

ADMINISTRATIVE PANEL DECISION

Beiersdorf AG, Beiersdorf, INC. v. Nivea Campaign, Nivea, Beiersdorf /BDF DUR Consumer, Beiersdorf, Beiersdorf/Consumer Relations, Beiersdorf
Case No. D2023-3553

1. The Parties

The Complainants are Beiersdorf AG, Germany, and Beiersdorf, INC., United States of America (“United States”), internally represented.

The Respondents are Nivea Campaign, Nivea; Beiersdorf /BDF DUR Consumer, Beiersdorf and Beiersdorf/Consumer Relations, Beiersdorf, Kenya.

2. The Domain Names and Registrar

The disputed domain names <agbeieresdorf.com>, <beiersdorfpr.com> and <relationsbeiersdorf.com> are registered with Squarespace Domains II LLC (the “Registrar”)¹.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 22, 2023. On August 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On August 23, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for multiple underlying registrants which differed from the named Respondent (Contact Privacy Inc. Customer and Tucows Domain Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainants on August 24, 2023, 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 amendment to the Complaint on the same date.

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”).

¹ The Complaint was filed identifying the Registrar as Google LLC. On September 28, 2023, Google LLC confirmed that the disputed domain names are registered with Squarespace Domains II LLC following a purchase agreement. Google LLC has confirmed both Registrars’ compliance with the UDRP and the implementation of the decision by either Registrar.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents of the Complaint, and the proceedings commenced on August 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2023. On August 24, 2023, one of the Respondents sent an email communication to the Center. On September 19, 2023, the Center notified the Parties of the Commencement of Panel Appointment process.

The Center appointed Luca Barbero as the sole panelist in this matter on September 20, 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 first Complainant Beiersdorf AG is a German multi-national company with headquarters in Hamburg, Germany and with 160 affiliates worldwide, including the second Complainant Beiersdorf, INC. Founded in 1882, for over 141 years the Complainants have been active in the manufacturing of products under the widely known trademarks Nivea, Eucerin, Aquaphor, Elastoplast, Labello, La Prairie and Coppertone.

The first Complainant is the owner of a broad number of trademark registrations for BEIERSDORF, including the following, as per trademark certificates submitted as annex 4 to the Complaint:

- European Union trademark registration No. 000363143 for BEIERSDORF (word mark), filed on August 8, 1996, and registered on October 02, 1998, in international classes 3, 5 and 10;
- Kenya trademark registration No. 43395 for BEIERSDORF (word mark), filed on October 27, 1995, and registered on February 24, 1998, in international class 3;
- United States trademark registration No. 3374611 for BEIERSDORF (word mark), filed on July 19, 2006, and registered on January 22, 2008, in international classes 3,

The first Complainant is also the owner of the domain name <beiersdorf.com>, which was registered on November 27, 1995, and is used by the Complainant to promote its products under the trademark BEIERSDORF.

The disputed domain names <agbeieresdorf.com>, registered on July 3, 2023, <beiersdorfpr.com> registered on April 11, 2023 and <relationsbeiersdorf.com> registered on November 21, 2022, are all currently not pointed to active websites. According to the evidence submitted by the Complainants – which has not been contested by the Respondents -, the Respondents have used the disputed domain names to send scam/phishing emails impersonating the Complainants.

5. Parties' Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainants indicate that given the longstanding, worldwide and exclusive use of the BEIERSDORF mark and of the numerous trademark registrations provided as proof in the annexes of the Complaint, they have acquired significant goodwill and world renown and submit that the Respondents knowingly chose to fraudulently register the disputed domain names containing the BEIERSDORF mark, with an aim of perpetrating illegal activity on unsuspecting influencers and customers.

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainants state that considering the above conduct, the Respondents deliberately chose to engage in criminal activity through phishing emails, by way of gathering personal information and banking details from unsuspecting victims, whilst misleading consumers into believing that they are legitimately part of the Beiersdorf group, which they are not.

With reference to the circumstances evidencing bad faith, the Complainants indicate that the Respondents' conduct in itself is in no way consistent with good faith use of the disputed domain names, since further demonstration of the Respondents' bad faith is evident through the fact that they took all precautions to create false guise that they are legitimately part of the Beiersdorf organization such as preparing a contract using the Complainants' NIVEA figurative mark and corporate letterhead, referencing Beiersdorf AG's official site "www.beiersdorf.com" and providing links to Complainant's privacy policy at "https://www.nivea.co.ke/about-us/privacy-policy", all whilst claiming to be a marketing manager for the Complainants using a fake identity.

The Complainants emphasize that the Respondents likely registered the disputed domain names under the exact name BEIERSDORF and other variations such as Beier(e)sdorf, intentionally misspelling the names with hopes of possibly being undetected through a Whois lookup.

The Complainants conclude that for all the reasons stated above, the Respondents are evidently acting in bad faith and operating a criminal enterprise by using the Complainants' trademark whilst taking advantage of the considerable goodwill and trust associated to the BEIERSDORF name and trademark.

B. Respondents

The Respondents did not reply to the Complainants' contentions.

On August 24, 2023, the Center received an email communication from an individual named "Collins Kirwa", sent from one of the email addresses disclosed by the Registrar for the disputed domain name <beiersdorfpr.com> requesting to "close" this disputed domain name and indicating that someone had used his email to register it.

6. Discussion and Findings

6.1. Preliminary procedural issues

A. Consolidation of multiple Complainants

The Complaint has been filed by the German company Beiersdorf AG, parent company of the Beiersdorf group and owner of trademark registrations for BEIERSDORF and of the domain name <beiersdorf.com>, and Beiersdorf, INC., which is an affiliate of Beiersdorf AG based in the United States.

The Panel finds that granting consolidation of the Complainants is appropriate in this case since the Complainants have a specific common grievance against the Respondents and the Respondents have engaged in common conduct that has affected the Complainants in a similar fashion. The Panel also finds that it would be equitable and procedurally efficient to permit the consolidation. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.1.

B. Consolidation of multiple Respondents

Paragraph 10(e) of the Rules provides that a panel shall decide to consolidate multiple domain name disputes in accordance with the Policy and the Rules.

As stated in 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. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants’ identity(ies) including pseudonyms, (ii) the registrants’ contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).”

In the case at hand, the Panel finds that although according to the Registrar disclosed details, the disputed domain names appear to be registered in the name of different entities, they appear to be under common control, since:

- (i) all disputed domain names incorporate the trademark BEIERSDORF (or a misspelled version thereof in the case of the disputed domain name <agbeieresdorf.com>) and were registered in the .com Top Level Domain;
- (ii) the disputed domain names were registered via the same Registrar and using the same privacy service;
- (iii) the disputed domain names are not pointed to active websites and, according to the evidence submitted by the Complainants – not challenged by the Respondents - were all used to create email addresses to perpetrate a fraudulent scheme in which the sender pretended to be a Complainants’ employee contacting influencers on Instagram and proposing a newly launched NIVEA campaign in exchange for a flat fee. Upon gaining their consent, the customer or influencer was requested to sign a seemingly official contract in the name of the Complainants, providing personal information and banking details;
- iv) all the registrants of the disputed domain names are located in Kenya according to the registrant information provided by the Registrar;
- v) the registrant information for all the disputed domain names appears to be fictitious as the registrant names all include references to the Complainants’ name and trademarks.

In view of the above, this Panel concludes that the consolidation of the multiple domain names is appropriate in this case and is consistent with the Policy and Rules as well as with prior relevant UDRP decisions in this area (see, amongst others, *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#)).

Therefore, the Panel will now proceed to a decision on the merits of the case.

6.2. Substantive Issues

According to paragraph 15(a) of the Rules: “A Panel shall decide a 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.” Paragraph 4(a) of the Policy directs that the Complainants must prove each of the following:

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

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 Complainants' trademark and the disputed domain names. [WIPO Overview 3.0](#), section 1.7. Based on the available record, the Panel finds the Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the BEIERSDORF mark is reproduced within the disputed domain names <beiersdorfpr.com> and <relationsbeiersdorf.com>. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel also finds the BEIERSDORF mark is recognizable within the disputed domain name <agbeieresdorf.com> even despite the addition of an "e" between "beier" and "sdorf". Accordingly, even in this case the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Moreover, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9.

While the addition of other terms "ag" (abbreviated form for "Aktiengesellschaft"), "pr" (abbreviation for "public relations") and "relations" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Therefore, based on the available record, 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 a respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 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. 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 record, the Panel finds the Complainants have established a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names. The Respondents have not rebutted the Complainants' *prima facie* showing and have not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

According to the evidence on record, there is no relationship between the Complainants and the Respondents and the Complainants have not authorized the Respondents to register or use their trademark or the disputed domain names.

Moreover, there is no element from which the Panel could infer the Respondents' rights and legitimate interests over the disputed domain names, or that the Respondents might be commonly known by the disputed domain names.

As mentioned above, the disputed domain names have not been pointed to active websites but have been used for the creation of email addresses used for the sending of emails claiming to come from a marketing manager of the Complainants, and promoting an alleged NIVEA campaign aimed at influencers on Instagram. Recipients of such email communications were then requested to sign a contract in the name of the Complainants, providing their personal information and banking details.

The Panel finds that the Respondents' use of the disputed domain names does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainants' trademark.

Panels have held that the use of a domain name for illegal activity (*e.g.*, the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Therefore, based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In light of the well-known character of the Complainants' trademark BEIERSDORF and of the Complainants' world renown, the Panel finds that the Respondents could not ignore the Complainants' trademark at the time of registration of the disputed domain names, with which they are confusingly similar.

Moreover, in view of the fact that Respondents included the Complainants' name and trademarks in the registration information of the disputed domain names and made explicit reference to the Complainants' trademarks, company details and website in the email communications sent from email addresses based on the disputed domain names, the Panel finds that the disputed domain names were registered with a deliberate intent to impersonate or at least create an impression of an association with the Complainants.

The disputed domain names are currently not pointed to an active website. However, also use of a domain name for purposes other than hosting trademark-abusive content, such as sending email, phishing and identity theft, may constitute bad faith. In the present case, the Panel finds that the Respondents' use of the disputed domain names to impersonate the Complainants and send deceptive emails aimed at obtaining sensitive or confidential personal information from third parties amounts to bad faith use.

[WIPO Overview 3.0](#), section 3.4.

The Panel further finds that the Respondents' provision of false contact details in the WhoIs records – as also demonstrated by the email communication sent to the Center mentioned under section 5.B above - and their lack of a Response to the Complainants' contentions further demonstrate the Respondents' bad faith.

Therefore, based on the available record, the Panel finds the third element of the Policy has been established.

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, <agbeieresdorf.com> <beiersdorfpr.com> and <relationsbeiersdorf.com>, be transferred to the Complainants.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: October 4, 2023