

## **ADMINISTRATIVE PANEL DECISION**

Société des Produits Nestlé S.A. v. Arif Shah and Naveed Qurashe,  
aqua pure  
Case No. D2023-0960

### **1. The Parties**

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

The First Respondent is Arif Shah, United Arab Emirates, and the Second Respondent is Naveed Qurashe, aqua pure, United Arab Emirates (collectively referred to as “the Respondents”).

### **2. The Domain Names and Registrar**

The disputed domain names <nestle-uae.com> and <nestleuae.com> are registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 3, 2023. On March 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 6, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondents are listed as the registrants and providing the contact details.

The Center verified that 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 Respondents of the Complaint, and the proceedings commenced on March 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2023. The Respondents did not submit any formal response; however the First Respondent sent an informal communication email to the Center on March 9, 2023. Accordingly, the Center notified the commencement of panel appointment process on March 30, 2023.

The Center appointed Zoltán Takács as the sole panelist in this matter on April 3, 2023. 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 is part of the Nestlé Group, a Swiss multinational conglomerate founded in 1866 by Henri Nestlé.

The Nestlé Group is amongst the world's largest food consumer products company in terms of sales, marketing its products in over 190 countries of the world.

The Complainant is owner of numerous national and international trademark registrations consisting of or comprising the term NESTLÉ, including the International Trademark Registration ("IR") No. 479337 for the word mark NESTLÉ registered on August 12, 1983, for goods of classes 1, 5, 29-33 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks and European Union Trademark Registration No. 002977569 for the word mark NESTLE registered on May 25, 2004, for goods of classes 1-29 (collectively referred to as the "NESTLÉ trademark").

The Nestlé Group owns the domain name <nestle.com>, which was registered on October 25, 1994, and resolves to its primary web portal for global promotion.

One of the Nestlé Group's subsidiaries, Nestlé Waters S.A., is managing the water division of the Group. It is nowadays amongst the largest bottled water company in the world and one of its bottled water brands is NESTLÉ PURE LIFE, marketed in more than 20 countries of the world. The website dedicated to NESTLÉ PURE LIFE bottled water product is available at the domain name <nestlepurelife.com>, registered on June 22, 2005.

The First Respondent registered the disputed domain name <nestleuae.com> on January 1, 2023, and the Second Respondent registered the disputed domain name <nestle-uae.com> on January 24, 2023.

The disputed domain names resolved to websites with highly similar layout and content to the Complainant's own website, displaying the NESTLÉ PURE LIFE bottled water product as well as related imagery copied from the Nestlé Group's Facebook page.

Currently the disputed domain name <nestleuae.com> resolves to an error page, while the disputed domain name <nestle-uae.com> is parked free, courtesy of the Registrar at a website which contains sponsored links to third party websites.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain names, which incorporate its NESTLÉ trademark are confusingly similar to it because the addition of the abbreviation "uae", which is short for the United Arab Emirates, and a dash mark to the trademark does not distinguish the disputed domain names.

The Complainant alleges that the Respondents have no rights or legitimate interests in respect of the disputed domain names and are unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant contends that the Respondents' unauthorized use of its NESTLÉ trademark in the disputed domain names and official imagery of the NESTLÉ PURE LIFE bottled water product on the websites at the disputed domain names is evidence of the Respondents' attempt to impersonate the Complainant or one of its affiliated companies in order to divert Internet users to their own websites, which amounts to bad faith registration and use of the disputed domain names.

The Complainant requests that the disputed domain names be transferred from the Respondents to the Complainant.

## **B. Respondent**

On March 9, 2023, the First Respondent sent an informal communication to the Center reading:

“On which basis you are making complain on?

We have government registered documents on which we can use this domain and no one have rights to stop if i have Government issued trade license.

Thanks and regards (not to waste your golden time)”

Apart from this message, the Respondents did not reply to the Complainant’s contentions.

## **6. Discussion and Findings**

### **6.1. Preliminary procedural issues – Consolidation of Multiple Domain Names and Respondents**

The Complaint was filed regarding two domain names and two domain name holders and the Complainant requested consolidation of its claims.

Under paragraph 10(e) of the Rules, UDRP panels have the authority to order the consolidation of multiple domain names involving differently-named domain name holders.

According to section 4.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) the burden of proof of meeting the criteria for consolidation is on the party seeking consolidation.

According to section 4.11.2 of the [WIPO Overview 3.0](#), “where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties”.

The evidence submitted by the Complainant in support of its request for consolidation strongly indicates that the disputed domain names are under common control.

The disputed domain names incorporate the Complainant’s well-known NESTLÉ trademark in its entirety and have been constructed in an almost identical manner. The disputed domain names share the same name servers and MX records. The content and the layout of the websites to which the disputed domain names resolved were highly similar, displaying the same official imagery taken from the Nestlé Group’s advertisement campaign. At the time of filing the Complaint, both disputed domain names pointed to the same error page.

The Panel concludes in the circumstances of this case that the disputed domain names are subject to common control and that consolidation would be fair, equitable, and procedurally efficient to all parties. The closely similar factual background regarding registration and use of the disputed domain names in view of the Panel justifies hearing and determining them in a single administrative proceeding in order to avoid incurring additional unnecessary expense for the parties.

The Panel therefore allows the consolidation as requested by the Complainant pursuant to paragraph 10(e) of the Rules.

## 6.2. Substantive issues

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced evidence of having registered rights in the NESTLÉ trademark, as cited above, that satisfy the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain names are identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the [WIPO Overview 3.0](#), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

The disputed domain name <nestle-uae.com> includes the Complainant's NESTLÉ trademark, with the addition of a dash and the term "uae" (being the acronym for United Arab Emirates). The disputed domain name <nestleuae.com> includes the Complainant's NESTLÉ trademark and the term "uae".

The Respondents' additions in the disputed domain names do nothing to prevent the disputed domain names from being confusingly similar to the trademark, which is clearly recognizable in the disputed domain names.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark and that the first ground of the Policy is established.

## **B. Rights or Legitimate Interests**

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice of the dispute, its use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established prior rights in the NESTLÉ trademark.

According to section 2.1 of the [WIPO Overview 3.0](#), while 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 often impossible 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 the relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has submitted evidence that it holds well-established prior rights in the NESTLÉ trademark.

The Respondents are not affiliated with the Complainant and the Complainant has never authorized the Respondents to use its NESTLÉ trademark in a domain name or otherwise.

As shown by the Complainant, the Respondents have used the disputed domain names to confuse Internet users very likely looking for the Complainant through redirecting them to their own websites. The websites at the disputed domain names repeatedly used the Complainant’s NESTLÉ trademark, pictures of the NESTLÉ PURE LIFE bottled water product and related imagery copied from the Nestlé Group’s Facebook page without any information as to the Respondents’ relation or lack thereof to the Complainant. These facts reinforced the false impression that the disputed domain names are in some way related to or associated with the Complainant. This cannot constitute fair use because it effectively impersonates or suggest sponsorship or endorsement by the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#)).

The Respondents chose not to respond to the Complainant’s contentions, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

The Panel finds that the Respondents have no rights or legitimate interests in the disputed domain names in accordance with paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to

the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

The Complainant's NESTLÉ trademark has been repeatedly ranked among the world's best known and most valuable marks. The well-known status of the NESTLÉ trademark has been recognized by previous UDRP panels as well (see *Société des Produits Nestlé SA v. Peter Carrington, c/o Party Night Inc.*, WIPO Case No. [D2002-0954](#) and *Société des Produits Nestlé S.A. v. Pedro Flores*, WIPO Case No. [D2014-2220](#)).

The disputed domain names fully incorporate and the corresponding websites prominently used the Complainant's famous NESTLÉ trademark without any authorization or approval. Prior UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

Due to the Complainant's NESTLÉ trademark famous status as well as the Respondents' unauthorized use of it on the corresponding websites, it is implausible to presume that the Respondents choose to incorporate the NESTLÉ trademark in the disputed domain names for any other reason than to create a false impression of an association with the Complainant and trade off of the goodwill of the NESTLÉ trademark. This qualifies as bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

At the time of rendering of this administrative decision the disputed domain name <nestleuae.com> resolved to an error page. According to section 3.3 of the [WIPO Overview 3.0](#), from the inception of the UDRP, 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.

At the time of rendering of this administrative decision the disputed domain name <nestle-uae.com> was parked free, courtesy of the Registrar at a website which contained sponsored links to third party websites. According to section 3.5 of the [WIPO Overview 3.0](#), in particular with respect to “automatically” generated pay-per-clicks, panels have found that the fact that such links are generated by a third party (such as a registrar in this case) would by itself not prevent a finding of bad faith. A domain name registrant is normally deemed responsible for content appearing on a website at its domain name.

The Complainant evidently notified both Respondents of their unauthorized use and targeting of its NESTLÉ trademark and the Panel finds that the presence of certain advertising at the website associated with the disputed domain name <nestle-uae.com> constitutes evidence of bad faith use on the part of the Second Respondent.

For the reasons set out above, the Panel finds that the Respondents have registered and are using the disputed domain names in bad faith within the meaning of the Policy and that paragraph 4(a)(iii) of the Policy is satisfied.

## 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 names, <nestle-uae.com> and <nestleuae.com>, be transferred to the Complainant.

*/Zoltán Takács/*

**Zoltán Takács**

Sole Panelist

Date: April 13, 2023