

## **ADMINISTRATIVE PANEL DECISION**

Groupe Lactalis v. Rodger Young  
Case No. D2022-3582

### **1. The Parties**

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

The Respondent is Rodger Young, Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <ca-lactalis.com> is registered with IONOS SE (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 28, 2022. On September 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 6, 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 (Redacted For Privacy, 1 & 1 Internet Inc., United States) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 7, 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 October 11, 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 October 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 10, 2022.

The Respondent did not submit any formal response, however submitted informal communication emails on October 7 and 28, 2022 from an email address different from those confirmed by the Registrar, stating that he wishes to transfer the disputed domain name to the Complainant. The Center sent the possible settlement communication to the Parties on October 30, 2022, to which the Complainant replied on

November 2, 2022 that they do not wish to submit a suspension request and would like to continue with the proceedings.

The Center notified the Commencement of Panel Appointment Process on November 14, 2022 and appointed Zoltán Takács as the sole panelist in this matter on November 21, 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, based in Laval, France is the largest dairy products group in the world. It employs over 83,000 people, has 250 industrial sites and strong presence in over 50 countries worldwide, including Canada, which appears to be the Respondent's residence.

The Complainant's extensive trademark portfolio consisting of or comprising the LACTALIS trademark include:

- French Trademark Registration No. 98766742 for the word mark LACTALIS, filed on December 29, 1998 for variety of goods and services of the Nice Agreement Concerning the International Classification of Good and Services for the Purpose of the Registration of Marks ("Nice Classification") and

– Canadian Trademark Registration No. TMA920257 for the mark LACTALIS & Design, registered on November 16, 2015 for goods and services of classes 3, 5, 11, 29, 30, 31, 32, 33, 35, 38, 42, and 45 of the Nice Classification.

The Complainant has online presence at "www.lactalis.com". The corresponding domain name has been registered since January 9, 1999.

Since October 5, 2011, the Complainant owns the domain name <lactalis.ca> which links to the website of its Canadian business.

The disputed domain name <ca-lactalis.com>, registered on July 21, 2022, does not display any content and there is no evidence it was ever put to any use.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name fully incorporates its LACTALIS trademark and is therefore confusingly similar to it. The difference between the disputed domain name and its trademark is the Respondent's addition of the abbreviation "ca", the ISO standard country code for Canada.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant claims that the Respondent could not have been unaware of its existence and business at the time of registration of the disputed domain name.

The Complainant argues that establishing mail exchange records ("MX records") for the disputed domain suggest a possibility of sending emails, perhaps of fraudulent nature.

The Complainant requests that the disputed domain name, being registered and used in bad faith be

transferred from the Respondent to the Complainant.

## **B. Respondent**

The Respondent did not submit any formal response, but submitted informal communication emails to the Center on October 7, and 28, 2022, although from an email address different from those confirmed in the Registrar Verification.

In the October 7, 2022 dated email sent to the Center the Respondent among others alleged: "I made it for my website". "No fraud was attempted". "Was registered to a company here in Canada I decided to not move forward with "ca-". "I've no interest in fighting any legal battle due to an email registration".

In the October 28, 2022 dated email sent to the Center the Respondent wrote: "I hope this is the proper place to respond to this. I wish to transfer domain rights to them. The domain should have been cancel prior to the cease and desist email. I read what you have wrote. There isn't anything on my domain name because the website didn't launch; LatalisPets. Was to be an online pet store. They can have the domain name. It cannot serve me in the way I want it".

## **6. Preliminary issue – Respondent's informal consent to transfer**

In the October 28, 2022 dated email sent to the Center the Respondent among others stated: "I wish to transfer domain rights to them", suggesting that he is willing to consent to a transfer of the disputed domain name to the Complainant.

Section 4.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), which deals with the question of a respondent's intent to transfer the domain name to the Complainant outside of the standard settlement process provides that despite such a consent, a panel may in its discretion still find appropriate to rather proceed to a substantive decision on the merits than to order the requested remedy solely on the basis of such consent.

According to section 4.10 "Scenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent's consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights".

In the present case the following factors lead the Panel to proceed to a decision on the merits.

The emails dated October 7 and 28, 2022 were not signed and were sent to the Center from an email address different from those confirmed by the Registrar Verification. However, in spite of that, it can be presumed that these emails were sent by the actual Respondent, since there was clear reference to the subject administrative proceeding in the subject line of the emails. They were in fact sent from the same email address the Respondent used in replying to the August 22, 2022 dated cease-and-desist letter of the Complainant. Use of different email addresses by the Respondent signals to the Panel the Respondent's evident intent to hide his identity and activities, which does not qualify as good faith conduct under the Policy.

The Respondent expressly disclaims any bad faith, yet in his reply of August 22, 2022 to the Complainant's cease-and-desist letter of the same day the Respondent admitted that he registered the disputed domain after finding out that the domain name <ca.lactalis.com> he initially intended to obtain was already registered by a Canadian company.

Also, having received the Complainant's cease-and desist-letter before filing of the Complaint the Respondent clearly became aware of the Complainant's assertions and claims well before initiation of this administrative proceeding and could have transferred the disputed domain name to the Complainant without putting the Complainant to the effort and expenses of this proceeding.

The Complainant on the other hand – having submitted its Complaint and paid the requisite fees – is entitled to the benefit of the Panel's decision on the merits (see *Starline Publications, Inc. v. Texas International Property Associates*, WIPO Case No. [D2008-1824](#)).

## 7. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

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

### A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced proper evidence of having registered rights in the LACTALIS trademark and for the purpose of this proceeding the Panel finds that the French Trademark Registration No. 98766742 and the Canadian Trademark Registration No. TMA920257 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assessed whether the disputed domain name is identical or confusingly similar to the Complainant's trademarks.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. If so, the domain name is normally considered confusing similar to that mark for the purposes of UDRP standing. See section 1.7 of the [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. See section 1.8 of the [WIPO Overview 3.0](#).

The disputed domain name incorporates the Complainant's LACTALIS trademark in its entirety. The design

element of the Complainant's Canadian Trademark Registration No. TMA 920257 does not convey to this Panel any relevant information for the purpose of this proceeding; it is the word component LACTALIS that stands out in the Complainant's trademark.

Addition of the abbreviation "ca", which is the internationally recognized two- digit ISO code as well as the country code Top Level Domain ("ccTLD") for Canada and the hyphen character in view of the Panel does not prevent a finding of confusing similarity.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the 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 generally disregarded under the first element confusingly similar test.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and that requirement of paragraph 4(a)(i) of the Policy is satisfied.

## **B. Rights or Legitimate Interests**

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the LACTALIS trademark.

The Complainant has never authorized the Respondent to use its LACTALIS trademark in any way, and its prior rights in the trademark precede the date of registration of the disputed domain name.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 the 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. See section 2.1 of the [WIPO Overview 3.0](#).

Except for suggesting intent to transfer the disputed domain name, the Respondent chose not to formally respond to the Complaint, to the facts and circumstances brought forward by the Complainant. By doing so, the Respondent failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant's *prima facie* case.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

The LACTALIS trademark is distinctive and unique to the Complainant. A basic Internet search against the disputed domain name returns solely the Complainant and its businesses.

The Respondent has registered the disputed domain name that fully incorporates the Complainant's LACTALIS trademark in conjunction with the abbreviation "ca", the internationally recognized two digit ISO code as well as the "ccTLD" for Canada plus a hyphen character. The Respondent failed to provide any explanation for its inclusion of the Complainant's trademark in the disputed domain name.

In his August 22, 2022 dated response to the Complainant's cease-and-desist letter of the same day the Respondent admitted that he decided to obtain the disputed domain name after finding out that the domain name he initially intended to register, <ca.lactalis.com> was already registered by a Canadian company.

In view of the Panel these facts suggest that the Respondent either knew, or through a basic Internet and trademark search could have easily become aware of the Complainant's business and its prior rights in the LACTALIS trademark at the time of obtaining the disputed domain name. The Panel cannot conceive any other reason for the Respondent's choice to register a domain name fully incorporating the Complainant's trademark but to exploit the reputation behind the LACTALIS trademark without any authorization or rights to do so.

There is no evidence that the disputed domain name has been used in any active way. According to section 3.3 of the [WIPO Overview 3.0](#), from the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding.

In view of the Panel, the Respondent's lack of any rights or legitimate interests in the disputed domain name, the Respondent's deliberate concealment of identity and setting up of the MX records for the disputed domain name (which suggest a possibility of sending fraudulent emails) further support a presumption of the Respondent's evident targeting of the Complainant's trademark rights.

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

## **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 <ca-lactalis.com> be transferred to the Complainant.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: December 5, 2022