

ADMINISTRATIVE PANEL DECISION

Asociación de la Industria del Salmón de Chile A.G. v. Jorge Wurth, Alkimia & Salispiper Comunicaciones Ltda.
Case No. D2024-1806

1. The Parties

The Complainant is Asociación de la Industria del Salmón de Chile A.G., Chile, represented by Sargent & Krahn Procuradores Internacionales de Patentes y Marcas Ltda., Chile.

The Respondent is Jorge Wurth, Alkimia & Salispiper Comunicaciones Ltda., Chile.

2. The Domain Name and Registrar

The disputed domain name <salmondechile.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 30, 2024. On May 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 8, 2024, 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 (Registration Private) and contact information in the Complaint.

The Center sent an email communication to the Complainant on May 10, 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 May 15, 2024.

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 May 16, 2024. In accordance with the Rules, paragraph 5, the due date for

Response was June 5, 2024. Aside from an informal communication, the Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on June 6, 2024.

The Center appointed Felipe Claro as the sole panelist in this matter on June 24, 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.

On July 15, 2024, the Center notified to the parties a Procedural Order issued by the Panel, which was answered by both parties; by the Respondent on July 18, 2024, and by the Complainant on July 19, 2024.

4. Factual Background

The Complainant operates and is widely known, among others, by the name “Salmón de Chile” within the salmon farming market. Salmon farming is the second largest export sector in Chile, and Chile is the second largest salmon producer in the world.

With over 35 years of experience, the Complainant brings together the main producers and suppliers of Atlantic Salmon, Coho and Trout, with offices in the Chilean Regions of Araucanía, Los Lagos, Aysén and Chiloé. Its mission is focused on unifying the main salmon producers in Chile to face the health, environmental, regulatory, social and economic challenges of the sector, both nationally and internationally.

The Complainant is the holder of several trademark registrations for SALMON DE CHILE or similar, some of them in association with the Chilean Governmental Organization “DIRECON - Dirección General de Relaciones Económicas Internacionales”.

A list of some of these trademarks is detailed below:

- (i) Registration No. 1.240.955, SALMONCHILE, registered on July 10, 2017 for class 25 in Chile.
- (ii) Registration No. 1.263.140, SALMON DE CHILE, registered on November 13, 2017 for class 35 in Chile
- (iii) Registration No. 1.271.769, SALMON DE CHILE, registered on March 20, 2018 for class 29 in Chile.

Additionally, the Complainant is the registered owner (or licensee) of the following domain names, among others:

- (i) <salmondechile.com.br>
- (ii) <salmondechile.cl>
- (iii) <salmonchile.cl>

The disputed domain name was registered on February 3, 2012. The disputed domain name was used to host a website from the Complainant. Currently, it does not resolve to a site with any content.

5. Parties' Contentions

A. Complainant

The Complainant contends that it is the owner of trademark registrations for SALMON DE CHILE or similar, some of them in association with “DIRECON - Dirección General de Relaciones Económicas Internacionales”.

The trademark portfolio was built up to protect the reputation and goodwill associated with its products and services and to promote the Chilean salmon industry.

The Respondent was hired to help in marketing the Chilean salmon in Brazil and it took advantage in registering and keeping the disputed domain name under its control during and even after the termination of a commercial agreement between them. The Respondent informally communicated to the Center that it would not transfer the disputed domain name to the Complainant if not paid for the transfer. These allegations were confirmed in the Complainant's reply to the Procedural Order issued by the Panel.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. It sent an informal communication to the Center, on May 15, 2024, indicating that payment was needed for the transfer to cover the maintenance costs of the disputed domain name, before considering its transfer to the Complainant. This was confirmed on the Respondent's reply to the Procedural Order issued by the Panel. No documentation concerning this monetary request was provided to the Center.

6. Discussion and Findings

In view of the lack of a formal response and supporting evidence by the Respondent as required under paragraph 5 of the Rules, the Panel may draw inferences from this circumstance as it considers appropriate, but will regardless weigh all available evidence available in the case file.. Under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding based on the Complainant's undisputed representations. In that regard the Panel makes the following specific findings.

A. Identical or Confusingly Similar

The Complainant's trademark SALMON DE CHILE is well known in Chile and abroad. This trademark is identical to the disputed domain name. The addition of a gTLD does not alter the identity existing between both signs.

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.

Registering a domain name that is identical to a well-known trademark has been objected in numerous decisions. See *Dymatize Enterprises LLC v. Bailey Ethan Dallinger, Pro Amino* WIPO Case No. [DAU2023-0010](#) <dymatize.au>: "This Panel observes that the Australian Registered trade mark in which the Complainant has rights is wholly incorporated into and exactly the same as the Disputed Domain Name. Accordingly, the Panel finds that the Disputed Domain Name is identical to the Complainant's trademark and the Complainant has established the first element of paragraph 4(a) of the Policy."; and *Gilead Sciences, Inc. v. fei na* WIPO Case No. [D2023-0301](#) <gileadsciences.shop>: "the Panel notes that the disputed domain name is exactly the same as Complainant's GILEAD SCIENCES mark, therefore the disputed domain name is identical for purposes of paragraph 4(a)(i) of the Policy".

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

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. It only requested payment to transfer the domain name to the Complainant, without proving any right or legitimate use over it.

The Respondent is a publicity agency which was hired by the Complainant to conduct publicity campaigns, which included the registration and handling of the disputed domain name.

The Respondent is not the legitimate creator of the trademark SALMON DE CHILE and has no legitimate right or interest in holding the disputed domain name.

The Respondent lacks a legitimate right or interest because it does not own any trademarks that resemble the Complainant’s mark.

The Complainant had a commercial relationship with the Respondent according to which the Respondent registered for the Complainant the disputed domain name. Once terminated the agreement the Respondent refused to transfer the disputed domain name to the Complainant. See [WIPO Overview 3.0](#), section 2.11.: “[...] a respondent claiming a right or legitimate interest in a domain name for example based on a prior agreement or relationship between the parties or based on past good-faith use (thus demonstrating merely a past right or legitimate interest) would not necessarily have rights or legitimate interests in the domain name, at the time a decision is rendered.”

The Respondent's lack of legitimate interest in this domain name is clear, because the agreement between the parties did not include a transfer of the trademark rights over the expression SALMON DE CHILE to the Respondent, nor any right to hold the registration in its name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Complainant hired the Respondent to promote its goods through advertising services to expand the presence of the SALMON DE CHILE brand in Brazil.

These services included the management of the disputed domain name during the duration of the agreement. The Respondent sent invoices to the Complainant regarding charges for renewing the disputed domain name.

The Respondent recognized that the disputed domain name was registered for the Complainant in the context of advertising services, referred to the name and trademarks of the Complainant, which were duly charged to the Complainant.

By refusing to transfer the domain name voluntarily, unless monetarily compensated, the Respondent is taking advantage of its position of having access to and managing the domain name. This has disrupted the operation of the web site by the Complainant, not being able to use the domain name to promote its trademark and industry.

From the facts evidenced in the Complaint, the Panel finds that the Respondent was requested to maintain the website, but it was not authorized to register the disputed domain name under its name, and having the Respondent done so (as confirmed by the Complainant when responding to the Procedural Order referred above and not rebutted by the Respondent), the Respondent went against the terms of the agreement and therefore acted in bad faith.

In the present case, the Panel notes that the Respondent has requested the Complainant to pay for the domain name maintenance but has not showed any right to receive such payment nor has indicated a due amount.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

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 <salmondechile.com> be transferred to the Complainant.

/Felipe Claro/

Felipe Claro

Sole Panelist

Date: July 28, 2024