

Decision for dispute CAC-UDRP-104581

Case number CAC-UDRP-104581

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Domain names bioderma.live

Case administrator

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

Complainant

Organization NAOS

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization JustinThe.com

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

International Trademark Registration No. 267207 BIODERMA registered on 19 March 1963 for cosmetics in class 3

International Trademark Registration No. 510524 BIODERMA registered on 19 March 1987 for various cosmetic goods in class 3 (based on a French registration)

International Trademark Registration No. 678846 BIODERMA registered on 13 August 1997 for various cosmetic goods in class 3 (based on a French registration)

FACTUAL BACKGROUND

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

The Complainant is the owner of numerous trademarks and domain names containing, or consisting, of the word BIODERMA. This includes <bioderma.com> which the Complainant has owned since 25 September 1997. BIODERMA is one of the Complainant's main skincare product brands and BIODERMA branded goods are sold in over 130 countries.

The disputed domain name was registered on 8 May 2022. At the time of the complaint, it redirected users to a page where the disputed domain name is offered for sale through auction.

A Whois record provided by the Complainant revealed that the respondent used a privacy service to attempt to conceal its identity. After the filing of the Complaint, the registrar for the disputed domain name revealed that in registering the disputed domain name the respondent has provided its name as JustinThe.com with an address in the United States of America.

PARTIES CONTENTIONS

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).

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 (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

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

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

The Complainant has claimed registered rights over a number of trademarks consisting of the word BIODERMA in a number of countries over many decades. This includes in its home jurisdiction of France.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a single trademark in a single jurisdiction that predates the registration of the disputed domain name (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217

(WIPO 7 May 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436).

Hence here registered rights in BIODERMA are established.

The next question is whether the disputed domain name is confusingly similar to this trademark.

The disputed domain name consists of the distinctive BIODERMA trademark followed by the non-distinctive gTLD <.live>. An internet user viewing the disputed domain name will simply see it as part of the Complainant's portfolio of domain names containing, or consisting of, the trademark BIODERMA.

The Panel is therefore satisfied that <BIODERMA.LIVE> is confusingly similar to a trademark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name bears no resemblance to the disputed domain name. Further, the disputed domain name resolves to a website purporting to offer the disputed domain name for sale. None of these factors indicate any rights or legitimate interests that the Respondent may have.

There is simply no basis to conclude that the Respondent has rights or interests in the disputed domain name.

BAD FAITH

It is undisputed that the BIODERMA is a well-known brand used on products sold by the Complainant into over 130 countries. It is also a distinctive trademark that bears no resemblance to a generic word or phrase. Further, even though the disputed domain name has only been registered for a short period of time the fact it is offered for sale in such circumstances does not assist the Respondent in indicating a possible good faith reason for the registration. Rather, the combined facts indicate the Respondent registration was opportunistic.

These facts indicate that the Respondent knew of the said trademark before seeking to register the disputed domain name and its subsequent offering for sale of the disputed domain name at auction only further confirms its lack of bona fides. Further, there is no response from the Respondent to contradict this inference that the Panel draws under Rule 14(b) and (5) (a) of the UDRP Rules.

As the Panel has found the Respondent had such prior knowledge of the BIODERMA trademark at the time of registering the disputed domain name it can only follow that its purpose in registering the disputed domain name was to opportunistically profit from such confusing similarity through auction. The Respondent targeted the Complainant's well-known name for this purpose. Such opportunism has been recognised as bad faith by numerous panels, the Panel refers to the commentary of the learned Gerald M Levine, *Domain Name Arbitration*, Legal Corner Press, 2nd ed. 2019, pp. 432 to 434.

Therefore, in consideration of all the circumstances the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. BIODERMA.LIVE: Transferred

PANELLISTS

Name **Mr Andrew Norman Sykes**

DATE OF PANEL DECISION **2022-06-14**

Publish the Decision
