

ADMINISTRATIVE PANEL DECISION

Barry Callebaut AG, Barry Callebaut Belgium NV v. Jacuzzi Europe S.p.A.
Case No. D2023-2884

1. The Parties

The Complainants are Barry Callebaut AG, Switzerland, and Barry Callebaut Belgium NV, Belgium, represented by Adlex Solicitors, United Kingdom.

The Respondent is Jacuzzi Europe S.p.A., Italy.

2. The Domain Name and Registrar

The disputed domain name <barry-callebaut-pl.com> (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 July 6, 2023. On July 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 6, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainants on July 13, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on July 17, 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 July 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 11, 2023.

The Center appointed Jeremy Speres as the sole panelist in this matter on August 21, 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 Complainants are part of the Barry Callebaut Group, a leading manufacturer of chocolate and cocoa products. Since 1996, the Group has traded under the brand BARRY CALLEBAUT. The Complainant Barry Callebaut AG owns numerous trade mark registrations for the BARRY CALLEBAUT mark around the world, including International Trade Mark Registration No. 702211 for BARRY CALLEBAUT in classes 29 and 30, registered on September 4, 1998, designating the Respondent's country of Italy amongst others. The Complainants' mark has been recognised as being well-known by prior UDRP panels. See *e.g. Barry Callebaut AG and Barry Callebaut Belgium NV v. mail filter*, WIPO Case No. [D2023-1063](#).

The Domain Name was registered on June 9, 2023 and does not resolve to any website.

5. Parties' Contentions

A. Complainants

The Complainants contend that the Domain Name is confusingly similar to their BARRY CALLEBAUT mark, that the Respondent has no rights or legitimate interests in the Domain Name, and the Domain Name was registered and used in bad faith under the passive holding doctrine in light of the prior repute of the Complainants' mark.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

A. Preliminary Issue – Consolidation – Multiple Complainants

The Panel notes that the Complainants are two entities within a group of related companies that have a specific common grievance. The Complainant Barry Callebaut AG holds rights in the relevant trade mark registrations, while the Complainant Barry Callebaut Belgium NV is the main trading company. As such, the Complainants both have interests in the BARRY CALLEBAUT mark. It would be equitable and procedurally efficient to allow consolidation in these circumstances (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 4.11.1).

B. Identical or Confusingly Similar

The Complainants' registered BARRY CALLEBAUT mark is wholly contained within the Domain Name as its first element. Where the trade mark is recognisable within the disputed domain name (as in this case), the addition of other terms does not prevent a finding of confusing similarity ([WIPO Overview 3.0](#) at section 1.8). The Complainants have satisfied the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Complainants' mark was registered and well-known for many years prior to registration of the Domain Name. The Domain Name is confusingly similar to the Complainants' mark and the Complainants have certified that the Domain Name is unauthorised by it.

For the reasons discussed in relation to bad faith below, there is no conceivable good faith use of the Domain Name. There is no evidence that any of the circumstances set out in paragraph 4(c) of the Policy, nor any others which might confer rights or legitimate interests upon the Respondent, pertain. The Complainants have satisfied paragraph 4(a)(ii) of the Policy by virtue of having made out an unrebutted *prima facie* case ([WIPO Overview 3.0](#) at section 2.1).

D. Registered and Used in Bad Faith

UDRP panels have consistently found that registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term, as in this case) to a famous or well-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#) at section 3.1.4).

The Complainants' well-known BARRY CALLEBAUT mark has no generic or descriptive meaning that the Respondent might in good faith have sought to adopt, and the mark is highly specific to the Complainants. The Complainants also have a presence in Italy, where the Respondent resides, according to the Whois records. It is therefore difficult to conceive of any good faith use of the Domain Name, the composition of which implies that it is associated with the Complainants' presence in Poland, where the Complainants have a subsidiary. This indicates bad faith under paragraph 4(b)(iv) of the Policy ([WIPO Overview 3.0](#) at section 3.1.4).

Mail exchange ("MX") records are set for the Domain Name, enabling use for email. This raises the risk of email-based fraud (*Statoil ASA v. Registration Private, Domains By Proxy, LLC / Eldar Saetre*, WIPO Case No. [D2018-0563](#)).

The fact that the Domain Name does not resolve to any website does not prevent a finding of bad faith under the doctrine of passive holding; all the factors that panels typically consider under that doctrine favour the Complainant ([WIPO Overview 3.0](#) at section 3.3).

The Panel draws an adverse inference from the Respondent's failure to take part in the present proceeding where an explanation is certainly called for ([WIPO Overview 3.0](#) at section 4.3).

The Complainants have satisfied 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 Domain Name, <barry-callebaut-pl.com>, be transferred to the Complainant.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: September 4, 2023