Decision for dispute CAC-UDRP-102832

Case number	CAC-UDRP-102832
Time of filing	2019-12-30 14:13:29
Domain names	hyalexoexpanscience.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	EXPANSCIENCE

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Super Privacy Service LTD c/o Dynadot

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any pending or decided proceeding related to the disputed domain name.

IDENTIFICATION OF RIGHTS

EXPANSCIENCE (known also as “LABORATOIRES EXPANSCIENCE”) (the Complainant) is a 100% French family-owned pharmaceutical and dermo-cosmetics laboratory, who has been developing its expertise for more than 60 years.

The Complainant owns several trademarks comprising the terms “EXPANSCIENCE”, such as the international trademark EXPANSCIENCE® n° 282517 registered since 1964-04-17. The Complainant owns and communicates through various websites worldwide, its official one being <www.expanscience.com> registered and used since 1997-04-04.

FACTUAL BACKGROUND

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

Please see for instance Forum Case No. 1778422, Lockheed Martin Corporation v. Yu Tian / Xu Tian (“Complainant claims the <lockheedmartinblockchain.com>, <lockheedmartincryptocurrency.com>, and <lockheedmartincryptocurrencies.com> domain names are nearly identical or confusingly similar to the LOCKHEED MARTIN mark because they contain Complainant’s mark in its entirety and add the descriptive terms “blockchain,” “cryptocurrency,” or “cryptocurrencies,” as well as the gTLD “.com.” Slight differences between domain names and registered marks, such as the addition of descriptive

terms in connection with the mark, do not adequately distinguish the domain name from the incorporated mark.”).

Please see for instance Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy paargraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).”)

Please see Forum Case No. 1562569, Enterprise Holdings, Inc. v. Webmaster & Support (“A general solicitation to sell a disputed domain name provides further evidence of a respondent’s lack of rights and legitimate interests in a disputed domain name. […] Therefore, the Panel finds that Respondent’s willingness to sell the <wwenterprise.us> domain name is credible evidence that Respondent lacked rights and legitimate interests in the disputed domain name pursuant to Policy paragraph 4(a)(ii).”).

Please see Forum Case No. FA 1784212, Airbnb, Inc. v. khaled salem (“Complainant argues that Respondent diverts traffic to a parked website used to offer the disputed domain name for sale, in bad faith under Policy paragraph 4(a)(iii). The Panel agrees and finds that Respondent’s failure to actively use the disputed domain name demonstrates bad faith per Policy paragraph 4(a)(iii).”).

Please see NAF Case No. FA 1623939 Citigroup Inc. v. Kevin Goodman (“Respondent offered the <citi.club> domain name for sale or lease at prices well above even its alleged but unverified acquisition costs. […] Therefore, the evidence shows that Respondent registered <citi.club> primarily for the purpose of transferring it for a profit and demonstrates Respondent’s bad faith registration and use of the <citi.club> domain name pursuant to Policy paragraph 4(b)(i).”)

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

1. Identical or confusingly similar
The Complainant contended that the disputed domain name <hyalexoexpanscience.com> is identical to its registered trademark "EXPANSCIENCE". The Complainant also stated addition of the term “Hyalexo”, which is the exact wording used in the trademark application filed on the same day of the registration of the domain name by the Complainant, is not sufficient to escape the finding that the disputed domain names is identical to the Complainant's trademark and does not change the overall impression of the designations as being connected to its trademark.

The Complainant's registered mark "EXPANSCIENCE" has no common meaning in the English language. The Complainant's business is a France-based family owned company that has been in the business of pharmaceutical and dermo-cosmetics for more than 60 years. The Complainant owns several trademarks comprising the terms "EXPANSCIENCE", such as the international trademark EXPANSCIENCE® n° 282517 registered since 1964. Complainant's official website used to communicate with its customers and the general public, is <www.expanscience.com> registered and used since 1997. In addition, the Complainant applied for new European trademark HYALEXO EXPANSCIENCE on 2019-12-04.

As indicated by the Complainant, slight differences between domain names and registered marks such as the addition of a descriptive term in connection with the mark, should NOT adequately distinguish the domain name from the incorporated mark. Moreover, and in this case, the added term mimics the additional trademark already applied by the Complainant, making the intention of applying for a domain name incorporating two of the Complainant's trademarks especially suspicious. At the same time, it is also well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (See WIPO Case No. D2003-0888). Furthermore, the addition of a top level domain would not change the determination that the dispute domain name is identical to the Complainant's trademark. According to WIPO Overview 3.0 §1.11.1, "the applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusion similarity test". According to WIPO Overview 3.0 § 1.8, "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element." Here, the addition of the term "Hyalexo" which represented another trademark already applied for by the Complainant, should not impair the natural association consumers might have with the Complainant's brand, and therefore should not impact the assessment of the identicality or confusing similarity within the meaning of paragraph 4(a)(i) of the Policy.

The Panel therefore concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Respondent has offered two arguments to support its contention that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Firstly, the Respondent is not known as the disputed domain name; secondly, neither license or authorization has been granted to the Respondent.

According to the information of the Respondent as provided by the Registrar, the name of the Respondent's organization is protected by privacy. Therefore, there is no evidence suggests that the Respondent is in anyway associated with the name "EXPANSCIENCE" or "HYALEXO EXPANSCENCE". The Complainant also contended that it does not carry out any activity for, nor has any business with the Respondent. It has never licensed nor authorized the Respondent to make any use of the Complainant's trademark EXPANSCIENCE.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

As contended by the Complainant, it is true that UDRP Panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Complainant's trademark "EXPANSCENCE" is not a commonly English word and a simple Google search reveals all results related to the Complainant's brand. Moreover, the disputed domain name has also fully incorporated the Complainant's recently filed trademark registration for "HYALEXO", and is registered on the day that the "HYALEXO" trademark registration was applied. Based on the circumstances, it could be inferred from the circumstance that the Respondent was aware of the Complainant's brand name at the time of registering the disputed domain name.
The Complainant has also contended that by creating a website using a domain name similar to its own while keeping the website inactive, the Respondent could easily reach to the Complainant's costumers, and gives the wrong impression that the Respondent operates as an affiliate or a partner of the Complainant. Moreover, the disputed domain name resolves to a parking page displaying a general offer to sell the domain for 990 USD. This is a "passive holding" scenario, where the panellist is allowed to examine a totality of circumstances including the degree of distinctiveness or reputation of the complainant's mark, the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, the respondent's concealing its identity or use of false contact details, and so on (WIPO Overview 3.0 § 3.4). Here not only the Respondent maintains the website in its inactive state, it also contains a general offer to sell the particular domain name through the domain trading website dynadot (www.dynadot.com). Not being able to fathom any other plausible reason that the Respondent registered the disputed domain name, these evidence collectively give a strong inference that the domain name has been registered and used in bad faith.

In view of the above, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the disputed domain name was registered and is being used in bad faith within the meaning of 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. **HYALEXOEXPANSCIENCE.COM**: Transferred

PANELLISTS

Name	**Carrie Shang**

DATE OF PANEL DECISION 2020-02-24

Publish the Decision