

## **ADMINISTRATIVE PANEL DECISION**

Clarins v. Privacy service provided by Withheld for Privacy ehf / Loc Nguyen, Cha qian sui

Case No. D2022-1618

### **1. The Parties**

The Complainant is Clarins, France, represented by Tmark Conseils, France.

The Respondent is Privacy Service provided by Withheld for Privacy ehf, Iceland / Loc Nguyen, Cha qian sui, Viet Nam.

### **2. The Domain Name and Registrar**

The disputed domain name <clarinserum.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 4, 2022. On May 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 10, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on May 13, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 5, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 15, 2022.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on July 20, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is one of the major players in the field of cosmetics and make-up products. It has been doing business in France for more than 60 years, where it is well-known, and is also well-established worldwide. The Complainant owns multiple trademarks for CLARINS which have been registered worldwide. The Complaint is based on the following trademarks (in chronological order):

United States Trademark No. 0935002 for CLARINS, registered on May 30, 1972, in International Class 3;

Thai Trademark No. Kor76352 for CLARINS, registered on March 24, 1988, in International Class 3;

United States Trademark No. 1574179 for CLARINS, registered on January 2, 1990, in International Class 3;

French Trademark No. 1637194 for CLARINS, registered on January 7, 1991, in International Classes 1 – 45;

Canadian Trademark No. TMA645123 for CLARINS, registered on July 29, 2005, in International Class 3;

European Union Trademark No. 005394283 for CLARINS, registered on October 5, 2010, in International Classes 3, 5, 10, 16, 21, and 44;

United Kingdom Trademark No. UK00905394283 for CLARINS, registered on October 5, 2010, in International Classes 3, 5, 10, 16, 21, and 44.

Hereafter collectively referred to as the “CLARINS Trademarks”.

The Complainant also owns *inter alia* the domain names <clarins.com> and <clarinsusa.com>, registered since March 16, 1997, and November 11, 1997 respectively.

The disputed domain name was registered on March 16, 2022, well after the Complainant secured rights to the CLARINS Trademarks and the abovementioned domain names. At the time of this Decision, the disputed domain name is not in use.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that each of the three elements specified in paragraph 4(a) of the Policy are present. The three elements being: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) the disputed domain name has been registered and is being used in bad faith.

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's earlier CLARINS Trademarks. The disputed domain name incorporates the entirety of the CLARINS Trademarks

and the Complainant points out that numerous earlier UDRP decisions have held that when a domain name wholly incorporates a Complainant's registered trademark, this is sufficient to establish confusing similarity under the Policy. Furthermore, the Complainant claims that this is all the more true in the present case since the CLARINS Trademarks are reproduced in the first position and the element "erum" is added to it. The latter should be seen as a reference to "serum", a generic term to describe the nature of cosmetic products.

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant claims that prior UDRP panels have decided that if the Complainant makes a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, the burden of production switches to the Respondent. The Complainant then contends that the lack of rights or legitimate interest of the Respondent results notably from the following elements. First, the Complainant's CLARINS Trademarks have been registered in numerous countries and predate the disputed domain name by many years. On the other hand, the Respondent does not own any trademarks for CLARINS, as demonstrated by a global trademark search conducted by the Complainant. Second, CLARINS is not a generic term but a registered trademark owned by the Complainant and there appears to be no legitimate reason why the Respondent would incorporate the Complainant's CLARINS Trademarks in the disputed domain name. The Complainant refers to the fact that the disputed domain name is not currently resolving to an active website in support of this. Finally, the Complainant states that it has never licensed or otherwise authorized in any way the Respondent to use CLARINS as a domain name or as an element of a domain name or for any other purpose.

(iii) the disputed domain name was registered and is being used in bad faith

The Complainant contends that the disputed domain name was registered and is being used in bad faith. Regarding the registration in bad faith, the Complainant claims that the Complainant was already extensively using the CLARINS Trademarks well before the registration date of the disputed domain name and that these trademarks have a well-known character worldwide. The Complainant also points to its global website operating under the <clarins.com> domain name. Consequently, the Complainant argues, the Respondent does not have any legitimate reason to register the disputed domain name and its aim must have been to act in bad faith by taking advantage of confusion created by its fraudulent registration. The Complainant claims that the Respondent knew of the Complainant's prior rights and wide use of CLARINS Trademarks and that this was the only reason for it to register the disputed domain name.

According to the Complainant, the Respondent also uses the disputed domain name in bad faith. The disputed domain name is not currently in use but the Complainant relies on the "passive holding" doctrine to claim that this passive holding amounts to bad faith use (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *S.p.A. v. Virginia Peretti, Il Tuo Futuro SRL*, WIPO Case No. [D2020-0631](#); and *Government Employees Insurance Company ("GEICO") v. Steven Blome, Blome Agency*, WIPO Case No. [D2021-4019](#)). In particular, the Complainant contends that since it owns numerous trademark registrations for CLARINS that have a wide reputation, it is not possible to conceive of a plausible situation in which the Respondent could have ignored the existence of the CLARINS Trademarks and it is also not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the disputed domain name.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

The Panel finds that it has jurisdiction to hear this dispute as the Policy has been incorporated by reference into the registration agreement between the Registrar and the Respondent.

The Panel notes that while the Respondent has been duly notified, it did not reply to the Complainant's contentions within the time period established by the Rules. Pursuant to paragraph 14 of the Rules the Panel shall nonetheless proceed to a decision on the Complainant's complaint and it may draw such inferences from the Respondent's failure to respond as it considers appropriate.

Paragraph 4(a) of the Policy requires that in order for its complaint to succeed, the Complainant must prove that the following three elements are present:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The above three elements will each be discussed in further detail below.

### **A. Identical or Confusingly Similar**

The Complainant is required to establish: (1) that it owns rights in a trademark or service mark, and, if so, (2) that the disputed domain name is identical or confusingly similar to its trademarks.

Firstly, the Panel finds that the Complainant has clearly evidenced that it owns registered trademark rights in the CLARINS Trademarks. It should be noted that paragraph 4(a)(i) of the Policy does not set minimum requirements as to the jurisdictions of the trademarks a complainant relies on, nor as to the number, nature or scope of protection of such trademarks.

Secondly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's CLARINS Trademarks since the disputed domain name contains CLARINS in its entirety. The addition of the suffix "erum" does not prevent confusing similarity with the CLARINS Trademarks, as the trademark CLARINS is recognizable within the disputed domain name. It is a well-established view of UDRP panels, with which the Panel agrees, that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see for instance: *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#); *Nintendo of America Inc. v. Fernando Sascha Gutierrez*, WIPO Case No. [D2009-0434](#); *M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts*, WIPO Case No. [D2015-1384](#); *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#)).

Finally, as for the applicable Top-Level Domain, *i.e.* ".com", the Panel holds that this can be disregarded under the first element confusing similarity test (*CANAL + FRANCE v. Franck Letourneau*, WIPO Case No. [DTV2010-0012](#); *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#); *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, this Panel finds and concludes that the disputed domain name is confusingly similar to the Complainant's trademarks.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy non-exhaustively lists three circumstances that shall demonstrate a right or legitimate interest:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you 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 (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 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.”

It is a well-established view of UDRP panels, with which the Panel agrees, that a *prima facie* case advanced by a complainant that a respondent has no rights or legitimate interests in the domain name is generally sufficient to satisfy the requirements under paragraph 4(a)(ii) of the Policy, provided that the respondent does not submit any evidence to the contrary (*AGUAS DE CABREIROA, S.A.U. v. Hello Domain*, WIPO Case No. [D2014-2087](#); *Spigen Korea Co., Ltd., Spigen Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2016-0145](#); *HubSpot, Inc. v. WhoisGuard Protected, WhoisGuard, Inc. / Steve Johnson*, WIPO Case No. [D2016-1338](#)).

The Panel notes that the Respondent has not responded to any of the Complainant’s contentions, let alone submitted evidence to the contrary, and that, pursuant to paragraph 14 of the Rules, the Panel may draw such inferences from the Respondent’s failure to respond as it considers appropriate. In the present case, taking into consideration the Respondent’s default, this Panel finds that the Complainant has made out an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, in view of the circumstances of this case, including the following factors.

The Panel agrees that there is no evidence that the Respondent is using the disputed domain name for a *bona fide* offering of goods or services, the fact that the disputed domain name does not currently resolve to an active website indeed supports this. The Panel finds that such use does not constitute a legitimate noncommercial or fair use of the disputed domain name, as the incorporation of the mark CLARINS in the disputed domain name carries a risk of implied affiliation and cannot constitute fair use, as it effectively impersonates, or suggests sponsorship or endorsement by the Complainant. In addition, there is no evidence that the Respondent has been commonly known by the disputed domain name. The global trademark search conducted by the Complainant which showed that the Respondent does not own trademarks for CLARINS further supports this.

Finally, there is no evidence that the Respondent is sponsored by or affiliated with the Complainant in any way or that the Complainant has licensed, authorized, or permitted the Respondent to register domain names incorporating the CLARINS Trademarks. The Panel has taken note of the Complainant’s confirmation in this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated *bona fide* or legitimate use of the disputed domain name could reasonably be claimed (see e.g. WIPO Case No. [D2014-1875](#), *Sportswear Company S.P.A. v. Tang Hong*; WIPO Case No. [D2010-0138](#), *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*).

For all the foregoing reasons, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy non-exhaustively lists four circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location."

The Panel finds that the circumstances and evidence presented by the Complainant offer sufficient proof that Respondent has engaged in bad faith.

The Panel will first discuss the Respondent's registration of the disputed domain name. The Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the CLARINS Trademarks. The Panel is convinced by the evidence presented that the CLARINS Trademarks were registered well before the registration date of the disputed domain name and that the Complainant and the CLARINS Trademarks are widely known internationally. The Respondent's knowledge of the Complainant's CLARINS Trademarks may be inferred from these circumstances (*SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. [D2001-1092](#), and *American Funds Distributors, Inc. v. Domain Administration Limited*, WIPO Case No. [D2007-0950](#)). Additionally, the Panel notes that the addition of "erum" in the disputed domain name may be interpreted as a typographical variation of "serum", which is a descriptive term affiliated with the Complainant's industry, which to the Panel reinforces the finding that the Respondent was aware of and intended to target the Complainant.

As for the use of the disputed domain name, it should be noted that, according to the Complainant, the disputed domain name is currently not being used. However, as rightfully pointed out by the Complainant in the Complaint, it is a well-established view of UDRP panels that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#), as well as the more recent cases cited by the Complainant: *S.p.A. v. Virginia Peretti, Il Tuo Futuro SRL*, WIPO Case No. [D2020-0631](#); and *Government Employees Insurance Company ("GEICO") v. Steven Blome, Blome Agency*, WIPO Case No. [D2021-4019](#)). The Panel agrees with this view and is of the opinion that the totality of circumstances provided by the Complainant show that the disputed domain name is being used in bad faith. For instance, the Complainant's numerous CLARINS Trademarks predate the registration of the disputed domain name by many years and have a wide reputation and the Respondent has failed to participate in this proceeding. Therefore, and in the absence of any evidence of current or future good faith use of the disputed domain name by the Respondent, the Panel finds that it can be inferred that the disputed domain name is maintained for future bad faith use.

In light of the above, the Panel finds that the disputed domain name was registered and is being used by the Respondent in bad faith.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <clarinserum.com> be transferred to the Complainant.

*/Benoit Van Asbroeck/*

**Benoit Van Asbroeck**

Sole Panelist

Date: August 3, 2022