L'Oréal v Tina Smith*, WIPO Case No. D2008-0820 *Titoni AG v Runxin Wang* and WIPO Case No. D2009-0877, *Alstom v. Itete Peru S.A.*).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Complainant has never licensed or authorised the Respondent to register the disputed domain name nor to make use of its LURPAK trademark in the disputed domain name.

From the evidence available in this case file, the disputed domain has been used in the past to resolve to a website that could have caused confusion among consumers who could have had the impression that such was authorized by the Complainant, when such was not. Moreover, after the Complainant's sending of a cease and desist letter, the Respondent agreed to remove the content from the website corresponding to the disputed domain name, but mentioned to keep the disputed domain name as such "could generate tens of thousands in revenue for us in the future even without an active website", so not for selling the Complainant's LURPAK products, and thus, the disputed domain name resolved to a parked page.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

The Complainant's LURPAK trademark is a well known trademark. The Respondent has chosen to register the domain name containing entirely to the Complainant's earlier LURPAK trademark with the addition of the generic term "butter", which is closely related to the Complainant's business activities under the brand LURPAK. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant's LURPAK trademark and has intentionally registered one in order to benefit from the reputation of the Complainant's trademark.

In the present case, the following factors should be considered:

(i) the Complainant's trademark is a well known one;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name containing entirely the Complainant's earlier LURPAK trademark with the addition of the generic term "butter", which is closely related to the Complainant's business activities under the brand LURPAK;

(iv) the Respondent was ever authorised to use a domain name similar to the Complainant's trademark;

(v) the disputed domain was used in the past to resolve to a website that could have caused confusion among consumers who could have had the impression that such was authorized by the Complainant, when such was not. Moreover, after the Complainant's sending of a cease and desist letter, the Respondent agreed to remove the content from the website corresponding to the disputed domain name, but mentioned to keep the disputed domain name as such "could generate tens of thousands in revenue for us in the future even without an active website", so not for selling the Complainant's LURPAK products, and thus, the disputed domain name resolved to a parked page.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. LURPAKBUTTER.COM: Transferred

PANELLISTS

Name	Delia-Mihaela Belciu
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DATE OF PANEL DECISION 2021-11-18

Publish the Decision
