

ADMINISTRATIVE PANEL DECISION

Fit Foods Ltd. v. Domain Manager, Tranco
Case No. D2022-3941

1. The Parties

The Complainant is Fit Foods Ltd., Canada, represented by Palmer IP Inc., Canada.

The Respondent is Domain Manager, Tranco, Norway.

2. The Domain Name and Registrar

The disputed domain name <isogold.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 20, 2022. On October 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 24, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 25, 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 26, 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 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 16, 2022. The Response was filed with the Center on November 17, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on November 24, 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.

On December 9, 2022, the Panel issued Administrative Panel Order No. 1 pursuant to paragraph 12 of the Rules:

- (a) inviting the Complainant to submit further information about the matters specified in the Panel Order by December 13, 2022;
- (b) allowing the Respondent until December 20, 2022 to submit any materials in answer to the supplemental filing, if any, made by the Complainant; and
- (c) extending the due date for the decision to December 24, 2022.

On December 13, 2022, the Complainant submitted a supplemental filing. The Respondent did not submit a supplemental filing.

4. Factual Background

The Complainant is a Canadian company founded in 1996 originally under the name PVL Nutrients. It manufactures and distributes in Canada and around the world sports nutrition and healthy lifestyle products including dietary supplements and protein powders.

Since April 2005, it has been manufacturing and distributing a dried whey protein powder which it markets under the name ISOGOLD.

In Canada, the ISOGOLD products are stocked in a range of retail outlets including Popeyes Supplements, which apparently has over 100 physical locations across Canada, other specialty retail chains including Reflex Supplements, Fuel Supplements, Here's Nutrition Canada, and grocery chains such as the Real Canadian Superstore. Prior to March 2011, the Complainant's supplemental filing includes evidence that, while most of the sales appear to have occurred in Canada, sales also occurred in the United States of America, the Netherlands, Ireland, Denmark, Bosnia & Herzegovina, Italy, Bulgaria, Hong Kong, China, Greece, Switzerland, Belgium, Sweden, and Norway.

The Complainant also promotes and offers for sale its products from its website at "www.pvl.com". The Complaint includes evidence that the ISOGOLD product has been so marketed since at least April 2010, the earliest capture by the Wayback Machine at "web.archive.org".

In addition, the Complainant has promoted its products extensively in bodybuilding magazines, brochures, and other publications. According to the declaration of James B McMahon, who is the President and Chief Executive of the Complainant, annual advertising expenditure on the ISOGOLD product was CAD 659,000 for 2005 rising to CAD 1.2 million for 2010. Copies of a brochure and advertisements from 2009 have been included in his declaration.

According to the Complaint, the Complainant was generating more than CAD 10 million annually in sales of its ISOGOLD product. From information submitted in its supplemental filing, the Complainant's annual sales of its ISOGOLD product before March 2011 were between CAD 750,000 and CAD 1 million.

The Complainant is the owner, amongst other things, of registered trademarks for ISOGOLD:

- (a) Australian Registered Trademark No. 2234670 which was filed on and registered with effect from October 29, 2021;
- (b) Chinese Registered Trademark No. 1631607 which was registered on April 21, 2022;
- (c) European Union Trademark No. 1631607 which was filed and registered on October 29, 2021;

- (d) Mexican Registered Trademarks Nos 2439722, 2439723, and 2439724 which were registered on September 1, 2022;
- (e) New Zealand Registered Trademark No. 1197519 which was filed on October 29, 2021, and entered on the Register on August 2, 2022; and
- (f) United Kingdom Registered Trademark No. WO0000001631607 which was filed on October 29, 2021, and entered on the Register on March 1, 2022.

Each of the above trademarks is derived from International Registration No. 1631607 which was filed and registered on October 29, 2021, and each is registered in respect of relevant goods in International Classes 5, 29, and 32.

The Complaint also includes evidence of numerous pending trademark applications, mostly derived from International Registration No. 1631607.

According to the Response, the Respondent registered the disputed domain name on March 8, 2011.

The disputed domain name does not appear to have resolved to an active website or otherwise been used.

However, the Respondent offers the disputed domain name for sale for CAD 9,560.23.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint 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. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the several registered trademarks for ISOGOLD identified in section 4 above.

The Complaint does also include evidence of a number of pending trademark applications. However, these do not qualify as trademark rights under the Policy. See e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.1.4.

Having regard to the volume of sales and advertising expenditure, the Panel finds that the Complainant also has rights in “IsoGold” as an unregistered trademark and that it likely had acquired such rights before March 2011.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date the rights accrued and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, the disputed domain name consists of the Complainant’s trademark. Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] 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 [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The *onus* of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

It is not in dispute between the parties that the Respondent has not been authorised by the Complainant to register or use the disputed domain name. Nor is the Respondent affiliated with the Complainant in any way.

The disputed domain name is not derived from the Respondent’s name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could

be derived. The Respondent does not hold any trademarks corresponding to the disputed domain name.

The Respondent registered the disputed domain name after the Complainant began using its trademark but before the Complainant had registered its trademark.

In the circumstances of this case, the use of the disputed domain name to offer it for sale does not qualify as a legitimate noncommercial or fair use for the purposes of paragraph 4(c)(iii) of the Policy. However, the registration of a domain name for the purposes of later “selling” it is not necessarily inconsistent with the Policy. It only becomes so where the registration and use are in “bad faith”.

Those requirements are more appropriately considered under the third element.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent: *see e.g. Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Paragraph 4(b) identifies situations, which may demonstrate that registration or use of a disputed domain name was not in bad faith under the Policy:

For the purposes of paragraph 4(a)(iii), 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 [the disputed] domain name in bad faith:

(i) circumstances indicating that [the Respondent] has registered or [the Respondent has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent has] registered the [disputed] 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 [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] 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] website or location or of a product or service on [the Respondent's] web site or location.

The instances of bad faith set out in paragraph 4(b) of the Policy are examples only, intended to illustrate types of conduct which is caught by the Policy. *See Do The Hustle, LLC v Tropic Web* WIPO Case No. [D2000-0624](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

In the present case, the Respondent specifically denies knowledge of the Complainant and its trademark. A plausible denial of knowledge of a complainant's trademark is fatal to the Complaint. In the present case, the Respondent offers three arguments in support of his denial.

First, the Respondent points out that he registered the disputed domain name many years before the Complainant registered its trademark.

As the Respondent points out, [WIPO Overview 3.0](#), section 3.8.1 explains in part:

“Subject to scenarios described in 3.8.2 below, where a respondent registers a domain name before the complainant’s trademark rights accrue, panels will not *normally* find bad faith on the part of the respondent. (This would not however impact a panel’s assessment of a complainant’s standing under the first UDRP element.)” (emphasis supplied).

There are a range of situations in which the registration of the domain name before the registration of the Complainant’s rights has not provided a defence. By way of example, [WIPO Overview 3.0](#), section 3.8.2 explains:

“As an exception to the general proposition described above in 3.8.1, in certain limited circumstances where the facts of the case establish that the respondent’s intent in registering the domain name was to unfairly capitalize on the complainant’s nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

“Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent’s insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant’s filing of a trademark application.”

In the present case, the Complainant had in fact been using its ISOGOLD trademark as an unregistered trademark for about six years before the Respondent registered the disputed domain name. It is not possible to exclude the possibility of knowledge of the Complainant’s trademark, therefore, solely from the date of the registrations.

Secondly, the Respondent contends that the Complainant’s product is a “niche” product offered for sale in Canada, while he is based in Norway.

The Complainant’s sales and reputation are certainly much greater now than was the case in 2011. While sports nutrition products such as protein powders may be a “niche” product, the evidence in the Complainant’s supplemental filing demonstrates the Complainant’s products had an international distribution, apart from any international circulation the bodybuilding magazines and other publications in which the Complainant’s advertising appeared may have had. The evidence of sales in Norway itself is limited but there is some evidence. In addition, the Complainant was promoting its ISOGOLD products on the Internet from well before 2011.

Thirdly, by way of further explanation, the Respondent contends that ISOGOLD is just an ordinary combination of two common words. According to the Response:

“The domain combines of two words ISO and GOLD. ISO is both short form for many words like ‘isolation’, ‘Isometric’, ‘isotope’. ISO is also acronym for hundreds of definitions, and most known for ‘International Organization for Standardization’. Screenshots from The Free Dictionary screenshots, attached as Respondent Annex 1. The word GOLD is generic.”

The Panel accepts that “gold” is an ordinary dictionary word and is often used in a laudatory sense to convey that something is of “gold standard” or premium quality in addition to the name of the precious metal. The Panel also accepts that “iso” can be the first two syllables of many words and the acronym of organisations such as the International Standards Organisation.

However, the Panel does not accept that the two elements are an obvious combination. “North Pole” and “bananas” are ordinary English terms. However, one would not ordinarily combine them in the same

expression. Similarly, contrary to the Respondent's contention, in combination the elements "iso" and "gold" are meaningless and apparently a wholly capricious combination. As the Complainant contends, in combination they are an invented term and distinctive.

The Respondent has not provided evidence to suggest that he has engaged in a pattern of registering "iso" domain names or "gold" domain names or otherwise engaged in some pattern of registration that would explain his claimed random arrival at the disputed domain name.

It is not possible for the Panel to exclude entirely the possibility that the Respondent did arrive at the disputed domain name randomly. On the balance of probabilities, however, having regard to the capricious nature of the combination, the Complainant's engagement in international trade, and the promotion and availability of its product on the Internet as well as bodybuilding magazines and other publications, the Panel is unable to accept the Respondent's explanation of how he derived the disputed domain name. It appears more likely that the Respondent did register the disputed domain name with knowledge of the Complainant's trademark (albeit unregistered at the time).

Bearing in mind that the only use the Respondent has made of the disputed domain name is to offer it for sale at a price which considerably exceeds the usual cost of registering a domain name in the .com gTLD, therefore, the Panel finds that the Respondent registered the disputed domain name in bad faith under the Policy. The circumstances appear to be analogous to the circumstances outlined in paragraph 4(b)(i) to (iii) of the Policy.

It also follows that the Respondent does not have rights or legitimate interests in the disputed domain name and, in offering it for sale at the price indicated, has been seeking to take advantage of the trademark significance of the disputed domain name. Accordingly, the Respondent has also been using the disputed domain name in bad faith under the Policy.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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, <isogold.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: December 24, 2022