Decision for dispute CAC-UDRP-103142

Case number	CAC-UDRP-103142
Time of filing	2020-07-01 11:13:21
Domain names	bioderma.sucks

Case administrator

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

Complainant

Organization	NAOS

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Honey Salt Ltd.

Respondent representative

Organization	ESQwire.com, P.C.

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks including the wording “BIODERMA” in several countries, such as the international trademark BIODERMA® n°267207 registered since March 19, 1963 for class 03Cosmétiques.

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.

The disputed domain name <bioderma.sucks> was registered on June 17, 2020. It resolves to a website displaying information regarding the Complainant, several links loosely related to the Complainant's products, and the message "domains for sale". Besides, it is offered for sale on SEDO for 199 USD. Respondent was formed on or around February 12, 2020 to register and hold domain names for the benefit of the organization Everything.sucks Inc. ("Everything.sucks").

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Respondent is not identified in the WHOIS as the disputed domain name and has not acquired trademark rights in this term. The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use the trademark BIODERMA® in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent. Besides, the disputed domain name resolves to a website displaying information regarding the Complainant, several links loosely related to the Complainant's products, without any criticisms, and the message "domains for sale". Finally, the disputed domain name is used to talk about numerous companies, not only the Complainant, and the Respondent registered the corresponding domain names, which are also for sale. The Complainant contends that the Respondent has registered the disputed domain name only in to capitalize on, or otherwise take advantage of, the Complainant's trademark rights, which evinces bad faith registration and use.

RESPONDENT:

This is a case of fair use of a trademark and appropriate use of a descriptive domain name. Despite Complainant's protest there is no basis for transferring the disputed domain name <Bioderma.Sucks> (the "Disputed Domain") to Complainant. Respondent is not a "cybersquatter", rather (as Complainant was aware before filing this claim), Respondent has registered and is using the Disputed Domain in connection with a commentary and criticism site involving Complainant's product, Bioderma. This is neither a case where the Panel must divine the intended purpose of Respondent nor one where a consumer could be confused by the Disputed Domain and corresponding website. Here, the Disputed Domain is comprised of TRADEMARK + SUCKS, and it resolves to a wiki type page with commentary, information, and criticism of the referenced trademarked product – consumers are not confused or mislead [sic], as here, the pejorative term "Sucks" clearly indicates criticism and the website likewise does not purport to be associated in any way with the trademark holder. This is a legitimate and fair use that is not cybersquatting under the Policy. Regardless of the parties' personal views of the use of the pejorative term "sucks" the facts demonstrate that Respondent's registration and use of the Disputed Domain is an appropriate use and protected under the UDRP and laws in the EU, United States, and elsewhere regarding freedom of expression and free speech. Respondent registered the Disputed Domain to point it to the valid criticism and feedback site that was created for Complainant's product. This wiki style criticism and feedback page is one of many pages that consumers can find at Everything. Sucks, which, itself, acts as a portal or hub to critique hundreds of companies and products of all types. Complainant's product is one of thousands of companies or products that are reviewed and critiqued at Everything. Sucks. Many individual comment pages, like the website for the Disputed Domain also has user generated comments and commentary about the referenced brand or product. In any event, it is settled that it is permissible to sell descriptive and highly valuable domain names. In this case, the unique convention of a trademark + the .SUCKS TLD undoubtedly creates a highly descriptive impression and conveys a message to a user that the website associated with the Disputed Domain has a descriptive purpose, namely, to provide negative comment and feedback. Complainant has failed to meet its burden of proving bad faith registration and use and, the Complaint must, therefore, be dismissed.

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). The Panel notes that the Respondent does not actively contest the Complainant's case on this element of the Policy.

The disputed domain name <bioderma.sucks> is identical to its trademark BIODERMA®. Indeed, the second level of the disputed domain name includes in its entirety the above mentioned trademark without any adjunction of letter or word. The addition of the new gTLD ".SUCKS" does not add any distinctiveness to the disputed domain name.

It is the consensus view of UDRP panelists under the Policy that a domain name consisting of a trademark and a negative or pejorative term (such as [trademark]sucks.com) generally would be considered confusingly similar to a complainant's mark for purposes of the standing requirement of the first element of the Policy. The same applies to the gTLD ".sucks" used in combination with a protected trademark. Although the generic Top-Level Domain ("gTLD") may in appropriate circumstances be considered when evaluating identity or confusing similarity, gTLDs may also be disregarded, and usually are not taken into consideration when evaluating the identity or confusing similarity between the complainant's mark and the disputed domain name. See Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525; Rollerblade, Inc. v. Chris McCrady, WIPO Case No. D2000-0429; Phenomedia AG v. Meta Verzeichnis Com, WIPO Case No. D2001-0374.

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 Respondent is not identified in the WHOIS as synonymous with the disputed domain name and has not acquired trademark rights in this term. Indeed, past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name itself (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>). Furthermore, the Respondent is not affiliated with the Complainant nor authorized by it in any way to use the trademark BIODERMA® in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Respondent argues that it is making fair use of the disputed domain name to engage in protected speech such as criticism and commentary. It correctly points to section 2.6 of the WIPO Overview 3.0 as a guide to what previous panels have found in this area. For this Panel, the Respondent's case fails in connection with section 2.6.1 of the Overview whereby "the respondent's criticism must be genuine and non-commercial" noting that "in a number of UDRP decisions where a respondent argues that its domain name is being used for free speech purposes the panel has found this to be primarily a pretext for cybersquatting, commercial activity, or tarnishment".

Here, it is important to note that the Respondent is not the person who is said to be making the allegedly free speech commentary or criticism. The Respondent is a third party, or at least claims to be. Yet the Respondent is the registrant of the disputed domain name, not some other person who may or may not have a genuine gripe to make about the Complainant. In fact, the Respondent has no way of knowing anything of the genuineness of any criticisms made on the associated website. The process by which the disputed domain name was registered seems to be automatic and, importantly, took place before any criticism whatsoever was even present on the website (as may be inferred from the Parties' evidence, namely the Complainant's screenshot of June 24, 2020). The alleged criticism seems to have been added as an afterthought between that date and the date when the Response was filed, further calling its genuineness into question.

The Respondent has no direct relationship with any person who might, or might not, be able to invoke rights of free speech/freedom of expression under the laws of any particular jurisdiction (or indeed who might be able to invoke the fair use defence under the Policy, were it the registrant of the disputed domain name). The Respondent has no knowledge of whether any such person using its site might be able to invoke such rights, nor is it in any position to engage in any balancing exercise with the trademark owner's rights. Even assuming a third party generated the page on the Respondent's website in order to engage in non-commercial criticism, rather than the Respondent itself, the Respondent immediately proceeds to exploit the position commercially by registering and offering the disputed domain name for sale. In fact, the Respondent is an offshore company (Honey Salt Ltd., based in Turks and Caicos Islands) doing business, among others, in registering ".sucks" domain names and selling them.

In the circumstances of this case, the Respondent's entire endeavour seems to the Panel to be a pretext for commercial activity. Section 2.6.3 of the WIPO Overview 3.0 notes that use may be fair if prima facie non-commercial, genuinely fair and not misleading or false, adding that incidental commercial activity e.g. fundraising may also be permitted. This does not apply here – the use is prima facie commercial, potentially furthering the ultimate commercial aims of the Respondent's website, and it is definitely commercial in the sense of a proposed sale of the disputed domain name (the Respondent says it intends to develop the websites and to resell domains such as the disputed domain name "to parties that may wish to use [it] for expanded or enhanced commentary or feedback purposes on their own site"). In the present case, there is also doubt as to the genuineness of the criticism (a matter on which the Respondent must accept that it can never answer as it is not, nor does it act for, the party allegedly making the criticism). A useful discussion of the overall position is to be found in HAI Global v. Dane Rose, CAC 102016, June 25, 2018. This suggests that the assessment on rights and legitimate interests proceeds in light of available evidence including the website at the disputed domain name but is not a full assessment of the merits and demerits of the substantive criticism. It adds that such assessment will necessarily overlap with consideration of the wording of paragraph 4(c) of the Policy, excluding situations where there is intent for commercial gain etc. The Panel considers that this accords with its approach as outlined above – intent for commercial gain is present and there is no need to go further than that.

UPWORK INC. v. Sunny Kumar, CAC 101294, October 30, 2016 and Novartis AG v. BRANDIT GmbH, CAC 103013, May 26, 2020 are both decided by the same panelist and take broadly the same approach as each other, even using some of the same wording. These focus perhaps a little too much on EU law for this Panel (attracting the same criticism as those decisions which originally applied US First Amendment principles). Nevertheless, the cases apply an "all circumstances" view which the Panel believes is consistent with its own analysis above. Importantly, in each of these cases, the respondent, in whose favour the panel found, was the person seeking to make genuine criticism or to publish genuinely held views/commentary about the complainant. It was not a third party, as in the present case.

Finally, the Panel has reviewed Intesa Sanpaolo S.p.A. v. Robert Sloan, CAC 102267, January 24, 2019. The panel in that case notes that "it has been said time and time again in relevant decisions that to rely on the free speech defence, the site must be used solely for a real criticism or fan site and not for commercial purposes under the guise of a criticism site."

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 Respondent clearly knew the identity of the Complainant and had intent to target its rights for commercial purposes before it registered the disputed domain name. It follows from the previous discussion on the second element that the disputed domain name is not connected with genuine non-commercial criticism of the Complainant and that the Respondent's approach was to take unfair commercial advantage of the Complainant's name and trademark while having no actual criticism or free speech of its own in which to engage. It looked to sell the disputed domain name on the open market before any criticism had even been published. The fact that the disputed domain name is used for a web page not containing genuine criticism content but only automatically generated links loosely related to the Complainant's product (as demonstrated by the Complainant's screenshot dating from before the filing of the present Complaint) constitutes further evidence of bad faith. The fact that the disputed domain name is used in a page containing links to other companies and where the relevant domain names (to which the links point) are systematically put on sale by the Respondent is additional evidence of cybersquatting.

In the opinion of the Panel, due to the fact that the disputed domain name is not used for a genuine criticism website, the arguments put forward by the Respondent cannot be accepted. As explained by the Respondent, "where a respondent has a legitimate interest in the domain name, a general offer for sale is not evidence of bad faith". However, this reasoning does not apply to the present case, because the Respondent does not have any legitimate interest in the disputed domain name.

Furthermore, the Panel does not agree with the Respondent's argument based on the "descriptive impression" and "descriptive purposes" of .sucks domain names, because this would imply that anyone would be free to register .sucks domain names corresponding to third-party trademarks regardless of their intent and purpose in so doing. In the opinion of the Panel, only a non-profit organization (or a private person) could be entitled to register .sucks domain names

corresponding to a third-party trademark of which the registrant has prior knowledge, and only then for use in connection with a genuine and active criticism web site.

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 Respondent cannot claim to have legitimate interest based on free speech website. He is not the person who is said to be making the allegedly free speech commentary or criticism. The Respondent is a third party, or at least claims to be. Yet the Respondent is the registrant of the disputed domain name, not some other person who may or may not have a genuine gripe to make about the Complainant. In fact, the Respondent has no way of knowing anything of the genuineness of any criticisms made on the associated website. The process by which the disputed domain name was registered seems to be automatic and, importantly, took place before any criticism whatsoever was even present on the website (as may be inferred from the Parties' evidence, namely the Complainant's screenshot of June 24, 2020. Furthermore has registered and acts in bad faith: The fact that the disputed domain name is used for a web page not containing genuine criticism content but only automatically generated links loosely related to the Complainant's product (as demonstrated by the Complainant's screenshot dating from before the filing of the present Complaint) constitutes evidence of bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BIODERMA.SUCKS**: Transferred

PANELLISTS

Name	**Thomas Hoeren, Michele Antonini, Andrew Lothian**

DATE OF PANEL DECISION 2020-08-26

Publish the Decision