

Decision for dispute CAC-UDRP-105041

Case number	CAC-UDRP-105041
Time of filing	2022-12-09 09:15:19
Domain names	sephorabeautysalon.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	SEPHORA SAS
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Complainant representative

Organization	INSIDERS
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Respondent

Name	Mahmood banafe
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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 owns Trademark Registrations for the mark SEPHORA including the following:

- United States Trademark No. 2431967 registered on February 27, 2001
- International Trademark No. 1462976 registered on September 25, 2018

FACTUAL BACKGROUND

Commencing in 1970, the Complainant has sold cosmetics and beauty products under trademark SEPHORA. The Respondent uses the disputed domain name to promote its operation of a beauty salon in the USA state of New Jersey.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant was founded in France in 1970 and today it is a well-known cosmetics retail company, operating over 2,700 stores in 35 countries worldwide, with an expanding base of over 500 stores across the Americas, and a world-class ecommerce site at sephora.com.

The disputed domain name <sephorabeautysalon.com> was registered on November 8, 2019 and resolves to a beauty salon website, where the salon's offer is presented along with the possibility of making an appointment. The beauty salon is in New Jersey and is called Sephora Beauty Salon. Further, Sephora Beauty Salon LLC was registered as a company in 2019. The Respondent is not affiliated with the Complainant and a search on Google.com did not show any relevant results about this business or its owner. The Complainant had the Respondent's related Instagram and Facebook accounts shut down and the Complainant tried to contact the Respondent by mail and by phone in order to find an amicable solution but with no success.

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).

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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of 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 set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also GROUPE CANAL + v. Danny Sullivan, UDRP-102809 (CAC January 21, 2020) ("the Panel, based on the poorly supported and conclusory allegations of the Complainant, retains that the Complainant has not prevailed on all three elements of the paragraph 4(a) of the Policy and, therefore, rejects the Complaint.").

1. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrate its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant, UDRP-103255 (CAC September 30, 2020) ("it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).").

The Complainant has submitted a scan of its trademark registration from the United States Patent and Trademark Office as well as screenshots from the website of the World Intellectual Property Office (WIPO) as evidence that it owns registered rights to its asserted SEPHORA trademark in multiple jurisdictions. The earliest of these reflects a registration date of February 27, 2001. Registration with national offices has been found sufficient to satisfy the threshold requirement of proving trademark rights under Paragraph 4(a)(i) of the Policy. *Margaritaville Enterprises, LLC v. Neil Wein*, FA 1916531 (FORUM November 9, 2020) (“It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights”). The disputed domain name, which was registered on November 8, 2019, adds the generic words “beauty salon” to the SEPHORA trademark and this has the effect of increasing the confusing similarity of the disputed domain name as the Complainant’s core line of business is cosmetics. Thus, the Complainant asserts that the second level of the disputed domain name is confusingly similar to the asserted trademark and will lead internet users to wrongly believe that the disputed domain name originates or is endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. *Avast Software s.r.o. v. Milen Radumilo*, UDRP-102384 (CAC April 19, 2019) (“it is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity.”).

Also, the extension “.com” typically adds no meaning or distinguishing element to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. *Novartis AG v. Wei Zhang*, 103365 (CAC December 9, 2020) (“it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.com”) is to be disregarded under the confusing similarity test”).

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of generic words thereto in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant’s trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Pursuant to Paragraph 4(a)(ii) of the Policy, the Complainant has the burden of making a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name. *Cephalon, Inc. v. RiskIQ, Inc.*, UDRP-100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

The Complaint is very brief and only claims that “[t]he Respondent does not have any rights or legitimate interests in respect of the domain name in question” without specifically addressing the examples set out in Paragraph 4(c) of the Policy. Nevertheless, the Panel will consider each of these in-turn.

With reference to Paragraph 4(c)(ii) of the Policy, relevant WHOIS information as well as any authorization to use the asserted trademark may factor into the determination of whether a Respondent is commonly known by a disputed domain name. See, *BOURSORAMA SA v. vikan koilzas*, UDRP-105026 (CAC December 28, 2022) (“the WHOIS information excludes that the Respondent could be commonly known with the sign BOURSO or BOURSO BANQUE.”) Also see, *Arla Foods Amba v. Kawashige Tsubasa*, UDRP-105010 (CAC January 2, 2023) (“lack of authorization to use a complainant’s mark may indicate that the respondent is not commonly known by the disputed domain name.”). Here, the WHOIS record for the disputed domain name lists the registrant as “Mahmood banafe” and the Respondent has not participated in these proceedings to assert that it is known otherwise. Further, the Complaint claims that “[t]he Respondent is not affiliated with the Complainant in any way and was not authorized by SEPHORA SAS to use the registered SEPHORA trademark.” The Panel notes that the Complainant has submitted the results of a business name search that reveals that a New Jersey entity named “SEPHORA BEAUTY SALON LLC” was formed in 2019. This document does not contain an address and there is no information tying the named corporate entity to the named Respondent in this case. Furthermore, the existence of a corporate entity, alone, does not indicate reputation or that a domain name registrant is commonly known by that name and an image on Google Maps for the address shown on the website of the disputed domain name shows a beauty salon whose exterior awning and sign bear the name “Jazzy Nails”. Finally, the Complainant’s trademark is quite well-known and use of the phrase “Sephora Beauty Salon” on the Respondent’s website does not support a different conclusion as it also does not demonstrate reputation. *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*, D2000-0847 (WIPO October 16, 2000) (“use which intentionally trades on the fame of another” should not be considered. “To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.”). Had the Respondent provided further information in this case it would have aided the Panel in its determination but, based upon the submissions and information before it, the Panel finds lacking sufficient evidence to conclude, under Paragraph 4(c)(ii), that the Respondent is commonly known by the disputed domain name.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. Using a confusingly similar domain name to pass oneself off as a Complainant is not a bona fide offering of goods or services or a legitimate non-commercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy. See *Migros-Genossenschafts-Bund v. Anthony Maitama Smith*, UDRP-104873 (CAC November 4, 2022) (“the Respondent was using the disputed domain name to operate a

website impersonating an official MIGROS BANK online banking website in order to pass off as the Complainant, deceive internet users and extract sensitive information and money. Such activity is outright criminal in many jurisdictions and certainly cannot establish Complainant's rights or legitimate interest in respect of the disputed domain name.”). Here, the Complainant submits screenshots of the Respondent's website and this contains the title “Sephora Beauty Salon” and claims to offer services such as haircuts, bridal makeup, skin care, facials, waxing, and eye lashes. At least some of these incorporate cosmetic products of the type that are sold by the Complainant. The bottom of the page displays an address in the US state of New Jersey as well as the footer “© Copyright Sephorabeautysalon.com”. In light of the well-known reputation of the Complainant's trademark, the Panel views the content of the Respondent's website as being for the purpose of creating the impression of origination with or approval by the Complainant and the Respondent has not filed a Response or made any other submission in this case to offer an alternative theory or explanation for its actions. Further, as the Respondent does not appear to be promoting the Complainant's products and its website does not inform viewers of its lack of any affiliation with the Complainant, this situation does not pass the test set out in the seminal decision of *Oki Data Americas, Inc. v. ASD, Inc.*, D2001-0903 (WIPO November 6, 2001). As the Complainant has made out a prima facie case that has not been rebutted by the Respondent, upon a preponderance of the evidence before it the Panel finds that the Respondent fails to make a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

3. The disputed domain name was registered and used in bad faith

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. Further guidance on that requirement is found in Paragraph 4(b) of the Policy, which sets out four examples of possible actions by the Respondent that may satisfy this burden of proof.

Inherently prerequisite to a finding of bad faith under Paragraph 4(a)(iii) of the Policy is some attribution of knowledge of the Complainant's claimed trademark, whether actual or based upon a conclusion that the Respondent should have known of the trademark. See, *Domain Name Arbitration*, 4.02-C (Gerald M. Levine, Legal Corner Press, 2nd ed. 2019) (“Knowledge and Targeting Are Prerequisites to Finding Bad Faith Registration”); *USA Video Interactive Corporation v. B.G. Enterprises*, D2000-1052 (WIPO December 13, 2000) (claim denied where “Respondent registered and used the domain name without knowledge of Complainant for a bona fide commercial purpose.”). See also, WIPO Overview 3.0, par. 3.1.1 (when examining whether “circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark”, Panels may consider such issues as “the respondent's likely knowledge of the complainant's rights”). Here, the Complainant states that “[a] professional hairdresser or make-up artist could not reasonably not know SEPHORA.” The Complainant notes that it operates over 2,700 stores in 35 countries worldwide, with an expanding base of over 500 stores across the Americas, and a world-class ecommerce site at sephora.com. The Panel finds that the Respondent's claimed operation of a beauty salon, combined with the market reputation of the SEPHORA trademark, indicates a high likelihood that the Respondent had prior knowledge of the Complainant's trademark at the time that it registered the disputed domain name.

Next, the Complainant argues that the Respondent registered and uses the disputed domain name in bad faith as the Respondent exploits the Complainant's brand reputation in promoting a beauty salon. Using a confusingly similar domain name to pass oneself off as a complainant can demonstrate bad faith under Paragraphs 4(b)(iii) and (iv) of the Policy. See *Inter IKEA Systems B.V. v. Fu Lei*, UDRP-104726 (CAC August 17, 2022) (“The evidence shows that the disputed domain name website appeared to be passing off as the Complainant by making reference to the Complainant, the Complainant's IKEA mark and its goods despite the Respondent not being authorized or licensed by the Complainant. This is another indicator of bad faith on the part of the Respondent.”). The Complainant asserts that the disputed domain name is used to promote a beauty salon that offers services which use products of the type produced by the Complainant and that it “knowingly attracts potential SEPHORA clients to their own website and therefore exploits SEPHORA's popularity and renown for their own gain.” The screenshots of the Respondent's website and the other evidence in this case shows that the Respondent is, for commercial gain, using its website at the disputed domain name to pass itself off as the Complainant to actual and potential customers in furtherance of offering for sale beauty and cosmetic services. The Respondent has not participated in this case to explain its actions and so, based upon a preponderance of the available evidence, the Panel finds it highly likely that the Respondent registered and uses the disputed domain name in bad faith by seeking commercial gain through confusion with the Complainant's trademark, per Paragraph 4(b)(iv).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **sephorabeautysalon.com**: Transferred

PANELLISTS

Name	Steven Levy Esq.
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DATE OF PANEL DECISION	2023-01-05
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Publish the Decision	
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