

## **ADMINISTRATIVE PANEL DECISION**

**Société des Produits Nestlé S.A. v. Domains By Proxy, LLC / shawn moore**  
Case No. D2022-3123

### **1. The Parties**

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

The Respondent is Domains By Proxy, LLC, United States of America (“United States”) / shawn moore, United States.<sup>1</sup>

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

The disputed domain names <nestleglobal.com> (the first disputed domain name) and <nestleglobal.org> (the second disputed domain name) 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 August 24, 2022. On August 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 24, 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 August 25, 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 the same day.

On August 26, 2022, the Respondent registered the second disputed domain name.

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”).

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<sup>1</sup> As the first named Respondent is a privacy service, the Panel will refer to the second named Respondent as the Respondent unless the context requires the contrary.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2022. The Response was filed with the Center on September 18, 2022. The Respondent had also sent an informal email communication to the Center on August 24, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on September 23, 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.

Prior to the Panel's appointment, on September 22, 2022, the Complainant requested to consolidate the second disputed domain name in the proceeding. The request was accompanied by a supplemental filing supporting the request.

On October 4, 2022, the Panel issued Procedural Order No. 1 inviting the Respondent to make a supplemental filing addressing the Complainant's request to consolidate the Complaint against the second disputed domain name in the proceeding and the substantive matters raised in the Complainant's supplemental filing.

On October 11, 2022, the Respondent filed a supplemental filing pursuant to that invitation.

#### **4. Factual Background**

The Complainant is part of the Nestlé corporate group of companies which traces its origins back to the business founded by Henri Nestlé in Switzerland in 1866.

Today, the Nestlé corporate group markets its products in over 185 countries around the world. The Nestlé corporate group employs over 270,000 people. It has more than 400 production centers worldwide. In 2020, the Nestlé corporate group's revenues from sales were Swiss Francs 83.4 billion. The Nestlé corporate group has been consistently ranked by Forbes in the largest 100 global companies since at least 2009.

In the United States, the Nestlé corporate group has been operating since the early 1900s at least. It employs over 30,000 people and has manufacturing facilities, R&D facilities, supply chain facilities and corporate offices in 150 different locations in 31 states.

The Nestlé corporate group promotes its products and services worldwide through a global portal at the website "www.nestle.com".

In 2020, Interbrand valued the NESTLÉ trademark at USD 10,252 million, making it the 63rd most valuable trademark in the listing for that year. The Complainant's "Nestlé" trademark has been included in the Interbrand rankings since 2002.

The Complainant owns most of the Nestlé corporate group's registered trademarks. According to the Complaint, there are more than 2,250 registrations around the world for NESTLE or variations thereof. For present purposes, it is sufficient to note only a few:

- (a) United Kingdom Registered Trademark No. UK00000294777, NESTLE, which has been registered since 1907, in respect of condensed milk and milk food products in International Class 29 and chocolate in International Class 30;
- (b) International Registration No. 400444 which designates some 21 (mostly European) countries and which has been registered since 1973, in respect of a range of goods in International Classes 1, 5, 29, 30, 31 and 33 for the fancy mark:



(c) International Registration No. 479337, NESTLÉ, which has been registered since 1983, in respect of a range of goods in International Classes 1, 5, 29, 30, 31, and 33 designating some 34 countries;

(d) United States Registered Trademark No 188089, NESTLÉ, which has been registered since 1924, in respect of condensed milk and evaporated milk and claims first use in commerce in 1878;

(e) United States Registered Trademark No. 1105743, for the fancy mark corresponding to International Registration No 404444, which has been registered since 1978 in respect of milk chocolate, hot cocoa mix, candy and cookie mix; and

(f) European Union Trademark ("EUTM") No. 002977569, NESTLE, which has been registered in respect of a very wide range of goods and services in International Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45 since 2004.

The Respondent was employed by Gerber Life Insurance between 2007 and 2018. Throughout that period, Gerber Life Insurance was a member of the Nestlé corporate group. It was subsequently sold. The Respondent still receives a pension from the Nestlé Savings plan as a former employee. Although it is not entirely clear, it appears that the Respondent considers the sale of Gerber Life Insurance unfavourably.

According to the Whois report and the Respondent, the first disputed domain name was registered on April 27, 2014. As already noted, the second disputed domain name was registered on August 26, 2022, a day or so after the filing of the Complaint.

The Respondent is also the holder of 41 other domain names. Some of these, like the two disputed domain names, duplicate each other or may be seen as variants attempting to block potential typosquatting. Only some of the Respondent's domain names are active: the Respondent mentions he has four websites and there is evidence of three blogs. One of the Respondent's other domain names is <nestleglobe.com> which the Respondent states he registered on March 16, 2018. This domain name is not the subject of this proceeding.

The Respondent states that in around 2014 he also registered the domain name <gerberlifeinsurance.com> when he was working for Gerber Life Insurance and subsequently transferred it to that company.

For a number of years following its registration, the first disputed domain name simply resolved to an "under construction, coming soon" parking page. In at least 2021, the website displayed sponsored links largely to websites offering food products for sale including to vendors such as Orco and Duplo chocolate products which are in competition with the Complainant's products.

When the Complainant discovered this, its representatives contacted the Registrar to ascertain the registrant's details. Almost immediately following that approach on August 12, 2021, the Complainant's representatives received an email from the Respondent stating (omitting formal parts):

"I received an email that there may be some interest in the content or purchase of the domain.

Let me know if I can be of assistance."

The Complainant's representative replied that it was interested in the first disputed domain name in connection with a project and asked if the Respondent "would be interested in transferring/assigning it". Later that day, the Respondent replied:

“The intent is to use the domain for blogging purposes or for sale (preferably to the company).

I worked for a Nestle subsidiary in a prior life and I think it’ll be a good fit.

Thanks for the interest,”

On August 16, 2021, the Complainant’s representative asked what price he was seeking and, on September 7, 2021, the Respondent replied:

“Make me an offer.”

After the Complainant’s representative suggested USD 50, no further communications were received from the Respondent.

The second disputed domain name resolves to a website which is headed “NestleGlobal - An Activist’s Perspective Across Countries and Borders” then in much larger type “Stand Out from the Crowd”.

Underneath, there is a “Subscribe” button and the exhortation “Sign up to hear from us about specials, sales and events”.

Under the link “About Us”, there are two headings “Passionate Social Activists” and “Our Analytical Approach”. The text under the first heading states:

“There are two multinational conglomerates which have defined a lack of social awareness and ineptitude for my generation. These are Shell (particularly for the exploitation of Nigerian oil and the Ogoni people) and Nestle (where companies and ideas go to die).”

The text under the second heading states:

“We provide blogposts and analysis demonstrating areas where conglomerates and multinationals have sacrificed basic standards of human decency in the pursuit of short-term profits and agency remuneration. We will also highlight the efficiencies enabled by multinationals and the potential for developing companies which have high ESG quotients.”

There is a page apparently providing links to regular updates on financial analysis; a Reviews page stating “Reviews coming soon”; and a Frequently Asked Questions page with placeholder text where questions and answers can be added.

Finally, on the Contact Us page, there are further exhortations “Hire Us and See Positive Results” and:

“We believe that a business with a great marketing team can make an impact on the world. Take the first step: contact us, and together, we will reach your company’s goals.”

## **5. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain names, the Complainant must demonstrate each of the following;

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint 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. Consolidation of Multiple Domain Names**

The Complainant has requested consolidation of its complaints against the two disputed domain names.

Paragraph 3(c) of the Rules expressly permits a complaint to relate to more than one domain name where all the domain names are registered by the same domain name holder. That is the case here.

In addition, the Complainant's objections to both disputed domain names arise from the same trademark rights.

Further, the Respondent registered the second disputed domain name the day after the Complaint was filed and served. The Complainant only learned of its existence when the Respondent disclosed it in his Response. The Complainant, therefore, could not have included it in the Complaint as filed.

The Respondent has had an opportunity to respond to the Complainant's request and has taken advantage of the opportunity. In doing so, the Respondent has not pointed to any prejudice he would suffer arising from consolidation. The Panel does not consider there would be prejudice given the domain names at issue. In these circumstances, it appears to the Panel to be fair and equitable to all parties, and an efficient use of resources, to consolidate all of the disputed domain names in the one Complaint.

#### **B. Identical or Confusingly Similar**

The first element that the Complainant must establish is that the disputed domain names are identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of numerous registered trademarks for NESTLE either in plain characters or the slightly stylised form identified above.

The Respondent points out that "nestle" is an ordinary dictionary word, apparently contending therefore that there is no conflict with the Complainant's rights. That, however, misunderstands the nature of the inquiry at this stage.

The second stage of this inquiry simply requires a visual and aural comparison of each disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g.*, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

As the Complainant's trademark is registered (in multiple jurisdictions), therefore, it is appropriate to consider the Respondent's contention based on the dictionary nature of the term "nestle" under the second and third elements of the Policy.

In undertaking the comparison under the first element, it is permissible in the present circumstances to disregard the generic Top-Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

It is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, [WIPO Overview 3.0](#), section 1.10. The exceptions to the usual practice do not apply here.

Disregarding the “.com” and “.org” gTLDs, the disputed domain names consist of the Complainant’s registered trademark and the term “global”. As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant’s trademark remains visually and aurally recognisable within each disputed domain name.

Accordingly, the Panel finds that the Complainant has established that both disputed domain names are confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

### **C. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name;

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered both disputed domain names long after the Complainant began using its trademark and also long after the Complainant had registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain names. Nor is the Respondent affiliated with it.

The disputed domain names are not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain names could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain names.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain names subject to consideration of the Respondent's contentions.

### **The first disputed domain name**

Although the first disputed domain name has been registered since 2014, delay or the lapse of time is not usually a ground for rejection of a Complaint. See e.g., [WIPO Overview 3.0](#), section 4.17. That is all the more so in the present case where it appears that the first disputed domain name has been inactive or "under construction" for most of the period in which it has been registered.

As noted above, the Respondent points out that "nestle" is an ordinary dictionary word meaning "to settle or lie comfortably within or against something". He points out that he has developed and operates four other websites, two of which are maintained for free for small entities and one from which he derives income which is a website serving as an educational resource for Tribal African Art and cultures.

The Respondent further contends that he registered the disputed domain name to develop a website and blog to provide commentary on the problems faced by multi-national companies and social awareness issues. The Respondent points to his history in blogging about social awareness issues from other sites and contends he registered the first disputed domain name to protect or reinforce the website at the second disputed domain name. As noted in section 4 above, there is some evidence of that strategy with his other domain name registrations.

The Respondent also denies that he has derived any revenues from the pay-per-click ("PPC") advertising on the website which has been implemented by the Registrar under its Parked Free policy as a result of which the Registrar retains all moneys earned through the site.

The Respondent also points to his registration of the domain name <nestleglobe.com> since 2018 and claims that the registration of the second disputed domain name should not be problematic as no objection has been made against the former.

The Panel accepts that "nestle" is an ordinary dictionary word. To sustain a claim of rights or legitimate interests on that basis, however, it is usually necessary to show use of, or demonstrable preparations to use, the disputed domain name in accordance with its dictionary or descriptive meaning. See e.g., [WIPO Overview 3.0](#), section 2.10.

While the Respondent does appear to be claiming that he is using "nestle" in a purely descriptive sense in reliance on the manner of use at the website to which the second disputed domain name resolves, the Panel considers that claim is rather stretching the possible meanings of the term "nestle". Even more so in the context of the composite expression "nestle global". In assessing the Respondent's claim, it is also necessary to take into account the Respondent's past history as an employee of a Nestlé subsidiary and the specific reference to the Complainant on the Respondent's website.

Having regard to these matters and what the Panel considers a tenuous claim to descriptive use, the Panel finds that the "descriptiveness" claim does not support a claim to rights or legitimate interests in this case.

The Panel accepts that use of a domain name for a social awareness or criticism site can support a claim to rights or legitimate interests. A range of factors must be taken into account in considering such claims including the nature of the disputed domain names and whether the overall facts and circumstances support a claim that the use is both genuine and fair. See e.g., [WIPO Overview 3.0](#), sections 2.5 and 2.6. In the

present case, the nature of both disputed domain names carries a high risk of implied affiliation.

Although the Respondent registered it in 2014, there has been no use of it in connection with the claimed social awareness purpose. For most of the time it has been registered, it was inactive or “under construction”. Since 2021 (at least), it has been used as a parking page with PPC advertising directing browsers to other businesses including businesses competitive with the Complainant’s business. While the Respondent has referenced difficulties in launching his “Tribal African Art” website, there has not been any real explanation of particular difficulties in launching his proposed social awareness website by reference to the first disputed domain name even after 2018 when he ceased to be an employee of the Nestlé subsidiary.

The Respondent does point out that the PPC advertising results from the Registrar’s Parked Free policy and he has not derived any revenues from the PPC advertising. However, it is well established under the Policy that a registrant cannot usually escape liability for PPC advertising on the website to which the registrant’s domain name resolves in the absence of demonstrated efforts to prevent the parasitic use of the domain name. See e.g., [WIPO Overview 3.0](#), section 2.9. This is because the registrant is the person with ultimate control of and responsibility for the use and content of the domain name and any website to which it resolves. There is no such evidence in this case.

The Respondent does contend that the first disputed domain name is intended to protect the second disputed domain name from some form of attack which he describes as reverse domain name hijacking.

That is something of a challenge given the first disputed domain name was registered some eight years before the second disputed domain name. However, the Panel will consider the claim to fair use in the context of the second disputed domain name below.

### **The second disputed domain name**

There are aspects of the website to which the second disputed domain name resolves which can be seen as consistent with the Respondent’s claim.

First, however, the Panel notes that the second disputed domain name was registered immediately following the filing of the Complaint. The Panel infers that was done to retain the “Nestle Global” expression under the Respondent’s control in the event the Complaint against the first disputed domain name was decided against him.

Secondly, the content of the website has changed significantly between the filing of the Complainant’s supplemental filing and the date this decision is being prepared.

When the Complainant’s supplemental filing was filed, putting to one side elements which were “under construction” such as the FAQ placeholders, there was a banner heading on the landing page “Nestleglobal – An Activist’s Perspective Across Countries and Borders” and, on the “About Us” Page, there was text under the headings “Passionate Activists” and “Our Analytical Approach”. These materials do provide some support for the Respondent’s claimed social awareness purpose.

The landing page banner is somewhat undercut, however, by the even larger banner “Stand Out from the Crowd”. Moreover, immediately under the Subscribe button, the landing page urges “Sign up to hear from us about specials, sales and events”. The “Contact Us” page then states prominently “Hire Us and See Positive Results” and “We believe that a business with a great marketing team can make an impact on the world. Take the first step: contact us, and together, we will reach your company’s goals”.

Hours of operation – business hours Monday to Friday from 9:00 am to 5:00 pm are also specified.

The clear indication from these materials is that the website is operated by a marketing or advertising business, albeit one with a social conscience, whose services are available for a fee. This is a commercial purpose. It is also not use of this disputed domain name for the claimed purpose of promoting of social



awareness. This provides a very strong inference that the expression “Nestle Global” was not adopted for some contended descriptive meaning but rather to attract users to the website in reliance on the reputation of the Complainant’s trademark.

The Panel notes that these aspects appear to have been removed after the filing of the Complainant’s supplemental filing and replaced with text more consistent with a social awareness commentary site. The FAQ section has also been filled in to disclaim association with the Complainant.

The Panel does not give these changes much weight having regard to the content of the website as originally uploaded and the fact they were made after the Complainant filed its supplemental filing.

The Panel also does not give much if any weight to the Respondent’s claims based on his registration of <nestleglobe.com>. There is no evidence when this domain name came to the Complainant’s attention. Moreover and in event, there is no suggestion that the Respondent registered either of the disputed domain names in reliance on anything the Complainant said, did or did not do in relation to the domain name <nestleglobe.com>. There is no evidence before the Panel which would indicate any conduct by the Complainant disintitling it from enforcing its rights against any of the disputed domain names or, for that matter, <nestleglobe.com>.

Having regard to the high risk of implied affiliation from the content of the disputed domain names and use of the website to attract customers to what appears to be the Respondent’s marketing business, the Panel rejects the Respondent’s claim to legitimate noncommercial or fair use.

Accordingly, the Panel finds that the Respondent has not rebutted the *prima facie* case established by the Complainant against both disputed domain names.

The Panel therefore finds the Complainant has established the second requirement under the Policy also.

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

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see *e.g.*, *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

As the Respondent was an employee of a Nestlé subsidiary when he registered the first disputed domain name, he must have been aware of the Complainant’s trademark – even if one does not take into account how well-known the trademark is around the world. That conclusion follows also in respect of the second disputed domain name as the Respondent was a participant in the Nestlé retirement plan and obviously registered the second disputed domain name in reaction to the filing of the Complaint.

In the communications on August 12, 2021, with the Complainant’s representatives, the Respondent did claim “[t]he intent is to use the domain for blogging purposes or for sale (preferably to the company)”.

The Respondent has never, or at least for the first seven plus years of holding the registration, used the first disputed domain name “for blogging”. Moreover, on the materials before the Panel, the Panel has concluded in Section 5C above that the blogging or social awareness purposes claim is really a pretext. Given those matters, the Panel infers the Respondent registered the first disputed domain name for sale “(preferably to the company)”. At the very least, it was registered in an attempt to take advantage of the resemblance of the first disputed domain name to the Complainant’s trademark.

Registration of the disputed domain names to take advantage of their resemblance to the Complainant's trademark without permission constitutes registration in bad faith under the Policy. The passive holding and subsequent use for PPC advertising also constitute use in bad faith for the reasons outlined in Section 5C above.

The Respondent is in no better position in respect of the second disputed domain name which appears to have been registered as some sort of defensive response to the filing of the Complaint and, as discussed in Section 5C above, the manner of use to attract potential customers to the Respondent's website through the second disputed domain name's resemblance to the Complainant's trademark is use in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy in respect of both disputed domain names.

## **6. 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, <nestleglobal.com> and <nestleglobal.org>, be transferred to the Complainant.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: October 23, 2022