Decision for dispute CAC-UDRP-102057

Case number	CAC-UDRP-102057
Time of filing	2018-06-20 09:15:24
Domain names	labo-expanscience.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	EXPANSCIENCE

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	EXPANSCIENCE LABORATOIRES

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks comprising the international trademark no. 282517 “EXPANSCIENCE” registered since April 17, 1964 in classes 1, 3, 5, 10, 21.

The Complainant’s main domain name EXPANSCIENCE.COM has been registered since April 4, 1997.

The Complainant has carried out its business under the trade / company name EXPANSCIENCE for over 60 years.

The above-mentioned trademark, domain name and company name are hereinafter collectively referred to as the EXPANSCIENCE Trademark.

The Complainant has proved its rights in the EXPANSCIENCE Trademark for the purposes of the Policy.

FACTUAL BACKGROUND

The Complainant is a 100% French family-owned pharmaceutical and dermo-cosmetics company with over 60 years of

expertise.

The Complainant has developed and manufactured innovative osteoarthritis and skincare products, inclusing two leading brands - Piasclédine 300 and Mustela - sold in more than 120 countries.

The Complainant counts 16 subsidiaries all around the world, and had more than 271,2 million euros of turnover in 2017. 61,9% of the company's turnover has been generated by international business, and 4% of turnover has been invested in innovation, research and development.

The disputed domain name <laboexpanscience.com> was registered on May 22, 2018 and points to a website displaying the script: "You have reached a domain that is pending ICANN verification".

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

THE COMPLAINANT'S CONTENTIONS

The Complainant contends that the disputed domain name, containing in its entirety the EXPANSCIENCE Trademark, is confusingly similar to such trademark. Neither the addition of the term "LABO" (which refers to the Complainant's name and activities, since it is the French common abbreviation for "LABORATOIRES"), nor the gTLD .com is sufficient to escape the finding that the disputed domain name is confusingly similar to the EXPANSCIENCE Trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is not related in any way to the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither licence nor authorization has been granted to the Respondent to make any use of the EXPANSCIENCE Trademark, or apply for registration of the disputed domain name by the Complainant.

Furthermore, the fact that the disputed domain name points to a page displaying the message: "You have reached a domain that is pending ICANN verification" shows that the Respondent, who is not making any use of disputed domain name since its registration, has no demonstrable legitimate interests in respect of such domain name.

Concerning the bad faith in the registration and use of the disputed domain name, the Complainant asserts that:
- the disputed domain name is confusingly similar to the EXPANSCIENCE Trademark;
- carrying out a Google search on the term "EXPANSCIENCE" provides several results, all of them related to the Complainant. If the Respondent have done a simple Google search before the registration of the disputed domain name, it would have found out easily about the existence of the EXPANSCIENCE Trademark. Thus, the Respondent could not have ignored the Complainant's trademark at the moment of registration of the disputed domain name, which cannot be a coincidence;
- the disputed domain name points to a page displaying the message: "You have reached a domain that is pending ICANN verification". The Respondent has, therefore, failed to use the disputed domain name and has not taken any active steps to regain the control over the domain name by verifying its contact details with the ICANN.

Consequently, the Complainant requests the transfer of the disputed domain name.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED BY THE RESPONDENT.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in

respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements to obtain the transfer or the cancellation of the domain name:
(1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
(2) the Respondent has no rights or legitimate interests in respect of the domain name; and
(3) the domain name has been registered and is being used in bad faith.

1. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has provided sufficient documentary evidences to demonstrate to be owner of the EXPANSCIENCE Trademark since 1964.

In assessing identity or confusing similarity the Panel finds that the disputed domain name incorporates the entirety of the Complainant's EXPANSCIENCE Trademark and differs from such mark by merely adding:
- the generic and descriptive term "labo", which is related to the Complainant's business, and, thus, even enhances the risk of confusing similarity to such mark;
- a hyphen;
- the top-level domain name ".com".
Thus, the disputed domain name is confusingly similar to the Complainant's trademark.

In UDRP cases where the relevant trademark is recognizable within the disputed domain name, Panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see paragraph 1.7 WIPO Overview 3.0).

UDRP Panels also agree that the top-level domain is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

2. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP Panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see paragraph 2.1 of the WIPO Overview 3.0: "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").

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain name.

The disputed domain name was registered on May 22, 2018 with privacy service. After the CAC's request for Registrar verification, the Registrar disclosed the underlying registration data, identifying the Respondent as Expanscience Laboratoires.

The disputed domain name points to a website displaying the script: "You have reached a domain that is pending ICANN verification". It also states that "As of January 1, 2014 the Internet Corporation for Assigned Names and Numbers (ICANN) will mandate that all ICANN accredited registrars begin verifying the Registrant WHOIS contact information for all new domain registrations and Registrant contact modifications." The most likely reason of the suspension of the disputed domain name is that the Registrant's email address has not been verified and the Registrant has not taken actions to reactivate the domain name. It is, therefore, most likely that the Respondent provided fake data for the registration of the domain name.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent has registered the disputed domain name which is to be considered confusingly similar to Complainant's mark, since it incorporates the EXPANSCIENCE Trademark in its entirety and differs from it merely by adding the generic and descriptive term "labo" and a hyphen between the word "labo" and the Complainant's distinctive mark, as well as the TLD ".com" (which is disregarded for the purpose of determination of confusing similarity between the disputed domain name and the trademark of the Complainant as it is a technical requirement of registration). Considering that the Complainant has been active in the pharmaceutical sector over 60 years, the Respondent's choice to add the generic and descriptive term "labo" which is a French common abbreviation for the word "laboratoires" to the trademark of the Complainant shows its clear intention to enhance such likeliness of confusion for the Internet users who are seeking or expecting the Complainant.

Given the distinctiveness and reputation of the Complainant's prior mark, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

The Complainant has also submitted the results of a Google search on the term "EXPANSCIENCE", all of them related to the Complainant, and affirmed that due to the distinctiveness and reputation of the Complainant's mark in several countries the Respondent most likely knew the Complainant and its mark.

Considering that:
- the disputed domain name was registered with privacy service and the Registrar, upon the request of the CAC, revealed the identity of the underlying Registrant, identifying the same as Expanscience Laboratoires;
- the disputed domain name has been subject of ICANN verification and the Registrant has not taken active steps to regain control over the disputed domain name,
this Panel finds that the Respondent should have had constructive knowledge of the Complainant's mark and deliberately provided fake registration data at the moment of the registration of the disputed domain name, hiding itself behind a privacy shield. Hence, neither the registration nor the use of the disputed domain name are in good faith.

Having registered the disputed domain name which is confusingly similar to and, thus, infringing the Complainant's EXPANSCIENCE Trademark with fake data, the Respondent has also violated the paragraph 2 of the UDRP Policy: “By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations”.

Taken into account all circumstances of this case, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **LABO-EXPANSCIENCE.COM**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2018-08-06

Publish the Decision