

ADMINISTRATIVE PANEL DECISION

Groupe Lactalis v. Mark Taylor
Case No. DCO2023-0040

1. The Parties

The Complainant is Groupe Lactalis, France, represented by Nameshield, France.

The Respondent is Mark Taylor, Canada.

2. The Domain Name and Registrar

The disputed domain name <lactaliscanada.co> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 21, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 21, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Unknown / REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 21, 2023 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 April 24, 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 April 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2023.

The Center appointed Olga Zalomiy as the sole panelist in this matter on June 1, 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.

4. Factual Background

The Complainant is a French multi-national company, engaged in the food industry. The Complainant owns several trademark registrations for the LACTALIS trademark, such as:

- The European Union Trade Mark LACTALIS, No. 001529833, registered on November 7, 2022;
- The International trademark LACTALIS, No. 900154, registered on July 27, 2006;
- The International trademark LACTALIS, No. 1135514, registered on September 20, 2012;
- The Canadian trademark LACTALIS, No. TMA920257, registered on November 16, 2015;
- The Colombian trademarks LACTALIS, Nos. 12164454, 12164546 and 12164555, registered on October 25, 2013, December 24, 2013 and December 24, 2013 respectively.

The Domain Name was registered on February 7, 2023. The Domain Name used to resolve to a website that was a copy of the Complainant's Canadian website at "www.lactalis.ca". Currently, the Domain Name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarized as follows:

The Complainant states that the Domain Name is confusingly similar to its LACTALIS trademark and its domain names associated with the mark because Domain Name includes the LACTALIS trademark in its entirety. The Complainant contends that the addition of the term "CANADA" is not sufficient to avoid finding of confusing similarity between the Domain Name and the LACTALIS trademark. The Complainant contends that the addition of the country-code Top Level Domain ("ccTLD") ".co" does not change the overall impression of the designation as being connected to the Complainant's trademark.

The Complainant asserts that the Respondent is not commonly known by the Domain Name because the Respondent is not identified in the Whois database under the Domain Name. The Complainant contends that it did not grant the Respondent a license or an authorization to use the Complainant's LACTALIS trademark for registration of the Domain Name. The Complainant argues that the Respondent is not using the Domain Name in connection with a *bona fide* offering of goods or services because the Domain Name points to a website that is virtually identical to the Complainant's official website at "www.lactalis.ca". The Complainant asserts that with the exception of a contact phone number and a contact email address, the website under the Domain Name is identical to the Complainant's Canadian website. The Complainant alleges that the Respondent copied the Complainant's trademarks, logos photographs of the Complainant's employees, information and the postal address of the Complainant's address in Canada from the Complainant's official website.

The Complainant states that the Respondent registered the Domain Name in bad faith because the Respondent registered the Domain Name with full knowledge of the Complainant and its trademark rights. The Complainant contends that the fact that the Domain Name is identical to its LACTALIS trademark and that the website under the Domain Name is a copy of the Complainant's Canadian website support such contention. The Complainant asserts that the Respondent is using the Domain Name in bad faith because by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website. The Complainant alleges that the Respondent configured mail exchange servers, which suggests that the Domain Name may be actively used for email purposes.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (paragraph 4(a)(i)); and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name (paragraph 4(a)(ii)); and
- (iii) the Domain Name has been registered and is being used in bad faith (paragraph 4(a)(iii)).

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must prove that the Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The submitted evidence shows that the Complainant owns multiple trademark registrations for the LACTALIS trademark. Pursuant to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), this satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

"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."¹ It is well-established that the applicable Top-Level Domain ("TLD") should be disregarded under the confusing similarity test as a standard registration requirement."²

The Domain Name consists of the Complainant's LACTALIS trademark, the geographical term "Canada" and the ccTLD ".co" assigned to Colombia. Because the Complainant's LACTALIS trademark is recognizable within the Domain Name, the addition of the geographical term "Canada" does not prevent finding of confusing similarity. The ccTLD ".co" is disregarded from the assessment of confusing similarity. Therefore, the Domain Name is confusingly similar to the Complainant's LACTALIS trademark.

The Complainant has satisfied the first element of the UDRP.

B. Rights or Legitimate Interests

To succeed under the second UDRP element, the Complainant must make out a *prima facie* case in respect of the lack of rights or legitimate interests of the Respondent.

To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under the UDRP, paragraph 4(c) include the following:

- (i) before any notice of the dispute, the respondent's 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

¹ Section 1.8, [WIPO Overview 3.0](#).

² Section 1.11, [WIPO Overview 3.0](#).

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

(iii) the respondent is 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.

There is no evidence that the Respondent has been commonly known by the Domain Name. The Domain Name is registered in the name of Mark Taylor. The website under the Domain name used to display section "About us" that described the Complainant.

The Complainant contends and the Respondent does not dispute that the Complainant has not licensed or permitted the Respondent to use the Complainant's LACTALIS trademark in domain names, or for any other purpose.

There is no evidence that the Respondent is using the Domain Name in connection with a *bona fide* offering or goods or services or making a legitimate noncommercial or fair use of the Domain Name. The Respondent used to use the Domain Name for a website that was virtually identical to the Complainant's official Canadian website. The only difference between the websites was in the phone number and the contact email displayed on the Complainant's website. It is likely that the Respondent planned to use the Domain Name for an illegal activity.

Nor does the current non-use of the Domain Name confer any rights or legitimate interests in the Domain Name on the Respondent because a webpage under the title "[t]his Account has been suspended" does not show use or preparations to use the Domain Name in connection with a *bona fide* offering of goods or services.

The Panel finds that the Complainant has made out the *prima facie* case and the burden of producing evidence demonstrating it has rights or legitimate interests in the Domain Name has shifted to the Respondent³. Since the Respondent failed to present any rebutting evidence, the Complainant is deemed to have satisfied the second element of the UDRP.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must prove that the Domain Name was registered and is being used in bad faith.

The UDRP establishes that, for purposes of paragraph 4(a)(iii), "bad faith" registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to source, sponsorship, affiliation or endorsement of the respondent's website or location, or of a product or service on the respondent's website or location. See Policy, paragraph 4(b)(iv).

Prior UDRP panels have found "the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark:... (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, ... (vi) absence of any conceivable good faith use."⁴

Here, the website at the Domain Name was a copy of the Complainant's Canadian website with the Complainant's phone number and a contact email being replaced by the Respondent's contact phone

³ Section 2.1, [WIPO Overview 3.0](#).

⁴ Section 3.1.4, [WIPO Overview 3.0](#).

number and email address. The Respondent's website used to display the Complainant's trademarks, text from the Complainant's website and photographs of the Complainant's Canadian employees. The evidence shows that the "About us" section of the website contained information about the Complainant. Thus, it is likely that the Respondent registered the Domain Name with the full knowledge of the Complainant's mark and the Complainant. The Panel concludes that the Respondent, who has no rights or legitimate interests in the Domain Name, attempted to create a confusion for the Respondent's commercial benefit between the Domain Name and the Complainant's mark. Thus, the Respondent registered and is using the Domain Name to intentionally attempt to attract, for commercial gain, the Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation or endorsement of the Respondent's website or location, or of a product or service on the Respondent's website or location. Such registration and use are in bad faith.

Given the circumstances of this case, the Respondent's current non-use or passive holding of the Domain Name constitutes further evidence of the Respondent's bad faith. It is well-established that non-use of a domain name would not prevent finding of bad faith.⁵ The Respondent's failure to submit a response, his registration of the Domain Name incorporating the distinctive Complainant's trademark along with his prior bad-faith use of the Domain Name that makes any good faith use of the Domain Name implausible. Therefore, the totality of circumstances of this case indicate that the Respondent is registered and is using the Domain Name in bad faith.

The Complainant has satisfied the third element of the UDRP.

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 Name, <lactaliscanada.co> be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: June 15, 2023

⁵ Section 3.3, WIPO Overview 3.0.