Decision for dispute CAC-UDRP-106726

Case number	CAC-UDRP-106726
Time of filing	2024-07-18 09:53:44
Domain names	biodermabeautystore.shop

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	NAOS

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Nan

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

In these proceedings, the Complainant relies on the following trademarks:

- BIODERMA (word), International Registration No. 267207A, filed on March 19, 1963, in the name of NAOS (the Complainant), duly renewed;

- BIODERMA (word), International Registration No. 510524, filed on March 9, 1987, in the name of NAOS (the Complainant), duly renewed; and

- BIODERMA (word), International Registration No. 678846, filed on August 13, 1997, in the name of NAOS (the Complainant), duly renewed, designating among others the U.S.A., where the Respondent is apparently located.

It is worth noting that, the Complainant owns many other trademarks in various countries, which have not been cited in these proceedings.

FACTUAL BACKGROUND

According to information provided by the Complainant and not refuted by the Respondent, the Complainant is a French international

group, originally founded about 40 years ago, known as a beauty and cosmetics company specialized in the skincare industry. Ever since, the Complainant has become a very large enterprise, present in as many as 130 countries around the world.

The Complainant owns a large-sized portfolio of trademarks including the wording "BIODERMA", among which an International registration dating back to 1963. It also owns quite a few related domain names, like <bioderma.com> since September 25,1997.

The disputed domain name <BIODERMABEAUTYSTORE.SHOP> was registered on July 10, 2024 by the Respondent, as confirmed by the Registrar.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name is confusingly similar to its BIODERMA trademark, as it fully incorporates this trademark. This last element is sufficient to support the finding that the disputed domain name is confusingly similar to the Complainant's trademark. Indeed, the mere addition of the descriptive terms “BEAUTY” and “STORE” to the Complainant’s trademark does not change the overall impression of a most likely connection with the trademark BIODERMA of the Complainant. As to the gTLD “.shop”, the Complainant suggests that it should be disregarded, as per the usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name because the Complainant is not affiliated with nor has it ever authorised the Respondent to register its trademark as a domain name, the Complainant has never licensed its trademark to the Respondent and the Respondent is not known as the disputed domain name.

According to the Complainant, given the distinctiveness and reputation of its BIODERMA trademark, the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed way with the aim to create a likelihood of confusion with the Complainant’s trademarks and domain names, and this is evidence of the fact that the disputed domain name was registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has used the domain name to impersonate the Complainant and to pass off its products for those of the Complainant, which is considered as a clear indication of bad faith. It is, indeed, impossible to conceive any actual or contemplated use that would not be illegitimate.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

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).

The disputed domain name consists of the Complainant's whole registered trademark (“BIODERMA”), accompanied by two descriptive words, “BEAUTY” and “STORE”. Indeed, the mere addition of the said terms to the disputed domain name not only is it not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark of the Complainant, but it actually reinforces the confusion, as these terms relate and point to the Complainant’s actual line of business, which is the sale of products in the beauty industry.

As far as the gTLD ".shop" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to

shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the BIODERMA trademark in a domain name, and that it had never licensed its trademark to the Respondent.

Furthermore, the disputed domain name resolves to an active website promoting products of a competitor company to the Complainant, which are in fact passed off for products of the Complainant, and therefore the Respondent cannot demonstrate any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark and the fact that the disputed domain name fully incorporates this trademark (even accompanied by two descriptive terms), it is quite evident that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves to an active website promoting products of a competitor company to the Complainant, which are in fact passed off for products of the Complainant. Such fraudulent use of a domain name shows bad faith under some circumstances, such as when the complainant’s trademark has such a strong reputation that it is widely known, and when it is impossible to conceive any plausible actual or contemplated active use of the domain name by the respondent that would not be illegitimate. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain name. These are the circumstances that apply in the case at issue, to a fair extent. The trademark BIODERMA enjoys wide and extensive reputation in the skincare and beauty industry. Therefore, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate. This conclusion is further reinforced by the intentional use of the descriptive words “BEAUTY” and “STORE” by the Respondent, as these terms relate and point to the Complainant’s actual line of business, which is the sale of products in the beauty industry.

Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain name incorporates the Complainant's trademark, accompanied by descriptive terms relating to the Complainant’s business. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's well-known trademark. His use of the disputed domain name as an active website promoting competitors' products is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **biodermabeautystore.shop**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2024-08-10

Publish the Decision