

ADMINISTRATIVE PANEL DECISION

Barry Callebaut AG, Barry Callebaut Belgium NV v. Mr. Barry Callebaut
Case No. D2024-2731

1. The Parties

The Complainants are Barry Callebaut AG, Switzerland (the “First Complainant”), and Barry Callebaut Belgium NV, Belgium (the “Second Complainant”), represented by Adlex Solicitors, United Kingdom.

The Respondent is Mr. Barry Callebaut, France.

2. The Domain Name and Registrar

The disputed domain name <barry-callebaut-manufacturing-france.com> is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 4, 2024. On July 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 9, 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 July 10, 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 July 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 12, 2024.

The Center appointed Eva Fiammenghi as the sole panelist in this matter on August 14, 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 Complainants in this case are Barry Callebaut AG, a company incorporated in Switzerland, and Barry Callebaut Belgium NV, a company incorporated in Belgium. The Complainants are part of the Barry Callebaut international group of companies (the "Group"). The Group specializes in the production and marketing of high-quality chocolate and cocoa products. The First Complainant, the Group's holding company, owns an extensive international portfolio of registered trademarks for the term "Barry Callebaut". The Second Complainant is the main trading company for chocolate within the Group. The Complainants are hereinafter collectively referred to as the "Complainant".

The Complaint is based on several registered trademarks that are used in connection with the production and sale of chocolate and cocoa products:

- Swiss Trademark BARRY CALLEBAUT Reg. No. 453449 registered on July 28, 1998, in classes 29 and 30.
- Swiss Trademark BARRY CALLEBAUT Reg. No. 561861 registered on September 6, 2007, in classes 5, 29, and 30.

Information about the disputed domain name:

The disputed domain name <barry-callebaut-manufacturing-france.com> was registered on May 22, 2024. According to the Complainant, evidence, at June 6, 2024, the disputed domain name displayed a registrar holding page, and mail exchange (MX) records had been set up to enable email services.

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.

The Complainant argues that the disputed domain name is confusingly similar to its well-known BARRY CALLEBAUT trademarks, which is incorporated in its entirety within the disputed domain name. The addition of the terms "manufacturing" and "france" does not mitigate this similarity but rather increases the likelihood of confusion. These terms are directly related to the Complainant's business activities and geographical presence, further strengthening the association with the Complainant's trademarks.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with or authorized by the Complainant in any way to use the BARRY CALLEBAUT trademarks. Furthermore, the Respondent has not demonstrated any use of the disputed domain name that would constitute a legitimate interest, such as a bona fide offering of goods or services. The disputed domain name was registered by the Respondent without the Complainant's knowledge or consent, indicating a lack of legitimate interests.

The Complainant asserts that the disputed domain name was registered and is being used in bad faith. The timing of the dispute domain name registration, its content, and the absence of any legitimate use by the Respondent indicate that the Respondent intended to exploit the reputation of the BARRY CALLEBAUT trademarks. The Complainant points out that the inclusion of the terms "manufacturing" and "france" in the disputed domain name is a clear attempt to mislead consumers into believing that the disputed domain name

is associated with the Complainant, thus disrupting the Complainant's business or profiting from its established trademark. This, the Complainant argues, constitutes evidence of bad faith.

The Complainant highlights the established reputation of the BARRY CALLEBAUT trademarks, which is internationally recognized and has been in use for decades. The combination of this strong trademark with terms that directly relate to the Complainant's business activities in the disputed domain name is a deliberate act of bad faith by the Respondent, designed to deceive or confuse the public.

The Complainant also emphasizes the lack of any response or defense from the Respondent, which further supports the claim that the disputed domain name was registered and used in bad faith. The Complainant believes that these factors collectively fulfill the requirements under the Policy for the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed 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 in respect of the disputed domain name; and

(iii) the disputed domain name was registered and is being used in bad faith.

These elements are discussed in turn below. In considering these elements, paragraph 15(a) of the Rules provides that the Panel shall decide the Complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

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.

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 Complainant's trademark BARRY CALLEBAUT is wholly incorporated into the disputed domain name. The entirety of the mark is therefore reproduced 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.

Although the addition of other terms, here "manufacturing" and "france" may bear on the assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 neither commonly known by the disputed domain name nor authorized by the Complainant to use the BARRY CALLEBAUT trademark. The evidence provided by the Complainant shows that the Respondent has used the address of the Complainant’s manufacturing facility in France as its address while registering the disputed domain name. There is no evidence that the Respondent has used the disputed domain name for a bona fide offering of goods or services, nor has the Respondent made any legitimate noncommercial or fair use of the disputed domain name.

Moreover, the composition of the disputed domain name, which includes the addition of the terms “manufacturing” and “france” to the Complainant’s trademark, carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds 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.

The use of the Complainant’s well-known trademark in the disputed domain name strongly suggests that the Respondent was aware of the Complainant’s rights and intended to exploit those rights for profit. The use of the address of the Complainant’s manufacturing facility in France further evidences the Respondent’s knowledge of the Complainant and its trademark when registering the disputed domain name. Therefore, the Respondent registered the disputed domain name in bad faith.

The disputed domain name resolves to the Registrar’s parking page without substantive content. The Panel considers this case to involve passive holding. 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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation and distinctiveness of the Complainant’s trademark and the misleading composition of the disputed domain name. These factors lead to the conclusion that the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Furthermore, the evidence suggests that the Respondent's actions may cause illegal activity. because the disputed domain name has been set up with MX records configured for potential fraudulent use.

Were the disputed domain name used for fraudulent activity, panels have held that the use of a domain name for illegal activity, such as phishing or impersonation, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

In this case, the Panel finds that the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <barry-callebaut-manufacturing-france.com> be transferred to the First Complainant, Barry Callebaut AG.

/Eva Fiammenghi/

Eva Fiammenghi

Sole Panelist

Date: August 28, 2024