

ADMINISTRATIVE PANEL DECISION

Roquette Frères v. Stephen Wheeler

Case No. D2023-4464

1. The Parties

The Complainant is Roquette Frères, France, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Stephen Wheeler, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <sethness-roquettes.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 October 27, 2023. On October 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 27, 2023, 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 (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 Complainant on October 31, 2023, 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 November 2, 2023.

The Center verified that the Complaint together with the amendment to 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 November 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 5, 2023.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on December 27, 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 Complainant is a French company active in the field of liquid and powder caramel colors for the food and beverage industry. The Complainant's predecessor, named "Sethness" after the surname of its founder, Mr. Charles O. Sethness, was founded in 1880 in the United States. At that time, the Complainant produced caramel colors for the beverage industry in the United States. In 1995, the Complainant was largely present at the international level, and produced over 7,000 tons of caramel color annually. In 2018, the United States family-owned company Roquette acquired the Complainant and changed its name to "Sethness Roquette". Nowadays, the Complainant manufactures a wide range of liquid and powder caramel colors in the United States, France, India, and China.

The Complainant is the owner of several trademark registrations for SETHNESS ROQUETTE in various jurisdictions, including the following:

- SETHNESS-ROQUETTE and Chinese characters, Chinese registration No. 12601187, filed on May 17, 2013 and registered on October 14, 2014, covering goods in class 2;
- SETHNESS ROQUETTE (word mark), French registration No. 4552348, registered on May 17, 2019, covering goods in class 2;
- SETHNESS ROQUETTE (word mark), International registration No. 1489477, registered on June 25, 2019, designating Canada, the European Union, India, and the United States, and covering goods in class 2.

Moreover, the Complainant is the owner of the domain names <sethness-roquette.com>, registered on May 25, 2006, which resolves to its main website, and <sethness.com>, registered since July 18, 1997, also used to advertise its business.

The Respondent is reportedly an individual located in the United States. The disputed domain name was registered on May 23, 2023. The disputed domain name initially resolved to a parked page of the Registrar containing sponsored pay-per click ("PPC") links to third parties' websites. In September 2023, the Complainant sent to the Privacy Service provider, appearing as the registrant of the disputed domain name in the Whois database, a cease and desist letter, pointing out its earlier conflicting trademark rights. In this letter, the Complainant requested the immediate transfer of the disputed domain name in exchange of the reimbursement of the out-of-pocket costs the Registrar might charge for the transfer, and the registration fee paid for the registration of the disputed domain name. The Respondent did not reply to the Complainant's letter, nor to the two reminders sent in September 2023. However, the disputed domain name no longer resolved to the Registrar's parked page mentioned above, but to a page displaying the wording, "This site can't be reached".

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is a purposeful misspelling of the Complainant's trademark. The only differences between the disputed domain name and the Complainant's trademark are the addition of a letter "s" at the end of the Complainant's trademark, and of a hyphen

between the words “sethness” and “roquettes”. These minor differences do not change the overall impression of the disputed domain name as being confusingly similar to the Complainant’s SETHNESS ROQUETTE trademark.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant did not sponsor the Respondent and did not authorize the Respondent to use the Complainant’s trademark in any manner whatsoever, including in domain names. The Complainant is not affiliated with the Respondent, is not a Complainant’s licensee and does not appear to be commonly known by the disputed domain name. Prior to the filing of the Complaint, the Respondent was using the disputed domain name to resolve to a website featuring sponsored links to third-party websites, most of which did not appear to relate to the Complainant. Presumably, the Respondent received PPC fees from the linked websites. As such, the Respondent was not using the disputed domain name to provide a *bona fide* offering of goods or services. Currently, the disputed domain name is inactive. This use does not amount to a *bona fide* nor to a legitimate or fair use of the disputed domain name.

In relation to bad faith, the Complainant maintains that its SETHNESS ROQUETTE trademark is known internationally. The Complainant has been a market leader in the caramel color industry for over 100 years. The Complainant sold its goods under the SETHNESS name and trademark since 1880 and under the name SETHNESS ROQUETTE since 2014. The Complainant’s trademark coincides with the names of the founders of the two family-owned businesses that merged to form the Complainant. Accordingly, the trademark SETHNESS ROQUETTE has no meaning when divorced from the Complainant. A simple search across a number of Internet search engines for the words “sethness roquette” returns multiple links referring to the Complainant and its business. The registration of the disputed domain name, which is a minor variation of the Complainant’s trademark, implies bad faith. By registering the disputed domain name, the Respondent has shown that it was familiar with the Complainant and its trademark.

The Respondent was using the disputed domain name to confuse unsuspecting Internet users looking for the Complainant’s products, and to mislead them as to the source of the disputed domain name and website. The Respondent cannot discharge its responsibility because the PPC links associated with its website are generated by a third party, as this circumstance cannot prevent bad faith. Likewise, the fact that the disputed domain name currently resolves to an inactive website cannot prevent a finding of bad faith. More specifically, there is no plausible good faith reason or logic for the Respondent to have registered the disputed domain name. Rather, it is indicative of an intention to hold the disputed domain name for some future active use in a way, which would be competitive with or otherwise detrimental to the Complainant. Furthermore, in light of the circumstances of this case, it is not possible to conceive any plausible actual or contemplated legitimate active use of the disputed domain name by the Respondent.

Lastly, the Complainant points out that the Respondent ignored the Complainant’s attempts to resolve the dispute amicably as it failed to reply to the Complainant’s cease and desist letter, and hid its identity behind a privacy shield. Both these circumstances are further elements of the Respondent’s bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The disputed domain name differs from the Complainant's mark only by the addition of the adjacent keyboard letter "s" at the end of the word "roquette" and of a hyphen between the words "sethness" and "roquettes". Accordingly, the disputed domain name contains an intentional misspelling of the Complainant's mark and is confusingly similar to it. [WIPO Overview 3.0](#), section 1.9. Furthermore, the addition of a hyphen does not affect the confusing similarity, particularly given its inclusion in the Complainant's Chinese trademark registration mentioned above.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Respondent is not related to the Complainant and the Complainant authorized the Respondent to make use of its trademark (or a confusingly similar one) in a domain name. The Respondent does not appear to be commonly known by the disputed domain name.

Prior to the filing of the Complaint, the Respondent used the disputed domain name to host a parked page containing PPC links to third parties' websites. The Respondent is probably deriving an income from each click on the sponsored links. The use of a domain name in connection with PPC links does not represent a *bona fide* offering where such links capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9. In the instant case, the Panel notes that the Complainant's trademark is highly distinctive as it consists of the conjunction of the family names of the two founders of the companies forming the Complainant's business. Moreover, the Complainant has been operating in the caramel color field for more than 140 years. Therefore, the Complainant's trademark is likely to have gained a certain recognition among the consumers of reference. By registering a domain name, which is a willful misspelling of the Complainant's mark and which includes a hyphen between the two family names of the founders of the Complainant, thus adding further emphasis to their names, the Respondent has shown a clear intention to capitalize on the recognition and goodwill of the Complainant's mark and to mislead the relevant consumers. This malicious intention is also confirmed by the fact that the Complainant's main website is linked to a domain name consisting of the words "sethness" and "roquette" separated by a hyphen (namely, <sethness-roquette.com>). Thus, the disputed domain name is almost

identical to the Complainant's principal domain name, which reinforces the likelihood that the Respondent sought to mislead Internet users through such inherently misleading disputed domain name.

The current lack of use of the disputed domain name cannot confer to the Respondent rights or legitimate interests in the disputed domain name. The disputed domain name in itself is already an evidence of the Respondent's intention to impersonate the Complainant and to mislead the Complainant's potential consumers. Moreover, the Respondent past use of the disputed domain name clearly shows a lack of *bona fide* use and a lack of legitimate noncommercial or fair use of the disputed domain name under paragraph 4(c)(i) and (iii) of the Policy. Such past use cannot be undermined by a subsequent non-use occurred after the Respondent received the Complainant's cease and desist letter and reminders.

Based on the available record, the Panel finds that the Complainant duly made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent should have provided appropriate evidence to rebut the Complainant's arguments but decided not to file a Response. Accordingly, the Panel finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain name, which is a willful misspelling of the Complainant's trademark. The disputed domain name is almost identical to the Complainant's trademark and the Complainant's main domain name, and is therefore highly misleading for Internet users expecting to find the Complainant. The Panel is of the opinion that the Respondent was well aware of the Complainant's trademark when it registered the disputed domain name. The Complainant's trademark is inherently distinctive as it consists of the union of the two surnames of the founders of the companies that gave rise to the Complainant. Not to mention the fact that these surnames are uncommon surnames. Therefore, the adoption of the disputed domain name, almost identical to the Complainant's mark, cannot have occurred by chance. Moreover, the Respondent has decided to separate the words "sethness" and "roquettes" in a way that renders the disputed domain name almost identical to the Complainant's main domain name <seethness-roquette.com>. The registration of the disputed domain name confusingly similar to the Complainant's mark, being aware of such mark and with no rights or legitimate interests, amounts to registration in bad faith.

As far as use of the disputed domain name in bad faith is concerned, the Panel notes that at first, the Respondent used the disputed domain name to resolve to a parked page containing sponsored links to third parties' websites. After receiving the Complainant's cease and desist letter and reminders, the disputed domain name became inactive.

It is likely that the Respondent received click-through revenue from the sponsored links. Thus, in light of the overall situation, the Respondent was using the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's parked page, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's parked page.

Currently, the disputed domain name does not resolve to an active website. However, panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the Complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated

good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. The Panel notes that the Complainant's trademark is inherently distinctive. Moreover, the Respondent failed to submit a Response or to provide evidence of actual or contemplated evidence of good faith use. The Respondent concealed his identity behind a privacy service shield and did not reply to the Complainant's cease and desist letter and subsequent reminders. Lastly, considering that the Complainant's mark is uniquely associated with the Complainant and certainly enjoys recognition in its field, any good-faith use of the disputed domain name is implausible.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <sethness-roquettes.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: January 10, 2024