Decision for dispute CAC-UDRP-106505

Case number	CAC-UDRP-106505
Time of filing	2024-05-02 11:34:59
Domain names	lactalisopexsupport.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Groupe Lactalis

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Lactalis SA

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 the trademark LACTALIS:

EUIPO trademark Reg. No. 1529833 registered on November 7, 2002;

French trademark Reg. No. 3908891 registered on March 28, 2012;

International trademark Reg. No. 900154 registered on July 27, 2006;

International trademark Reg. No. 1135514 registered on September 20, 2012; and

International trademark Reg. No. 1721957 registered on December 2, 2022.

FACTUAL BACKGROUND

Founded in 1933, the Complainant is a French multi-national company, engaged in the food industry, particularly the dairy sector. The Complainant has traded under the name “Lactalis” since 1999. LACTALIS 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.

The disputed domain name was registered on April 3, 2024, and redirects to a parking page. The disputed domain name has been set up with MX records.

PARTIES CONTENTIONS

COMPLAINANT:

(i) The Complainant has rights in the LACTALIS mark as identified in section “Identification of rights” above. The disputed domain name is confusingly similar to the Complainant's LACTALIS mark because it incorporates the Complainant’s mark LACTALIS merely adding the generic terms “OPEX” (a common business abbreviation for “operating expenses”) and “SUPPORT,” and the “.com” generic top-level domain (“gTLD”).

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent uses the identity of the Complainant’s subsidiary in order to increase the likelihood of confusion with the Complainant. The Respondent is not affiliated with nor authorized by LACTALIS Group in any way. The Respondent is not related in any way to Complainant’s business. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license 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. The Respondent does not use the disputed domain name for any bona fide offering of goods or services or legitimate noncommercial or fair use. Instead, the disputed domain name is not directed to an active website.

(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 LACTALIS mark. The Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name. The disputed domain name has been set up with MX records, which suggests that it may be actively used for email purposes.

RESPONDENT:

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 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

Rights

The Complainant contends that it is the owner of the registered trademark LACTALIS as identified in section “Identification of rights”

above. The Panel notes that a trademark registration with a national trademark agency and an international trademark organization is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark LACTALIS.

The Complainant further contends that the disputed domain name is confusingly similar to its mark LACTALIS on the grounds that the disputed domain name <**lactalisopexsupport.com**> incorporates the Complainant's mark LACTALIS merely adding the generic terms "OPEX" (a common business abbreviation for "operating expenses") and "SUPPORT," and the ".com" gTLD. The Panel agrees and finds that the disputed domain name is confusingly similar to the Complainant's LACTALIS mark under Policy paragraph 4(a)(i).

No rights or legitimate interests

A complainant must first make a prima facie case that a respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to the 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 has no rights or legitimate interests in respect of the disputed domain name. The Respondent uses the identity of the Complainant's subsidiary in order to increase the likelihood of confusion with the Complainant. The Complainant specifically points out that the disputed domain name was registered in the name of Complainant's South Africa subsidiary. However, the Respondent's email address is not affiliated with LACTALIS and the address used by the Respondent does not correspond to the Complainant's subsidiaries. The Respondent is not affiliated with nor authorized by LACTALIS Group in any way. The Respondent is not related in any way to Complainant's business. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license 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. The Panel agrees and finds that the Respondent is not commonly known by the disputed domain name.

Next, the Complainant contends that the Respondent does not use the disputed domain name for any bona fide offering of goods or services or legitimate noncommercial or fair use. Instead, the disputed domain name is not directed to an active website. The Panel is of the view that failure to make an active use of a website does not represent a bona fide offering of goods and services or a legitimate or fair use per Policy paragraph 4(c)(i) and (iii). See CrossFirst Bankshares, Inc. v Yu-Hsien Huang, FA 1785415 (Forum June 6, 2018) ("Complainant demonstrates that Respondent fails to actively use the disputed domain name as it resolves to an inactive website. Therefore, the Panel finds that the Respondent fails to actively use the disputed domain name for a bona fide offering of goods or services or legitimate noncommercial or fair use under Policy paragraph 4(c)(i) or (iii)."). The Complainant provides screenshot evidence of the resolving website. The Panel therefore finds the Respondent fails to use the disputed domain name in connection with a bona fide offering of goods and services or a legitimate or fair use per Policy paragraph 4(c)(i) and (iii).

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 Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active 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) Founded in 1933, the Complainant is a French multi-national company, engaged in the food industry, particularly the dairy sector. The Complainant has traded under the name "Lactalis" since 1999. LACTALIS 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. As such, the Complainant's mark LACTALIS is considered as being a well-known and reputable trademark;

(ii) The disputed domain name has been set up with MX records, which suggests that it may be actively used for email purposes by way of causing consumer confusion; and

(iii) 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 under Policy, paragraph 4(a)(iii) and that the Respondent is using the disputed domain name in bad faith.

The Complainant further contends that given the distinctiveness of the Complainant's trademark and reputation, the Respondent has registered the disputed domain name with knowledge of the Complainant's trademark LACTALIS, and therefore could not ignore the Complainant. The Panel notes that while constructive knowledge is insufficient for a finding of bad faith, per Policy paragraph 4(a)(iii), registration of a disputed 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 the 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 and the Respondent's use of the identity of the Complainant's subsidiary as the Registrant's name in registering the disputed domain name that the Respondent had actual knowledge of the Complainant's rights in its mark LACTALIS 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. **lactalisopexsupport.com**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2024-06-11

Publish the Decision