

ADMINISTRATIVE PANEL DECISION

**General Mills Inc., Blue Buffalo Enterprises, Inc. v. Contact Privacy Inc.
Customer 1247961575/ Michael Buffalo
Case No. D2022-0743**

1. The Parties

The Complainants are General Mills Inc., United States of America (“United States”), and Blue Buffalo Enterprises, Inc, United States, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Contact Privacy Inc. Customer 1247961575, Canada / Michael Buffalo, United States.

2. The Domain Name and Registrar

The disputed domain name <shopbluebuffalo.com> (the “Disputed Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 3, 2022. On March 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 3, 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 March 4, 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 March 10, 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 March 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 1, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on April 8, 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

General Mills Inc. (the “First Complainant”), through its subsidiary Blue Buffalo Enterprises, Inc. (the “Second Complainant”) (hereinafter together the “Complainants”), submitted a Complaint regarding the Disputed Domain Name <shopbluebuffalo.com>. Founded in 1928, the First Complainant has a portfolio of brands including Cheerios, Annie’s, Yoplait, Nature Valley, Haagen-Dazs, Betty Crocker, Pillsbury, Old El Paso, and Blue. In 2020, the First Complainant reported revenue in excess of USD 17 million, and remains a well-known brand with 35,000 employees. In 2018, the First Complainant announced the acquisition of the Second Complainant. Founded in 2003, the Second Complainant is one of the fastest growing major pet food companies in the United States.

The Complainants own the following registered trademarks: BLUE BUFFALO, Canadian Trademark Registration No. TMA1011547, registered on December 19, 2018, in international class 31; BLUE BUFFALO, United States Trademark Registration No. 4,356,570, registered on June 25, 2013, in international class 31; and BLUE BUFFALO, International Trademark Registration No. 1236838, registered on October 28, 2014, in international class 31 (hereinafter collectively referred to as the “BLUE BUFFALO Mark”).

The Complainants own the domain name <bluebuffalo.com>, registered in 1999, which resolves to the official website at “www.bluebuffalo.com”.

The Disputed Domain Name was registered on August 14, 2020 and resolves to an inactive landing page that has no substantive content, stating: “This page isn’t working. shopbluebuffalo.com didn’t send any data.”

The Complainants’ attorneys sent several cease-and-desist letters to the Respondent on October 7, 14 and 26, 2021 but received no response.

5. Parties’ Contentions

A. Complainants

The following are the Complainants’ contentions:

- the Disputed Domain Name is confusingly similar to the Complainants’ BLUE BUFFALO Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainants seek the transfer of the Disputed Domain Name from the Respondent to the Complainants in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

In order for the Complainants to prevail and have the Disputed Domain Name transferred to the Complainants, the Complainants must prove the following (Policy, paragraph 4(a)):

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

This element consists of two parts: first, do the Complainants have rights in a relevant trademark, and second, is the Disputed Domain Name identical or confusingly similar to that trademark. The Panel concludes that the Disputed Domain Name is confusingly similar to the BLUE BUFFALO Mark.

It is uncontroverted that the Complainants have established rights in the BLUE BUFFALO Mark based on the years of use as well as the registered trademarks for the BLUE BUFFALO Mark in the United States and other jurisdictions worldwide. The consensus view is that “registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive”. See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainants have rights in the BLUE BUFFALO Mark.

The Disputed Domain Name consists of the BLUE BUFFALO Mark in its entirety preceded by the term “shop”, and then followed by the generic Top-Level Domain (“gTLD”) “.com”. It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[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”. For example, numerous UDRP decisions have reiterated that the addition of a term to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as “.com” to a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainants’ BLUE BUFFALO Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainants.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence to rebut this by demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Name. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the Complainants' BLUE BUFFALO Mark. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name. Moreover, the Complainants do not have any business relationship with the Respondent and based on the passive holding of the Disputed Domain Name, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name.

The Respondent's name listed on the Whois form (Michael Buffalo) does not entitle him to claim rights or legitimate interests in the Disputed Domain Name, because the Respondent must demonstrate that it is commonly known by a name fully corresponding to the Disputed Domain Name, and not only a part of it, as here. Apart from the term "buffalo", the Disputed Domain Name does not resemble the Respondent's full name in any manner, whereas it incorporates the BLUE BUFFALO Mark in its entirety, along with the term "shop".

Finally, the composition of the Disputed Domain Name, comprising the entirety of the BLUE BUFFALO Mark with the term "shop", carries a risk of implied affiliation and cannot constitute fair use here, as it effectively suggests sponsorship or endorsement by the Complainants. See [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainants.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainants have demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, based on the circumstances here, the Panel concludes that the Respondent registered and is holding the Disputed Domain Name in bad faith probably to take unfair advantage of the similarity with the Complainants' BLUE BUFFALO Mark. The Panel notes that, while the Respondent's surname may be "Buffalo" (which is not even proven), there is no explanation for the Respondent's selection of the term "shop" along with the terms "blue buffalo", and the Panel finds it likely that the composition of the Disputed Domain Name was selected for its reference to the Complainants' BLUE BUFFALO Mark. The composition of the Disputed Domain Name indicates that such registration and holding has been done for the specific purpose of trading on the name and reputation of the Complainants and its BLUE BUFFALO Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Second, with respect to the use of the Disputed Domain Name, passive holding does not prevent a finding of bad faith. By holding the Disputed Domain Name passively, the Respondent registered and is using the Disputed Domain Name in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). "The lack of use [of a domain name] by itself does not indicate anything. Nevertheless, the lack of use of a domain name that is not backed up by any trademark and that coincides with a known, well-known or renowned trademark owned by someone else, does not indicate other than bad faith in the sense of paragraph 4(b) of the Policy." See *El Bebe Productions Ltd v. Rachid Zouad*, WIPO Case No. [D2018-0469](#) (citing *Itaú Unibanco Holding S.A. v. Valdery Dos Santos Decorações ME*, WIPO Case No. [D2009-1335](#)).

Third, the Panel finds it likely that the Respondent had actual knowledge of the Complainants' BLUE BUFFALO Mark and targeted the Complainants when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. It can be inferred that the Respondent had actual knowledge of the Complainants and its BLUE BUFFALO Mark when it registered the confusingly similar Disputed Domain Name. UDRP panels have found that the registration of a domain name that is confusingly similar to a well-known trademark by an unaffiliated entity can create a presumption of bad faith. See [WIPO Overview](#)

[3.0](#), section 3.1.4.

Finally, the lack of response by the Respondent to the cease-and-desist letters sent by the Complainants' attorneys supports a finding of bad faith. Past UDRP panels have held that failure to respond to a cease-and-desist letter may be considered a factor in finding bad faith registration and use of a domain name. See *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party*, WIPO Case No. [D2000-0330](#) (failure to respond to a demand letter provides "strong support for a determination of 'bad faith' registration and use").

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainants.

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 <shopbluebuffalo.com> be transferred to the Complainants.

/Lynda M. Brau/

Lynda M. Braun

Sole Panelist

Date: April 22, 2022