

ADMINISTRATIVE PANEL DECISION

Bertelsmann SE & Co. KGaA v. Uno Park WALLER COs
Case No. D2023-5212

1. The Parties

Complainant is Bertelsmann SE & Co. KGaA, Germany, represented by SafeBrands, France.

Respondent is Uno Park WALLER COs, United States of America (“USA”).

2. The Domain Name and Registrar

The disputed domain name <arvatos-scs.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 14, 2023. On December 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on December 15, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on December 19, 2023.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on December 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 12, 2024.

The Center appointed Gabriel F. Leonardos as the sole panelist in this matter on January 23, 2024. 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

Complainant is Bertelsmann SE & Co. KGaA (“Bertelsmann”), a German conglomerate promoting a range of services in the media, services, and education fields. One of Bertelsmann’s divisions is the Arvato Group (“Arvato”), that develops and implements customized solutions for various business processes for customers, including supply chain services. Bertelsmann is the owner of the trademark ARVATO.

Complainant owns several domain names including the mark ARVATO, such as <arvato-scs.com>; <arvato.com>; and <arvato-systems.com> in which promotes and offers its services.

Some examples of Complainant’s trademark registrations can be found below:

Registration No.	Trademark	Jurisdictions	International Class	Registration Date
001203041	ARVATO	European Union (“EU”)	9, 16, 35, 36, 38, 39, 40, 41, 42	November 17, 2000
UK00901203041	ARVATO	United Kingdom (“UK”)	9, 16, 35, 36, 38, 39, 40, 41, 42	November 17, 2000
833560	ARVATO	Australia, Japan, Singapore, USA, China, Poland	9, 16, 35, 36, 38, 39, 40, 41, 42	January 15, 2004

The disputed domain name was registered on August 10, 2023, and resolves to an error webpage without content. However, it was used to send out fraudulent emails.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that the disputed domain name is confusingly similar to the registered trademark ARVATO, since it fully incorporates Complainant’s trademark ARVATO.

Complainant affirms that the disputed domain name is confusingly similar to Complainant’s registered domain name <arvato-scs.com> as the disputed domain name merely includes the letter “s” after the mark, going against Complainant’s earlier trademarks rights. Complainant states that the addition of a single letter to the trademark does not prevent finding of confusing similarity as the disputed domain name contains sufficiently recognizable aspects of the relevant trademark, quoting the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.9.

Therefore, according to Complainant, the disputed domain name is confusingly similar with Complainant’s trademark ARVATO, fulfilling paragraph 4(a)(i) of the Policy and paragraphs 3(b)(viii) and 3(b)(ix)(1) of the Rules.

In addition, Complainant states that Respondent would not have any rights or legitimate interests in respect of the disputed domain name, nor is Respondent commonly known by the disputed domain name.

Further, Respondent has not been authorized, or licensed to use Complainant's trademark ARVATO as a domain name nor is Respondent associated with Complainant.

Moreover, Complainant states that Respondent is using the disputed domain name to arguably support fraudulent emails to Complainant's clients aiming to redirect invoices to another bank account usurping one of Complainant's customer's identity and reproducing Complainant's customer logo to mislead the end customer.

Complainant informs that it has requested a takedown to the Registrar in order to cease the mentioned fraudulent activities pertaining the disputed domain name and as of the filing of the Complaint, the disputed domain name has been suspended by the Registrar.

This way, Complainant states that no legitimate use of the disputed domain name could be reasonably claimed by Respondent, thus paragraph 4(a)(ii) of the Policy and paragraph 3(b)(ix)(2) of the Rules have been fulfilled.

Finally, Complainant states that (i) Respondent engages in a "typosquatting" behavior as registered a domain name very similar to Complainant's; (ii) Respondent was well aware of the existence of the trademark ARVATO, and is intentionally sending phishing emails – which led Complainant to the conclusion that the disputed domain name would potentially contact Complainant's costumers and collect data; and (iii) Respondent reproduces Complainant's client as his trademark in the fraudulent email signature, aiming to give credibility to an apparent phishing scheme, harming Complainant's image.

Thus, according to Complainant, the requirements for the identification of a bad faith registration and use of the disputed domain name have been fulfilled, pursuant to paragraph 4(b)(iv) of the Policy.

Accordingly, Complainant requests transfer of the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

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

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

The burden of proving these elements is upon Complainant.

Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the complaint, in the absence of exceptional circumstances, the panel's decision shall be based upon the complaint.

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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds Complainant has 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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds that the disputed domain name contains the mark ARVATO in its entirety, merely adding an adjacent letter “s” and the term “scs” that makes logical reference to “supply chain services” as explained by Complainant and verified by the Panel on the similarly registered domain name owned by Complainant <arvato-scs.com>, corresponding to a typosquatting behavior. [WIPO Overview 3.0](#), section 1.9

Although the addition of the letter “s” and the term “scs” may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8

The disputed domain name consists also of the generic Top-Level Domain (“gTLD”) “.com”. The applicable gTLD in a domain name, such as “.com” in this case, is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1

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 Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of 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 (although the burden of proof always remains on the complainant). If respondent fails to come forward with such relevant evidence, complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that Complainant suspects that the disputed domain name is used for phishing schemes to obtain payments, as supported by emails that have been sent via the disputed domain name (Annex 09 to the Complaint).

Panels have held that the use of a domain name for illegal activity (e.g., phishing, 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.

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

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that Respondent has registered the disputed domain name that is confusingly similar to Complainant's trademark ARVATO – as explained above in Section 6.A – as merely adds the letter "s" and includes the abbreviation "scs" in this context, according to Complainant, pertaining to "supply chain services", which does not disclose Respondent's lack of any relationship to Complainant nor is significantly distinctive to avoid confusion. The Panel finds that it was duly demonstrated that Respondent was aware of Complainant's rights to the trademark ARVATO at the time of the registration – as Complainant enclosed fraudulent phishing emails sent by servers related to the disputed domain name informing Complainant's clients a change of invoice information (Annex 09 to the Complaint).

The Panel concludes the registration and use is in bad faith under paragraph 4(b) of the Policy as the use of the disputed domain name falls under paragraph 4(b)(iv) of the Policy as Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant's mark.

Panels have held that the use of a domain name for illegal activity (e.g., phishing, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name to send fraudulent emails to Complainant's clients aiming to divert invoices (Annex 09 to the Complaint) constitutes bad faith under the Policy.

Section 3.4 of the [WIPO Overview 3.0](#) establishes that "Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. [...] Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers."

The panel in *Twitter, Inc. v. Whois Agent, Whois Privacy Protection Service, Inc. / Domain Support*, WIPO Case No. [D2015-1488](#) came to a similar conclusion:

"The Panel notes that Respondent's use of the website at the Domain Name which incorporates Complainant's trademark in its entirety indicates that Respondent possibly registered the Domain Name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, as per paragraph 4(b)(iv) of the Policy. Furthermore, the Panel accepts Complainant's undisputed submission that bad faith registration and use of the Domain Name is further indicated by the fact that there is strong suspicion of Respondent using the Domain Name in an elaborate common phishing scam."

The Panel finds that the circumstances of the present case allows a finding of bad faith in the registration and use of the disputed domain name, considering that (i) Respondent would likely obtain commercial gain by using a confusingly similar domain name to Complainant's trademark; (ii) Complainant operating an almost identical domain name, such that Respondent most likely knew (or should have known) of its existence, taking advantage of the confusion caused on the public by its use in the disputed domain name, and (iii) the actual use of the disputed domain name in order to send out fraudulent emails.

Moreover, the Panel finds it relevant that Respondent has not provided any evidence of good faith registration or use, or otherwise participated in this dispute. Complainant has put forward serious claims regarding the apparent bad faith use of the disputed domain name that the Panel would expect any legitimate party would seek to refute.

Based on the available record, the Panel finds that Complainant has established the third element of the Policy.

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 name <arvatos-scs.com> be transferred to Complainant.

/Gabriel F. Leonardos/

Gabriel F. Leonardos

Sole Panelist

Date: February 6, 2024