

Decision for dispute CAC-UDRP-102277

Case number CAC-UDRP-102277

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Domain names loccitane.biz

Case administrator

Name Šárka Glasslová (Case admin)

Complainant

Organization Laboratoires M&L

Complainant representative

Organization Brandstock Domains GmbH

Respondent

Organization Zhaoxingming

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

International trademark L'OCCITANE No. 1006051 registered on August 8, 2008, duly renewed, and designating goods and services in international classes 9, 14, 18, 24, 25, 28, 30, 35, 43 and 44;

International trademark L'OCCITANE No. 579875 registered on November 5, 1991, duly renewed and designating goods in international classes 03, 04, 05, 16 and 21.

International trademark L'OCCITANE No. 1330027 registered on June 28, 2016 and designating goods and services in international classes 04, 16, 18, 25, 43 and 44.

FACTUAL BACKGROUND

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

To the best of the Complainant's knowledge, the language of the Registrar's registration agreement is Chinese. However, the Panel has authority to determine the language of proceedings. In many UDRP cases, English was adopted as the language of proceedings, even if the Registration agreement of the registrar was exclusively in another language (see for instance Case no. D2008-1191).

In the absence of an agreement, the language of the registration agreement shall normally dictate the language of the proceedings. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case.

The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her ability to articulate the arguments for the case. This has been confirmed in Case no. D2014-1889, where the Panel also stated:

"One important consideration is the issue of fairness to both parties in their abilities to prepare the necessary documents for this proceeding and also to respond adequately to these documents when they are served upon the parties."

The Complainant has undertaken a reverse whois search for domain names owned by the Respondent and found several domain names containing English words:

agfaphoto.cc - alarisworld.biz - americanapparel.biz - assurantsolutions.ie - baselondon.biz - bestsound-technology.info - christiesrealestate.biz - columbiasportswear.biz - dreambaby.biz

The terms emphasized above are very apparently English words. This must be seen as an indication that the Respondent is in position to understand the English language.

In addition, the Complainant states that the Respondent has already undergone recent domain name procedures in the English language. See for example WIPO Case DCC2018-0003 and DCC2018-0011.

Furthermore, the Complainant submits that the disputed domain name is offered for sale on Afternic. The matter of the sale is discussed at a further stage. However, the Complainant notes that Afternic.com is solely available in the English language.

Finally, a brief report by DomainIQ, has associated the name and email address of the Respondent to several domain names. The "portfolio" section indicates that 49 % of the domains registered by the Respondent comprise English words.

Therefore, the Complainant contends that the Respondent is able to understand English and undergo the present proceedings in the English language.

In addition, it would not be unfair to the Respondent to conduct these proceedings in English. The same was already decided in UDRP cases. For example, in WIPO Case No. D2015-1466 the Panel decided that "the Respondent's other domain name registrations contain generic English terms such as "outlet" and "replica". These circumstances lead the Panel to the belief that the Respondent would not be prejudiced if English is adopted as the language of the proceeding."

On the contrary, the Complainant is not able to communicate in Chinese. Being a French entity, the Complainant is not in position to conduct these proceedings in Chinese without a great deal of additional expense and delay due to the need for translation of the Complaint. English language is not the native language of the Complainant or its representative, therefore it would not give him unfair advantage over the Respondent.

Paragraph 10 (c) of the UDRP Rules provides that the Panel shall ensure that the administrative proceeding takes place with due expedition. Conducting the proceedings in Chinese would contravene this provision for the reasons stated above.

Therefore, the Complainant kindly requesteds that the Panel agrees to conduct these proceedings in English.

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.

The Complainant holds numerous trademarks in the term L'OCCITANE, amongst which several are valid in China where the Respondent is supposedly located:

International trademark L'OCCITANE No. 1006051 registered on August 8, 2008, duly renewed, and designating goods and services in international classes 9, 14, 18, 24, 25, 28, 30, 35, 43 and 44;

International trademark L'OCCITANE No. 579875 registered on November 5, 1991, duly renewed and designating goods in international classes 03, 04, 05, 16 and 21.

International trademark L'OCCITANE No. 1330027 registered on June 28, 2016 and designating goods and services in international classes 04, 16, 18, 25, 43 and 44.

Copies of these trademarks are attached as Annexes 9, 10 and 11. The Complainant also holds a number of L'OCCITANE trademarks in various jurisdictions, which are attached to the Complaint as Annex 12.

The disputed domain name is <loccitane.biz>.

The Complainant contends that the disputed domain name is identical to the Complainant's earlier trademarks. Indeed, the disputed domain name reproduces the L'OCCITANE trademark in its entirety, with the exception of the apostrophe between the first two letters of the trademark.

The apostrophe is not a valid character for domain name registration and the domain name corresponding to a particular word containing an apostrophe typically omits it. The omission of an apostrophe in a domain name does not normally change the identity of the original word containing the apostrophe. WIPO Case D2012-0624. In addition, the disputed domain name is highly similar to the Complainant's main domain name loccitane.com.

The Complainant is active in China and holds trademarks in this territory (see above). The Complainant distributes its products under the subdomain loccitane.cn. The Complainant also operates the Facebook page of L'Occitane, followed by almost 6 million users, and the Instagram page L'Occitane, followed by more than 820,000 users.

From these findings, it can be asserted that the L'OCCITANE 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 L'OCCITANE trademark. L'OCCITANE EN PROVENCE was indeed founded in 1976.

It is established case law that the TLD must not be taken into account when assessing the similarity between the prior trademarks and the disputed domain name. The .biz TLD is a technical suffix necessary within the context of domain naming and may not be taken into account, but for "dot spanning" cases, which the Complainant does not assert in this case.

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

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 "L'OCCITANE" term.

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

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. On the contrary, the website to which the disputed domain name is linked automatically downloads a file on the computer of the internet user. The Representative of the Complainant had the file analyzed by its IT department which have confirmed that the file is malware.

The Complainant contends that the Respondent is trading on the reputation of the Complainant's trademarks to redirect Internet traffic intended for the Complainant to a website that contains malware, which does not give rise to a legitimate interest in the disputed domain name. See for example WIPO Case D2017-0736.

Thirdly, indeed the Respondent is not commercially linked to the Complainant. The Complainant never granted the Respondent any authorization, consent, right, license, exclusive or not, to use the trademark L'OCCITANE within the disputed domain name or in any other way for that matter.

Fourthly, since the adoption and extensive use by the Complainant of the trademark L'OCCITANE predates by far 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.

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 proof 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 disputed domain was registered and is being used in bad faith.

Firstly, the Complainant states that the L'OCCITANE trademarks have enjoyed wide-spread extensive use and are widely well-known as stated above. It seems inconceivable that the Respondent ignored the Complainant's 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 and the L'OCCITANE brand, in particular the first result being the official website of the Complainant.

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 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 L'OCCITANE trademark without authorization 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.

Thirdly, by having malicious software being downloaded on the internet user's computers, the Respondent is definitely trying to harm the internet users, by attracting them to the Respondent's website. These actions are extremely damageable to the

Complainant's fame and worldwide reputation, and may only be seen as bad faith use on the part of the Respondent.

Fourthly, the Respondent is offering the disputed domain name for sale at the price of USD 9,999 on Afternic, see supra. This amount exceeds by far the regular out-of-pocket expenses induced by the registration of a .biz domain name. Undoubtedly, the Respondent is trying to earn money by using the Complainant's reputation. The Complainant contends that the Respondent registered the domain primarily to sell it at an extremely important price, which is evidently a factor of bad faith registration and use.

Fifthly, as mentioned above, the Respondent has engaged in a pattern of behaviour by registering a large number of domain names reproducing third parties trademarks without authorization or consent, including well-known trademarks, which the Complainant only partially reproduces below:

activia.biz - agfaphoto.cc - armaniexchange.biz - beiersdorf.biz - bioderma.biz - bmw-i.biz - bosch-rewroth.info - carrefour.biz - christies.biz - delpeyrat.biz - eramet.biz - forever21.biz - giorgioarmani.info - goodyear.biz - hewlettpackard.biz - jeanpaulgaultier.biz - lancaster.cc - lanvin.biz - lexmark.info - lipton.biz - pernodricard.cc - paulsmith.biz - renault-trucks.biz - sandisk.biz - sergiotacchini.info - sonos.biz - sncf.info - technicolor.info

This statement is further evidenced by the fact that the Respondent was recently subject to two different domain name proceedings in which the Panel ordered that the corresponding domain name be transferred to the complainants:

WIPO Case DCC2018-0003 against the domain name wartsila.cc

WIPO DCC2018-0011 against the domain name promod.cc

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

The third condition under the Policy should be deemed satisfied.

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 reproduces the L'OCCITANE trademark in its entirety, with the exception of the apostrophe between the first two letters of the trademark.

The Respondent is not commercially linked to the Complainant. The Complainant never granted the Respondent any authorization, consent, right, license, exclusive or not, to use the trademark L'OCCITANE within the disputed domain name or in any other way for that matter.

The Complainant is active worldwide, and notably in China (it distributes its products under the subdomain loccitane.cn). The Complainant also operates the Facebook page of L'Occitane, followed by almost 6 million users, and the Instagram page L'Occitane, followed by more than 820,000 users. From these findings, it can be asserted that it is very unlikely that the Respondent was not aware of the existence of the Complainant - and its trademarks - at the moment of the registration.

The Complainant contends that (1) the website to which the disputed domain name is linked automatically downloads a file on the computer of the internet user and (2) it has had the file analyzed by its IT department which have confirmed that the file is malware

The Complainant has made a prima facie case that conditions for a transfer of the disputed domain name are satisfied. In the absence of answer from the Respondent, the transfer shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. LOCCITANE.BIZ: Transferred

PANELLISTS

Name	Mr. Etienne Wéry
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DATE OF PANEL DECISION 2019-01-31

Publish the Decision
