

Decision for dispute CAC-UDRP-104256

Case number **CAC-UDRP-104256**

Time of filing **2022-01-05 09:10:09**

Domain names **advancedbioderma.com, advancedbiodermacorporation.com**

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

Organization **NAOS**

Complainant representative

Organization **NAMESHIELD S.A.S.**

Respondent

Name **Julio Nieto**

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 owns several trademarks consisting of the wording BIODERMA in several countries, among them the active International registration 267207A BIODERMA in class 3, registered on March 19, 1963, extended to France and the US registration 4239940 BIODERMA filed for on February 16, 2012.

FACTUAL BACKGROUND

Founded in France 40 years ago, the Complainant is a major player in skincare using three brands, Bioderma, Institut Esthederm and Etat Pur.

The Complainant ranks among the top 10 independent beauty companies and employs more than 3 000 employees located around the world through its international presence based on 48 subsidiaries and long-term partnerships with local distributors. Products branded with BIODERMA are sold in over 90 countries.

The disputed domain name <advancedbioderma.com> was registered on March 5, 2018 and resolves to a website showing company information about an US company Advanced Bioderma with a contact address in Boca Raton, Florida, US.

The disputed domain name is registered for the Respondent which is a shareholder and secretary of Advanced Bioderma Corporation founded in 2017. This company is the proprietor of a European Union Trademark, figurative and in color, 017996532 ADVANCED BIODERMA (fig.) in class 35. The mark was filed on December 5, 2018 for goods in class 3 and more services in class 35. On opposition filed against all goods and services by the Complainant, all goods in class 3 and certain services in class 35 were removed whereas the opposed trademark application which is now registered, still enjoys protection for other remaining services in class 35.

The Complainant succeeded in a Forum ADR proceeding (FA2201001978937) against the Respondent with regard to a domain name <advancedbioderma.us>. The Respondent did not submit a response in this NAF ADR proceeding (FA2201001978937).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant states that the disputed domain name is confusingly similar to its trademark BIODERMA since the addition of the generic term "advanced" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark. The Respondent has in view of Complainant no rights or legitimate interest in the domain name.

Although the Respondent has attempted to register the trademark "advanced Bioderma", the Complainant has filed a complaint and won the withdrawal of this trademark. The Opposition Division found that the trademark "advanced Bioderma" registered in particular in Classes 3 ("Hair lotions... cosmetic preparations for skin care") and 35 ("Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.") was identical to the point of confusing them with the Complainant's trademarks. Accordingly, Respondent has no rights or legitimate interests on the disputed domain name. The domain name has been registered and is being used in bad faith since the Respondent must have been aware of the Complainant's BIODERMA trademarks (especially its USPTO trademark) at the time the Respondent registered the disputed domain name. The Complainant claims that the term "BIODERMA" has no meaning in the dictionary. All the results of a Google search of the term "BIODERMA" are related to the Complainant and its products. Furthermore, Previous Panels confirmed that the combination of "BIO" and "DERMA" is distinctive to the Complainant and its trademark. Therefore, the Complainant finds that the disputed domain name was registered in bad faith with the intention of taking predatory advantage of Complainant, its rights and reputation and to attract and divert Internet traffic to Respondent's website. The use of the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website, is considered as bad faith. On this basis, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT:

Respondent contends that the disputed domain name is linked to an active website that is used by the company Advanced Bioderma Corporation for which the Respondent is a major shareholder and Secretary. Accordingly, the domain name is used in connection with a bona fide offering of services, demonstrating rights and legitimate interests for Policy 4(c)(i) and 4(c)(ii).

The website is not an online shop, but a static website showcasing the manufacturing services of Advanced Bioderma Corporation. The landing page shows that products are developed, manufactured and produced, inter alia for different brand names. The company's own line is called FYAB.

Respondent has rights and legitimate interest in respect of the domain name. The company in which he has shares is the owner of a trademark that is identical to the domain name.

The disputed domain name was not registered in bad faith as it is the same as the company name. It is also not for the purpose of selling the domain to make a profit. The Complainant is not a competitor. The company is a contract manufacturer and has been operating since 2017 with an ISO certified facility in Florida, USA. The domain was registered for Advanced Bioderma Corporation's continued business use, an active website.

RIGHTS

In order to succeed in its claim, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established that it has valid trademark rights for BIODERMA in several countries. The disputed domain name is highly similar to the trademark, since it is acknowledged that the generic Top-Level Domain (“gTLD”) does not have relevance in assessing whether the subject domain name is identical or confusingly similar to a trademark and the generic addition “Advanced”, even if at the beginning of the disputed domain name, does not sufficiently diminish the similarity created by the more distinctive element “BIODERMA”.

The Panel therefore considers the disputed domain name to be similar to the BIODERMA trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

Paragraph 4(a)(ii) requires a complainant to establish a prima facie case that respondent lacks rights or legitimate interests in the subject domain name, and if it does so, the burden shifts to respondent to rebut complainant’s contentions.

In view of the Panel, the Complainant could not show that Respondent has no rights or legitimate interests with respect to the disputed domain name.

Respondent is a shareholder of a company with the company name Advanced Bioderma Corporation which has a valid European Union Trademark for ADVANCED BIODERMA. The color (blue for the element “Bioderma”) and the figurative element within the mark (at the position of the “O” in “BIO” there is a graphic element with an outer oval border) does not change the impression of the word “BIODERMA” as also the Complainant indicated in connection with his presentation of “Respondent’s trademark Advanced Bioderma” when he mentioned the trademark of the company Advanced Bioderma in the complaint.

The UDRP does not require a specific trademark right for the same goods or services as the Complainant has rights in or for which he is using his rights. The valid European trademark and eventually also the company name of the US company Advanced Bioderma Corporation in which Respondent has shares provides rights in the meaning of Paragraph 4(a) II.

In addition, Respondent has demonstrated that the company he has shares in is using the domain name for inter alia manufacturing services for quite some time.

Panel has in view of the statements and evidence provided in this proceeding no reason to believe that the Respondent is not affiliated with the Rights Holder. His shareholder ship has been claimed and Respondent was entered on the company register as secretary to the trademark owner prior to the filing of this ADR Complaint. Last but not least, the Complainant also assumes that the Respondent and the trademark owner are connected if the Complaint states that “Respondent has attempted to register the trademark “advanced bioderma”.

The Panel concludes the Respondent having rights or legitimate interests in the disputed domain name.

BAD FAITH

In view of the above it is therefore not necessary any more to evaluate whether the disputed domain name was registered in bad faith and even used in bad faith.

This decision reflects and applies the requirements of the UDRP and should not be considered as prediction to the advantage or disadvantage of the Complainant or the Respondent in any intellectual property proceedings in court in which a justification of use or an infringement of designation rights may be evaluated in more depth in relation to the broader legal statutory framework compared to the intended narrow scope of application of the UDRP.

PROCEDURAL FACTORS

The initial complaint was directed also against another domain name, <advancedbiodermacorporation.com> for which another registrant was indicated in the registry. Since the Panel could not find sufficient circumstances that both domain names are owned by the same entity or under the same control, the cases were not consolidated but split and only the present one was sent to the panel for decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has established that it has valid trademark rights for BIODERMA in several countries. The disputed domain name is highly similar to the trademark, since it is acknowledged that the generic Top-Level Domain (“gTLD”) does not have relevance in assessing whether the subject domain name is identical or confusingly similar to a trademark and the generic addition “Advanced”, even if at the beginning of the disputed domain name, does not sufficiently diminish the similarity created by the more distinctive element “BIODERMA”.

However, the Complainant could not show that Respondent has no rights or legitimate interests with respect to the disputed domain name.

Respondent is a shareholder of a company with the company name Advanced Bioderma Corporation which has a valid European Union Trademark for ADVANCED BIODERMA. The color (blue for the element “Bioderma”) and the figurative element within the mark (at the position of the “O” in “BIO” there is a graphic element with an outer oval border) does not change the impression of the word “BIODERMA” as also the Complainant indicated in connection with his presentation of “Respondent’s trademark Advanced Bioderma” when he mentioned the trademark of the company Advanced Bioderma in the complaint.

The UDRP does not require a specific trademark right for the same goods or services as the Complainant has rights in or for which he is using his rights. The valid European trademark and eventually also the company name of the US company Advanced Bioderma Corporation in which Respondent has shares provides rights in the meaning of Paragraph 4(a) II. In addition, Respondent has demonstrated that the company he has shares in is using the domain name for inter alia manufacturing services for quite some time.

The Panel concludes that the Respondent has rights or legitimate interests in the disputed domain name. It is therefore not necessary any more to evaluate whether the disputed domain name was registered in bad faith and even used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **ADVANCEDBIODERMA.COM**: Remaining with the Respondent
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PANELLISTS

Name	Dietrich Beier
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DATE OF PANEL DECISION	2022-03-22
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Publish the Decision
