

## **ADMINISTRATIVE PANEL DECISION**

Britannia Industries Limited v. Paul Alexander, Paul Alexander  
Case No. D2023-5079

### **1. The Parties**

The Complainant is Britannia Industries Limited, India, represented by Fidus Law Chambers, India.

The Respondent is Paul Alexander, Paul Alexander, United Kingdom (“UK”).

### **2. The Domain Name and Registrar**

The disputed domain name <britanniabiscuits.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2023. On December 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 7, 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 December 8, 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 December 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 2, 2024.

The Center appointed Emre Kerim Yardimci as the sole panelist in this matter on January 8, 2024. 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 leading food company that was established in 1892 with “The Britannia Biscuit Company” trade name, which then changed its name as “Britannia Industries Limited” in 1979. The Complainant sells biscuits, breads, and dairy products throughout India and in more than 70 countries across the globe and has been serving food and beverage products since 1918.

The Complainant holds trademark registrations for BRITANNIA such as the following:

- the Indian Trademark Registration no. 289346 for BRITANNIA, filed on July 12, 1973, and registered on May 19, 1975, covering goods in the International Class 30 including biscuits where the first owner trade name is The Britannia Biscuit Company Limited;
- UK Trademark Registration no. 2529770 for BRITANNIA EAT HEALTHY, THINK BETTER, design mark, registered on October 26, 2009, in Class 30.

The Complainant also owns a number of domain names including <britannia.co.in> which redirects to its official website.

The disputed domain name was registered on February 15, 2023, and at the time of the decision it resolves to an inactive parked website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that the disputed domain name incorporates the Complainant's registered trademark BRITANNIA and the additional descriptive term “biscuit” which reinforces the confusion with the Complainant as it directly falls within the main field of its activity.

The Complainant considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name, mainly because the Complainant has neither licensed nor otherwise authorized the Respondent to use its marks or to apply for or use any domain name incorporating the trademark BRITANNIA.

The Complainant also states that the Respondent is not using the disputed domain name in connection with any *bona fide* offering of goods and services.

Finally, in addressing the question of registration and use of the disputed domain name in bad faith, the Complainant observes that the Respondent is well aware of the Complainant's trademark considering that it has registered with the descriptive term “biscuits” which is clearly targeting the Complainant's most well-known products.

##### **B. Respondent**

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

## 6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

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

### A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar for the purpose of the Policy to the Complainant's trademark BRITANNIA.

The disputed domain name wholly incorporates the Complainant's trademark and the addition of the term "biscuits" does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

As regards the generic Top-Level Domain ("gTLD") ".com", which is viewed as a standard registration requirement, it is typically disregarded under the confusing similarity test.

For the reasons mentioned above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's BRITANNIA trademark. The Complainant has thus fulfilled paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

The onus is upon the Complainant to make out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and it is then for the Respondent to rebut this case through the production of evidence to the contrary.

The Panel accepts the Complainant's submissions that the Respondent does not appear to have been known by the disputed domain name, has not made demonstrable preparations to use the disputed domain name, and the Respondent is not making a legitimate noncommercial use of the disputed domain name.

The Respondent has not filed a Response.

It has no consent from the Complainant to register any domain name incorporating the Complainant's trademark, it has not used the disputed domain names for a *bona fide* offering of goods or services, and the Respondent is not commonly known by the disputed domain name, nor is it making a noncommercial or fair use of the disputed domain name.

The fact that the Respondent is passively holding of the disputed domain name does not give rise to any rights or legitimate interests in accordance with settled previous UDRP decisions. While "Brittania" can be considered an ordinary English word, sometimes used as the national personification of the country "Britain" (i.e., the United Kingdom), the composition of the disputed domain name creates a direct inference of association with the Complainant given the descriptive addition of "biscuits" that identifies the Complainant's main products offered under the BRITANNIA trademark.

In the Panel's view, the Complainant has made out their *prima facie* case under this element of the Policy and the Respondent, who is in default, has failed to rebut this case.

In the circumstances of this case, and in view of the Panel's discussion above, the Panel finds that the second element of the Policy has been established.

### C. Registered and Used in Bad Faith

The Panel accepts the Complainant's assertions that the trademark BRITANNIA is a well-known trademark in its field of goods and services.

The incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#); *General Electric Company v. CPIC NET and Hussain Syed*, WIPO Case No. [D2001-0087](#); and *Microsoft Corporation v. Montrose Corporation*, WIPO Case No. [D2000-1568](#)).

The Respondent has registered the disputed domain name but has not put it to any material use.

The Respondent's registration of the disputed domain name with addition of the descriptive term "biscuits" - which refers to Complainant's main product line - supports a finding of bad faith registration as it clearly targets the Complainant's company and its products.

The Panel considers that the Respondent is likely attempting to build an appearance that the disputed domain name is connected or associated to the Complainant. The Respondent, by retaining control of the disputed domain name creates a real or implied threat to the Complainant.

The Panel is not aware of any use, seeing as the Respondent is holding the disputed domain name passively. It has long been generally held in UDRP decisions that the passive holding of a domain name that incorporates a well-known trademark, without any actual or contemplated good faith use, does not prevent a finding that the domain name is in use within the requirements of paragraph 4(a)(iii) of the Policy (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Lastly, the Panel observed that the Respondent used a privacy shield. While the Respondent's use of a privacy service will not in itself constitute bad faith under the Policy, the Panel may still take it into account and draw adverse inferences under certain circumstances. The use of the privacy shield in this case together with other elements gives rise to the suspicion that the privacy shield was used to mask the identity of the underlying registrant, and, thus, supports a finding of bad faith.

Given the Respondent's lack of participation in this proceeding, the history and well-known character of the Complainant's mark generally and within the Respondent's reported residence in the UK, the composition of the disputed domain name, the lack of use of the disputed domain name, and the Respondent's use of privacy service, the totality of circumstances supports an inference of bad faith. Therefore, in the view of cumulative circumstances, the Panel finds that the requirement of registration and use in bad faith is satisfied, according to the Policy, paragraph 4(a)(iii)

### 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 <britanniabiscuits.com> be transferred to the Complainant.

/Emre Kerim Yardimci/

**Emre Kerim Yardimci**

Sole Panelist

Date: January 24, 2024