Decision for dispute CAC-UDRP-106545

Case number	CAC-UDRP-106545
Time of filing	2024-05-17 13:19:58
Domain names	mustela.xyz

Case administrator

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

Complainant

Organization	LABORATOIRES EXPANSCIENCE

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Biplob Hossain

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 owner of International Registered Trademark no. 154904 for the word mark MUSTELA, registered on July 16, 1951 in Classes 3 and 5, designated in respect of more than 25 territories.

FACTUAL BACKGROUND

The Complainant is a French family-owned pharmaceutical and dermo-cosmetics laboratory, which claims more than 70 years' experience and expertise. The Complainant develops and manufactures osteoarthritis and skincare products, counting 13 subsidiaries in over 100 countries. 78 per cent of the company's turnover in 2023 was generated from international business.

The Complainant owns two brands, Piasclédine 300 and Mustela. Mustela is the leading brand for the daily child and baby care products market in France.

The Complainant owns several trademarks for the word mark MUSTELA, dating back to 1951. The Complainant owns and communicates through various websites worldwide, the relevant one for this administrative proceeding being found at the domain name <mustela.com>, registered and used since December 3, 1998.

The disputed domain name was registered on April 28, 2024. It resolves to a page at <dynadot.com> where it is offered for sale at a

“Buy Now” price of EUR 46.01.

PARTIES CONTENTIONS

Complainant:

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to the Complainant’s distinctive MUSTELA trademark which is incorporated in the disputed domain name in its entirety, without any additions, deletions or alterations. The Complainant contends that the addition of the Top-Level Domain “.xyz” does not change the overall impression of the designation as being connected to Complainant’s trademark, adding that it does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its associated domain names.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name, is not related in any way to the Complainant, and does not carry out any activity for, nor has any business with, the Complainant. The Complainant states that it has not granted any license or permission to the Respondent to use its MUSTELA trademark. The Complainant notes that the disputed domain name is offered for sale by the Respondent and contends that such general offer to sell the disputed domain name is evidence of the Respondent’s lack of rights or legitimate interests within the meaning of the Policy.

The Complainant asserts that the Respondent has registered and is using the disputed domain name in bad faith, adding that the disputed domain name is identical to the Complainant’s distinctive trademark MUSTELA which was registered many years before the registration of the disputed domain name. Given the distinctiveness of said trademark and the extent of the Complainant’s reputation, the Complainant asserts that it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant’s trademark.

The Complainant claims that, as the disputed domain name redirects to a page where it is offered for sale, the Respondent fails to make an active use of the disputed domain name, adding that previous panels in cases under the Policy have held that failure to use a domain name actively may be evidence of bad faith registration and use. The Complainant concludes that the Respondent has registered the disputed domain name only in order to sell it to the Complainant for more than its out-of-pocket costs, which evinces bad faith registration and use.

Respondent:

The Respondent contends that the Complaint should be denied.

The Respondent accepts that the disputed domain name is identical to the Complainant’s trademark but claims not to have been aware of the Complainant or its mark prior to acquiring it. The Respondent states that it is not located in a territory covered by the Complainant’s trademark.

The Respondent asserts that it is difficult for individual registrants to know which domain names correspond to trademarks, adding that the disputed domain name was freely available for anyone to register and that the registry did not indicate that it corresponded to any trademark.

The Respondent submits that it is not illegal to offer a domain name for sale and that doing so can be a legitimate business activity. The Respondent contends that offering the disputed domain name for sale does not mean it is targeting the trademark owner, and adds that the Respondent is not promoting any products which are competitors of the Complainant’s products.

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

The Complainant has demonstrated that it has UDRP-relevant rights in its MUSTELA trademark by virtue of its corresponding trademark registration. This mark is alphanumerically identical to the Second-Level Domain of the disputed domain name and may therefore be considered identical to the disputed domain name as a whole, the Top-Level Domain being typically disregarded in the comparison process (see section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0")). Accordingly, the Panel finds that the disputed domain name is identical to the Complainant's MUSTELA trademark, and therefore that the first element of the Policy has been established.

The Complainant asserts that the Respondent lacks rights or legitimate interests in the disputed domain name, noting the absence of any license, permission or authorization on the Complainant's part that would entitle the Respondent to register or use the disputed domain name. The Complainant also asserts that it has no business connection to or relations with the Respondent. The WHOIS record for the disputed domain name does not suggest that the Respondent is commonly known by the disputed domain name. The disputed domain name is being offered for sale at a price likely exceeding the Respondent's out of pocket costs, and the Complainant asserts that such a general offer for sale in the face of the Complainant's rights in its distinctive MUSTELA mark is evidence of the Respondent's lack of rights and legitimate interests within the meaning of the Policy.

Taking the Complainant's assertions, evidence and observations together, the Panel finds that these are sufficient to constitute the requisite prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name (see, for example, section 2.1 of the WIPO Overview 3.0). The Panel therefore turns to the Respondent's case to consider whether it has successfully rebutted the Complainant's prima facie case.

The Respondent's case may be summarized as an assertion that it is entitled to register the disputed domain name and to offer it for general sale because it was allegedly unaware of the Complainant's mark when it registered it, such mark not being in force in the territory where it is based. However, as the panel noted in Fakir Elektrikli EV Aletleri Diş Ticaret Anonim Şirketi v. Development Services, Telepathy, Inc., WIPO Case No. D2016-0535, "the fact that a respondent is in a different jurisdiction than a complainant is something that some people can consider to be of greater significance than it actually is, particularly if the complainant has a significant online presence". The Panel is satisfied in the present case that the Complainant has such a presence, and that even the most cursory Internet search for the meaning of the term "mustela" would have disclosed the Complainant's interest. Importantly, the Respondent does not set out why it registered the disputed domain name even if allegedly unaware of its trademark value, and how and why it selected the term "mustela" in the disputed domain name without any prior awareness of the Complainant's rights. The Respondent does not, for example, assert that this term has any independent meaning whereby the disputed domain name might be capable of being offered for sale without exploiting its trademark value.

The Respondent asserts that it was difficult for it to screen the disputed domain name for corresponding trademarks, suggesting that the registry should perform this task. This overlooks the representation that registrants must make to their registrar in paragraph 2 of the Policy that, to their knowledge, the registration of the domain name concerned will not infringe upon or otherwise violate the rights of any third party. Paragraph 2 of the Policy goes on to note that it is the registrant's responsibility to determine whether their domain name registration infringes or violates someone else's rights. In any event, where a registrant asserts that they were unaware of the trademark value of the term in the domain name concerned, the Panel considers that it is incumbent upon such registrant, as a bare minimum, to be in a position to explain why they considered its registration to be reasonable and legitimate, and independent of the rights at issue. The Respondent has failed to do so in this case.

In these circumstances, the Panel finds that the Respondent has failed to rebut the Complainant's prima facie case that it has no rights or legitimate interests in the disputed domain name. The Panel finds the second element of the Policy has been established.

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In order to make out a case of bad faith registration under the Policy, generally speaking, a complainant must demonstrate that some form of targeting of its rights has occurred and at least the fact that the respondent had the complainant or its rights in mind at the point when it registered the domain name concerned. In the present case, the Complainant provides evidence demonstrating that its rights in the distinctive MUSTELA mark are both of a longstanding and substantial nature, suggesting likely awareness on the Respondent's part. The Complainant provides evidence showing that the disputed domain name has been offered for general sale shortly after its registration. Significantly, the disputed domain name is identical to the Complainant's mark in its Second-Level Domain. Particularly where the domain name at issue is identical or confusingly similar to a highly distinctive or famous mark,

panels have tended to view with a degree of skepticism a respondent defense that the domain name was merely registered for legitimate speculation. WIPO Overview 3.0, section 3.1.1.

To this case, the Respondent's only answer is that it was unaware of the Complainant's mark, and that it is a legitimate business activity to offer a domain name for sale. Notably, what the Respondent does not do is offer any explanation as to why it decided to register the disputed domain name and why it considered that it was appropriate to offer it for general sale immediately thereafter. In the absence of any credible evidence-backed rationale from the Respondent for its registration of the disputed domain name, the Panel considers it reasonable to infer that the Respondent's primary motivation was to sell it to the Complainant for valuable consideration of its out-of-pocket costs directly related thereto. This constitutes evidence of registration and use in bad faith in terms of paragraph 4(b)(i) of the Policy.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith, and that the Complainant has established the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **mustela.xyz**: Transferred

PANELLISTS

Name	**Andrew Lothian**

DATE OF PANEL DECISION 2024-06-07

Publish the Decision