Decision for dispute CAC-UDRP-103211

Case number	CAC-UDRP-103211
Time of filing	2020-07-30 09:25:17
Domain names	biodermastore.com

Case administrator

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

Complainant

Organization	NAOS

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	DERMA POINT SAC

OTHER LEGAL PROCEEDINGS

The Complainant has declared that there are no other legal proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of a number of trade marks, including an EUTM for the word 'BIODERMA' (3136892, first registered 15 April 2003) and word marks 'BIODERMA' under the Madrid international system (267207, first registered 19 March 1963 on the basis of an Austrian mark; 510524, first registered 9 March 1987 on the basis of a French mark). These marks subsist in class 3 and/or class 5.

FACTUAL BACKGROUND

The Complainant, a company with its seat in Aix-en-Provence, France, has been in operation for 40 years. It manufactures skincare / beauty products which are promoted under three brands; 'BIODERMA' is one of them. It operates at a global scale, with BIODERMA products sold in close to 100 countries (including, according to a map supplied by the Complainant, the Respondent's country). In this context, it operates a number of websites at domain names including <BIODERMA.COM> (first registered 24 September 1997).

The Respondent, a company with an address in Lima, Peru, registered the disputed domain name on 25 June 2020.

PARTIES CONTENTIONS

No administrative compliant response has been filed. The Respondent never accessed the online platform, although an e-mail sent by the Provider was successfully relayed. The Provider is not aware whether written notice of the dispute was received by the Respondent or not.

The Complainant highlights the commercial links (related to its own activities) found at the Respondent's website, and argues that no rights or legitimate interests are present. It provides evidence of its various trade marks, contends that the disputed domain name has been registered and is being used in bad faith, and asks that the disputed domain name be transferred to itself.

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).

Disregarding the gTLD .com, as is the established practice under the Policy, it is noted that the difference between the Complainant's mark BIODERMA and the disputed domain name <BIODERMASTORE.COM> is the addition of the string 'STORE'. The Panel finds that this is confusingly similar to the Complainant's mark, as this is a situation where the disputed domain name consists of a mark accompanied by a generic term (see WIPO Jurisprudential Overview, version 3.0, para 1.8). Indeed, there are many cases where a mark followed by 'STORE' easily meets the requirements of paragraph 4(a)(i) of the Policy; see for example CAC Case No. 102078 Mammut Sports Group AG v Lubberger Lehment. The Complainant also cites the very recent decision of a Panel at another Provider, in respect of its mark, where the accompanying generic term was 'SHOP' rather than 'STORE': WIPO AMC Case No. D2020-0143, NAOS v (xiao meng lin) <BIODERMASHOP.COM>.

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).

The Complainant declares that the Respondent is not related in any way to the Complainant, and that it (the Complainant) does not carry out any activity for, nor has any business with, the Respondent. The Complainant also affirms that it has not licensed or authorised any activity to be carried out by the Respondent.

The Respondent is known as 'Derma Point SAC', but the Panel is not able to identify any other identifying features or activities of the Respondent, given the Respondent's failure to participate in these proceedings. The Panel's own web search does not identify any further features of this business activity other than its registration as a closely held company.

The nature of the website at the disputed domain name (likely to be pay-per-click links related to the activities of the Complainant and others) does not provide a plausible basis for the finding of rights or legitimate interests. The Panel has not been able to identify any possibility of such. The Panel notes that there is no basis for a 'reseller' argument here (in contrast with e.g. CAC Case No. 102168 Interparfums v Congj Buxar, <ROCHASSHOP.COM>), given the absence of any evidence of activity of this nature by the Respondent.

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).

The Complainant argues that the Respondent must have been aware of its trade mark, presenting as evidence the results of a Google search for 'BIODERMA STORE' where all results point to the Complainant's activities. Although the terms 'BIO' and 'DERMA' on their own are in reasonably common use (as abbreviations or as indicators), and the Respondent has 'DERMA' as part of its own name, the specific combination of 'BIODERMA' is unlikely to arise without knowledge of the Complainant. As another Panel considering a Complaint from the same Complainant recently found, the mark is distinctive and enjoyed a reputation ('it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark “BIODERMA” when registering the disputed domain name': CAC Case No. 102484, NAOS v Frank Nkafu.) The Panel does note that the

distinctiveness of the string BIODERMA has been the subject of extensive consideration in other proceedings; see for instance the decision of the General Court of the European Union, T-427/11 Laboratoire Bioderma v OHMI, reference to which is included in the documentation of the Complainant's marks supplied as an Annex to the Complaint. However, the Complainant's broad success in these proceedings, and the more limited nature of the Panel's consideration of possible bad faith, and the failure of the Respondent to make any argument in this regard, allows the Panel to accept the Complainant's contention here.

Specifically, the Panel finds that the present dispute is one where the Respondent has attempt to attract Internet users for commercial gain to its own website, by creating a likelihood of confusion with the Complainant's mark (one of the examples of bad faith enumerated in the Policy, at para 4(b)(iv). This finding relies on the use of the disputed domain name, by the Respondent, for a 'parking' page of commercial links, many of which relate directly to the Complainant's activities.

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 reasons for the decision are set out above. In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. On the other hand, it is clear that the Complainant has rights in respect of the trade mark BIODERMA. The Respondent has registered a domain name which incorporates the Complainant's mark and an additional generic term STORE; the disputed domain name is confusingly similar to the mark in which the Complainant has rights. Through the commercial links made available via its website, without any further explanation and likely to be in full knowledge of the Complainant's rights and activities, the Respondent was found to have registered and be using the disputed domain name in bad faith. The requirements for the acceptance of a Complaint under paragraph 4 of the Policy have therefore been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BIODERMASTORE.COM**: Transferred

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2020-08-29

Publish the Decision