

ADMINISTRATIVE PANEL DECISION

Tetra Laval Holdings & Finances S.A. v. Whols Agent, Whols Privacy Protection Service, Inc. / Trupper Mexico
Case No. D2022-2490

1. The Parties

Complainant is Tetra Laval Holdings & Finances S.A., Switzerland, represented by Aera A/S, Denmark.

Respondent is Whols Agent, Whols Privacy Protection Service, Inc., United States of America (“United States”) / Trupper Mexico, Mexico.

2. The Domain Names and Registrar

The disputed domain names <plantatetrapak.com> and <seminuevostetrapak.com> (the “Domain Names”) are registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 8, 2022. On July 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On July 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on July 12, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 13, 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 Respondent of the Complaint, and the proceedings commenced on July 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 4, 2022.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on August 11, 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

Complainant is a Swiss corporation that is part of the Tetra Laval group. The Tetra Laval group consists of three independent industry groups: Tetra Pak, DeLaval, and Sidel Group. The Tetra Pak group is a multinational food processing and packaging company founded in 1947 in Sweden by Ruben Rausing. The Tetra Pak group develops, markets, and sells equipment for processing, packaging, and distribution of food products. Products such as dairy products, beverages, ice cream, cheese, food, vegetables, and pet food are processed and packaged in the processing and packaging lines of Tetra Pak. The Tetra Pak group is world leading within development, production, and sale of equipment and processing plants for making, packaging, and distributing foods and accessories. The Tetra Pak group employs more than 25,000 people and operates in more than 160 countries worldwide including the United States and Mexico.

Complainant owns the TETRA PAK trademark, which is registered both as a word mark and part of device marks in more than 160 countries throughout the world with more than 1,500 registrations, including:

- TETRA PAK, Swedish Regis. No. 71196, registered in 1951;
- TETRA PAK, United States Regis. No. 0580219, registered in 1953;
- TETRA PAK, United States Regis. No. 0586480, registered in 1954;
- TETRA PAK, European Union Regis. No. 1202522, registered in 2000; and
- TETRA PAK, International Regis. No. 1146433, registered in 2012.

Further, Complainant is the owner of more than 300 domain name registrations throughout the world containing the TETRA PAK mark distributed among generic Top-Level Domains (“gTLDs”) and country code Top Level Domains (“ccTLDs”).

The fame of the trademark TETRA PAK has been confirmed in previous UDRP cases, including *Tetra Laval Holdings & Finance S.A. v. TetraPak Global PH-AU, Gerald Smith*, WIPO Case No. [D2012-0847](#); *Tetra Laval Holdings & Finance S.A. v. Kilt Kully, Huy*, WIPO Case No. [D2019-0802](#); *Tetra Laval Holdings & Finance S.A. v. ddd Firat, Analiz*, WIPO Case No. [D2019-2864](#); *Tetra Laval Holdings & Finance S.A. v. Whols Agent (693439573), Whols Privacy Protection Service, Inc./ József Buda*, WIPO Case No. [D2020-3105](#); and *Tetra Laval Holdings & Finance S.A. v. WholsGuard Protected, WholsGuard, Inc. / Zetao Wang*, WIPO Case No. [D2021-0559](#).

The Domain Names were registered on May 12 and June 29, 2022, respectively. The Domain Names resolved to websites purporting to offer cars for sale, while displaying the TETRA PAK trademark in the picture of each car displayed on the websites.

5. Parties' Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant states that by virtue of its long use and the renown of its TETRA PAK trademark, the mark is associated exclusively with Complainant and its licensee Tetra Pak. Complainant submits that the reputation associated with Complainant's mark is excellent by virtue of the quality of Complainant's goods and services, and the TETRA PAK mark is undisputedly considered a well-known trademark within its field of business.

Complainant further asserts that the Domain Names are confusingly similar to its TETRA PAK trademark and trade name, as the Domain Names incorporate the entirety of the well-known TETRA PAK mark and trade name in combination with the words “planta” (English translation, “factory plant”) and “seminuevos” (English translation, “pre-owned”). Complainant contends the addition of these terms does not impact the overall impression of the dominant part of the name “tetrapak”. Consequently, the terms as prefix are not sufficient to overcome the confusing similarity with respect to Complainant’s TETRA PAK mark, which remains the dominant and only distinctive element in the Domain Names.

Complainant asserts that considering the brand awareness of the TETRA PAK trademark worldwide, an Internet user would most probably assume a connection with or endorsement from Complainant and its business when seeking information on the websites linked to the Domain Names, in particular when Complainant’s logo and trademark are being used without permission on Respondent’s websites.

Bearing in mind in particular the following factors, (a) the widespread reputation and high degree of recognition of Complainant’s TETRA PAK marks, and (b) the lack of distinguishing factors between the Domain Names and Complainant’s marks, Complainant submits the Domain Names should be considered as confusingly similar to the TETRA PAK mark in which Complainant has rights.

(ii) Rights or legitimate interests

Complainant contends that Respondent has no rights to or legitimate interests in the Domain Names, in view of Complainant’s continuous and long prior use of its TETRA PAK trademark and trade name. Respondent is not affiliated with or related to Complainant in any way, or licensed or otherwise authorized to use the TETRA PAK mark in connection with a website or for any other purpose. Respondent is not using the Domain Names in connection with any *bona fide* offering of goods or services, is not generally known by the Domain Names, and has not acquired any trademark or service mark rights in that name or mark. Respondent cannot have been ignorant of the rights held by Complainant and its business, in particular, when using Complainant’s logotypes and website layouts without Complainant’s permission.

Further, given the fact that Respondent has never been an authorized reseller, service provider, licensee, or distributor of Complainant, Respondent is not permitted to use Complainant’s trademark in the promotion of its products and services. On the other hand, the unauthorized use shows that Respondent is well aware of Complainant and hence is intentionally diverting consumers for commercial gain.

(iii) Registered and used in bad faith

Complainant contends that Respondent has intentionally registered and is using the Domain Names in bad faith. It is apparent from the composition of the Domain Names that Respondent must have known of Complainant’s TETRA PAK trademark and business. That being so, Respondent could not have chosen or subsequently used the word “tetrapak” in combination with “planta” and “seminuevos” for any reason other than to trade-off on the goodwill and reputation of Complainant’s trademark or otherwise create a false association, sponsorship, or endorsement with Complainant. Moreover, even a cursory Internet search at the time of registration of the Domain Names would have made clear to Respondent that Complainant had rights in its TETRA PAK trademark.

Complainant claims that in light of the unauthorized use of Complainant’s trademarks and illicit association, Respondent is deliberately disrupting the business of Complainant and intentionally attracting users for commercial gain. Respondent is seeking to create an impression of association with Complainant by registering the Domain Names including “tetrapak”, and using Complainant’s marks without permission on websites and social media.

Accordingly, in view of the well-known status of the TETRA PAK trademark and Complainant’s world-wide business including Mexico, Respondent was more likely than not aware of Complainant’s trademarks. The purpose of the registration of the Domain Names and the use of Complainant’s trademarks is to create an impression of an association with Complainant. Complainant has no business relationship with Respondent

and hence the unauthorized use of TETRA PAK is tarnishing the reputation of Complainant's mark. Moreover, the descriptive terms coupled with Complainant's TETRA PAK mark in the Domain Names are apt to increase the likelihood of confusion with Complainant's trademark since users, once they arrive at the websites, will see the TETRA PAK logo and listings of used cars, and may believe that the Domain Names are used by Complainant to promote and sell cars on the Mexican market. Consequently, Complainant submits that Respondent has registered and is using the Domain Names in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) Respondent has registered and is using the Domain Names in bad faith.

A. Identical or Confusingly Similar

The Panel determines Complainant has demonstrated that it has well-established rights in its TETRA PAK trademarks through registration and widespread use around the world.

The Panel further finds that the Domain Names incorporate the TETRA PAK mark in its entirety, while adding the terms "planta" (English translation, "factory plant") and "seminuevos" (English translation, "pre-owned"). The Panel determines that the addition of these terms does not prevent a finding of confusing similarity. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), which states that "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"; see also [WIPO Overview 3.0](#), section 1.8 ("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 the Domain Names are confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#) states, "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".

Here, the Panel determines that Complainant has made out a *prima facie* case, which Respondent has failed to rebut. The Panel finds that Complainant has not authorized Respondent to use Complainant's well-established TETRA PAK trademark; that Respondent is not commonly known by either of the Domain Names; that Respondent has not used the Domain Names for a legitimate noncommercial or fair use, nor

used them in connection with a *bona fide* offering of goods or services. Instead, the Domain Names have been used to connect to websites that purport to offer cars for sale, while displaying the TETRA PAK trademark in the picture of each car displayed on the websites. Moreover, the construction of the Domain Names themselves, consisting of the TETRA PAK trademark in its entirety, is such to carry a risk of implied affiliation that cannot constitute fair use. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel concludes, based on the entire record in this case, that Respondent's use of the Domain Names in the manner demonstrated by the evidence does not give rise to any right or legitimate interest in the Domain Names. Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interests in respect of the Domain Names, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Names in bad faith. [WIPO Overview 3.0](#), section 3.1, states that "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark".

For the reasons discussed under this and the preceding heading, the Panel considers that Respondent's conduct in this case constitutes bad faith registration and use of the Domain Names within the meaning of paragraph 4(a)(iii) of the Policy. It is evident that Respondent was aware of Complainant and its distinctive and unique TETRA PAK trademark, and targeted that mark, when registering the Domain Names. Respondent used Complainant's trademark in full, while combining it with the terms "planta" and "seminuevos". In this case, where Complainant's TETRA PAK trademark is so strong and distinctive, it is a reasonable inference in the circumstances of this case that Respondent registered the Domain Names based on the goodwill and reputation of Complainant's mark, in order to drive traffic to Respondent's websites, where Respondent purportedly offers cars for sale, with each car photo displaying the TETRA PAK trademark. In the attendant circumstances of this case, the Panel considers it more likely than not that Respondent's primary motive in relation to the registration and use of the Domain Names was to capitalize on, or otherwise take advantage of, Complainant's known trademark rights, for commercial gain. This amounts to bad faith use within the broad ambit of the Policy. See [WIPO Overview 3.0](#), section 3.1.4

In conclusion, the Panel determines that, for all of the above reasons, the Domain Names were registered and are being used in bad faith. Accordingly, Complainant has satisfied the third element 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 Domain Names, <plantatetrapak.com> and <seminuevostetrapak.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: September 12, 2022