Decision for dispute CAC-UDRP-102241

Case number	**CAC-UDRP-102241**
Time of filing	**2018-11-29 08:40:49**
Domain names	**ukerborian.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**L'Occitane International SA**

Complainant representative

Organization	**Brandstock Domains GmbH**

Respondent

Organization	**Site Matrix LLC**

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

EU trademark Erborian No. 005632799, dated January 22, 2017 and designating goods in class 03;
International trademark Erborian No. 1125364, dated June 29, 2012 and designating goods and services in international classes 03 and 05;
US trademark ERBORIAN No. 3357694 dated March 26, 2006, duly renewed and designating goods and services in international class 03.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is part of the L'Occitane Group. The L'Occitane Group is a global, natural and organic ingredient-based cosmetics and well-being products manufacturer and retailer. The Group has five brands (L'OCCITANE EN PROVENCE, MELVITA, ERBORIAN, L'OCCITANE AU BRÉSIL and LIMELIFE BY ALCONE) in its portfolio and is committed to developing and retailing high quality products that are rich in natural and organic ingredients of traceable origins and respect the environment.

In 2015, the L'Occitane Group counted 2,797 retail locations on all continents throughout the world, with 1,384 owned retail stores. The Group employs more than 8,000 people around the world and generated a revenue of more than 1 billion US dollars in 2015.

In 2015, net sales were €1,177.9 million, a growth of 11.7%. At constant exchange rates, sales growth was 10.3%. Growth was primarily driven by China, Japan, Hong Kong, and the United States.

Founded in 2007, Erborian became part of the L'Occitane Group in 2012. It is distributed in numerous countries, notably France, United Kingdom, Germany, Italy, China and Hong Kong. Its main domain name, erborian.com, registered in 2006, belongs to L'Occitane International.

The Complainant holds several trademarks in the term ERBORIAN, amongst which several are valid in the United States, where the Respondent is supposedly located, and in the UK:

EU trademark Erborian No. 005632799, dated January 22, 2017 and designating goods in class 03;

International trademark Erborian No. 1125364, dated June 29, 2012 and designating goods and services in international classes 03 and 05;
US trademark ERBORIAN No. 3357694, dated March 26, 2006, duly renewed and designating goods and services in international class 03.

The Complainant also holds a number of ERBORIAN trademarks in a number of jurisdictions.

The disputed domain name is <ukerborian.com>.

The Complainant contends that the disputed domain name is highly similar to the Complainant's earlier trademarks. Indeed, the disputed domain name reproduces the ERBORIAN trademark in its entirety, preceded by the country code "uk", which does not diminish the likelihood of confusion:

WIPO Case D2014-1702: "The Disputed Domain Name incorporates the Complainant's, trademark in its entirety with only the addition of the descriptive element "uk-". Such addition does not alter the fact that the Complainant's trademark is the dominant element of the Disputed Domain Name."

CAC Case 102161: "The disputed domain name incorporates the Complainant's ARCELORMITTAL trademark in its entirety, merely adding a hyphen and the non-distinctive prefix "uk". The addition of the prefix "uk" does not add to the distinctiveness of the disputed domain name as it corresponds to the country code and abbreviation of the United Kingdom. The addition of a geographical term does not prevent a finding of confusing similarity".

CAC Case 100311: "As to the addition of a geographic term to a domain name, (i.e., "uk"), it does not decrease the existing confusing similarity, as this term simply refers to the place where the Respondent's exercises its activity, or to the place of origin of the consumers of reference of the goods sold through the Domain Name website. Moreover, the Complainant is also active in the UK and enjoys trademark rights in this country."

The Complainant is active in the United Kingdom and holds a number of trademarks in this territory (see above). The Complainant distributes its products under the subdomain <uk.erborian.com>. Not only is the disputed domain name highly similar to the Complainant's earlier trademarks, but also to the subdomain the Complainant uses to communicate to and distribute products in the United Kingdom.

The Complainant also operates the Facebook page of Erborian, followed by 78.000 users, and the Instagram page Erborian, followed by more than 62,000 users.

From these findings, it can be asserted that the ERBORIAN trademark is well-known worldwide. The Complainant submits

that it enjoys a widespread reputation and goodwill through the continuous and long-standing use of the ERBORIAN trademark.

It is established case law that the TLD must not be taken into account when assessing the similarity between the prior trademarks and the contested domain. Therefore, the disputed domain name must be considered as identical or confusingly similar to the Complainant's prior trademarks ERBORIAN.

The disputed domain name fully incorporates the Complainant's prior trademarks ERBORIAN. Therefore, the Complainant contends that the disputed domain name is identical or highly similar to the Complainant's earlier trademarks ERBORIAN.

The first element of the Policy is deemed satisfied.

The Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name that is the subject of the Complaint. Indeed, the Respondent is not commonly known by the disputed domain name, and has acquired no trademark or service mark rights related to the "ERBORIAN" term.

Firstly, the Complainant has conducted trademark searches and found no ERBORIAN trademarks or rights owned by the owner of the disputed domain name.

The Complainant further submits that the disputed domain name is connected to an e-mail server: ukerborian.com. 3599 IN MX 1 mail.mxproc.com.

The Complainant undertook further verifications and it appears that the e-mail address contact@ukerborian.com is valid and working. It is submitted that the use of this e-mail address, without right or authorization from the rightful trademark holder, cannot be seen as a bona fide offer of goods or services.

Indeed, the Respondent is not, and has never been, an authorized retailer, contractor, distributor, employee, licensee of the Complainant and has never been granted any right to use the trademark ERBORIAN within the disputed domain name or any other domain name for that matter.

Secondly, the Respondent's use of the disputed domain name or preparation to use the disputed domain name demonstrate no intent to use it in connection with a bona fide offering of goods or services. Indeed, the disputed domain name has been used with a redirection to a parking page of pay-per-click commercial links.

The pay-per-click commercial links' ability to generate revenue depends on the ability of the disputed domain name to attract users seeking information on the owner of the trademark. As the disputed domain name only comprises the Complainant's trademark, it appears that the disputed domain name is very likely to attract Internet users.

Thirdly, the Respondent in this Administrative Proceeding is, at the time of filing of the Complaint, a US based company. The Complainant submits that the registration of a domain name reproducing the Complainant's earlier trademark and the geographical abbreviation "UK" by a US company, without further registrations of domain names showing that the Respondent in fact intends to direct its business to the UK, cannot be seen as a bona fide offer of goods or services for the purpose of this UDRP proceeding, in particular in light of the lack of authorization from the Complainant.

Fourthly, since the adoption and extensive use by the Complainant of the trademark ERBORIAN predates the first entry of the disputed domain name, the burden is on the Respondent to establish the Respondent's rights or legitimate interests the Respondent may have or have had in the disputed domain name.

None of the circumstances which set out how a respondent can prove his rights or legitimate interests, are present in this case. In light of all the elements mentioned above, the Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name that is the subject of the Complaint.

Given that the Complainant has made a prima facie case that the Respondent lacks legitimate rights or interest in the disputed domain name, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name.

The second condition under the Policy should be deemed satisfied.

The Complainant submits that the domain was registered and is being used in bad faith.

Firstly, the Complainant states that the ERBORIAN trademarks have enjoyed wide-spread extensive use and are widely well-known, as is the Complainant L'Occitane International. It seems inconceivable that the Respondent ignored the Complainants' earlier rights.

It is clear that the Respondent had the Complainant or its trademarks in mind when registering the disputed domain name. The Respondent's choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant and its trademarks.

Indeed, a simple search on an online search engine yields results only related to the Complainant. All results relate to the Complainant and the ERBORIAN brand.

Consequently, it can easily be asserted that the Respondent obviously knew about the earlier rights of the Complainant. The registration of a domain name reproducing identically the trademarks of the Complainant clearly shows that the Respondent had full knowledge of these earlier trademarks and registered the disputed domain name fully knowing that it would contravene the Complainant's rights.

Secondly, the term "erborian" is an arbitrary term with no meaning whatsoever. The brand name, ERBORIAN, was created as a derivation from "Herbs of the Orient" (See https://group.loccitane.com). Therefore, the Complainant submits that the Respondent registered the disputed domain name with the ERBORIAN trademark in mind.

Thirdly, the Complainant sees no possible way whatsoever that the Respondent would use the disputed domain name in connection with a bona fide offer of products or services. Indeed, any use of the ERBORIAN trademark would amount to trademark infringement and damage to the reputation of the trademark. The sole detention of the disputed domain name by the Respondent, in an attempt to prevent the Complainant from reflecting its trademark in a domain name, is a strong evidence of bad faith. Furthermore, any actual use of the disputed domain name by the Respondent would de facto amount to bad faith active use.

The use of the disputed domain name <ukerborian.com> in connection with a mailbox – presumably contact@ukerborian.com – on the contrary shows bad faith on the part of the Respondent who is very likely to send e-mails to clients of the Complainant. Impersonating the Complainant to its customers and, potentially, engaging in phishing activities cannot be seen as a use of the disputed domain name in good faith whatsoever.

Fourthly, it is noted that the Respondent in this Administrative Proceeding is a privacy protection provider at the day of filing of the Complaint. The Complainant submits that the use of a privacy protection service may be seen as an aggravating factor when assessing the bad faith of the Respondent.

Fifthly, the use of the disputed domain name in connection with a parking page with pay-per-click commercial links is another element showing the bad faith of the Respondent. Regardless of the content of the links themselves, the Respondent is attempting to make profit on the sole unauthorized use of the trademark of the Complainant as a domain name.

Sixthly, it appears that the domain is listed for sale at a price clearly exceeding out-of-pocket costs for the registration of a .com domain (https://checkout.afternic.com). This is another evidence of bad faith use on the part of the Respondent.

In light of the above, the Complainant contends that the disputed domain name was registered and is being used in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

The disputed domain name is highly similar to the Complainant’s earlier trademarks, reproducing the ERBORIAN trademark in its entirety, preceded by the country code “uk”, which does not diminish the likelihood of confusion.

WIPO Case D2014-1702: “The Disputed Domain Name incorporates the Complainant's, trademark in its entirety with only the addition of the descriptive element "uk-". Such addition does not alter the fact that the Complainant's trademark is the dominant element of the Disputed Domain Name.”

CAC Case 102161: “The disputed domain name incorporates the Complainant’s ARCELORMITTAL trademark in its entirety, merely adding a hyphen and the non-distinctive prefix “uk”. The addition of the prefix “uk” does not add to the distinctiveness of the disputed domain name as it corresponds to the country code and abbreviation of the United Kingdom. The addition of a geographical term does not prevent a finding of confusing similarity”.

CAC Case 100311: “As to the addition of a geographic term to a domain name, (i.e., “uk”), it does not decrease the existing confusing similarity, as this term simply refers to the place where the Respondent's exercises its activity, or to the place of origin of the consumers of reference of the goods sold through the Domain Name website. Moreover, the Complainant is also active in the UK and enjoys trademark rights in this country.”

Complainant's trademark ERBORIAN is well-known worldwide. The disputed domain name must be considered as identical or confusingly similar to the Complainant’s prior trademarks ERBORIAN.

The disputed domain name fully incorporates the Complainant’s prior trademarks ERBORIAN.
Therefore, the disputed domain name is identical or highly similar to the Complainant’s earlier trademarks ERBORIAN.

The Respondent has no rights or legitimate interests in respect of the disputed domain name that is the subject of the Complaint. Indeed, the Respondent is not commonly known by the disputed domain name, and has acquired no trademark or service mark rights related to the “ERBORIAN” term.

The Respondent lacks legitimate rights or interest in the disputed domain name. The Respondent did not come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name.
The disputed domain name is considered to have been registered in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **UKERBORIAN.COM**: Transferred

PANELLISTS

Name	**Mr. E.J.V.T. van den Broek**

DATE OF PANEL DECISION 2019-01-09

Publish the Decision