

ADMINISTRATIVE PANEL DECISION

Groupe Lactalis v. paul goodrich
Case No. D2022-2429

1. The Parties

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

The Respondent is paul goodrich, United States of America.

2. The Domain Name and Registrar

The disputed domain name <us-lactalis.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 5, 2022. On July 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 6, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 July 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2022.

The Center appointed Theda König Horowicz as the sole panelist in this matter on August 16, 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 is a multinational Group having its headquarters in France which was founded in 1933 and specializes in the food industry especially in the dairy industry.

The Complainant notably built its reputation by commercializing camembert cheese and the name LACTALIS was adopted in 1999 when the group internationalized itself due to its worldwide success in the dairy field.

The Complainant's business name incorporates LACTALIS, a name which is also widely registered on its behalf in trademark registrations and domain names.

Indeed, the denomination Groupe Lactalis has been registered as the Complainant's company name since December 14, 1984.

The Complainant also owns many trademark registrations for LACTALIS including, the French trademark registration LACTALIS (device), No. 4438490 as of March 20, 2018 and the European Union Trade Mark LACTALIS, No. 001529833 as of November 7, 2002.

In addition, the Complainant holds domain names comprising LACTALIS including the domain name <lactalis.com> which was registered by the Complainant on January 9, 1999.

The disputed domain name was registered on April 7, 2022. It resolves to an unreachable page and is thus inactive.

On May 18, 2022, the Complainant sent a warning letter to the Respondent which remained unanswered despite reminders on May 30 and June 8, 2022.

5. Parties' Contentions

A. Complainant

The Complainant contends to have rights in LACTALIS through its business name, trademark registrations, and domain names which have been registered for many years. It alleges that the disputed domain name is confusingly similar to Complainant's brand LACTALIS. More specifically, the Complainant states the disputed domain name contains the ISO standard "US" which designates the United States of America (hereinafter, "USA") and which is descriptive. This term is associated with the trademark LACTALIS on which the Complainant has exclusive rights and which is distinctive thus creating a high risk of confusion.

The Complainant alleges that the Respondent does not have legitimate interests or rights in the disputed domain name, notably as the disputed domain name was never activated. In addition, the Complainant notes that the Respondent does not have rights in the name LACTALIS. Furthermore, the Complainant never authorized the Respondent or any other third party to register the disputed domain name which contains its LACTALIS trademark in its entirety.

The Complainant states that the disputed domain name was registered in bad faith, notably considering the well-known character of the LACTALIS trademark and the strong worldwide reputation of the Complainant which was acknowledged in several UDRP decisions. The Respondent could thus not ignore the Complainant's rights in LACTALIS when registering the disputed domain name. Additionally, the reproduction of the entire distinctive LACTALIS trademark in the disputed domain name demonstrates the Respondent's bad faith and shows that the Respondent aimed at misleading the consumers. The Complainant further contends that the disputed domain name is used in bad faith as:

- (i) the Respondent has no rights in the name LACTALIS;
- (ii) the disputed domain name disrupts the Complainant's business and causes harm to the brand image;
- (iii) the Respondent has configured mail servers on the disputed domain name which enables the Respondent to send fraudulent emails through emails addresses using the LACTALIS name;
- (iv) the warning letter sent by the Complainant remained unanswered.

B. Respondent

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

6. Discussion and Findings

Under the Policy, in order to prevail, a complainant must prove the following three elements for obtaining the transfer of a domain name:

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

A. Identical or Confusingly Similar

The Complainant showed to have trademark rights in LACTALIS through several registrations worldwide.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

The disputed domain name contains the LACTALIS trademark in its entirety. The addition at the beginning of the disputed domain name of the letters "us" as a likely reference to the USA and a hyphen does not prevent a finding of confusing similarity, as the LACTALIS trademark is completely recognizable in the disputed domain name.

Under these circumstances, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's mark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in the use of a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services;
- (ii) being commonly known by the domain name; or
- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondents under this ground, the burden of production shifts to the Respondents to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made some submissions in order to demonstrate that the Respondents would have no rights or legitimate interests in the disputed domain name which are considered by the Panel as sufficient to shift the burden of production to the Respondent.

The Panel notes that the evidence available in the case file does not show that the Respondent would be known by the trademark LACTALIS.

The disputed domain name fully incorporates the Complainant's well-known LACTALIS trademark which has no specific significance and can be considered as having a strong distinctive character. It is therefore difficult to imagine that the disputed domain name legitimately includes the Complainant's trademark. As a matter of fact, it is way more likely that the Respondent aimed at referring to the Complainant's trademark and business, and to give the false impression that he would be an authorized representative of the Complainant in the USA.

In this frame, it is also noted that it is more than likely that the Respondent was planning to surf on the Complainant's notoriety, as the LACTALIS brand can be characterized as well-known as it was recognized in many UDRP decisions and the Complainant has shown to have a worldwide presence, all facts which could not be ignored by the Respondent. The absence of use of the disputed domain name and the absence of response to the Complainant's warning letters is another indication of lack of legitimate interests or rights.

Consequently, the Panels finds that the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel agrees that the trademark LACTALIS can be considered as a well-known trademark, based on the evidence provided in the case file.

The Respondent must thus have known about the LACTALIS trademark when registering the disputed domain name. See section 3.2.2 of the [WIPO Overview 3.0](#).

The Panel agrees with the Complainant that the bad faith of the Respondent is supported by several findings, notably the absence of use of the disputed domain name and the potential harm to the Complainant's well-known LACTALIS brand, being reminded that LACTALIS is clearly recognizable in the disputed domain name. The absence of response in the present proceedings is an additional element evidencing bad faith.

While the disputed domain name may not resolve to an active website, its passive holding does not prevent a finding of bad faith considering the totality of circumstances. See section 3.3 of the [WIPO Overview 3.0](#). Moreover, the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

In light of the above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that the Complainant has established its case under paragraph 4(a)(iii) of the Policy.

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, <us-lactalis.com>, be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: September 7, 2022