

Decision for dispute CAC-UDRP-104920

Case number **CAC-UDRP-104920**

Time of filing **2022-10-14 12:16:54**

Domain names **arlafoods-co.com**

Case administrator

Organization **Iveta Špiclová (Czech Arbitration Court) (Case admin)**

Complainant

Organization **Arla Foods Amba**

Complainant representative

Organization **Elena Zubenko (BRANDIT GmbH)**

Respondent

Organization **Oscar Huerta Goodrich (Privacy service provided by Withheld for Privacy ehf)**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of an international portfolio of trademark and service mark registrations for the ARLA mark including:

- International trademark ARLA, registration number 731917, registered on March 20, 2000, for goods and services in classes 1, 5, 29, 30, 31, 32.;
- International trademark ARLA (figurative), registration number 990596, registered on September 8, 2008 for goods and services in classes 1, 5, 29, 30, 31, 32.;
- EU Trademark Registration ARLA, registration number 018031231, registered on September 6, 2019 or goods and services in classes 1, 5, 9, 16, 29, 30, 32, 35, 39, 41, 44, 42, 43, 44, 45.;
- Denmark trademark ARLA FOODS, registration number VR 2000 01185, registered on March 6, 2000, for goods in classes 1, 5, 29, 30, 31, 32.

FACTUAL BACKGROUND

The Complainant is a producer of dairy products and owns uses the ARLA and ARLA FOODS registered trademarks and service marks to distinguish its goods and services in its international business.

Complainant has an established Internet presence, maintaining a website at <www.arka.com>, and on social media including Facebook and Twitter.

The disputed domain name <arlafoods-co.com> was registered on September 27, 2022. It does not resolve to any active website but has been used by Respondent to create an e-mail address from which Respondent has sent out phishing e-mails to a third party, purporting to impersonate Complainant.

There is no information available about the Respondent except for that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar in response to the request by the Center.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant submits that it is the fifth-largest dairy company in the world, constituted as a co-operative in 2000 by more than 12,500 dairy farmers by the merger of MD Foods with its Swedish counterpart Arla ekonomisk Förening.

The Complainant now employs 119,190 people across 105 countries and reached a global revenue of EUR 11,2 billion for the year 2021, as evidenced by an excerpt from its Consolidated Annual Report 2021, annexed to the Complaint.

The Complainant submits that its products and brands are recognised across the world and its brands including ARLA, LURPAK, CASTELLO, APETINA have an established global reputation.

The Complainant adds that it enjoys a strong online presence via its official website and social media including a Facebook account, and it owns a large portfolio of Internet domain names containing the trademark ARLA, among them <arla.com> (registered on July 15, 1996), <arla.eu> (registered on June 1, 2006), <arlafoods.com>, <arlafoods.co.uk> (registered on October 1, 1999) and <arlafoods.ca> (registered on November 29, 2000), which resolve to its official websites through which it informs Internet users and potential consumers about its products and services.

The Complainant alleges that the disputed domain name is identical or confusingly similar to the ARLA and ARLA FOODS marks in which the Complainant claims rights established by its ownership of the trademark and service mark registrations described herein and its use of the mark described above.

The Complainant argues that the disputed domain name incorporates, in its the Complainant's trademarks ARLA and ARLA FOODS entirely with the addition of the letter combination "co".

Previous UDRP Panels have constantly held that the mere addition of a descriptive term – such as "foods" – would not prevent a finding of confusing similarity to a trademark (see *Minerva S.A. v. Domain Administrator, Fast Serv Inc. d.b.a. QHoster.com*, WIPO Case No. D2019-2767 and *Bouygues Travaux Publics v. Christian Gzaignes*, CAC Case No. 101690).

Furthermore, the generic Top-Level Domain ("gTLD") extension <.com> is a standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see *Arcelormittal S.A v. James*, supra and *Credit Mutuel Arkea v. Domain Administration*, CAC Case No. 102345).

The Complainant next alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name arguing that the disputed domain name was registered on September 27, 2022, many years after the first registration of the Complainant's ARLA and ARLA FOODS trademarks.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademark including the terms "arlafoodsco" or "arla foods co". Moreover, the Respondent is using a privacy shield and his/her/their identity is not disclosed on the publicly available Registrar's WHOIS for the disputed domain name.

The Complainant asserts that it has not licensed or authorized the Respondent to register or use the disputed domain name nor is the Respondent affiliated to the Complainant in any form, neither has the Complainant endorsed or sponsored the Respondent or the Respondent's website.

As shown in a search result annexed to the Complaint, when conducting a search for the term "arlafoods-co.com" on Internet search engine at <Google.com> all the top results relate to the Complainant, its official websites and third parties' websites directly referring to the Complainant. Furthermore, searches on online trademark databases, the results of which are annexed to the Complaint, disclose no information is found in relation with trademarks corresponding to the terms "arla foods co".

The Complainant furthermore refers to an e-mail, a copy of which has been exhibited in an annex to the Complaint, which shows that the disputed domain name has been used to create an e-mail account which the Respondent has used to conduct an e-mail phishing scheme. The exhibited e-mail message shows that on September 27, 2022 an e-mail impersonating Complainant's Junior Accountant was sent to one of the Complainant's customers from the e-mail address associated with the disputed domain name and signed off with the name of the officer of the Complainant.

The e-mail purported to inform the customer on "updates bank details" which should be used for all future payments. The fraudsters also sent an "amended" invoice that had to be settled informing that old bank details should not be used in the future. Thus, the

fraudsters were trying to divert the payments, disrupting the business of the Complainant and damaging the reputation of the Complainant.

The Complainant and its customer realized that they were facing a fraud. In order to prevent such very harmful phishing scheme to spread and continue, the Complainant filed a takedown action before the Registrar on October 7, 2022 and received confirmation from the Registrar that the disputed domain name was suspended.

Furthermore, it appears that the disputed domain name has not been resolving to any active web page and there is no “evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name” (see *Bollore v. Tywonía W Hill*, WIPO Case No. DCO2017-0012).

As the disputed domain name has not been used for any other purposes and ways than to perpetrate a phishing scheme, the Complainant contends that therefore it has not been used in any way in connection with a bona fide offering of goods and services and such use of the disputed domain name to perpetrate an illegal activity characterized bad faith can never confer rights or legitimate interests on a respondent.

The Complainant finally alleges that the disputed domain name was registered and is being used in bad faith, arguing that the Respondent registered the disputed domain name many years after the first registrations of the Complainant’s ARLA and ARLA FOODS trademark and service mark. The Complainant adds that its ARLA trademark is a widely known trademark, as previously held by panels established under the Policy. (see *Arla Foods Amba v. Fredrik Enghall*, WIPO Case No. D2016-1205 and *Arla Foods Amba v. Nashan*, CAC Case No. 101486).

The ARLA and ARLA FOODS marks are registered in many countries and the Complainant is also very active on social media (Facebook and Twitter) to promote its mark, products and services. The Complainant is followed by 1,192,118 people on Facebook and 1,762 people on Twitter (see *Laboratoires M&L v. Zhaoxingming*, CAC Case No. 102277).

By conducting a simple online search regarding the terms “arlafoods-co.com” the Respondent would have inevitably learnt about the Complainant, its trademark and business (see *Intesa Sanpaolo S.p.A. v. Abayomi Ajileye*, CAC Case No. 102396).

Additionally, the Respondent initiated correspondence by using the identity of one of the Complainant’s employees in order to deceive Complainant’s customer and provide the customer with the false bank details as described above, which clearly demonstrates that the Respondent did not act randomly but knew the Complainant and its trademark when it undertook such fraudulent manoeuvre.

Therefore, the Respondent knew the Complainant’s trademark at the time it registered the disputed domain name and proceeded to register it in bad faith.

The Complainant adds that such fraudulent use of the disputed domain name to carry out a phishing scheme constitutes use in bad faith for the purposes of the Policy and previous panels established under the Policy have also stated that “the use of the disputed domain name in connection with a fraudulent e-mail scheme can only lead to the conclusion that the disputed domain name is being used in bad faith” (see *SAP SE v. Anuluwapo Akobi*, WIPO Case No. D2018-0624).

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has provided convincing, uncontested evidence that it has rights in the ARLA and ARLA FOODS marks, established by the ownership of the portfolio of trademark and service registrations described above and its use of the mark to distinguish its products and services in its global dairy business.

The disputed domain name <arlafoods-co.com> consists of each of the Complainant's ARLA and ARLA FOODS marks in its entirety, together with a hyphen, the letters "co" and the gTLD <.com>.

ARLA and ARLA FOODS are the initial and dominant elements in the disputed domain name. Neither the hyphen nor the letters "co" have any distinguishing character and their presence in the disputed domain name do not prevent a finding of confusing similarity with Complainant's marks. The letters "co" in the context of the disputed domain name, placed as it is at the second level of the disputed domain name, would be perceived to be a commonplace abbreviation for the word and designation "company" which Internet users would perceive to merely infer that the disputed domain name is owned by a corporate entity.

In the circumstances of this proceeding, the gTLD <.com> extension would be considered a necessary technical requirement for a domain name registration.

This Panel finds therefore that the disputed domain name is confusingly similar to the ARLA and ARLA FOODS marks which the Complainant has rights and the Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

The Complainant has made out a *prima facie* case that Respondent has no rights legitimate interests in the disputed domain name arguing that:

- the disputed domain name was registered on September 27, 2022, many years after the first registration of the Complainant's ARLA and ARLA FOODS trademarks;
- there is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademark including the terms "arlafoodsco" or "arla foods co": Moreover, the Respondent is using a privacy shield and his/her/their identity is not disclosed on the publicly available Registrar's WHOIS for the disputed domain name;
- the Complainant has not licensed or authorized the Respondent to register or use the disputed domain name;
- the Respondent is not affiliated to the Complainant in any form;
- the Complainant has neither endorsed nor sponsored the Respondent or the Respondent's website;
- the search result annexed to the Complaint, shows that when a GOOGLE search is conducted using the search-term "arlafoods-co.com" all the top results relate to the Complainant, it's official websites and third parties' websites directly referring to the Complainant;
- exhibited results of searches on online trademark databases, disclose no information found in relation with trademarks corresponding to the terms "arla foods co";
- the copy of which has been exhibited in an annex to the Complaint, which shows that the disputed domain name has been used to create an e-mail account from which on September 27, 2022, the Respondent sent a message to one of Complainant's customers purporting to impersonate one of the Complainant's employees, purporting to notify the customer about "updates bank details" to be used for all future payments, to which the Respondent attached an "amended" invoice that had to be settled informing that old bank details should not be used in the future;
- by sending this e-mail purporting to impersonate Complainant, Respondent was endeavouring to divert the payments, disrupting the business of the Complainant and damaging the reputation of the Complainant;
- furthermore, the disputed domain name has not been resolving to any active web page and there is no evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name;

therefore, the disputed domain name has not been used in any way in connection with a bona fide offering of goods and services and such use of the disputed domain name to perpetrate an illegal activity, characterized as bad faith, can never confer rights or legitimate interests on the Respondent.

It is well established that once a complainant makes out a *prima facie* case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

The Complainant has adduced clear and convincing, uncontested evidence that it has rights in ARLA and ARLA FOODS trademark and service marks which predate the registration and first use of the disputed domain name.

The Complainant is a major international producer of dairy products and the uncontested evidence is that it has established a significant international goodwill and reputation and customer recognition of the marks upon which it relies.

The goodwill and reputation are supported by an active social media presence.

It is improbable that the registrant of the disputed domain name was unaware of Complainant and its ARLA brand for foodstuffs when the disputed domain name was chosen and registered.

This Panel finds therefore that on the balance of probabilities the disputed domain name was chosen and registered in bad faith with the Complainant in mind, with the intention of taking predatory advantage of the reputation and goodwill that the Complainant has built in the ARLA and ARLA FOODS marks.

The uncontested evidence adduced by the Complainant shows that the disputed domain name has been used to create an email account from which Respondent has sent an email to a customer of the Complainant, purporting to impersonate one of the Complainant's own, named employees. This demonstrates that Respondent is not only aware of the Complainant generally, but also detailed knowledge of the Complainant's accounts department which demonstrates that Respondent has carried out research about the Complainant's internal business arrangements.

Such use of a domain name for the purposes of impersonating the Complainant to carry out a phishing scheme constitutes use of the disputed domain name in bad faith for the purposes of the Policy.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, the Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

As the Complainant has proved each element of the test in Policy paragraph 4(a), it has succeeded in this Complaint and is entitled to the relief claimed.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **arlafoods-co.com**: Transferred

PANELLISTS

Name	James Bridgeman
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DATE OF PANEL DECISION 2022-11-17

Publish the Decision
