Decision for dispute CAC-UDRP-102484

Case number	CAC-UDRP-102484
Time of filing	2019-05-07 09:05:29
Domain names	bioderma-europe.com

Case administrator

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

Complainant

Organization	NAOS

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Frank Nkafu

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant, among others, of the international trademark registrations No. 267207, “BIODERMA”, registered on March, 19, 1963, and No. 510524, “BIODERMA”, registered on March 9, 1987, for goods and services in class 3.

The Complainant is also the registrant of the EU trademark registration No. 3136892, “BIODERMA”, registered on April 15, 2003, for goods and services in classes 3 and 5.

The disputed domain name was registered by the Respondent on April 9, 2019.

FACTUAL BACKGROUND

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

The Complainant states that it is among the top ten independent beauty companies, with 2 900 employees around the world and with 46 subsidiaries and long-term partnerships with local distributors.

The Complainant underlines that it sells products branded BIODERMA in over 90 countries, operating under the name

LABORATOIRES BIODERMA.

The Complainant points out that it is the owner of several trademarks and domain names consisting in the wording BIODERMA, registered before the disputed domain name.

The Complainant contends that the disputed domain name is confusingly similar to its trademark “BIODERMA” because it considers that the addition of the top-level domain “.COM” and of the geographical term “EUROPE” is not sufficient to distinguish a domain name from a trademark for the purposes of the UDRP.

In order to make a prima facie case that the Respondent has no rights or legitimate interests, the Complainant states that:

- according to the WHOIS information, the Respondent is not known as the disputed domain name;

- the Respondent is not related in any way with the Complainant;

- the Complainant does not carry out any activity for the Respondent;

- the Complainant does not have any business with the Respondent;

- the Complainant has not granted any license nor any authorisation to the Respondent to make any use of the Complainant's trademarks or apply for registration of the disputed domain name;

- the disputed domain name redirects to a parking page with commercial links related to the Complainant's products.

The Complainant observes that "BIODERMA", which is a trademark constituted by a word which has no meaning, is used worldwide, including in UK.

The Complainant points out that given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

The Complainant argues that the Respondent, using the website in connection with the disputed domain name on a parking page with commercial links related to the Complainant's products, attempts to attract Internet users for commercial gain and this constitutes an evidence of 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The 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.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark “BIODERMA”, identified in section “Identification of rights” above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain name.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant’s trademark.

The disputed domain name differs from the Complainant’s trademark “BIODERMA” only by the addition of the hyphen, of the geographical term "EUROPE" after the hyphen, and of the top-level domain ".COM".

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case the geographical term "EUROPE" after the hyphen has no impact on the distinctive part “BIODERMA”. It is well established that, where the relevant trademark is recognizable within the domain name, the addition of geographical terms would not be sufficient to prevent a finding of confusing similarity (see, for example, WIPO case No. D2014-0710).

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Respondent is not known as the disputed domain name;

- the Respondent is not related in any way with the Complainant;

- the Complainant does not carry out any activity for the Respondent;

- the Complainant does not have any business with the Respondent;

- the Complainant has not granted any license nor any authorisation to the Respondent to make any use of the Complainant's trademarks or apply for registration of the disputed domain name;

- the disputed domain name redirects to a parking page with commercial links related to the Complainant's products.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or

legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the website in relation with the disputed domain name consists in a parking page containing commercial links related to the Complainant's products. Other panels considered that the use of a domain name confusingly similar to a distinctive trademark in a parking page containing commercial links related to the Complainant's products does not give rise to any rights or legitimate interests in that domain name (see, for example, WIPO case No. D2018-1599). The Panel shares this view.

The Panel considers that, on the balance of probability, the Respondent knew of the reputation and goodwill that the Complainant had established in the trademark "BIODERMA" and registered the disputed domain name with knowledge of the Complainant's rights and reputation. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark “BIODERMA” in mind, when registering and using the disputed domain name. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain name.

Taking into account that the Respondent is not commonly known as the disputed domain name, that the Respondent has no connection or business relationship with the Complainant, that the Complainant has not authorized the Respondent to apply for registration of the disputed domain name or to use the Complainant's trademark, that the disputed domain name is used by a parking page containing commercial links related to the Complainant's products and not for any other legitimate purpose, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

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, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain

name was registered in bad faith and that it has been used in bad faith.

Taking into account the distinctiveness and reputation of the trademark “BIODERMA” also recognized by other panels, the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark “BIODERMA” when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel shares this view.

The Panel agrees also that directing Internet users to a web page containing commercial links in relation to the Complainant, like in the present case, is evidence of use in bad faith (see, for example, WIPO case No. D2017-0890).

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain name it would have filed a Response in this proceeding.

The Panel, having taken into account the Respondent's knowledge of the "BIODERMA" trademark at the time of the disputed domain name’s registration, that no response to the complaint has been filed and the use of the disputed domain name in a website containing commercial links in relation to the Complainant, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BIODERMA-EUROPE.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2019-06-23

Publish the Decision