

ADMINISTRATIVE PANEL DECISION

Fairlife, LLC v. Ephraim Mabuto
Case No. D2024-1484

1. The Parties

The Complainant is Fairlife, LLC, United States of America (“U.S.” or “United States”), represented by Shumaker, Loop & Kendrick, LLP, U.S.

The Respondent is Ephraim Mabuto, Canada.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2024. On April 12, 2024, 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 (JOHN DOE) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 17, 2024, 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 the same day.

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 April 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2024. The Respondent sent an email communication to the Center on April 19, 2024, expressing their willingness for reaching a settlement. The Center sent the possible settlement email to the Parties on April 22, 2024. However, the Complainant did not request a suspension

for settlement talks. Accordingly, the Center notified the Commencement of Panel Appointment Process to the Parties on May 9, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on May 15, 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 an U.S.-based business that provides high quality milk and dairy products across the United States and internationally. The Complainant owns numerous trademarks containing the name FAIRLIFE, inter alia:

- United States Trademark, Registration No. 4712931, registered on March 31, 2015;
- United States Trademark, Registration No. 4573174, registered on July 22, 2014;
- Canadian Trademark, Registration No. TMA1011512, registered on December 19, 2018;
- European Union Trademark, Registration No. 12278535, registered on September 26, 2016; and
- Japanese Trademark, Registration No 5852057, registered on May 20, 2016 (Annex 4 and 5 to the Complaint).

The Complainant further owns the domain name <fairlife.com> which addresses the official FAIRLIFE website (Annex 6 to the Complaint).

The disputed domain name was registered on July 11, 2023 (Annex 1 to the Complaint). At the time of filing the Complaint the disputed domain name resolved to a website which provided information about the Complainant's products together with FAIRLIFE-figurative trademarks and photographs of the Complainant's products as well as a link to another website where competitive products to the Complainant's products were offered for sale (Annex 7 and 8 to the Complaint).

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 FAIRLIFE trademark is distinctive, famous, and well known around the world. The Complainant notes that the disputed domain name contain the FAIRLIFE trademark in its entirety, simply adding the descriptive terms "protein" and "shake" which refer to the Complainant's products. The Complainant submits that it is therefore inconceivable that the Respondent would not have been aware of the Complainant's trademark when registering the disputed domain name, or that there would be any legitimate use for the disputed domain name. Further, the Complainant has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the FAIRLIFE trademark in any manner.

The Complainant notes that the disputed domain name was used to address a website which contained the distinctive FAIRLIFE mark as well as photographs of the Complainant's products without any authorization by the Complainant. Further, the Complainant contends that the Respondent redirects all traffic to another website where the Complainant's products are not available for purchase, just competitive products.

Hence, the Complainant contends, that based on the totality of these factors, it is clear that the Respondent is acting in bad faith with the intent to create a likelihood of confusion with the Complainant's mark and 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 interests with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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 the mark FAIRLIFE for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

In the present case, the disputed domain name is confusingly similar to the FAIRLIFE mark in which the Complainant has rights since it incorporates the entirety of the mark FAIRLIFE and only adds the terms "protein" and "shakes" at the end.

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms does not prevent a finding of confusing similarity under the first element of the Policy ([WIPO Overview 3.0](#), section 1.8). This is the case at present, since the suffixes are merely descriptive.

Finally, it has also long been held that generic Top Level Domains (in this case ".com") are generally disregarded when evaluating the confusing similarity of a disputed domain name. [WIPO Overview 3.0](#), section 1.11.1.

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.

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. 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 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, since it has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the FAIRLIFE trademark in any manner.

The Respondent is not an authorized dealer of the Complainant's products. The disputed domain name resolved to a website which displayed prominently the Complainant's trademark together with photographs of the Complainant's products, and the Respondent did not show a right or legitimate interest in that disputed domain name. Moreover, the Respondent provides a link on its website to another website where competitive products to the Complainant's products were offered for sale: As outlined in the "Oki Data test", for showing a right or legitimate interest the respondent must, inter alia, accurately and prominently disclose its relationship with the trademark holder and a respondent must use the site to sell only the trademarked goods or services. The Panel notes, that the Respondent's use of the disputed domain name clearly fails to meet these essential criteria.

Furthermore, the nature of the disputed domain name, comprising the Complainant's mark in its entirety together with the terms "protein" and "shakes", cannot be considered fair as these falsely suggest an affiliation with the Complainant and its products that does not exist. [WIPO Overview 3.0](#), section 2.5.

The Respondent did not reply and hence has not rebutted the Complainant's contentions.

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

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith; and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has established rights in the registered trademark FAIRLIFE, long before the registration of the disputed domain name. Further, the trademark FAIRLIFE is distinctive and well known.

Hence, it is inconceivable for this Panel that the Respondent has registered and used the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name entirely incorporates the Complainant's distinctive and registered trademark FAIRLIFE together with the terms "protein" and "shakes" which refer to the Complainant's products and strongly indicates that the Respondent was aware of the Complainant and its FAIRLIFE mark at the time of registration of the disputed domain name.

All of these facts indicate that the Respondent must have been aware of the Complainant's business and trademark when registering the disputed domain name.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) Further, the Complainant put forward evidence that the disputed domain name resolved to a website which prominently displayed the Complainant's trademark and photographs of the Complainant's products. In doing so, the Respondent has attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website according to paragraph 4(b)(iv) of the Policy which constitutes bad faith registration and use of the disputed domain name.

Moreover, the Respondent lures unsuspecting Internet users to its website and then directs them to another website to pass Respondent's website off as Complainant's website and thereby profit from Complainant's marks – this also constitutes bad faith under paragraph 4(b)(iv) of the Policy.

The evidence and documents produced and put forward by the Complainant together with the fact that the Respondent has failed to present any evidence of any good faith registration and use with regard to the disputed domain name further supports the finding of bad faith.

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 <fairlifeproteinshakes.com> be cancelled.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: May 28, 2024