

Decision for dispute CAC-UDRP-104915

Case number CAC-UDRP-104915

Time of filing 2022-10-12 09:34:16

Domain names biodermafr.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization NAOS

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization BioDerma

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 numerous trademarks in several countries consisting of the term "BIODERMA", including but not limited to the international trademark BIODERMA® n° 267207 registered since 19 March 1963 in class 03.

Further, the Complainant owns and operates using the official website <www.bioderma.com>, created on 25 September 1997.

FACTUAL BACKGROUND

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

The Complainant was founded in France more than 40 years ago. Complainant has more than 3,100 employees and 48 subsidiaries and long-term partnerships with local distributors who facilitate the sale of BIODERMA branded products in over 130 countries.

The Complainant owns several trademarks, characterised by the presence of the distinctive term "BIODERMA".

On 2 October 2022, the Respondent Nadir Cherif, an individual located in France, registered the disputed domain name <biodermafr.com>.

The disputed domain name resolves to a website offering for sale skincare products and prominently displaying Complainant's BIODERMA® trademark.

According to the information on the case file, the Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent because no Response was filed.

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

THREE ELEMENTS COMPLAINANT MUST ESTABLISH UNDER THE POLICY

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a disputed domain name should be transferred or cancelled:

- (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 in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term BIODERMA for cosmetic products and cosmetics. Such rights were created and/or registered well prior to 2 October 2022, the creation date of the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. As such, the Panel finds that the Complainant possesses rights in its BIODERMA® trademark.

In the present case, the disputed domain name consists of the BIODERMA® trademark reproduced in its entirety, merely with the addition of the letters “FR”, the common abbreviation of “France”.

The consensus view of UDRP panels is that where a relevant trademark is recognizable within the disputed domain name, the addition of geographical terms does not prevent a finding of confusing similarity. Thus the addition of the “FR” geographic term to the trademark BIODERMA®, does not prevent the disputed domain name from being confusingly similar to Complainant’s mark.

The TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant’s trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is confusingly similar to Complainant’s mark.

(B) RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it; see, for example, [CAC Case No. 102333](#), Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. [WIPO case no. D2003-0455](#), Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

However, the burden of proof still remains with the Complainant to make out its prima facie case on a balance of probabilities; see, for example, [CAC Case No. 102263](#), Intesa Sanpaolo S.p.A. v Ida Ekkert. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name at issue. Simply establishing that the complainant also has rights in the domain name at issue is insufficient.

In the present case, the Complainant asserts that the Respondent (i) is not in any way related to the Complainant, (ii) has not been granted an authorization or license to make any use of the Complainant’s BIODERMA® trademarks, and (iii) was not authorized to apply for the registration of the disputed domain name. While according to the Whois, the Respondent’s organization name is “BioDerma”, this is directly contradicted by Complainant as Complainant disclaims any association with the Respondent. Accordingly, legitimate interest under paragraph 4(c)(ii) of the Policy is not established because there is no credible evidence that Respondent is commonly known by the disputed domain name. Complainant’s assertions have not been contested by the Respondent.

Further, there is no apparent evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. According to evidence submitted by the Complainant, the disputed domain resolved to a website, featuring Complainant’s BIODERMA® trademark and offering for sale competitive skincare products labelled “Green Mask Stick”. Complainant’s BIODERMA® brand has a strong international presence in the skincare industry with sales in over 130 countries. The creation of a website to offer goods that compete directly with a complainant’s business does not constitute a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy or legitimate non-commercial or fair use under 4(c)(iii) of the Policy.

Finally, the Respondent has not responded in any form and thus has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name.

Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The third element requires Complainant to show that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Hallmark Licensing, LLC v. EWebMall, Inc., [WIPO Case No. D2015-2202](#) (“The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.”).

Further, Paragraph 4(b) of the Policy sets out four circumstances, in particular but without limitation, any one of which may be evidence of the registration and use of a domain name in bad faith. The four specified circumstances are:

- (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 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 the respondent’s 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 site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general (i.e. under paragraph 4(a)(iii) of the Policy) and in particular because the Respondent's conduct puts the case within paragraph 4(b)(iv) of the Policy for the following reasons:

1. As previously recognized by several panels (see for example [CAC Case No. 104581](#), NAOS v justinthe.com, "It is undisputed that the BIODERMA is a well-known brand used on products sold by the Complainant into over 130 countries") the Complainant's BIODERMA® trademark is distinctive and enjoys considerable reputation within the skincare industry. According, it is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical, or confusingly similar to, the Complainant's trademarks and that they registered the disputed domain name with knowledge of the Complainant's trademarks.
2. There is no credible evidence the Respondent is commonly known by the disputed domain name and Complainant asserts that the Respondent has never been authorized or licensed by the Complainant to use the Complainant's trademark(s) and/or register the disputed domain name, nor is there any business or other association between the Complainant and the Respondent.
3. There is compelling evidence of targeting by Respondent. The disputed domain name comprises Complainant's BIODERMA® trademark - which has been registered since 1963 - with only the addition of the letters "FR" - the common abbreviation for France. The Complainant is located in France, making the inclusion of the FR geographic term in the disputed domain name highly relevant to Complainant's business and brand. Moreover, the Respondent is also located in France, further support for the Panel's finding of targeting. Further, the disputed domain name resolves to a website in the French language selling skincare products in direct competition with Complainant, including prominently featuring Complainant's BIODERMA® trademark at the top of the site.
4. Respondent's subsequent use of the disputed domain name for a site selling competitive skincare products and including the use of Complainant's BIODERMA® trademark indicates that Respondent had actual notice of the Complainant's trademark when registering the disputed domain name. It has regularly been held that to copy a trademark in a domain name, or use it with a slight variation, knowing that the disputed domain name is based on the trademark of another party, constitutes bad faith registration and use of the disputed domain name according to the Policy. The Panel makes this finding in the present case.
5. By using the disputed domain name as noted above, the Respondent is attempting to disrupt the Complainant's business by operating a competing business and products. Such conduct constitutes bad faith within the provisions of paragraph 4(b)(iii) of the Policy.
6. By using the disputed domain name as noted above, the Respondent is intending to attract internet users for commercial gain, in a manner which would generate confusion as to the source, sponsorship, affiliation or endorsement of the site to which the disputed domain name resolves. Such conduct constitutes bad faith case within the provisions of paragraph 4(b) (iv) of the Policy.
7. As a final point, the Panel notes that it may draw a negative inference from Respondent's silence though these proceedings.

In light of the above analysis, the Panel concludes that the Complainant has sufficiently made out its case that the disputed domain name was registered and is being used in bad faith, and thus has satisfied this requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **biodermafr.com**: Transferred

PANELLISTS

Name	Claire Kowarsky
------	-----------------

DATE OF PANEL DECISION 2022-11-12
