Decision for dispute CAC-UDRP-106289

Case number	CAC-UDRP-106289
Time of filing	2024-02-23 09:11:23
Domain names	customerservicerussellstover.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Chocoladefabriken Lindt & Sprüngli AG

Complainant representative

Organization	SILKA AB

Respondent

Organization	Fundacion Comercio Electronico

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 following trademarks:

- United States national trademark “RUSSELL STOVER”, no. 739454, registered on 16 October, 1962, for goods in class 30;
- International trademark registration “RUSSELL STOVER”, no. 1243266, registered on 28 January, 2015, having several jurisdictions designated for protection, for goods and services in classes 29, 30, 35, 43;
- European Union trademark “RUSSELL STOVER”, no. 004342077, registered on 28 April, 2006, for goods and services in classes 30 and 35;
- Canadian national trademark “RUSSELL STOVER”, no. TMA442500, registered on 05 May, 1995, for goods in class 30;
- Mexican national trademark “RUSSELL STOVER”, no. 421292, registered on 4 September, 1992, for goods in class 30.

FACTUAL BACKGROUND

The Complainant, founded in 1845, is a well-known chocolate maker based in Switzerland. As a leader in the market of premium quality chocolate, the Complainant has 11 production sites in Switzerland, Europe and the United States and its more than 2,500 products are distributed via 28 subsidiaries, 500 own retail shops and a comprehensive network of more than 100 distributors in over 120 countries. The Complainant has more than 14 thousand employees and made a revenue of CHF 5.2 billion in 2023. Over the years, the Complainant has expanded its brand portfolio abroad and acquired chocolate businesses including Hofbauer and

Küfferle (1994), Caffarel (1997), Ghirardelli (1998) and Russell Stover (2014).

The Complainant acquired United States-based Russell Stover Candies, LLC („Russell Stover") in 2014. This acquisition was covered by many popular online news outlets.

Russell Stover was established in 1923 in Denver, Colorado, and has been headquartered in Kansas City, Missouri, since 1932. Russell Stover changed its company name to Rusell Stover Candies in 1943 (having previously been known as Mrs. Stover's Bungalow Candies). Russell Stover chocolates are made in the United States across three factories and are available at 13 retail locations. The Russel Stover division of the Complainant made sales of USD 377 million in 2022.

The Complainant is the owner of several trademarks for RUSSELL STOVER, covering several jurisdictions around the world, such as the United States national trademark "RUSSELL STOVER", no. 739454, the international trademark registration "RUSSELL STOVER", no. 1243266, the European Union trademark "RUSSELL STOVER", no. 004342077, the Canadian national trademark "RUSSELL STOVER", no. TMA442500, the Mexican national trademark "RUSSELL STOVER", no. 421292, (all cited above).

The Complainant advertises and sells its offerings online from the website www.russellstover.com, the domain of which was registered in 1996. The Complainant also holds the domain name <russellstover.net> (registered in 2010) and <russellstover.us> (registered in 2014).

The disputed domain name <customerservicerussellstover.com> was registered on 24 March, 2023 and as per the evidence available in the file, at the time when the complaint was filed, the website associated with the disputed domain name redirected internet users to random unconnected sites, many of which appear to be associated with malicious content/software. In addition, according to the evidence filed by the Complainant, the Respondent has configured the disputed domain name with an MX (mail exchange) record, thus, it can be used to send and receive emails.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

The Complainant's contentions are the following:

The disputed domain name <customerservicerussellstover.com> is confusingly similar to the Complainant's trademark RUSSELL STOVER, that the Respondent lacks rights or legitimate interests in the disputed domain name for a number of reasons and that the disputed domain name was registered and is being used 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

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1. Confusing Similarity

The Panel agrees that the disputed domain name <customerservicerussellstover.com> is confusingly similar to the Complainant's earlier trademark RUSSELL STOVER. The disputed domain name <customerservicerussellstover.com> includes in its entirety the Complainant's earlier trademark RUSSELL STOVER preceded by the term “customer service”, which is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant’s earlier trademark and it does not change the overall impression of the designation as being connected to the trademark RUSSELL STOVER, the earlier trademark of the Complainant RUSSELL STOVER being recognizable within the disputed domain name.

Where the relevant trademark is recognizable within the disputed domain name, as this is the case, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”), point 1.8).

Moreover, the extension “.com” is not to be taken into consideration when examining the similarity between the Complainant’s trademark 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.

2. 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 disputed 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 UDRP.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name as such is not identified in the WHOIS database as the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of a confusingly similar trademark in the disputed domain name.

The disputed domain name <customerservicerussellstover.com> which includes in its entirety the Complainant's earlier trademark RUSSELL STOVER preceded by the term “customer service”, carries a high risk of implied affiliation. Internet users are highly likely to believe, upon seeing the string that, the disputed domain name is controlled and/or used by the Complainant (or an authorised agent of such) in connection with its customer services operations. (WIPO Jurisprudential Overview 3.0, point 2.5.1)

In addition, based on the available evidence, at the time when the complaint was filed, the website associated with the disputed domain name redirected internet users to random unconnected sites, many of which appear to be associated with malicious content/software. In addition, according to the evidence filed by the Complainant, the Respondent has configured the disputed domain name with an MX (mail exchange) record, thus, it can be used to send and receive emails. Past panels have categorically held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent. (WIPO Jurisprudential Overview 3.0, point 2.13.1)

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.

3. Bad Faith

Based on the available evidence, the Complainant's trademarks RUSSELL STOVER were registered prior to the disputed domain name. Additionally, based on the available evidence, the top results from a basic Google search of “russell stover” term clearly pertain to the Complainant’s offerings . Thus, the Respondent has chosen to register the disputed domain name in order to create a confusion with such trademark. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant’s earlier trademarks and has intentionally registered one in order to create confusion with such trademarks.

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

(i) the Complainant's trademarks predate the registration date of the disputed domain name;

(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 which includes in its entirety the Complainant's earlier trademark RUSSELL STOVER preceded by the term “customer service”;

(iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name similar to the Complainant's trademark;

(vi) the website associated with the disputed domain name redirected, at the time when the complaint was filed, internet users to random unconnected sites, many of which appear to be associated with malicious content/software. In addition, according to the evidence filed by the Complainant, the Respondent has configured the disputed domain name with an MX (mail exchange) record, thus, it can be used to send and receive emails, where there is no relationship with the Complainant.

Considering the above, in the Panel’s view, it is inconceivable that the Respondent is able to make any good faith use of the disputed domain name.

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. **customerservicerussellstover.com**: Transferred

PANELLISTS

Name	**Delia-Mihaela Belciu**

DATE OF PANEL DECISION 2024-04-02

Publish the Decision