Decision for dispute CAC-UDRP-102982

Case number	CAC-UDRP-102982
Time of filing	2020-03-20 09:54:14
Domain names	cosmetics-esthederm.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	NAOS

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Organization	ZAHORI GROUP s.r.o.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceeding related to the disputed domain name.

IDENTIFICATION OF RIGHTS

NAOS is the trademark proprietor of several trademarks ISTITUTE ESTHEDERM around the world, such as to cite only few of them the following:
International Registration for ISTITUTE ESTHEDERM 561679 as of 1990;
EUTM for ISTITUTSE ESTHEDERM PARIS 815392 as of 2003.

These trademark registrations predate the registration of the disputed domain name, on March 4th, 2018 as shown in the WHOIS
The Complainant is also proprietor of several domain names including the trademark ESTHEDERM and the most important is esthederm.com.
The Respondent's domain name redirects to a parking page with commercial links in reference with the Complainant and to other subject matter related to cosmetics.

FACTUAL BACKGROUND

Founded in France 40 years ago by Jean-Noël Thorel, a pharmacist-biologist, NAOS is a major player in skincare thanks to its three brands: Bioderma, Institut Esthederm and Etat Pur.

Ranked among the top 10 independent beauty companies, NAOS is a pioneer in biology and shifts the Skincare industry paradigm. NAOS owes its success to the dedication of more than 2,900 employees located around the world through its international presence based on 46 subsidiaries and long-term partnerships with local distributors .

The disputed domain name redirects to a parking page with commercial links in reference with the Complainant. See American Council on Education and GED Testing Service LLC v. Anthony Williams, FA1760954 (Forum Jan. 8, 2018) (“Respondent’s hosting of links to Complainant’s competitors demonstrates bad faith registration and use of the <geddiploma.org> domain name pursuant to Policy paragraph 4(b)(iv)”). Use of a disputed domain name to resolve to a webpage that offers links related to a complainant’s mark may be evidence of bad faith per Policy paragraph 4(b)(iv). See State Farm Mutual Automobile Insurance, FA1878031 (Forum Jan. 31, 2020) (finding bad faith use where disputed domain resolved to a parked website providing click-through links).

PARTIES CONTENTIONS

The Respondent has decided not to join the proceeding.

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

A. THE DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain name cosmetics-esthederm.com (hereinafter referred to as the “disputed domain name”) incorporates the Complainant’s well-known, registered trademark ISTITUTE ESTHEDERM or at least its more distinctive part: ESTHEDERM. The addition of the gTLD “.com” does not add any distinctiveness to the disputed domain name.
Referring to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), as the term “ESTHEDERM” is distinctively recognizable in the disputed domain name, the disputed domain name should be considered identical or confusingly similar to the above listed Complainant’s trademarks. It is also well established that the specific top level of a domain name such as “.com”, “.org” or “.net” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant has never granted the Respondent any right to use ESTHEDERM trademarks within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form. Furthermore the disputed domain name currently resolves to a parking page with links that are connected to the Complainant’s areas of activities.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name. When entering the terms ESTHEDERM in the Google search engine, the returned results all point to the Complainant and its business activity.

There is no evidence showing that the Respondent's use of the disputed domain name is in connection with a bona fide offering of goods or services.

Taking into account of the above, the Respondent shall be considered as having no right nor legitimate interest in respect of the disputed domain name. According to the consistent case law of this Court, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. The Respondent in this case has chosen not to join the proceeding and therefore to stay silent on the fact and the merit of the case.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

It has to be highlighted that the Complainant's trademarks predate the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to use these trademarks nor to register the disputed domain name. The Respondent has chosen to incorporate the trademark ESTHEDERM in the disputed domain name with a descriptive additional element: cosmetics that exactly the area of business of the Complainant. From the Complainant's perspective, it is very likely that the Respondent had the trademark in mind when he registered the disputed domain name and registered it only to mislead Internet users. The Respondent was in bad faith at the moment of the registration of the disputed domain name as well as in its use later on through a parking web site.

In fact the Respondent has also been using the domain name in bad faith : its website is linked to the disputed domain name and is redirected to site connected to the Complainant . Use of a disputed domain name to resolve to a webpage that offers links related to a complainant's mark may be evidence of bad faith per Policy paragraph 4(b)(iv).
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Therefore, it is reasonable to conclude that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website to be redirected to website of others, connected to the same business of the Complainant and doing so caused a likelihood of confusion with the Complainant's trademark.

SUMMARY

To summarize, 1) the trademark registrations for ISTITUTE ESTHEDERM predate the registration of the disputed domain name; 2) The Respondent bears no relationship with the trademarks or the Complainant; it is not commonly known by the disputed domain name nor that has it interest over the disputed domain name; 3) The Respondent has been using the disputed domain name with the likely intention to take advantage of the trademark and to start a web parking activity connected to the Complainant's business. Consequently, the Respondent should be considered to have registered and use the disputed domain name identical to the Complainant in bad faith. The Respondent has no legitimate right or interest of using the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COSMETICS-ESTHEDERM.COM**: Transferred

PANELLISTS

Name	Massimo Cimoli

DATE OF PANEL DECISION 2020-04-27

Publish the Decision