

Decision for dispute CAC-UDRP-104407

Case number	CAC-UDRP-104407
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Time of filing	2022-03-11 09:03:52
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Domain names	esthederm.biz
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Case administrator

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

Organization	NAOS
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	QING SHUI
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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 trademarks containing the words “ESTHERDERM” and “INSTITUT ESTHERDERM” in several countries, inter alia:

- the French trademark INSTITUT ESTHERDERM (registration number 1590412 registered on April 27, 1990);
 - the US trademark INSTITUT ESTHERDERM (registration number 74109225 registered on October 25, 1990);
 - the international trademark INSTITUT ESTHERDERM PARIS (registration number 815392 registered on October 16, 2003);
- and
- the international trademark INSTITUT ESTHERDERM PARIS (registration number 1355266 registered since April 25, 2017).

FACTUAL BACKGROUND

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

The Complainant was founded in France 40 years ago and 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, the Complainant is a pioneer in biology and shifts the skincare industry paradigm. The Complainant owes its success to the dedication of more than 3,100

employees located around the world through its international presence based on 48 subsidiaries and long-term partnerships with local distributors.

The disputed domain name was registered on February 26, 2022 and resolves to a website where the domain name is offered for sale.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

i) The Complainant has rights in the French trademark INSTITUT ESTHEDERM (registration number 1590412 registered on April 27, 1990); the US trademark INSTITUT ESTHEDERM (registration number 74109225 registered on October 25, 1990); the international trademark INSTITUT ESTHEDERM PARIS (registration number 815392 registered on October 16, 2003); and the international trademark INSTITUT ESTHEDERM PARIS (registration number 1355266 registered on April 25, 2017). The disputed domain name is confusingly similar to the Complainant's trademarks.

ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks or apply for registration of the disputed domain name by the Complainant. The disputed domain name points to a website where the disputed domain name is offered for sale for USD 955.

iii) The Respondent has registered and is using the disputed domain name in bad faith. It is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of the Complainant's rights in the trademark. The disputed domain name resolves to a website displaying a general offer to sell the domain for USD 955. The Respondent fails to make an active use of the disputed domain name.

RESPONDENT:

Respondent did not submit a response in this 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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights

The Complainant contends that it has rights in the French trademark INSTITUT ESTHEDERM (registration number 1590412 registered on April 27, 1990); the US trademark INSTITUT ESTHEDERM (registration number 74109225 registered on October 25, 1990); the international trademark INSTITUT ESTHEDERM PARIS (registration number 815392 registered on October 16, 2003); and the international trademark INSTITUT ESTHEDERM PARIS (registration number 1355266 registered on April 25, 2017). The Complainant has provided evidence for the trademark registrations. The Panel notes that a national trademark registration or an international trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark INSTITUT ESTHEDERM.

The Panel notes that the addition of '.com' gTLD and a descriptive term INSTITUT, and the omission of a device element are disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing a disputed domain name and a trademark. Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark INSTITUT ESTHEDERM.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (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, the 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). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that i) the Respondent is not related in any way with the Complainant; ii) the Complainant does not carry out any activity for, nor has any business with the Respondent; iii) neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks or apply for registration of the disputed domain name by the Complainant; and iv) the disputed domain name points to a website where the disputed domain name is offered for sale for USD 955. The Panel finds that the Respondent it is neither commonly known by the disputed domain name nor is an authorized user or licensee of the Complainant's marks. The Respondent fails to use the disputed domain name for any bona fide offer of goods or services, nor for any legitimate non-commercial or fair use, as Respondent resolves the disputed domain name to a webpage that offers the disputed domain name for sale.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

- (i) circumstances indicating that the respondent has registered or 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 the 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 its website or other online 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 Complainant contends that the disputed domain name is confusingly similar to its trademark INSTITUT ESTHEDERM, which was registered several years before the registration of the disputed domain name. Moreover, the Complainant has used its trademark INSTITUT ESTHEDERM worldwide. The Complainant is present in more than 100 countries and is among the top 10 independent beauty companies. The term "ESTHEDERM" is highly related to the Complainant, as all the results of a simple Google search are related to the Complainant and its products. Therefore, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of Complainant's rights in the trademark.

While constructive knowledge is insufficient for a finding of bad faith, per Policy paragraph 4(a)(iii), registration of an infringing domain name with actual knowledge of another's trademark rights is sufficient to establish bad faith, and can be shown by the notoriety of the mark and the use Respondent makes of the disputed domain name. See *Orbitz Worldwide, LLC v. Domain Librarian*, FA 1535826 (Forum February 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding Policy paragraph 4(a)(iii) bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it."); see also *AutoZone Parts, Inc. v. Ken Belden*, FA 1815011 (Forum December 24, 2018) ("Complainant contends that Respondent's knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii)."). The Panel agrees and infers, due to the notoriety of the Complainant's mark around the world that the Respondent had actual knowledge of the Complainant's rights in its mark INSTITUT ESTHEDERM at the time of registering the disputed domain name, and thus the Panel finds the bad faith registration of the disputed domain name.

Next, the Complainant contends that the disputed domain name resolves to a website displaying a general offer to sell the domain for USD 955. Registering or acquiring a domain name for the purpose of selling, renting or otherwise transferring the domain name registration to a trade mark owner for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name is an indication of registration and use of the relevant domain name in bad faith (see paragraph 4(b)(i) of the Policy). This issue of "excessive" out-of-pocket costs is considered on a case-by-case basis. The Panel considers that the amount for which the disputed domain name is registered and advertised for sale, being USD 955 would exceed the Respondent's out-of-pocket costs directly associated with the disputed domain name. In circumstances where there is no active website associated with the disputed domain name, the Panel finds that the Respondent's general offer to sell the disputed domain name for an amount in excess of its out-of-pocket costs supports the Respondent's bad faith registration and use of the disputed domain name per paragraph 4(b)(i) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ESTHEDERM.BIZ**: Transferred

PANELLISTS

Name **Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2022-04-05

Publish the Decision