Decision for dispute CAC-UDRP-106318

Case number	CAC-UDRP-106318
Time of filing	2024-03-04 09:45:38
Domain names	us-lactalics.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Groupe Lactalis

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Law Offices of Nantha Associates

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides relevant evidence, that it owns a number of registrations for trademarks that consist of "LACTALIS," including EU Reg. No. 1,529,833 for LACTALIS (registered November 7, 2002); Int'l Reg. No. 900,154 for LACTALIS (registered July 27, 2006); and U.S. Reg. No. 6,824,877 for LACTALIS (registered on August 23, 2022) (the "LACTALIS Trademark").

FACTUAL BACKGROUND

Complainant states that it is "a French multi-national company, engaged in the food industry, particularly the dairy sector"; that it is "the largest dairy products group in the world, with over 85,500 employees, 266 production sites, and a presence in over 51 different countries"; that it "has traded under the name 'Lactalis' since 1999"; and that it "has a strong presence in the United States through its subsidiary LACTALIS AMERICAN GROUP."

The Disputed Domain Name was created on February 8, 2024, and, according to Complainant, is being used in connection with what appears to be a monetized parking, or pay-per-click ("PPC"), page, including a link labelled "Menu de la Semaine" (French for "Menu of the Week").

PARTIES CONTENTIONS

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that the Disputed Domain Name is confusingly similar to the LACTALIS Trademark because, inter alia, "the addition of the letter 'C' and the addition of the letters 'US' (for 'United States') are not sufficient to escape the finding that the domain name is confusingly similar to the trademark" because they "do[] not change the overall impression of the designation as being connected to the Complainant's trademark LACTALIS"; "the addition of the term 'US' may increase the risk of confusion as it directly refers to the Complainant's activities in the United States through its subsidiary LACTALIS AMERICAN GROUP"; and "the addition of the gTLD '.COM' does not change the overall impression of the designation as being connected to Complainant's trademark."

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Respondent is not identified in the WHOIS database as the disputed domain name"; "Respondent is not affiliated with nor authorized by LACTALIS Group in any way"; "[n]either licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark LACTALIS, or apply for registration of the disputed domain name by the Complainant"; and use of the Disputed Domain Name to "resolve[] to a parking page with commercial links… is not a bona fide offering of goods or services or legitimate non-commercial or fair use."

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, "given the distinctiveness of the Complainant's trademark and reputation, the Complainant can state that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trademark LACTALIS, and therefore could not ignore the Complainant"; by using the / Disputed Domain Name to "resolve[] to a parking page with commercial links[, …] the Respondent has attempt to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain"; and "MX servers are configured… which suggests that the disputed domain name may be actively used for email purposes."

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 UDRP).

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 UDRP).

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 UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the LACTALIS Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the LACTALIS Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., "us-lactalics") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is

disregarded under the first element confusing similarity test." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11.1.

Here, the Disputed Domain Name contains the LACTALIS in its entirety, simply adding an extra letter "c", the letters "us" and a hyphen. As set forth in section 1.9 of WIPO Overview 3.0: "A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element." And, as set forth in section 1.8 of WIPO Overview 3.0: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because, inter alia, "Respondent is not identified in the WHOIS database as the disputed domain name"; "Respondent is not affiliated with nor authorized by LACTALIS Group in any way"; "[n]either licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark LACTALIS, or apply for registration of the disputed domain name by the Complainant"; and use of the Disputed Domain Name to "resolve[] to a parking page with commercial links… is not a bona fide offering of goods or services or legitimate non-commercial or fair use."

WIPO Overview 3.0, section 2.1, states: "While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and, without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has 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 complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 registrant's website or location or of a product or service on the registrant's website or location.

WIPO Overview 3.0, section 3.1.3, 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." Here, as Complainant has noted, at least two previous panels have found that the LACTALIS Trademark is "well known." Groupe Lactalis v. paul Goodrich, WIPO Case No. D2022-2429 (transfer of <us-lactalis.com>); and Groupe Lactalis v. Contact Privacy Inc. Customer 1246860447 / Pietro Chirco, Pietro, WIPO Case No. D2020-1701 (transfer of <lactalis-fr.com>).

Further, numerous panels under the UDRP have found the registration and use of a domain name that is confusingly similar to a complainant's trademark to constitute bad faith pursuant to paragraph 4(b)(iv) of the UDRP where, as here, the domain name is associated with a monetized parking page that could be construed as associated with the complainant. See, e.g., Wal-Mart Stores, Inc. v. Whois Privacy, Inc., WIPO Case No. D2005 0850; Columbia Pictures Industries, Inc. v. North West Enterprise, Inc., WIPO Case No. D2006-0951; and Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service, WIPO Case No. D2011-1753.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **us-lactalics.com**: Transferred

PANELLISTS

Name	**Douglas Isenberg**

DATE OF PANEL DECISION 2024-04-09

Publish the Decision