

Decision for dispute CAC-UDRP-106013

Case number **CAC-UDRP-106013**

Time of filing **2023-11-28 09:48:39**

Domain names **sale-bioderma.shop**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **NAOS**

Complainant representative

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

Respondent

Name **Ken Leo**

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks, including the wording “BIODERMA” in several countries, such as:

The international trademark “BIODERMA” no. 267207 was registered on March 19th, 1963;

The international trademark “BIODERMA” no. 510524 was registered on March 9th, 1987, and

The international trademark “BIODERMA” no. 678846 was registered on August 13th, 1997.

FACTUAL BACKGROUND

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

Founded in France more than 40 years ago by Jean-Noël Thorel, a pharmacist-biologist, NAOS, the Complainant, 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. The Complainant has over 3,100 employees worldwide through its international presence based on 48

subsidiaries and long-term partnerships with local distributors. To sell its branded products “BIODERMA” in over 130 countries, the Complainant operates under the name “BIODERMA”.

Furthermore, the Complainant owns multiple domain names consisting of the wording “BIODERMA”, such as <bioderma.com> registered since September 25, 1997, and used for its official website.

The disputed domain name <sale-bioderma.shop> was registered on November 2, 2023, and redirects to a website displaying the Complainant’s trademark and offering unauthorized or counterfeited BIODERMA goods at discounted prices.

PARTIES CONTENTIONS

COMPLAINANT:

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

The Complainant states that the disputed domain name <sale-bioderma.shop> is confusingly similar to its trademark “BIODERMA” and its domain names associated. Indeed it includes it in its entirety.

The addition of the term “SALE”, is not sufficient to avoid the likelihood of confusion. It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”.

Moreover, the Complainant contends that the addition of the TLD “.SHOP” does not change the overall impression of the designation as being connected to Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark and its domain name associated.

Finally, prior decisions confirmed the Complainant’s rights. Please see for instance:

CAC Case No. 104635, NAOS v. HHShop <bioderma-vn.com>;

CAC case n° 102992, NAOS v. kivernoxoros <bioderma.shop>;

Consequently, the disputed domain name <sale-bioderma.shop> is confusingly similar to the Complainant’s trademark “BIODERMA”.

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

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.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and he 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 “BIODERMA”, or apply for registration of the disputed domain name by the Complainant.

Furthermore, the disputed domain name redirects to a website displaying the Complainant’s trademark and offering unauthorized or counterfeited “BIODERMA” goods at discounted prices. Such use demonstrates neither a bona fide offering of goods nor a legitimate interest of Respondent.

Furthermore, there is no information/disclaimer on the page of the website to identify its owner. Therefore, the Respondent failed at least in one of the elements of the Oki Data test, i.e. the website linked to the disputed domain name does not disclose accurately and prominently the registrant’s relationship with the trademark holder.

Accordingly, Respondent has no rights or legitimate interests on the disputed domain name.

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

The disputed domain name is confusingly similar to the Complainant’s trademark “BIODERMA”, registered since 1963 for cosmetics.

Besides, the Complainant’s trademark and goods are displayed on the website.

Thus, given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

Furthermore, the disputed domain name points to a website displaying the Complainant's trademark and offering unauthorized or counterfeited "BIODERMA" goods at discounted prices. The Complainant contends that the Respondent uses the disputed domain name to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and goods purportedly advertised therein.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT:

No administratively compliant Response was filed.

RIGHTS

To the satisfaction of the Panel, the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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

To the satisfaction of the Panel, the Complainant has 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 have been met, and there is no other reason why it would be unsuitable for providing the Decision.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or Confusingly Similar

First, the Panel is satisfied that the Complainant has shown it owns rights in the "BIODERMA" trademarks, with registration and evidence provided dating the trademark registration back to at least 1963.

Turning to analyze if there is a confusing similarity between the disputed domain name and the trademark, the Panel notes, based on the record at hand, that the disputed domain name reproduces the trademark in its totality, namely "BIODERMA", with the addition of the word "sale" and a hyphen anteceding the trademark. Adding this word heightens the appearance of confusing similarity with the trademark "BIODERMA" because it could indicate a discount channel of transacting for the products or the Complainant.

A more complete analysis of this will be conducted in the elements below, but suffice to say that in what relates to the first element, the verbatim reproduction of the trademark is enough to find confusing similarity between the disputed domain name and the Complainant's trademarks. The slight difference is immaterial and, therefore, insufficient to dispel the confusing similarity between the trademark and the disputed domain name. As mentioned earlier, it may enhance it, as it will be discussed below.

Consequently, the Panel determines that the Complaint has satisfied the Policy's first element set under paragraph 4(a)(i).

2. Rights or Legitimate Interests

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts.

The uncontested facts indicate that a) the Respondent is not commonly known by the disputed domain name; b) the Respondent is not related to the Complainant; c) the Respondent is not authorized to carry out any business activity for the Complainant; d) the Respondent has no license or authorization to use the trademarks; e) the Respondent has no authorization to register a domain name utilizing the Complainant's trademark and f) the disputed domain name redirects to a website displaying the Complainant's trademark and offering unauthorized or counterfeited "BIODERMA" goods at discounted prices.

Based on the above, the record at hand, and on the balance of probability, and considering that the Respondent has failed to respond to the Complainant's contentions, the Respondent has consequently not rebutted the prima facie case, as described in paragraph 2.1 of WIPO 3.0 Overview.

The above fact pattern on the balance of probabilities, and in conjunction with the use of the term "sale" in the disputed domain name, indicates, if nothing else, a likely intention of confusing Internet users with a likely implied association with the Complainant through appearing to be a formal channel of the Complainant. Nevertheless, the Respondent did not disclose its relationship to the Complainant, which could serve to establish a bona fide use under the widely persuasive "Oki Data Test". However, this will be subject to further analysis under the element below.

The evidence on record leads the Panel to conclude that the Respondent did not have rights or legitimate interests in the disputed domain name.

Consequently, the Panel determines that the Respondent has no rights or legitimate interests in the disputed domain name. Subsequently, the Complainant has fulfilled the second requirement set under paragraph 4(a)(ii) of the Policy.

3. Registered and Used in Bad Faith

Per the record and evidence, the Panel finds that the Respondent was likely aware of the Complainant and had the Complainant's trademark in mind when registering the disputed domain name. This is further reinforced by the fact that the "BIODERMA" trademark predates the registration of the disputed domain name as well as the global reputation of the "BIODERMA" mark indicates that the Respondent knew or should have known about the Complainant's rights when registering the disputed domain name.

Additionally, this conclusion is supported by the fact that the Respondent seems to evoke a connection to the Complainant's trademark by including the term "sale" in the disputed domain name, which appears to be an active effort by the Respondent to be a formal channel of the Complainant, without any visible explanation in disputed domain name regarding its association to the Complainant. Without further explanation from the Respondent, this appears to misrepresent a link between the disputed domain name and the Complainant. In this case, as the record supports, the Respondent appears to have targeted the Complainant on the balance of probabilities.

All the preceding analysis leaves the Panel no other option than to conclude that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/disputed domain name by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0 Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

4. Decision

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **sale-bioderma.shop**: Transferred

PANELLISTS

Name **Rodolfo Rivas Rea**

DATE OF PANEL DECISION **2023-12-27**

Publish the Decision