

Decision for dispute CAC-UDRP-104781

Case number	CAC-UDRP-104781
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Time of filing	2022-08-09 10:03:54
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Domain names	biodermavn.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	NAOS
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	HHShop
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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 submitted evidence that it is the owner of the following trademarks “BIODERMA” (hereafter the “Trademarks”):

- International trademark “BIODERMA” (wordmark), no. 267207, registered on March 19th, 1963, valid for various countries, in international class 3 (for cosmetics);
- International trademark “BIODERMA” (wordmark), no. 510524, registered on March 9th, 1987, valid for various countries, in international class 3 (for cosmetics); and
- International trademark “BIODERMA” (wordmark), no. 678846, registered on August 13th, 1997, valid for various countries including Vietnam, in international class 3 (for cosmetics).

FACTUAL BACKGROUND

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

The Complainant (NAOS) claims to be a major player in skincare, ranked among the top 10 independent beauty companies in

the world, with more than 3.100 employees located around the world through 48 subsidiaries and on-term partnerships with local distributors. The Complainant states that it owes its success due to three brands: “Bioderma”, “Institut Esthederm” and “Etat Pur”.

The Complainant declares it operates under the name “BIODERMA” to sell its branded products “BIODERMA” in over 130 countries around the globe. The Complainant states to own a large portfolio of registered “BIODERMA” trademarks (with reference to the “Trademarks” as mentioned above).

The Complainant also states that it is the owner of multiple domain names which include the word “BIODERMA”, for example the domain name <bioderma.com>, since September 25th, 1997.

The Complainant states that the disputed domain <biodermavn.com> was registered on August 2nd, 2022, and redirects to the website of a company allegedly named “BIODERMA VIETNAM”, allegedly selling products under the name “BIODERMA”.

PARTIES CONTENTIONS

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

1. Confusing similarity

The disputed domain name consists of the Complainant's Trademarks “BIODERMA” with the addition of the letters “VN”.

According to the Complainant, the addition of the letters “VN”, which is the common short form of “Vietnam”, is not sufficient to avoid a likelihood of confusion with the Trademarks. The Complainant states 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”. Further the Complainant states that the gTLD “.com” is not relevant in the appreciation of confusing similarity.

The Panel notes that the disputed domain name incorporates the entirety of the Complainants “BIODERMA” Trademark(s), with the sole addition of the letters “VN”.

The Panel remarks that Section 1.7 of WIPO Overview 3.0, clearly states that, “in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status”.

The Panel is of the opinion that the sole addition of the term “VN” does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy, since “VN” is indeed the two-letter country abbreviation for the country of Vietnam. The addition of the geographical term “VN” for Vietnam, the Respondent’s home country, does not prevent a finding of confusing similarity. This is supported by section 1.8 of WIPO Overview 3.0, which clearly states: “Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element”. The gTLD “.com” may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such appropriate allegations or evidence, the complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then must weigh all the evidence, with the burden of proof always remaining on the complainant.

The Complainant argues that:

- The Respondent is not identified in the WHOIS database as the disputed domain name. The Respondent is not commonly known by the disputed domain name (because the WHOIS information is not similar to the disputed domain name).
 - The Respondent is not related in any way to the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.
 - No license or authorisation was granted to the Respondent to make use of the Complainant’s Bioderma Trademarks.
 - The disputed domain name is used to host a website to impersonate the Complainant and attempt to mislead consumers into thinking the goods offered for sale on the website originate from the Complainant. In the disclaimer of the website available via the disputed domain name, a company is mentioned with the name “Bioderma Vietnam”. Thus, the Respondent tries to create a likelihood of confusion with the Complainant’s entity operating in Vietnam.
- The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name (the Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but failed to do so).

The Panel finds that the Respondent does not appear to have any rights or legitimate interests associated with the Trademarks from the following facts:

- There is no evidence at all that the Respondent is or has been commonly known, by the disputed domain name or by the term “BIODERMA”. The WHOIS information does not provide any information that might indicate any rights to use of the term “BIODERMA”.
- The Complainant’s Trademarks have been used well before the registration date of the disputed domain name. The disputed domain name was registered on August 2nd, 2022, whereas the first trademark of the Complainant was registered March 19th, 1963. At least one of the prior registered Bioderma Trademarks of the Complainant was registered for the territory of Vietnam.

- There is no evidence to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Trademarks. On the contrary, it appears that the Respondent is taking advantage (or at least intends to take advantage) of the Complainant's name and registered Trademarks to sell goods of the Complainant through the disputed domain name.
- The Respondent did not show to have any trademark rights or other rights regarding the term "BIODERMA".
- The Respondent does not seem to have any consent or authorisation to use the Trademarks or variations thereof and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. Bad faith

The Complainant argues that the Respondent has registered the domain name with full knowledge of the Complainant's Trademarks, given the distinctiveness and reputation of these Trademarks and given the fact that all the Google results for the search term "BIODERMA VN" refer to the Complainant, its trademarks and products.

The Complainant emphasises that the content of the website available via the disputed domain name creates the impression that it originates from the Complainant. The website prominently displays "BIODERMA" signs on the webpage, thereby giving the false impression that the website emanates from the Complainant. The Complainant states that this supports its claim of bad faith registration, as Internet users are likely to consider the disputed domain name as in some way endorsed by or connected to Complainant. Based on these arguments, the Complainant contends that the Respondent acquired the disputed domain name with the sole intention to attract for commercial gain internet users to the Respondent's website.

The Panel weighs these arguments and facts as follows:

First, the Panel notes that the Respondent has already been involved in a previous domain name dispute with the Complainant. The Panel refers to the CAC decision 104635 of June 9th, 2022 regarding the domain name <bioderma-vn.com>. This previous case involved similar facts, a similar domain name, and the same registered Bioderma Trademarks of the Complainant. In this previous decision, the domain name <bioderma-vn.com> was ordered to be transferred to the Complainant. Less than 2 months after this decision was rendered (decision date of June 9th, 2022), the Respondent registered the highly similar domain name <biodermavn.com> (registration date August 2nd, 2022).

Also, regardless of the earlier dispute between the parties, a simple Google search of the term "BIODERMAVN" on Google's search engine would have led to the Complainant and its activities.

As mentioned already, the disputed domain name reproduces the Complainant's Trademark "Bioderma" entirely, with the addition of the geographical term "VN" (short for Vietnam).

Furthermore, all the Complainant's Trademarks predate the registration of the disputed domain name and at least one of these Trademarks covers the territory of Vietnam, i.e., the Respondent's home country and the country referred to in the domain name itself (through the abbreviation "VN").

Finally, the Respondent is offering "Bioderma" products for sale on the website available via the disputed domain name and mentions "Bioderma Vietnam" with a local address on the website.

It is therefore inconceivable that the Respondent would have come up with a domain name consisting of the term "BIODERMA"

in combination with the abbreviation “VN” without having prior knowledge of the Complainant and its Trademarks and activities. On the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant’s Trademarks and the scope of these Trademarks at the time of registration and use of the disputed domain name.

The Respondent did not contest any of the Complainant’s arguments and did not provide any explanation concerning its choice for registering and/or using a domain name that includes the Complainant’s registered Trademark(s) in combination with the letters “VN” (which stand for “Vietnam”).

Second, the Panel finds that the disputed domain name is not being used for any bona fide offering of goods or services. The disputed domain name is rather used to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant. It is clear from the content on the website available via the disputed domain name that the Respondent seeks to create the impression of being connected to or acting on behalf of the Respondent. The Respondent even mentions the name “Bioderma Vietnam” on the website and thus tries to impersonate the Complainant (or its affiliates or partners).

The Panel is convinced that the Respondent had the Trademarks of the Complainant in mind when registering and subsequently using the disputed domain name. The Panel concludes that there is at least a risk that the disputed domain name is being used for the purpose of misleading Internet users. There is no evidence whatsoever of a bona fide offering of goods.

For all the reasons set out above, the Panel concludes that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **BIODERMAVN.COM**: Transferred

PANELLISTS

Name	Bart Van Besien
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DATE OF PANEL DECISION 2022-09-14

Publish the Decision