

ADMINISTRATIVE PANEL DECISION

Tetra Laval Holdings & Finance S.A. v. Trupper Mexico, trupper mexico
Case No. D2022-3489

1. The Parties

The Complainant is Tetra Laval Holdings & Finance S.A., Switzerland, represented by Aera A/S, Denmark.

The Respondent is Trupper Mexico, trupper mexico, Mexico.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 20, 2022. On September 21, 2022, 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 (Whols Agent, Whois Privacy Agent Service, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 22, 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 September 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 September 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 21, 2022.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on October 26, 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 part of the Tetra Pak Group. The Tetra Pak Group is a multinational food processing and packaging company founded in 1947 in Sweden by Ruben Rausing. The Tetra Pak Group employs more than 25,000 people and is doing business in more than 160 countries, including United States of America and Mexico.

The Complainant owns a number of trademark registrations worldwide. As such, a United States Patent and Trademark office registration no. 586,480 for TETRA PAK registered on March 9, 1954.

Previous UDRP decisions have recognized the fame of the TETRA PAK trademark; see by way of example, *Tetra Laval Holdings & Finance S.A. v. WhoisGuard Protected, WhoisGuard, Inc. / Zetao Wang*, WIPO Case No. [D2021-0559](#).

The Complainant is the owner of more than 300 domain names registrations containing the TETRA PAK mark distributed among generic Top Level Domains (“gTLDs”) and country-code Top Level Domains (“ccTLDs”).

The disputed domain name was registered on August 15, 2022, and used to redirect to a website that purport to offer cars for sale while displaying the TETRA PAK trademark in it. However, at the moment this decision was issued the disputed domain name was inactive.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its trademark and trade name TETRA PAK as it incorporates the entirety of the well-known trademark and trade name TETRA PAK in combination with the word “certificados”. The addition of the descriptive term “certificados” do not impact the overall impression of the dominant part of the name “tetrapak”. To support such findings the Complainant refers to sections 1.7 and 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) and provides a number of UDRP cases to reinforce its conclusions.

Moreover, the Complainant notes that the gTLD “.com” is usually disregarded under the confusing similarity test as it is a technical requirement of registration.

With regard to the second requirement, the Complainant asserts that the Respondent has no rights to or legitimate interest in the disputed domain name based on the Complainant’s continuous and long prior use of its trademark TETRA PAK. The Respondent is not affiliated or related to the Complainant in any way or licensed or otherwise authorized to use the TETRA PAK mark in connection with a website or for any other purpose. Further, the Respondent is not using the disputed domain name in connection with any *bona fide* offering of goods or services. Besides the Complainant highlights that the Respondent is not generally known by the disputed domain name and has not acquired any trademark or service mark rights in that name or mark.

The Complainant contends that the composition of the disputed domain name, reproducing TETRA PAK trademark in its entirety, is such to carry a risk of implied affiliation that cannot constitute fair use. See [WIPO Overview 3.0](#), section 2.5.1.

Finally, the Complainant's allegations stand out the Respondent's bad faith use and registration. Indeed, the Complainant alleges that, due to the composition of the disputed domain name, the Respondent must have been aware of the Complainant's TETRA PAK trademark and its business. The Respondent's goal to register the disputed domain name was to trade-off the Complainant's goodwill and reputation or otherwise create a false association, sponsorship or endorsement with the Complainant. In sum, due to the well-known status of the trademark TETRA PAK and the Complainant's world-wide business including Mexico, the Respondent was more likely than not aware of the Complainant's trademarks at the time of the registration of the disputed domain name.

The Complainant also asserts that the Respondent has engaged in a pattern of conduct of improperly registering and using domain names which incorporate the Complainant's marks. This kind of conduct amounts to registration and use of the domain name in bad faith. See *Tetra Laval Holdings & Finances S.A. v. Whols Agent, Whols Privacy Protection Service, Inc. / Trupper Mexico*, WIPO Case No. [D2022-2490](#).

The Complainant finishes with the assertion that the Respondent's registration and the use of disputed domain name and the Complainant's TETRA PAK trademarks was to create an impression of an association with the Complainant. However, the Complainant affirms that there is no business relationship with the Respondent and hence the unauthorized use of the TETRA PAK trademark is tarnishing the reputation of the Complainant.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

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

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a Response. Under paragraph 14(a) of the Rules in the event of such a "default" the Panel is still required "to proceed with a decision on the complaint", whilst under paragraph 14(b) it "shall draw such inferences there from as it considers appropriate". This dispute resolution procedure is accepted by the domain name registrant as a condition of registration.

A. Identical or Confusingly Similar

The Complainant has established trademark rights as set out in section 4. Thus, the Panel is satisfied that the Complainant has rights in the TETRA PAK trademark for purposes of the Policy paragraph 4(a)(i). Accordingly, the test for identity or confusing similarity under the first element rests on the comparison between the disputed domain name and the mark. That said, it is apparent that the TETRA PAK mark is reproduced in its entirety within the disputed domain name. The addition of the word "certificados" does not prevent a finding of confusing similarity. See section 1.8 of [WIPO Overview 3.0](#): "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".

Further, the gTLDs are generally irrelevant to the consideration of identity or confusing similarity between a trademark and a domain name. See section 1.11 of [WIPO Overview 3.0](#).

Therefore, the first requirement is met under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

[WIPO Overview 3.0](#), section 2.1 says that: “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name”.

The Complainant contends that the Respondent has no rights or legitimate interest in the disputed domain name for several reasons. Firstly, the Respondent is not affiliated with the Complainant nor has the Complainant licensed or otherwise authorized the Respondent to use its trademarks in a domain name. Secondly, the Complainant alleges that there is no *bona fide* offering of goods or services since the Respondent was well aware of the Complainant and its marks when it registered the disputed domain name. Hence, the Respondent is intentionally diverting consumers for commercial gain.

The Complainant also highlights how the composition of the disputed domain name, reproducing the TETRA PAK trademark in its entirety, implies a high risk of affiliation that cannot constitute fair use. The Panel looks at WIPO Overview 2.5.1: “Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.”

Further, the use of the TETRA PAK trademark in the corresponding website without authorization of the Complainant is evidence of the lack of fair use and hence, lack of rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has made a *prima facie* case and that the Respondent has not rebutted after being duly notified by the Center.

Under these circumstances the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

While paragraph 4(b) provides a list of non-exclusive scenarios that constitutes evidence of a respondent’s bad faith, [WIPO Overview 3.0](#) section 3.1 shows how bad faith registration and use maybe met under the UDRP. That said, bad faith registration and use is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark.

The evidence demonstrates how the TETRA PAK trademark is well-known in connection to the Complainant’s activity and business. The Panel is of the opinion that the similarity between the disputed domain name and the TETRA PAK trademark suggests that the disputed domain name either resolves to the Complainant’s official website or at least resolves to a website affiliated with the Complainant. However, here the Internet user is baited and switched to a website unaffiliated to the Complainant that purport to offer cars for sale while displaying the TETRA PAK trademark. The Panel also notes the well-known value of the TETRA PAK trademark as set out in section 4. Accordingly, and on the balance of probabilities, the Panel finds that the Respondent knew or should have known about the Complainant and its trademarks at the moment of the registration of the disputed domain name.

The Complainant has established how the Respondent attempts to create an unfair association or affiliation with the Complainant, noting how the TETRA PAK trademark is reproduced in the disputed domain name and in the corresponding website. Thus, the Respondent attempts to trade-off the Complainant by using the Complainant's trademark. Therefore the use of the disputed domain name fits with the circumstances described in 4b(iv) of the Policy.

As further evidence of the Respondent's bad faith registration and use of the disputed domain names, the Complainant notes how the Respondent has engaged in a pattern of conduct within the meaning of paragraph 4(b)(ii) of the Policy. See section 3.1.2 of [WIPO Overview 3.0](#) and see also *Tetra Laval Holdings & Finances S.A. v. Whols Agent, Whols Privacy Protection Service, Inc. / Trupper Mexico, supra*.

The Panel notes that the disputed domain name is currently inactive, which does not alter the findings of the Panel. Thus, passive holding doctrine applies when considered the totality of the circumstances in this case. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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, <certificadostetrapak.com>, be transferred to the Complainant

/Manuel Moreno-Torres/

Manuel Moreno-Torres

Sole Panelist

Date: November 9, 2022