

ADMINISTRATIVE PANEL DECISION

Société des Produits Nestlé S.A. v. Privacy service provided by Withheld for Privacy ehf / Raquel Mendoza
Case No. D2022-1387

1. The Parties

The Complainant is Société des Produits Nestlé S.A., Switzerland, represented by Studio Barbero, Italy.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Raquel Mendoza, Mexico.

2. The Domain Names and Registrar

The disputed domain names <remate-nestle.com> and <rematenestle.com> are registered with NameCheap, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on April 19, 2022, 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 and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 22, 2022 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 amendment to the Complaint on April 26, 2022.

The Center verified that the Complaint together with the amendment to the 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 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2022. Aside from what appears to be an automated communication, the Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on May 20, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on May 27, 2022. 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 owns over 2,250 International and local trademark registrations for NESTLÉ (or variations thereof), including the following:

- International Registration NESTLÉ No. 400444 (word and device mark), registered on July 16, 1973, in classes 01, 05, 29, 30, 31, 32, 33;
- Mexico Trademark Registration NESTLÉ No. 176325 (word and device mark), registered on February 02, 1973 in classes 01, 02, 03, 04, 06, 13, 17, 18, 19, 20, 21, 22, 25 and 31;

The Complainant is part of Nestlé company, founded in 1866 by Henri Nestlé, and it is wholly owned by Nestlé S.A. The Complainant is the registered owner of the majority of the trademarks of the Nestlé Group. Nestlé Group sells products and services all over the world in various industries, primarily in the food industry. The Complainant markets its products in over 185 countries, the Nestlé Group has more than 270,000 employees and it is present in more than 80 countries with more than 400 production centers worldwide. The Complainant is the world's largest food consumer products company in terms of sales. The trademark NESTLÉ is strongly supported by global advertising campaigns through television and other printed and virtual media.

The Complainant registered, well before the Respondent registered the disputed domain name, the word "Nestle" and variations thereof as domain names in numerous generic Top-Level Domains ("gTLDs") and country code Top-Level Domains ("ccTLDs"), including "nestle.us", "nestle.ca", "nestle.mx" and "nestle.com.mx".

The disputed domain name <rematenestle.com> was registered on September 21, 2021, and resolves to a website that advertises and offers for sale pre-owned cars, displaying the NESTLÉ trademark prominently; and the disputed domain name <remate-nestle.com> was registered on September 27, 2021, and resolves to a pay-per-click ("PPC") website.

6. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name are confusingly similar to trademarks in which the Complainant has rights. It points out that the disputed domain names incorporate the whole of the NESTLE mark and asserts that the addition of the non-distinctive element "remate" (a Spanish word that means "auction"), and a hyphen in one of the disputed domain names does not affect the confusing similarity.

The Complainant next maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant indicates that the Respondent is not a licensee, authorized agent, or in any other way authorized to use the NESTLE trademark.

The Complainant asserts that the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use.

The Complainant argues that the Respondent is not commonly known by the disputed domain names.

A cease-and-desist letter to the Respondent was sent by the Complainant's representative on October 1, 2021, via email (to the email address indicated in the public Whois and to the one published on the website related to <rematenestle.com>), requesting it to immediately cease its infringing use and transfer the domain name. In absence of any response, reminders were sent on October 14 and 25, as well as on November 2, 2021, but no reply was received.

On October 1, 2021, a cease-and-desist letter was also sent to the hosting provider, which promptly deactivated the corresponding website. However, the Complainant ascertained that the Respondent reactivated its website at the disputed domain names availing of a different hosting provider. Thus, a cease-and-desist letter to the new hosting provider was sent on February 15, 2022, but no feedback was received despite the reminders sent on March 2, 2022.

The Complainant's representative sent a last reminder to the Respondent on January 17, 2022, in an attempt to amicably solve the matter, but no reply was received, despite the email was apparently dispatched.

The Complainant contends that the disputed domain names were registered and is being used in bad faith. Given the widespread use of the NESTLE mark throughout the world, including in Mexico.

Further, according to the Complainant, in view of the terms encompassed in the disputed domain names and the contents found at the disputed domain name <rematenestle.com>, the Respondent clearly intended to impersonate the Complainant.

In light of the above, the Complainant declares, it is clear that the Respondent, in registering the disputed domain names, intentionally attempted to attract Internet users to his website for commercial gain by causing confusion as to the source, sponsorship, affiliation or endorsement of his website, within the meaning of paragraph 4(b)(iv) of the Policy.

B. Respondent

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

7. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

(i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and (iii) the disputed domain names have been registered and are being used in bad faith.

Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademark NESTLE on the basis of its multiple trademark registrations including in Mexico, which provides a clear indication that the rights in the trademark belong to the Complainant (see [WIPO Overview 3.0](#), section 1.2.1). It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark.

Such findings are in line with section 1.7 of [WIPO Overview 3.0](#). The Panel finds that the disputed domain names are confusingly similar to the Complainant's NESTLE marks. The Respondent's incorporation of the

Complainant's mark in full in the disputed domain names along with an additional term leads to the conclusion that the disputed domain names are confusingly similar to the Complainant's marks. Mere fact of the addition of the term "remate" in Spanish language (and a hyphen in one of the disputed domain names) which means "auction" in English do not prevent a finding of confusing similarity with the Complainant's marks.

Furthermore, the addition of the generic Top-Level Domains "(gTLD)" ".com" and ".org" are not sufficient to prevent a finding of confusing similarity.

The Panel is satisfied that the disputed domain names are identical or confusingly similar to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, the Complainant is deemed to have satisfied the second element..

The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner.

Furthermore, the disputed domain name <rematenestle.com> resolves to a website reproducing the look and feel of the "Nestlé corporate" website for Mexico, displaying the Complainant's NESTLÉ trademarks, taken from the home page of "www.nestle.com.mx" without authorization, exacerbating the user confusion as to the website's affiliation to the Complainant. Such use for deliberately attracting Internet users to its website in the mistaken belief that it is a website of the Complainant, or otherwise linked to or authorized by the Complainant supports a finding that the Respondent lacks rights to or legitimate interests in the disputed domain name.

The disputed domain name <remate-nestle.com> resolves to a PPC website, which in the circumstances of this case does not give rise to rights or legitimate interests in the disputed domain name.

Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests in the disputed domain names.

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain names and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith:

(i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct;

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. Also, there is evidence regarding the sending by the Complainant of several cease-and-desist letters in which the Respondent was informed of the Complainant's pre-existing trademark rights.

In this case, the Complainant submits that at the date of registration of the disputed domain names the Respondent at least should have known the Complainant's mark NESTLÉ. The Panel's finding is reinforced given the construction of the disputed domain names, which combines the NESTLÉ mark with the descriptive term in Spanish "remate".

The Panel is satisfied that by directing the disputed domain name <rematenestle.com> to a commercial website allegedly offering goods not related to the Complainant (*i.e.* pre-owned cars), but using the Complainant's logo, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website (see section 3.1.3 of the [WIPO Overview 3.0](#)). Similarly, the Panel find that the use of the disputed domain name <remate-nestle.com> for a PPC website would be in the circumstances of this case evidence of bad faith. Under paragraph 4(b)(iv) of the Policy, these circumstances shall be evidence of the registration and use of the disputed domain names in bad faith.

In addition, the use of the disputed domain name <rematenestle.com> apparently for fraudulent purposes (creating a perception of an association with the Complainant to allegedly offer for sale pre-owned cars), supported by the Complainant's claims and evidence, affirms a finding of bad faith (see [WIPO Overview 3.0](#), section 3.4). The Complainant points out that the Respondent is hiding its identity behind a privacy or proxy service. It is well-established that this, too, can be further *prima facie* evidence supporting a finding of bad faith in certain circumstances, and the Panel finds that occurs in this case.

Having considered the Complainant's submissions and in the absence of a Response, the Panel accepts the Complainant's submission that on the evidence there is no plausible circumstance under which the Respondent could legitimately register or use the disputed domain names. Consequently, the Panel finds that the disputed domain names were registered and used by the Respondent in bad faith within Paragraph 4(a)(iii) of the Policy.

8. 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 names, <remate-nestle.com> and <rematenestle.com>, be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: June 10, 2022