

Decision for dispute CAC-UDRP-105010

Case number **CAC-UDRP-105010**

Time of filing **2022-11-23 09:40:27**

Domain names **arla-ltd.com**

Case administrator

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

Complainant

Organization **Arla Foods Amba**

Complainant representative

Organization **BRANDIT GmbH**

Respondent

Name **Kawashige Tsubasa**

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 owner of trademark registrations for ARLA such as but not limited to:

- International trademark ARLA No. 731917, registered on March 20, 2000, designating Japan;
- International trademark ARLA (with a device) No. 990596, registered on September 8, 2008, designating Japan; and
- Danish trademark ARLA FOODS No. VR 2000 01185, registered on March 6, 2000.

FACTUAL BACKGROUND

The Complainant is the fifth-largest dairy company in the world and a cooperative owned by more than 12,500 dairy farmers. The Complainant was constituted in 2000, when the largest Danish dairy cooperative MD Foods merged with its Swedish counterpart Arla ekonomisk Förening. The Complainant employs 119,190 people across 105 countries and reached a global revenue of EUR 11,2 billion for the year 2021. The Complainant's 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 has active presence in Japan, where the Respondent is located. Namely, the Complainant is operating via its entity in Japan - Arla Foods Japan and Arla Foods

Ingredients, Japan K.K. (Tokyo). 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 disputed domain name was registered on July 26, 2022.

PARTIES CONTENTIONS

COMPLAINANT:

i) The Complainant has rights in international trademark ARLA No. 731917, registered on March 20, 2000, designating Japan; international trademark ARLA No. 990596, registered on September 8, 2008 designating Japan; and Danish trademark ARLA FOODS No. VR 2000 01185, registered on March 6, 2000. The disputed domain name is confusingly similar to the Complainant's ARLA mark.

ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent is not affiliated to the Complainant in any form; the Complainant has never granted the Respondent with any rights to use the ARLA trademark in any forms, including the disputed domain name; the Respondent is not commonly known by the disputed domain name; the disputed domain name has not resolved to any active page and resolved to an error page with the message "403 Forbidden"; and no response to the Complainant's cease and desist letter 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 Respondent has registered and is using the disputed domain name in bad faith: the Respondent has registered and used the disputed domain name with actual knowledge of the Complainant's rights in the ARLA mark; the disputed domain name has resolved to an error page, and such a passive holding constitutes bad faith registration and use of the disputed domain name; and the Respondent chose not to reply to the cease-and-desist letters sent by the Complainant which infers bad faith.

RESPONDENT:

No administratively compliant response has been filed. The Respondent contacted CAC administrative center with request for assistance. The Respondent was able to access and log in to the online platform but was unable to reach the case file. Case administrator provided the Respondent information how to access the case file. The Respondent did not reply to the email nor filled in the response form.

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

Preliminary Issue: Language of the Proceedings

The Panel notes that the Registration Agreement is written in Japanese, thereby making the language of the proceedings in Japanese. The Complainant has requested that the proceeding should be conducted in English. The Panel has the discretion under UDRP Rule 11(a) to determine the appropriate language of the proceedings taking the particular circumstances of the administrative proceeding into consideration. See Section 4.5, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition; see also Lovehoney Group Limited v yan zhang, CAC 103917 (CAC August 17, 2021) (finding it appropriate to conduct the proceeding in

English under Rule 11, despite Japanese being designated as the required language in the registration agreement).

The Complainant contends that (i) the disputed domain name incorporates, in its second level portion, the Complainant's ARLA trademark entirely, with the addition of the term "Ltd" which is known abbreviation of a very common noun in English "limited," and using such term in the second level portion of the domain name shows that the Respondent understands English and has intended, by registering such domain name, to target English speaking Internet users; (ii) the Complainant is a global company, originally founded in Denmark, having its website at "arla.com" displayed in the English language, and it appears that the Respondent is located in Japan, and the English language, being commonly used internationally, would be considered as neutral for both parties in the present case, and thus it would be fair to the parties that the language of the present proceeding be English; and (iii) a translation of the complaint in Japanese would entail significant additional costs for the Complainant and delay in the proceedings.

Pursuant to UDRP Rule 11(a), the Panel finds that persuasive argument has been adduced by the Complainant. After considering the circumstance of the present case, in the absence of the Response, Respondent's communication in English via email and no objection to the Complainant's request for the language of proceeding, the Panel decides that the proceeding should be in English.

The Panel is satisfied that all other 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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

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

(3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights

The Complainant claims rights in the marks ARLA and ARLA FOODS as identified in the section 'Identification of Rights' above. The Panel notes that an international trademark registration and a national trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the marks ARLA and ARLA FOODS.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark because the disputed domain name <arla-ltd.com> incorporates the Complainant's mark in its entirety with the addition of the term "Ltd" and the ".com" gTLD. The Panel notes that the use of a mark in its entirety with the mere addition of a hyphen, the descriptive term "Ltd" which is known abbreviation for "limited" and normally indicates the legal form of the entity - Limited Liability company, and the ".com" gTLD fails to sufficiently distinguish the disputed domain name from the Complainant's mark for the purposes of paragraph 4(a)(i) of the Policy. See *Marquette Golf Club v. Al Perkins*, FA 1738263 (FORUM July 27, 2017) ("When a respondent's domain name incorporates a mark in its entirety and merely adds a generic top-level domain (gTLD), ".com", then the Panel may find that the disputed domain name is identical to Complainant's mark."); see also *Health Devices Corporation d/b/a Doc Johnson Enterprises v. Aspen S T C*, FA158254 (Forum July 1, 2003) ("The addition of punctuation marks such as hyphens is irrelevant in the determination of confusing similarity pursuant to paragraph 4(a)(i) of the Policy."). Therefore, the Panel finds that the disputed domain name is confusingly similar to Complainant's ARLA mark.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM

Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent is not affiliated to the Complainant in any form; the Complainant has never granted the Respondent with any rights to use the ARLA trademark; and the Respondent is not commonly known by the disputed domain name. Where a response is lacking, WHOIS information may be used to determine whether a respondent is commonly known by the disputed domain name under Policy paragraph 4(c)(ii). See *State Farm Mutual Automobile Insurance Company v. Dale Anderson*, FA1504001613011 (Forum May 21, 2015) (concluding that because the WHOIS record lists "Dale Anderson" as the registrant of the disputed domain name, the respondent was not commonly known by the <statefarmforum.com> domain name pursuant to Policy paragraph 4(c)(ii)). Additionally, lack of authorization to use a complainant's mark may indicate that the respondent is not commonly known by the disputed domain name. See *Alaska Air Group, Inc. and its subsidiary, Alaska Airlines v. Song Bin*, FA1408001574905 (Forum Sept. 17, 2014) (holding that the respondent was not commonly known by the disputed domain name as demonstrated by the WHOIS information and based on the fact that the complainant had not licensed or authorized the respondent to use its ALASKA AIRLINES mark). The Panel notes that the WHOIS information for the disputed domain name lists the registrant as "Kawashige Tsubasa." Additionally, there is no evidence to suggest that the Respondent was authorized to use Complainant's mark in the disputed domain name. Therefore, the Panel finds the Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).

The Complainant further argues that the Respondent does not use the disputed domain name for any *bona fide* offering of goods or services, nor for any legitimate non-commercial or fair use. The Complainant specifically points out that the disputed domain name remains inactive.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant contends that the disputed domain name has resolved to an error page, and such a passive holding constitutes bad faith registration and use of the disputed domain name. The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith.). The particular circumstances of this case that the Panel has considered are:

i) The Complainant is the fifth-largest dairy company in the world and a cooperative owned by more than 12,500 dairy farmers. The Complainant was constituted in 2000, when the largest Danish dairy cooperative MD Foods merged with its Swedish counterpart Arla ekonomisk Förening. The Complainant employs 119,190 people across 105 countries and reached a global revenue of EUR 11,2 billion for the year 2021. The Complainant's 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. The Complainant has active presence in Japan, where the Respondent is located. Namely, the Complainant is operating via its entity in Japan - Arla Foods Japan and Arla Foods Ingredients, Japan K.K. (Tokyo). 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's ARLA mark enjoys a high degree of renown around the world; and

ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith registration and use per paragraph 4(b) (iii) and (iv) under Policy.

The Complainant further contends that the Respondent has registered and used the disputed domain name with actual knowledge of

the Complainant's rights in the ARLA mark and the Respondent chose not to reply to the cease-and-desist letters sent by the Complainant which infers bad faith.

While constructive knowledge is insufficient for a finding of bad faith, per Policy paragraph 4(a)(iii), registration of an infringing domain name with actual knowledge of another's trademark rights is sufficient to establish bad faith, and can be shown by the notoriety of the mark and the use Respondent makes of the disputed domain name. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum February 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding Policy paragraph 4(a)(iii) bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it."); see also AutoZone Parts, Inc. v. Ken Belden, FA 1815011 (Forum December 24, 2018) ("Complainant contends that Respondent's knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii)."). The Panel agrees and infers, due to the notoriety of the Complainant's mark around the world and in Japan where the Respondent resides that the Respondent had actual knowledge of the Complainant's rights in its mark ARLA at the time of registering the disputed domain name, and thus the Panel finds the bad faith registration of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **arla-ltd.com**: Transferred

PANELLISTS

Name	Mr. Ho-Hyun Nahm Esq.
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DATE OF PANEL DECISION 2023-01-02

Publish the Decision