

ADMINISTRATIVE PANEL DECISION

Barry Callebaut AG, Barry Callebaut Belgium NV v. Charles Webxpo Inc
Case No. D2024-3607

1. The Parties

The Complainants are Barry Callebaut AG, Switzerland and Barry Callebaut Belgium NV, Belgium, represented by Adlex Solicitors, United Kingdom.

The Respondent is Charles Webxpo Inc, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <barry-calilebaut.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 September 5, 2024. On September 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 6, 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 Complainants on September 10, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on September 11, 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 September 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 7, 2024.

The Center appointed Beatrice Onica Jarka as the sole panelist in this matter on October 21, 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 two Complainants are part of the Barry Callebaut international group of companies (“the Group”), which has its headquarters in Switzerland and is one of the world’s leading manufacturers of high-quality chocolate and cocoa products.

Since 1996, the Group has traded under the brand name “Barry Callebaut”. While the Group owns a number of other brands, “Barry Callebaut” is the house brand, used as the branding on many of the Group’s bulk cocoa products such as cocoa powder, cocoa butter and chocolate and it is also generally displayed in conjunction with each of the Group’s other brands.

Barry Callebaut AG (the “First Complainant”) was incorporated on 13 December 1994 and Barry Callebaut Belgium NV (the “Second Complainant”) on 15 December 1989.

The First Complainant, the Group’s holding company, owns an extensive international portfolio of registered trade marks for the term “Barry Callebaut” including,

- Swiss trade mark no. 453449, word mark for BARRY CALLEBAUT in classes 29 and 30, registered on July 28, 1998, together with Swiss trade mark no. 561861, logo mark for BARRY CALLEBAUT in classes 5, 29 and 30, registered on September 6, 2007,
- International registration for word BARRY CALLEBAUT no. 702211, registered on September 4, 1998.

The Second Complainant is the main trading company for chocolate within the Group.

Both companies are hereinafter referred to as “the Complainant.”

BARRY CALLEBAUT is the largest of the Complainant’s brands in terms of turnover.

The Group has operated its main website at “www.barry-callebaut.com” since approximately 1997. By way of example, there were approximately 4.7 million users and 16.3 million page views of the site and page views, respectively, between March 2019 and February 2023.

By way of further example, the Group has won various awards including the Food Ingredients Excellence Awards in 2011 and 2013 and the 2022 Ruby Award for Supplier Innovation at the Sweets & Snacks Expo Awards Ceremony.

The disputed domain name was registered on August 13, 2024, by an entity, Charles Webxpo Inc, in the United States.

There is currently no website available at the disputed domain and no evidence that the Respondent has ever used the disputed domain name to resolve to a website. As of August 29, 2024, MX records had been set up for the disputed domain to enable email, used by the Respondent to impersonate the Complainant.

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 Complainant holds trademarks registrations nationally, European and worldwide for “Barry Callebaut”
- By virtue of its extensive trading and marketing activities outlined above, the Complainant has acquired substantial reputation and goodwill in the name “Barry Callebaut” such that it is recognised by the public as distinctive of the Complainant’s business.
- The disputed domain name is confusingly similar to the Complainant’s trade mark. It differs only by the addition of the letter “i” thus creating a misspelling of the Complainant’s trade mark BARRY CALLEBAUT
- This has the obvious potential to cause confusion with the Complainant’s trade mark both visually and phonetically.
- The Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its trade marks. The Respondent has clearly used the disputed domain name and the Complainant’s trade mark to impersonate the Complainant for fraudulent purposes, which usage was clearly not bona fide.
- There is no evidence that the Respondent has been commonly known by the name comprised in the disputed domain.
- It is clear that the Respondent was out for commercial gain.
- The Respondent has registered and used the disputed domain name to confuse, attract and profit from the Complainant’s customers by impersonating the Complainant. The evidence points to registration of the disputed domain name for fraudulent purposes, namely sending fraudulent email impersonating the Complainant.
- The disputed domain name is uniquely referable to the Complainant’s distinctive mark.

B. Respondent

Although properly summoned according to the Policy, 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.

The Panel finds that the Complainant has shown sufficient registered rights in respect of a trademark BARRY CALLEBAUT for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name, with an addition of the letter “i”, which is creating a misspelling of the Complainant’s trade mark BARRY CALLEBAUT, which could be considered as typosquatting, as the addition of the letter “i” is an intentional misspelling of the trade mark. [WIPO Overview 3.0](#), section 1.9.

The Panel finds that the disputed domain name contains sufficiently recognizable aspects of the Complainant’s trade mark BARRY CALLEBAUT, with an obvious potential to cause confusion with the Complainant’s trade mark both visually and phonetically.

Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy, and thus 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. Although properly summoned, 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.

Considering that, the Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its trade marks and the use of the disputed domain name to impersonate the Complainant for fraudulent purposes, by engaging in the typosquatting practice, 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.

In the present case, the Panel notes that the Respondent sent on August 30, 2024, an email impersonating the Complainant, to the Complainant’s customer, purportedly from the Complainant’s credit control department, but in fact sent using the fraudulent email account. The email falsely states that the Complainant has experienced “issues” in receiving payment of an invoice from the customer into its main account and asks that payment be sent to its “subsidiary bank account” in Mexico. The Complainant did not send this email, nor does it own the subsidiary company or bank account named in the email.

Considering also that the Respondent engaged in the typosquatting practice of the Complainant’s trade mark BARRY CALLEBAUT, it is clear that the Respondent was out for commercial gain, by registering and using the disputed domain name to confuse, attract and profit from the Complainant’s customers by impersonating the Complainant.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

Accordingly, 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-calilebaut.com> be transferred to the First Complainant, Barry Callebaut AG.

/Dr. Beatrice Onica Jarka/

Dr. Beatrice Onica Jarka

Sole Panelist

Date: November 1, 2024