

Decision for dispute CAC-UDRP-104716

Case number	CAC-UDRP-104716
Time of filing	2022-07-11 10:55:10
Domain names	arla-international.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Arla Foods Amba
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Complainant representative

Organization	BRANDIT GmbH
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Respondent

Name	Saeed Hernandez
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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 owns many registered trademarks including but not limited to:

- EUTM Registration No. 018031231 for ARLA registered on 6 September, 2019;
- Danish national registered mark for ARLA FOOD No. VR 2000 01185, registered on 6 March, 2000;
- UK national Trademark Registration No. UK00002413775 registered on August 4, 2006;
- UK national Trademark Registration No. UK00002497944 registered on February 13, 2009;
- national trademark registration in China for ARLA FOODS No. 5174319, registered on March 21, 2009;
- International mark No. 731917, for ARLA, registered on 20 March, 2000 including China; and
- International mark No. 990596, for ARLA, registered on 8 September, 2008 including China.

It also owns many other registered marks internationally.

The Complainant also owns many domain names containing the trademark ARLA, among them: <arla.com> (registered July 15, 1996), <arla.eu> (registered June 1, 2006), <arlafoods.com>, <arlafoods.co.uk> (registered October 1, 1999) and

<arlafoods.ca> (registered November 29, 2000).

The Complainant uses these domain names to resolve to its official websites through which it informs Internet users and potential consumers about its ARLA mark and its products and services.

FACTUAL BACKGROUND

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

The Complainant, Arla Foods, is the fifth-largest dairy company in the world and a cooperative owned by more than 12,500 Danish and Swedish dairy farmers, since 2000. It employs 119,190 people across 105 countries and had a global revenue of EUR 10,6 billion for the year 2020.

Its products are famous and are household names including the brands ARLA®, LURPAK®, CASTELLO®, APETINA® and others.

Arla Foods Amba has a strong and established presence in Asian dairy market. It has offices in China, Bangladesh, Malaysia, Hong Kong, Indonesia, Japan, Philippines and others. Despite COVID-19, in 2020 in South East Asia increased revenue. Overall, revenue totalled EUR 171 million, unchanged from last year.

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

The disputed domain name was registered on May 30, 2022 by the Respondent. On June 8, 2022 a cease and desist letter was sent by the Complainant's representative to the Respondent via the Registrar. There was no response. The disputed domain name is parked and displays the name Arla Foods Amba in various ways.

Nothing is known of the Respondent except that he is UK resident.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

In accordance with Paragraph 4 (a)(i) of the Uniform Dispute Resolution Policy (the "Policy"), in an administrative proceeding the complainant must prove that (i) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no right 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) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

The Complainant owns numerous ARLA® trademarks registered many years before the disputed domain name <arla-international.com> was created (on May 30, 2022).

The disputed domain name incorporates, in its second-level portion, Complainant's trademarks ARLA® entirely with addition of the descriptive term "international" separated by hyphen. The term "international" directly refers to the Complainant and their business being international company.

Previous UDRP panels have constantly held that the mere addition of a descriptive term – such as "international" – 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 Gazon, CAC Case No. 101690).

Furthermore, 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).

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

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

The disputed domain name was registered on May 30, 2022, many years after the first registration of the Complainant’s ARLA® trademark.

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 or the Respondent’s website.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademark including the terms “arla-international.com” or “arla-international”:

When conducting the search regarding the term “arla-international.com” or “arla-international” on popular Internet search engines such as “Google.com” all the top results relate to the Complainant, its official websites and also third parties’ websites – directly referring to the Complainant.

When conducting searches on online trademark databases, no information is found in relation with trademarks corresponding to the terms “arla-international”.

When conducting the search with the name of the Respondent along with the terms of disputed domain name there are no relevant results that would show that the Respondent is known by the disputed domain name.

When conducting the search with the e-mail of the Respondent along with the terms of the disputed domain name there are no relevant results that would show that the Respondent is known by the disputed domain name.

At the time the Complainant found out about the disputed domain name and sent Cease and Desist Letter (June 2022) the disputed domain name used to resolve to Pay Per Click Page displaying links such as: “Pastasalat”, “Kok”, “Hotels for Large Groups”.

At the time of filing of the complaint the disputed domain name resolved to an active Pay Per Click Page displaying the links directly referring to the Complainant, such as: “Arla Foods Headquarters”, “Arla Foods US”, “Arla Foods Denmark”, “Arla Foods Corporation.” Such use of the aforesaid disputed domain name creates a likelihood of confusion in Internet users’ mind and may lead them to click on sponsored links displayed on the PPC page, action which generates revenues for the Respondent. Previous UDRP Panels have held that “the presence of pay-per-click advertising on the website at the disputed domain name, including in a way that appears to relate to the Complainant, points towards bad faith” (see Vivendi v. James H Park, CAC Case No. 102073 and Boehringer Ingelheim Pharma GmbH & CO.KG v. Ruthann Halay, CAC Case No. 101200).

Also, in similar circumstances panels have stated “The Respondent’s use of the Domain Name for a parking page displaying sponsored links for a variety of goods and services, including for goods and services for which the Complainant’s trademarks have been registered, cannot constitute a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name, as the Respondent is unduly profiting from the trademark value attached to the Complainant’s trademarks. Indeed, prior panels deciding under the Policy have held that pay-per-click (“PPC”) parking

pages built around a trademark (as opposed to PPC pages built around a dictionary word and used only in connection with the generic or merely descriptive meaning of the word) do not constitute a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy, nor do they constitute a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii). See *Ustream.TV, Inc. v. Vertical Axis, Inc*, WIPO Case No. D2008-0598. See also paragraph 2.6 of the WIPO Overview 2.0.” (*Fontem Holdings 4, B.V. v. J- B-, Limestar Inc.*, WIPO case No. D2016-0344).

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” (see *Bollore v. Tywonnia W Hill*, WIPO Case No. DCO2017-0012).

Moreover, the Respondent’s identity is not disclosed on the publicly available Registrar’s WHOIS regarding the disputed domain name <arla-international.com>. The Respondent is using a privacy shield. Hence, the Respondent is most likely aiming at hiding its identity rather than being known by the disputed domain name.

In addition, the Complainant tried to reach the Respondent by sending cease and desist letter June 8, 2022 by contacting abuse contact of the Registrar and filing in online form at the web-site of the Registrar. There was no response from the Respondent. The Respondent has been granted opportunity to present some compelling arguments that it has rights or legitimate interests in the disputed domain name but has failed to do so. This behaviour coupled with the absence of use of the disputed domain name in connection with a bona fide offering of goods and services further demonstrate the Respondent’s absence of rights or legitimate interests in respect of the disputed domain name.

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

Registration of the disputed domain name in bad faith

The Respondent registered the disputed domain name many years after the first registrations of the Complainant’s ARLA trademarks. The ARLA trademark is a widely known trademark, as previously held by UDRP Panels (see *Arla Foods Amba v. Fredrik Enghall*, WIPO Case No. D2016-1205 and *Arla Foods Amba v. Nashan*, CAC Case No. 101486), registered in many countries – including in UK where the Respondent seems to be located and the Complainant enjoys a strong online presence. The Complainant is also very active on social media (Facebook and Twitter) to promote its mark, products and services. The Complainant is followed by 1,192,118 people on Facebook and 1,762 people on Twitter (See, *Laboratoires M&L v. Zhaoxingming*, CAC Case No. 102277).

By conducting a simple online search regarding the terms “arla-international” and “arla-international.com”, the Respondent would have inevitably learnt about the Complainant, its trademark and business (see *Intesa Sanpaolo S.p.A. v. Abayomi Ajileye*, CAC Case No. 102396). Moreover, as stated above, when searching for the term “arla-international.com” online, all the top results relate to the Complainant.

Further, the disputed domain name incorporates, in its second-level portion, Complainant's trademarks ARLA® with addition of the descriptive term “international”. Therefore, it is a direct reference to the Complainant’s business - fifth largest in the world dairy producers having strong international presence. It is evident that the Respondent have 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 he registered the disputed domain name.

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

Use of the disputed domain name in bad faith

Paragraph 4(b)(iv) of the Policy reads “by using the domain name, you have intentionally attempted to attract, for

commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location".

As mentioned previously the disputed domain name has been resolving to Pay Per Click Pages.

At the time the Complainant found out about the disputed domain name and sent Cease and Desist Letter (June 2022) it resolved to Pay Per Click Page displaying links such as: "Pastasalat", "Kok", "Hotels for Large Groups".

At the time of filling of this complaint the disputed domain name resolves to an active Pay Per Click Page displaying the links directly referring to the Complainant, such as: "Arla Foods Headquarters", "Arla Foods US", "Arla Foods Denmark", "Arla Foods Corporation".

PPC pages aim at generating revenues by diverting Internet traffic to sponsored links. PPC pages generate revenues when Internet users click on the links displayed on the page. Where such links are based on trademark value, UDRP panels have tended to consider such practices generally as unfair use resulting in misleading diversion" (see Camilla Australia Pty Ltd v. Domain Admin, Mrs Jello, LLC, WIPO Case No. D2015-1593).

As previously mentioned, previous UDRP Panels have held that "the presence of pay-per-click advertising on the website at the disputed domain name, including in a way that appears to relate to the Complainant, points towards bad faith" (see Vivendi v. James H Park, CAC Case No. 102073 and Boehringer Ingelheim Pharma GmbH & CO.KG v. Ruthann Halay, CAC Case No. 101200).

Moreover, the disputed domain name incorporates, in its second-level portion, Complainant's well-known trademark ARLA in its entirety along with the descriptive term "international" directly related to the Complainant's business. Such structure of disputed domain name is very likely to create a likelihood of confusion among Internet users who seek for products or services of the Complainant.

WIPO Jurisprudential Overview 3.0., paragraph 3.1.4 states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

In addition, the Complainant tried to contact the Respondent on November June 8, 2022 through a cease-and-desist letter regarding the disputed domain name. The Respondent chose not to reply to the cease and desist letters sent by the Complainant which infers bad faith (see International Business Machines Corporation v. Adam Stevenson, Global Domain Services, WIPO case No. D2016-1695; Carrefour v. PERFECT PRIVACY, LLC / Milen Radumilo, WIPO Case No. D2018-2201).

RESPONDENT:

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

A complainant's burden is set out in the UDRP Policy at paragraph 4(a) and he must prove all three limbs in relation to a respondent's registered domain name: namely, the (i) ..domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) [respondent has] ..no rights or legitimate interests in respect of the domain name; and (iii) ..domain name has been registered and is being used in bad faith.

There can be no question that here the Complainant has Rights in a name or mark identical or confusing similar for the first limb of the Policy, paragraph 4(a)(i). The Complainant has a national mark in its home country of Denmark, an EUTM and two international registrations, both of which include the designation of China, as well as two UK marks where the Respondent resides.

The Complainant is famous, as are its main branded products, LURPAK and CASTELLO. It is one of the largest dairy companies in the world and has been in trade in its current form since 2000. Its goods are sold worldwide.

The disputed domain name <arla-international.com> incorporates, in its entirety the Complainant's trademark ARLA with the additional generic word international.

The ARLA mark is clearly recognizable in the disputed domain name. This is impersonation.

The addition of the generic term does not dispel the confusing similarity of the disputed domain name to the Complainant's marks, and is strongly evocative of typosquatting" (see Arla Foods Amba v. Michael Guthrie, M. Guthrie Building Solutions, WIPO Case No. D2016-2213). See also LinkedIn Corporation v. Daphne Reynolds, WIPO Case No. D2015-1679) and 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 Gazon, CAC Case No. 101690). The Complainant has discharged its burden under the first limb.

As to the second limb under paragraph 4(a)(ii) of the Policy, the Complainant must, in order to discharge its burden on this element, show a prima facie case that the Respondent is not known by the name or mark nor makes a bona fide offering under it. See Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO Case No. D2003-0455. Here, there is no evidence that the Respondent is known by the disputed domain name.

Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. See Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com.> Here it is not similar. There is also no other "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" (see Bollore v. Tywonina W Hill, WIPO Case No. DCO2017-0012). The Panel has drawn the appropriate inferences and finds the Complainant has discharged its burden and there is no rebuttal.

Finally, as to Bad Faith registration, the WIPO Overview version 3.0, paragraph. 3.1.4 states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Previously panels also stated the following: "..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" (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

As to Bad Faith use, this is also a case of passive holding and/or parking and pay per click advertising. That is not bad faith

per se, but it is highly fact sensitive and all the circumstances of the case are relevant. The overview says these factors should be considered: “..panellists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine 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.”

Previous UDRP panels have held that “the presence of pay-per-click advertising on the website at the disputed domain name, including in a way that appears to relate to the Complainant, points towards bad faith” (see Vivendi v. James H Park, CAC Case No. 102073 and Boehringer Ingelheim Pharma GmbH & CO.KG v. Ruthann Halay, CAC Case No. 101200).

The Panel finds that bad faith is made out.

The Complainant has discharged its burden on all three limbs of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. ARLA-INTERNATIONAL.COM: Transferred

PANELLISTS

Name	Victoria McEvedy
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DATE OF PANEL DECISION	2022-08-16
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Publish the Decision