

ADMINISTRATIVE PANEL DECISION

Groupe Lactalis v. Privacy Service Provided by Withheld for Privacy ehf / ray jay, Ray deep llc
Case No. D2022-2288

1. The Parties

The Complainant is Groupe Lactalis, France, represented by Inlex IP Expertise, France.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / ray jay, Ray deep llc, United States of America.

2. The Domain Name and Registrar

The disputed domain name <calactalis.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 24, 2022. On June 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 24, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 29, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 1, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2022.

The Center appointed Theda König Horowicz as the sole panelist in this matter on August 16, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a multinational group having its headquarters in France, which was founded in 1933 and specializes in the food industry especially in the dairy industry.

The Complainant notably built its reputation by commercializing camembert cheese and the name Lactalis was adopted in 1999 when the group internationalized itself due to its worldwide success in the dairy field.

The Complainant's business name incorporates Lactalis. Indeed, the denomination Groupe Lactalis has been registered as the Complainant's company name since December 14, 1984.

Additionally, the Complainant owns several trademark registrations and domain names comprising LACTALIS, including the French trademark registration LACTALIS with logo as of March 20, 2018 under the No. 4438490; and the domain names <lactalis.com> and <lactalis.ca> were registered by the Complainant on January 9, 1999, and October 5, 2011, respectively.

The disputed domain name was registered on April 13, 2022. It redirects to a parking page of the Registrar, which displays links for cheese factories or cheese brands/sorts which are sold and/or belong to the Complainant. Some other links redirect websites of the Complainant's competitors.

On May 6, 2022, the Complainant sent a warning letter to the Respondent, which remained unanswered despite reminders of May 24 and May 31, 2022.

5. Parties' Contentions

A. Complainant

The Complainant contends to have rights in LACTALIS through its business name, trademark registrations and domain names, which have been registered since many years. According to the Complainant the disputed domain name <calactalis.com> refers on the one hand to Canada though its prefix "ca", and on the other hand to its LACTALIS trademark. LACTALIS would be the dominant element of the disputed domain name and thus be confusing as it gives the impression that the disputed domain name <calactalis.com> is the Canadian web presence of the Complainant while the Complainant's official website in Canada is <lactalis.ca>.

The Complainant also alleges that the Respondent has not registered Calactalis as a trademark or that it would have acquired rights in the said denomination. In particular, the Complainant notes that the disputed domain name was never activated as it resolves to an automatic parking page generated by the Registrar. It was also registered anonymously which is a further indication of lack of rights or legitimate interests. Furthermore, the Complainant has never authorized the Respondent or any other third party to register the disputed domain name which contains its LACTALIS trademark in entirety. Moreover, there is no business relationship between the Parties.

The Complainant states that the disputed domain name was registered in bad faith, notably considering the well-known character of the LACTALIS trademark and the strong worldwide reputation of the Complainant, which was acknowledged in several UDRP decisions. The Respondent could thus not ignore the Complainant's rights in LACTALIS when registering the disputed domain name. The concealment of the Respondent's identity is another indication of bad faith. Finally, the Respondent's identity disclosed by the

Registrar after the filing of the Complaint confirms that the Respondent is not known by the Complainant. In addition, searches confirm that the Respondent does not own registered trademark rights over CALACTALIS and no matching results were found on engines such as Google. The fact that the disputed domain name redirects to a parking page containing pay-per-click links either to products sold by the Complainant or to products from the Complainant's competitors is another indication of bad faith. The Complainant underlines that the disputed domain name disrupts its business. It also notes that emails have been activated for the disputed domain name, which means that the Respondent could send fraudulent emails from email addresses associated with the disputed domain name to clients and suppliers usurping the identity of the Complainant. The fact that the warning letter sent by the Complainant remained unanswered is another indication of bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under the Policy, in order to prevail, a complainant must prove the following three elements for obtaining the transfer of a domain name:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) that the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant showed to have trademark rights in LACTALIS through several registrations worldwide.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

The disputed domain name contains the LACTALIS trademark in entirety. The addition at the beginning of the disputed domain name of the letters "ca" which might have been chosen to refer to Canada, does not prevent confusing similarity, as the LACTALIS trademark (which is an invented and original trademark) remains recognizable in the disputed domain name.

Under these circumstances, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's mark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in the use of a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services;

(ii) being commonly known by the domain name; or

(iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made some submissions in order to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name, in particular that the Respondent is not known by the name Calactalis and that the registration of the disputed domain name was not authorized by the Complainant.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case and the burden of production shifts to the Respondent who has chosen not to reply.

The Panel notes that the case file does indeed not show that the Respondent is commonly known by the disputed domain name or by Calactalis or Lactalis.

The disputed domain name fully incorporates the Complainant's well-known LACTALIS trademark which has no specific significance and can be considered as having a strong distinctive character. It is therefore difficult to imagine that the disputed domain name legitimately includes the Complainant's trademark in the disputed domain name. As a matter of fact, it is more likely than not that the Respondent aimed at referring to the Complainant's trademark and business, for example to benefit from the pay-per-click links related to the parking page to which the disputed domain name is linked to.

In this frame, it is noted that the disputed domain name resolves to a parking page showing links to products and brands referring to the Complainant's dairy business. As decided in several UDRP decisions, the use of a domain name to host a parked page comprising pay-per-click links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark. See section 2.9 of the [WIPO Overview 3.0](#). Considering the well-known character of the LACTALIS brand, the worldwide presence of the Complainant and the absence of response to the Complainant's warning letters, it is most likely that the Respondent was planning to surf on the Complainant's notoriety.

Consequently, the Panel finds that the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel agrees that the trademark LACTALIS can be considered as a well-known trademark, based on the evidence provided in the case file.

The Respondent must thus have known about the LACTALIS trademark when registering the disputed domain name. See section 3.2.2 of the [WIPO Overview 3.0](#).

The Panel agrees with the Complainant that the bad faith use of the disputed domain name is supported by several findings, notably (i) the absence of any license or permission from the Complainant to use its well-known trademark, (ii) the fact that the disputed domain name points to a parking page displaying commercial links associated with the Complainant's field of activity, and (iii) the absence of response to the Complainant's warning letter.

Additionally, the absence of response in the present proceedings, the fact that the Respondent has hidden its identity by using a privacy service when registering the disputed domain name and the fact that the Respondent cannot be found when making simple searches on the Internet in combination with the denomination Calactalis are additional elements evidencing bad faith.

In light of the above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that the Complainant has established its case under paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <calactalis.com> be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: August 30, 2022