Decision for dispute CAC-UDRP-103418

Case number	CAC-UDRP-103418
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Domain names	esthedermbeauty.com

Case administrator

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

Complainant

Organization	NAOS

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Organization	esthebeauty

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various trademark registrations, such as:

• the international semi-figurative trademark N°815392 INSTITUT ESTHEDERM PARIS, registered on October 16, 2003, in classes 3, 5 and 44, and renewed; and
• the EU semi-figurative trademark N°00344051 INSTITUT ESTHEDERM PARIS, registered on March 14, 2005, in classes 3 and 44, and renewed.

No information is provided on the last renewal of the international semi-figurative trademark N°561670 INSTITUT ESTHEDERM, registered on October 15, 1990, in classes 3, 5, 21 and 42.

The Complainant is also the owner of the domain name <esthederm.com>, registered on June 19, 1996.

The Complainant uses this domain name to resolve to its official website which is dedicated to its branded products and to its trademarks.

The disputed domain name <esthedermbeauty.com> was registered on October 30, 2020.

The identity of its registrant is not publicly available. The Registrar disclosed the provided data on November 17, 2020 and it appears that the Registrant is the company Esthebeauty domiciled in Cyprus.

FACTUAL BACKGROUND

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

The Complainant is the company NAOS, a pioneer in biology and skincare in the field of cosmetics with its three trademarks: BIODERMA, INSTITUT ESTHEDERM and ETAT PUR.

It was founded in France 40 years ago by Jean-Noël Thorel, a pharmacist-biologist.

It is ranked among the top 10 independent beauty companies and employs 2 900 employees located around the world through its international presence based on 46 subsidiaries and long-term partnerships with local distributors.

The Complainant offers to its customers its products exclusively through its website: <esthederm.com>

The domain name <esthedermbeauty.com> was registered on October 30, 2020 using a privacy service. According to the UDRP Rules, the Registrar disclosed the name of the registrant.

As of November 16, 2020, the domain name <esthedermbeauty.com> gives access to a website that offers for sale cosmetic's products including marked products INSTITUT ESTHEDERM PARIS.

It proposes also various other products in a section at the bottom of the page named "Partner products" and the Complainant contends that by clicking one of these products, the consumer is redirected to another website.

As of November 20, 2020, the Complainant conducted a search on the Respondent, identified as "esthebeauty" located in Ploutarhou 40 agios ioannis Limassol (CY). There was no result.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

On the confusing similarity

The disputed domain name <esthedermbeauty.com> is confusingly similar to its INSTITUT ESTHEDERM trademarks and domain names.

The addition of the term "Beauty", which refers to the Complainant's activity, is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and branded INSTITUT ESTHEDERM goods.

The Complainant relies on a CAC Case n° 102982 NAOS v. ZAHORI GROUP s.r.o.: "The domain name cosmetics-esthederm.com incorporates the Complainant's well-known, registered trademark ISTITUTE ESTHEDERM or at least its more distinctive part: ESTHEDERM."

On the absence of rights or legitimate interest.

The Complainant contends that the Respondent does not have any right or legitimate interest in the domain name.

The 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, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Respondent is not known under the disputed domain name.

The Complainant contends that it has no relation with the Respondent, that it does not carry out any activity for, nor has any business with the Respondent.

He adds that no license or authorization has been granted to the Respondent to make any use of its INSTITUT ESTHEDERM trademarks, or to register the disputed domain name.

It contends that in accordance with the disclosure of Registrant's information, the Respondent is identified as "esthebeauty" located in Ploutarhou 40 agios ioannis Limassol (CY). A search on this company on search engines on the internet does not provide any result. Therefore, the Complainant contends that the Registrant doesn't exist.

The Complainant submits that the Website is purporting to be an official online retailer, because it reproduces its logo "INSTITUT ESTHEDERM PARIS" on the top of the website. The website does not show any details regarding the editor of the website, leaving the Internet user under the false impression that the available online shop is provided by one of its official distributors.

The website is also using a number of Complainant’s official product images without authorization. It also offers products unrelated with the disputed domain name at the footer page and that by clicking one of these products, the consumer is redirected to another website.

The Complainant argues that Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. It submits that Respondent’s behavior shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly divert consumers or to tarnish its trademarks.

The Complainant contends that accordingly, Respondent has no rights or legitimate interests on the disputed domain name <esthedermbeauty.com>.

On bad faith registration and use.

The Respondent had knowledge of the “Esthederm” trademark when registering the disputed domain name. The Respondent started running its website using the INSTITUT ESTHEDERM PARIS trademarks immediately after registering the disputed domain name. The term “Esthederm” is purely an imaginative term and unique to the Complainant. “Esthederm” is not commonly used to refer to Skincare products. This is beyond the realm of reasonable coincidence, that Respondent chose the disputed domain name, without the intention of invoking misleading association with the Complainant.

The website is also using a number of Complainant’s official product images without authorization. It also offers products unrelated with the disputed domain name at the footer page and that by clicking one of these products, the consumer is redirected to another website.

The Respondent registered and used the dispute domain name with the intention to attract for commercial gain Internet users to the website by creating a likelihood of confusion with the Complainant's trademark. The confusion is exacerbated

by the use of Complainant’s official product images in conjunction with the disputed domain name, without Complainant’s authorization.

The Respondent has registered and is using the disputed domain name <salonesthederm.com> in bad faith.

RESPONDENT:

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).

The Panel finds that the Complainant has established rights in the INSTITUT ESTHEDERM PARIS trademarks.

It is also the registrant of the domain name <esthederm.com>.

The disputed domain name <esthedermbeauty.com> incorporates entirely the distinctive term ESTHEDERM of the Complainant’s registered INSTITUT ESTHEDERM PARIS trademark.

The addition of the generic term “beauty”, which refers to cosmetics, i.e. to the products designated by the INSTITUT ESTHEDERM PARIS trademarks and offered by the Complainant, does not exclude any likelihood of confusion. This is rather a direct and clear connection to the INSTITUT ESTHEDERM PARIS Complainant's trademarks.

The extension ".com" is not taken into consideration in this analysis, because of its technical function.

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).

No rights or legitimate interests

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:
(i) before any notice to it of the dispute, the Respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) the Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
(iii) the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

While the overall burden of proof in UDRP proceedings is on the Complainant, panels have recognized that proving a Respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the Respondent.

As such, where a Complainant makes out a prima facie case that the Respondent lacks rights or legitimate interests, the burden of proof shifts to the Respondent. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element.

The Respondent is not known by the disputed domain name and has not been licensed or authorized to use the INSTITUT ESTHEDERM PARIS trademarks or to register the disputed domain name <esthedermbeauty.com>.
It does not make a fair or non-commercial use of the disputed domain name.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent's lack of rights or legitimate interests in relation to the disputed domain name, which the Respondent has not rebutted. The conditions of paragraph (4)(a)(ii) of the Policy have therefore been satisfied.

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).

Bad faith

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of a domain name. It provides that: "For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
(i) circumstances indicating that the Respondent has registered or the Respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 domain name; or
(ii) the Respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website 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 website or location or of a product or service on the Respondent's website or location."

The INSTITUT ESTHEDERM PARIS trademarks predate the disputed domain name.

There is no doubt that the Respondent was well aware of the INSTITUT ESTHEDERM PARIS trademarks when it registered the disputed domain name.

The Respondent was planning to target internet users and potential consumers of the Complainant. This is why it registered a domain name incorporating the distinctive term ESTHEDERM, adding the generic term "beauty", and used it immediately after it was registered to give access to the litigious website www.esthedermbeauty.com.

The Panel finds that the Complainant has made a prima facie case that the Respondent registered the disputed domain name in bad faith.

With regard to the bad faith use, the disputed domain name was immediately used to resolve to a website offering INSTITUT ESTHEDERM PARIS branded cosmetics, providing a content related to the Complainant, using products' images without any authorization, whereas, on the bottom of the website it offers unrelated "partner products".

The Panel is of the opinion that this use satisfies the requirement of paragraph (4)(b)(iv) of the policy "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location".

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.

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 INSTITUT ESTHEDERM PARIS trademarks predate the registration of the disputed domain name.

The addition of the generic term “beauty”, which refers to cosmetics shows that the Complainant targeted the Complainant’s INSTITUT ESTHEDERM PARIS trademarks protected for cosmetics.
The Respondent is not known under the disputed domain name and has not been licensed or authorized to use the INSTITUT ESTHEDERM PARIS trademarks or to register the disputed domain name <esthedermbeauty.com>.
It does not make a fair or non-commercial use of the disputed domain name.
Given the fact that the disputed domain name was immediately used to resolve to a website offering INSTITUT ESTHEDERM PARIS branded cosmetics, using products’ images without any authorization, the Panel finds that the Respondent was well aware of the Complainant’s rights in the INSTITUT ESTHEDERM PARIS trademarks when it registered the disputed domain name. It constitutes bad faith registration.

The Panel is of the opinion that the criticized use satisfies the requirement of paragraph (4)(b)(iv) of the policy “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location”.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ESTHEDERMBEAUTY.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2020-12-15

Publish the Decision