

ADMINISTRATIVE PANEL DECISION

Upfield Europe B.V. v. Privacy Service Provided by Withheld for Privacy ehf /
Nika Grain LLC
Case No. D2022-2950

1. The Parties

The Complainant is Upfield Europe B.V., Netherlands, represented by Stobbs IP Limited, United Kingdom.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Nika Grain LLC, Cameroon.

2. The Domain Name and Registrar

The disputed domain name <upfieldsourcing-ab.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 10, 2022. On August 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 10, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 11, 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 August 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 August 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 6, 2022.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on September 12, 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 company active in the sourcing, production and sale of plant-based consumer products. The Complainant claims to employ more than 4,200 employees globally and sell over USD 1 billion worth of products through seven far-reaching brands, such as Flora, Violife, Becel, and Rama. The Complainant claims to hold an over 50% share of the margarine markets in over 40 markets. The Complainant owns multiple subsidiaries, including two in Sweden: Upfield Sweden AB and Upfield Sourcing Sweden AB.

The Complainant owns several trademarks for UPFIELD, including:

- International verbal trademark UPFIELD, registered under number 1454275 on October 1, 2018, in classes 5, 29, 30, and 35;
- Benelux verbal trademark UPFIELD, registered under number 1031339 on March 29, 2018, in classes 5, 29, 30, and 35; and
- United States of America verbal trademark UPFIELD, registered under number 5974506 on February 4, 2020, in classes 5, 29, 30, and 35.

The Complainant operates the domain name <upfield.com>, registered on November 20, 2001.

The disputed domain name was registered on January 6, 2022, by the Respondent. At the time of the filing of the Complaint, the disputed domain name resolved to an active website which features the Complainant's UPFIELD branding, lists Upfield Sourcing Sweden AB's name and address in contact details, and offers for sale consumer products including those of a similar category as offered by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its earlier trademarks UPFIELD, as the disputed domain name fully incorporates the trademark. Additionally, the Complainant submits that the addition of the generic term "sourcing" does not diminish the likelihood of confusion but rather reinforces the association with the Complainant and its subsidiary. Further, the Complainant contends that the addition of the generic Top-Level Domain ("gTLDs") ".com" does not diminish the likelihood of confusion arising from the disputed domain names.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name, as the Respondent has neither acquired trademark rights in the term "upfield" nor is commonly known by the disputed domain name. Further, the Respondent is not making use of the disputed domain name in relation to a *bona fide* offering of goods or services, as it is using the disputed domain name to impersonate the Complainant and its authentic website for the sale of their own products. For the same reason the Respondent cannot claim to be making a legitimate noncommercial or fair use of the disputed domain name without intent of or commercial gain to misleadingly divert consumers.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith as the Complainant's trademarks significantly predate the registration of the disputed domain name. According to the Complainant, the Respondent is clearly using the disputed domain name, which is confusingly similar to the Complainant's trademarks, in order to attract the Complainant's customers to their

own e-commerce store. Further, the Complainant contends that the Respondent fails to satisfy the second and third requirements of the reseller test set out in the Oki Data case (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)).

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must demonstrate that the disputed domain name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

On the basis of the evidence presented, it is established that the Complainant owns several UPFIELD verbal trademarks.

The disputed domain name reproduces the Complainant's UPFIELD trademarks, albeit with the addition of the terms "sourcing" and "ab". Previous UDRP panels have consistently held that, in circumstances where the disputed domain name incorporates the entirety of a trademark or its dominant feature is recognizable, the disputed domain name will be considered confusingly similar to the trademark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7; *Fondation Le Corbusier v. Monsieur Bernard Weber, Madame Heidi Weber*, WIPO Case No. [D2003-0251](#); *Bayerische Motoren Werke AG ("BMW") v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs*, WIPO Case No. [D2017-0156](#)).

This finding of confusing similarity is not precluded by the addition of other terms ([WIPO Overview 3.0](#), section 1.8; *Intesa Sanpaolo S.p.A. v. Rampe Purda*, WIPO Case No. [D2010-1116](#); *Société des Bains de Mer et du Cercle des Etrangers à Monaco v. Mark Bolet*, WIPO Case No. [D2006-1245](#)).

Additionally, it is well-established that the applicable gTLD ".com" is typically not to be taken into account for the purpose of assessing confusing similarity under the Policy, as it is merely standard registration requirements ([WIPO Overview 3.0](#), section 1.11).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's UPFIELD trademarks and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, evidence of the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(a)(ii) may be established, in particular, by any of the following circumstances:

(i) prior to becoming aware of the dispute, the Respondent has used 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 made serious preparations to do so;

(ii) the Respondent is known by the disputed domain name in question, even without having acquired trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent to divert consumers for profit by creating confusion or to tarnish the trademark or service mark at issue.

Where the Complainant establishes *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name, the burden of production on this element is on the Respondent and it is up to the Respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent does not provide such relevant evidence, the Complainant is deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

The Complainant provides *prima facie* evidence that the Respondent has not acquired trademark rights in the term “upfield” and that the Respondent is not commonly known by this term either. The disputed domain name is not a legitimate site authorized by the Complainant, nor by its subsidiary Upfield Sourcing Sweden AB.

Further, the Complainant provides *prima facie* evidence that the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain name in relation to a *bona fide* offering of goods or services. Indeed, the offering of goods and services provided by the Respondent on the disputed domain name does not fulfil the criteria set out in the *Okidata* case (*Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)):

- “1. Respondent must actually be offering the goods at issue, i.e. the goods and services which bear the protected trademark.
2. Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods.
3. The site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents.
4. The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.”

In this case, the Complainant contends that the disputed domain name resolves to an active page, which features the Complainant's UPFIELD branding, lists the Complainant's subsidiary Upfield Sourcing Sweden AB's registered legal name and legal address in contact details, and offers for sale consumer products including those of a similar category as offered by the Complainant. Based on information provided in the Complaint, the products offered for sale could be both the Complainant's goods and the Respondent's own products. While the disputed domain name does not facilitate payment processing facilities, an inquiry into any available products for sale includes the registration of a customer's name and email. Based on the above information, the second and third criteria of the *Okidata* test are not fulfilled, thus precluding the Respondent from the ability to claim use in relation to a *bona fide* offering of goods and services.

Additionally, while the disputed domain name is not an exact replica of the Complainant's authentic website <upfield.com>, based on the abovementioned information, the Panel finds that it has been set up with the intention to mislead consumers into believing it is an authentic domain name of the Complainant. It follows that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name either, without intent of commercial gain to misleadingly divert consumers.

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not exercised its right to defend itself and has not asserted the existence of a legitimate use of the disputed domain name, so the Panel must conclude that the second condition of paragraph (4)(a) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that evidence that a disputed domain name has been registered and is being used in bad faith may be adduced for the purposes of paragraph 4(a)(iii) in particular in certain circumstances, the fourth of which is that:

(iv) by using that domain name, [the respondent has] knowingly attempted to attract, for profit, Internet users to a website or other online space [it] owns, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsor, affiliation, or endorsement of [its] website or web space or a product or service offered therein.

This provision can support an inference of bad faith registration for a respondent to rebut. Such inference can be supported by (i) a clear absence of the respondent's own rights or legitimate interests, (ii) the nature of the domain name itself (i.e., the manner in which the domain name incorporates the complainant's mark), (iii) the content of any website to which the disputed domain name points, (iv) the reputation of the complainant's mark, (v) the use of (false) contact details or a privacy shield to hide the registrant's identity, (vi) the failure to submit a response, the plausibility of any response, or other indicia that generally cast doubt on the registrant's *bona fides* ([WIPO Overview 3.0](#), section 3.2.2).

The disputed domain name was registered on January 6, 2022, which is subsequent to the registration of the Complainant's UPFIELD marks between 2018 and 2020. The disputed domain name directs visitors to a webpage which reproduces the authentic domain name of the Complainant. The Panel finds that the Respondent is using the disputed domain name, which is confusingly similar to the Complainant's trademarks, in order to attract the Complainant's customers to their own e-commerce store. Furthermore, the Respondent made use of a privacy shield and did not submit a response in the context of these proceedings.

Furthermore, the Panel considers that the addition in the disputed domain name of the terms "sourcing" and "ab" directly references the name of the Complainant's subsidiary. This addition rather reinforces the impression that the disputed domain name is associated with the Complainant or, at least, that the Respondent unduly benefits from the Complainant's trademarks (*Telstra Corporation Limited v. Peter Lombardo, Marino Sussich et Ray Landers*, WIPO Case No. [D2000-1511](#); *Swarovski Aktiengesellschaft v. www.swarovski-outlet.org*, WIPO Case No. [D2013-0335](#); *Milipol v. Herbert Szekely*, WIPO Case No. [D2013-1752](#)).

The combination of the above elements demonstrates bad faith use by the Respondent of the disputed domain name (*Associated Newspapers Limited c. WhoisGuard, Inc. / Paul Baso*, WIPO Case No. [D2020-3261](#)) and, as foreseen in [WIPO Overview 3.0](#), section 3.2.2., also supports a bad faith registration inference. The Respondent has not exercised its right to defend itself and has not rebutted said inference, so the Panel must conclude that the third condition of paragraph (4)(a) of the Policy is satisfied.

Accordingly, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith and hence the third condition of paragraph 4(a) of the Policy has been fulfilled.

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, <upfieldsourcing-ab.com>, be transferred to the Complainant.

/Benoit Van Asbroeck/

Benoit Van Asbroeck

Sole Panelist

Date: September 27, 2022