

ADMINISTRATIVE PANEL DECISION

Barry Callebaut AG and Barry Callebaut Belgium NV v. mail filter Case No. D2023-1063

1. The Parties

The Complainants are Barry Callebaut AG, Switzerland, and Barry Callebaut Belgium NV, Belgium, represented by Adlex Solicitors, United Kingdom.

The Respondent is mail filter, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <barry-callebaut.cam> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2023. On March 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on March 13, 2023.

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 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 6, 2023. The Respondent did not submit any response.

However, on March 20, 2023, an email communication from third party was received, indicating “Hello, What is this about?”. Accordingly, the Center notified the Commencement of Panel Appointment Process on April 17, 2023.

The Center appointed Edoardo Fano as the sole panelist in this matter on April 21, 2023. 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.

The Panel has not received any requests from the Complainants or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), “to employ reasonably available means calculated to achieve actual notice to the Respondent”. Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainants are Barry Callebaut AG and Barry Callebaut Belgium NV, a Swiss and a Belgian company respectively, both part of the Barry Callebaut International Group, headquartered in Switzerland and operating in the field of chocolate and cocoa products. Barry Callebaut AG owns several trademark registrations for BARRY CALLEBAUT, among which:

- Swiss Trademark Registration No. 453449 for BARRY CALLEBAUT, registered on July 28, 1998;
- International Trademark Registration No. 702211 for BARRY CALLEBAUT, registered on September 4, 1998;
- United States Trademark Registration No. 2320385 for BARRY CALLEBAUT, registered on February 22, 2000.

The Complainants also operate on the Internet, their main website being “www.barry-callebaut.com”.

The Complainants provided evidence in support of the above.

According to the WhoIs records, the disputed domain name was registered on December 13, 2022, and it is inactive.

5. Parties’ Contentions

A. Complainants

The Complainants state that the disputed domain name is identical or confusingly similar to their trademark BARRY CALLEBAUT, as the disputed domain name wholly incorporates the Complainants’ trademark, with the addition of a hyphen between the two words of the trademark.

Moreover, the Complainants assert that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainants to register the disputed domain

name or to use their trademark within the disputed domain name, it is not commonly known by the disputed domain name, and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name is inactive.

The Complainants submit that the Respondent has registered the disputed domain name in bad faith, since the Complainants' trademark BARRY CALLEBAUT is well known. Therefore, the Respondent targeted the Complainants' trademark at the time of registration of the disputed domain name and the Complainants contend that the passive holding of the disputed domain name qualifies as bad faith registration and use.

B. Respondent

The Respondent has made no formal reply to the Complainants' contentions, and is in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3.

A third party has submitted two email communications stating: what is this about?

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Consolidation of Multiple Complainants

The Complaint and the amendment to the Complaint were filed by two Complainants, and the Complainants have requested consolidation of multiple complainants. No objection to this request was made by the Respondent.

Pursuant to the [WIPO Overview 3.0](#), section 4.11.1: "[a]ssessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation".

The Panel finds that there is sufficient evidence that the Complainants have common grievance against the Respondent, who has engaged in a common conduct that has affected both of them, and that the consolidation would be procedurally efficient and equitable. The Panel further notes that the Respondent did not object to the consolidation request. The Panel therefore accepts the Complainants' consolidation request.

For the purpose of this decision, the "Complainant" will refer to both the Complainants.

B. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark BARRY CALLEBAUT and that the disputed domain name is confusingly similar to the trademark BARRY CALLEBAUT.

It is well accepted that a generic Top-Level Domain (“gTLD”), in this case “.cam”, is typically ignored when assessing the similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is confusingly similar to the Complainant’s trademark, pursuant to the Policy, paragraph 4(a)(i).

C. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

“(i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is generally more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production to the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not using the disputed domain name for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services. The disputed domain name resolves to an inactive website.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain name.

Moreover, the Panel finds that the composition of the disputed domain name, almost identical to the Complainant’s trademark, carries a high risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Based on the facts of this case, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that “[f]or the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or [has] 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 the complainant, for valuable consideration in excess of [its] 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 [the respondent’s] web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] web site or location or of a product or service on [the respondent’s] web site or location”.

Regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant’s trademark BARRY CALLEBAUT in the field of chocolate and cocoa products is clearly established and the Panel finds that the Respondent likely knew of the Complainant, and deliberately registered the disputed domain name in bad faith.

As regards the current use in bad faith of the disputed domain name, which is inactive, the Panel considers that bad faith may exist even in cases of so-called “passive holding”, as found in the landmark UDRP decision *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In the circumstances of this case, the Panel finds that such passive holding does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3. In support thereof, the Panel considers as relevant the notoriety of the Complainant’s trademark, the identical incorporation of said distinctive trademark, the Respondent’s failure to formally participate, and the Respondent’s use of a privacy service to mask its details in the publicly-available Whois.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain name, which includes the Complainant’s trademark in its entirety with the addition of a hyphen between the two words composing said trademark, further support a finding of bad faith. See [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain name in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been 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, <barry-callebaut.cam>, be transferred to the Complainant Barry Callebaut AG.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: April 22, 2023