

Decision for dispute CAC-UDRP-106417

Case number CAC-UDRP-106417

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Domain names glownuxe.com

Case administrator

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

Complainant

Organization LABORATOIRE NUXE

Complainant representative

Organization ATOUT PI LAPLACE

Respondent

Organization GlowNuxe Beauty Emporium

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 evidence has established that the Complainant owns a portfolio of registered trademarks for NUXE including the French trademark for NUXE, registration no. 94 518 763, registered on May 2, 1994 and the European Union trademark for NUXE, registration no.8774531, registered on June 15, 2016 together with other national and international trademarks for NUXE and derivatives (collectively "the NUXE trademark").

FACTUAL BACKGROUND

The Complainant is a French company founded in 1964 and which is engaged in the provision of cosmetics and personal care products. It has acquired the aforesaid registered trademark rights for NUXE. It has come to the notice of the Complainant that the Respondent registered the domain name <glownuxe.com> on February 12, 2024 which resolves to a website with the message "Sorry, this store is currently unavailable", which implies that the Respondent has proposed to open an online store from which it will sell products that the Complainant provides under the NUXE trademark and the additional word "GLOW". The Complainant maintains that this will infringe its NUXE trademark and it has therefore brought this proceeding under the UDRP and seeks the transfer of the disputed domain name from the Respondent to itself.

A. COMPLAINANT

The Complainant made the following contentions.

1. The Complainant is a French company founded in 1964 and which is engaged in the provision of cosmetics and personal care products.
2. The Complainant owns a portfolio of registered trademarks for NUXE including the French trademark for NUXE, registration no. 94 518 763, registered on May 2, 1994 and the European Union trademark for NUXE, registration no. 8774531, registered on June 15, 2016 together with other national and international trademarks for NUXE and derivatives (collectively "the NUXE trademark").
3. The Complainant also owns several domain names that reflect the NUXE trademark, such as <nuxe.com> registered on February 27, 1998 and <nuxe.fr>, registered on June 25, 2008, which it uses in its business.
4. The Respondent registered the domain name <glownuxe.com> ("the disputed domain name") on February 12, 2024 and caused it to resolve to a website under construction and carrying the message "Sorry, this store is currently unavailable".
5. The disputed domain name is confusingly similar to the LUXE trademark, as it incorporates the entirety of the trademark and adds the generic word "glow", which invokes the brilliance and shiny aspects of products associated with products for which the Complainant is known pursuant to its trademark and which the Complainant uses in connection with the branding of those products by the LUXE trademark and the word "glow".
6. The Respondent has also added to the LUXE trademark the generic Top Level Domain ".com".
7. Neither of the aforesaid additions to the LUXE trademark can negate a finding of confusing similarity between the domain name and the LUXE trademark.
8. The Respondent has no rights or legitimate interests in the disputed domain name. In that regard, the Complainant must first establish a prima facie case and, if it is successful, the onus of proof reverts to the Respondent to disprove that case.

The Panel finds that the prima facie case in this proceeding is established by evidence that:

- (a) the Complainant is the sole owner of the NUXE trademark;
 - (b) the Complainant has not authorized the Respondent to register the disputed domain name or to make any use of the NUXE trademark;
 - (c) thus, the Complainant has never authorized the Respondent or anyone else to use the word "glow" in juxtaposition with the NUXE trademark, especially as the Complainant also uses the word GLOW in association with its own products bearing the NUXE trademark; and
 - (d) there is no other ground on which the Respondent could be shown to have a right or legitimate interest in the domain name.
9. The disputed domain name was registered and is being used in bad faith.

That is so because:

- (a) the disputed domain name was registered and has been used by the Respondent fraudulently, in bad faith and with the intention of infringing the Complainant's NUXE trademark;
- (b) the Respondent must have been aware of the Complainant's rights in and use of the NUXE trademark but, despite that, the disputed domain name reproduces the Complainant's trademarks, domain names and parts of its company name;
- (c) moreover, the structure of the disputed domain name, incorporating as it does the word "glow", purports to emphasize a fake link with the Complainant and its well known personal care products;
- (d) the Respondent had actual notice of the Complainant at the time it registered the disputed domain name;
- (e) the intention of the Respondent in registering and using the disputed domain name was to obtain a financial advantage from using the NUXE trademark and to prevent the Complainant from using it in a domain name, with the ultimate intention of trying to sell the disputed domain name to the Complainant;
- (f) the Complainant itself sells personal care products using the word "glow" in conjunction with its NUXE trademark;
- (g) the Respondent registered the disputed domain name through a privacy service;
- (h) messaging servers have been created with at least one IP address, showing that the Respondent intended to register and use the domain name in bad faith;

(i) the Respondent has intended to use the disputed domain name for phishing and to impersonate the Complainant; and

(j) the Respondent has used the disputed domain name for a website that is under construction for a “store” which the Complainant intends to use to sell products under the Complainant’s NUXE trademark, which it has no right to do.

B. RESPONDENT

The Respondent did not file 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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative compliance

By notification dated April 9, 2024, and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint did not sufficiently identify the Respondent. The notification invited the Complainant to have regard to the Registrar’s verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. Also, on April 9, 2024, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The 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 domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The first question that arises is whether the Complainant has rights in a trademark or service mark on which it may rely and which will give it standing to bring this proceeding. The Complainant has adduced evidence that the Panel accepts, that the Complainant is the registered owner of a large portfolio of registered trademarks including the French trademark for NUXE, registration no. 94 518 763, registered on May 2, 1994 and the European Union trademark for NUXE, registration no. 8774531, registered on June 15, 2016 together with numerous other national and international trademarks for NUXE and derivatives (collectively “the NUXE trademark”).

It will be seen therefore that the trademark was registered well before the disputed domain name was registered, which was on February 12, 2024. The Complainant has verified that the Respondent is the registrant of the disputed domain name.

The Panel therefore finds that the Complainant “has” a trademark which the Policy requires it to prove and which it has done.

The next question that arises is whether the disputed domain name is identical or confusingly similar to the NUXE trademark.

The Panel next finds that the disputed domain name is confusingly similar to the NUXE trademark for the following reasons.

First, the domain name includes the entirety of the NUXE trademark. Accordingly, it is clear that the domain name has been inspired by and is an attempt to copy the NUXE trademark. It is also clear and has been held many times in prior UDRP decisions that when internet users see an entire trademark used in a domain name in this way, they naturally conclude that the domain name is an official domain name of the trademark owner or at least that it is being used with the permission or authority of the trademark owner.

Secondly, the disputed domain name incorporates the entirety of the trademark and adds the generic word “glow”, which the evidence shows invokes the brilliance and shiny aspects of products associated with products for which the Complainant is known pursuant to its trademark and which the Complainant itself uses in connection with the branding of those products with the NUXE trademark and also with the word “glow”. UDRP panels have routinely found that adding a generic word to a trademark does not negate a finding of confusing similarity which is otherwise present, as it is in the present case. Thus, internet users would naturally conclude that the domain name in the present case means, would be interpreted to mean and would no doubt have been intended to mean that it is invoking products that are official products of the Complainant because they carry the trademark and the word “glow” used by the Complainant to designate its own products. This is seen from the Complainant’s annex, where some of the Complainant’s products are promoted by using the word “glow” in conjunction with the NUXE trademark.

Thirdly, the Respondent has also added the generic Top Level Domain “.com” which likewise cannot negate a finding of confusing similarity between the domain name and the trademark as all domain names require such an extension.

Internet users would also conclude that the domain name would lead to an official website of the Complainant, which is not true.

Taken as a whole, the internet user would look at the domain name and conclude that it is similar to the trademark and also that it is confusingly similar to it, because it gives rise to a question mark as to whether it really is an official domain name of the Complainant or not.

The Panel therefore finds that the disputed domain name is confusingly similar to the NUXE trademark.

The Complainant has thus made out the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations, taking them in the order in which they are set out by the Complainant.

(a) the Complainant is the sole owner of the NUXE trademark and the only entity that may use that trademark with respect to its products; thus, the Respondent cannot have any such rights to use the trademark;

(b) this is also so because the Respondent has added the word "glow" before the NUXE trademark, making it clear that it is invoking NUXE personal care products, as the evidence shows that the word "glow" invokes the brilliance and shiny aspects of products associated with products for which the Complainant is known pursuant to its trademark and which the Complainant itself uses in connection with the branding of those products with the NUXE trademark and also with the word "glow";

(c) the evidence shows that the Complainant has not authorized the Respondent to register the disputed domain name or to make any use of the NUXE trademark;

(d) the evidence also shows that the Complainant has never authorized the Respondent or anyone else to use the word "glow" in juxtaposition with the NUXE trademark, especially as the Complainant uses the word "glow" in association with its own products bearing the trademark;

(e) thus, the evidence shows that the Respondent has set about copying the Complainant and its trademark and is seeking to give the impression that it is in competition with or authorized by the Complainant. Such conduct cannot give rise to a right or legitimate interest in the domain name;

(f) it is also apparent from the evidence that the Respondent is not related to the Complainant in any way, and does not carry out any activity nor have any business with the Respondent;

(g) it is also apparent from the evidence that the Respondent has caused the domain name to resolve to a website under construction and carrying the message "Sorry, this store is currently unavailable"; this necessarily implies that the intention of the Respondent is to use the domain name for a "store" to sell the relevant products to which it relates and that when the "store" becomes available it would be used to sell products under the NUXE trademark, which the Respondent has no right to do, which does not give it any legitimate interest in the domain name proposed to be used for that purpose and which is an infringement on the Complainant's trademark;

(h) the evidence shows that the Respondent's use of the domain name is not a bona fide offering of goods or services within the meaning of Policy paragraph 4(c)(i); there is no way in which it could be said that taking a person's trademark without permission, copying it into a domain name, adding the word "glow" as aforesaid and proposing to use the domain name in competition with the trademark owner or to offer products for sale in a store was an activity that could even remotely be described as bona fide;

(i) nor is there any evidence to show that the Respondent is commonly known by the domain name within the meaning of Policy paragraph 4(c)(ii);

(j) nor could such conduct be described as legitimate, non-commercial or fair when it is clearly illegitimate; nor could that conduct be described as non-commercial when the conduct is clearly commercial, as its object must be to make money; nor could it be described as fair, when it is inherently unfair. The Respondent's use of the domain name is therefore not a legitimate non-commercial or fair use of the domain name within the meaning of Policy paragraph 4(c)(iii); and

(k) nor is there any other ground on which the Respondent could be shown to have a right or legitimate interest in the domain name.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. REGISTERED AND USED IN BAD FAITH

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and

that it is being used in bad faith.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. 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.

There is no need to repeat all of the details set out already, and the conduct of the Respondent in registering the domain name clearly amounts to bad faith registration and its conduct since the registration shows bad faith use. That is so because, taking the issues in the order in which the Complainant has set them out:

(a) the disputed domain name was registered and has been used by the Respondent fraudulently, in bad faith and with the intention of infringing the Complainant's NUXE trademark; the only conclusion that can be reached on the evidence is that the intention of the Respondent from the beginning was to copy the NUXE trademark, build around it a domain name that invoked the trademark and re-enforce that notion by adding the word "glow" and setting up a website to sell goods under that combined name, none of which the Respondent was authorized to do and all of which shows that the Respondent was motivated by bad faith to deceive internet users and that it both registered and used the domain name in bad faith;

(b) the Respondent must have been aware of the Complainant's rights in and use of the NUXE trademark but, despite that, the disputed domain name reproduces the Complainant's trademark, domain names and parts of its company name; the Complainant on the evidence could not but have had actual notice of the Complainant and its trademark and clearly set about aiming specifically at the Complainant; the Panel therefore finds that the Respondent had actual notice of the Complainant at the time it registered the disputed domain name;

(c) moreover, the structure of the disputed domain name, incorporating as it does the word "glow", purports to emphasize a fake link with the Complainant and its well known personal care products; the Panel has already noted that some of the Complainant's products use the word "glow" as well as the NUXE trademark, further inducing internet users to believe that the domain name would lead to an official or at least an approved use of the domain name, which was itself misleading and in bad faith;

(d) the intention of the Respondent in registering and using the disputed domain name was to obtain a financial advantage from using the NUXE trademark and to prevent the Complainant from using it in a domain name, with the ultimate intention of trying to sell the disputed domain name to the Complainant; the Respondent clearly did not have the interests of the Complainant at heart at any time and its objective was probably to make money by selling products under the trademark mark of the Complainant, but also and more likely than not, that the Respondent would be able to intimidate the Complainant into buying the domain name from it; the evidence also suggests that another intention of the Respondent was to engage in phishing for customers' personal information;

(e) the Respondent registered the disputed domain name through a privacy service; this has been seen by panels as a sign of its being a deceptive registration and it seems a likely motivation in the present case;

(f) messaging servers have been created with at least one IP address, showing that the Respondent intended to register and use the domain name in bad faith; this feature has often been relied on by panellists as it shows that the Respondent probably had in mind keeping its name and involvement concealed so that as few people as possible would know that it was not officially linked with or approved by the Complainant;

(g) the Respondent has used the domain name for a website that is under construction for a "store" which the Complainant intends to use to sell products under the Complainant's NUXE trademark, which it had no right to do; the significance of this feature has already been shown and it re-enforces the conclusion that the Respondent intended to register and use the domain name and the Complainant's trademark with bad faith intentions; and

(h) clearly the Respondent also intended to register and use the domain name to generate confusion with the Complainant and its trademark within the meaning of Policy 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. glownuxe.com: Transferred

PANELLISTS

Name **Neil Brown**

DATE OF PANEL DECISION **2024-05-06**

Publish the Decision
