

ADMINISTRATIVE PANEL DECISION

Elemis USA, Inc. v. imad el amrani

Case No. D2022-3276

1. The Parties

The Complainant is Elemis USA, Inc., United States of America (“United States”), represented by Strategic IP Information Pte Ltd., Singapore.

The Respondent is imad el amrani, Morocco.

2. The Domain Name and Registrar

The disputed domain name, <elemiscosmetics.shop> (the “Domain Name”), is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 2, 2022. On September 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 9, 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 amendments to the Complaint on September 12, 2022, September 13, 2022, and on September 21, 2022.

The Center verified that the Complaint (as amended) 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 October 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 28, 2022.

The Center appointed Tony Willoughby as the sole panelist in this matter on November 8, 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.

The initial invitation to the Complainant to file an amended Complaint stemmed from the fact that the Domain Name was registered in the name of a privacy service. In response to the Center's registrar verification request, the Registrar disclosed the name and address of the entity in whose name the Domain Name is currently registered. The first amendment to the Complaint names the underlying registrant as the Respondent. The two subsequent amendments to the Complaint were necessary to clarify the Mutual Jurisdiction to which the Complainant will submit.

4. Factual Background

The Complainant is a company incorporated in the United States and engaged in the marketing internationally of cosmetics under the name "Elemis". The Complainant is the registered proprietor of several trade mark registrations covering the name "Elemis" including United States Registration No. 1,678,043 ELEMIS (typed drawing) registered on March 3, 1992, (application filed on November 16, 1989) for a wide variety of toiletries and cosmetics in class 3.

The evidence filed by the Complainant supports the Complainant's contention that the Complainant's ELEMIS brand is well-established, well-known and favoured by numerous "A list" celebrities.

The Domain Name was registered on June 21, 2022, and is connected to a parking page hosted by the Registrar and featuring advertising links such as "Cosmetics", "Men Grooming Products", "Elemis", "Valmont", "Elemis Skincare", "Skincare" etc. Some of those links lead to retailers selling the Complainant's products, but many of them lead to offerings of competing products. At the foot of the parking page connected to the Domain Name is a statement reading "The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain name owner maintain any relationship with the advertisers."

At the date of the Complaint the website connected to the Domain Name was inactive. The Complainant contends that at some date prior to the filing of the Complaint the Domain Name was connected to a website offering for sale the Complainant's cosmetic products at discounted prices and featuring copyright images taken from the Complainant's website at "www.us.elemis.com".

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Complainant's ELEMIS registered trade mark, that the Respondent has no rights or legitimate interests in respect of the Domain Name and that the Domain Name has been registered and is being used in bad faith.

The essence of the Complainant's case is that the Respondent's unauthorised use of the Domain Name incorporating the Complainant's ELEMIS trade mark constitutes a false representation that the Domain Name

and the website to which it is attached is associated with and endorsed by the Complainant. The Complainant contends that this is an unfair bad faith use of the Domain Name and that the Respondent registered the Domain Name with this bad faith use in mind.

B. Respondent

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

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) the Domain Name is identical or confusingly similar to a trade mark 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.

B. Identical or Confusingly Similar

The Domain Name comprises the Complainant's registered trade mark ELEMIS, the dictionary word, "cosmetics", describing the Complainant's area of business, and the ".shop" generic Top-Level Domain identifier.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") explains the test for identity or confusing similarity under the first element of the Policy and includes the following passage:

"While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The Complainant's ELEMIS registered trade mark is readily recognizable in its entirety in the Domain Name. The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights.

C. Rights or Legitimate Interests

Section 2.0 of [WIPO Overview 3.0](#) addresses how panels approach this element of the Policy. Significant factors in the context of this case include the following:

- (i) While complainants are required to prove all three elements of paragraph 4(a) of the Policy, this element calls for the complainant to prove a negative in circumstances where it is often the case that all the relevant information is in the hands of the respondent, rendering the task impossible for the complainant. Thus, a protocol has been developed whereby the complainant is required to satisfy the panel that it has a *prima facie* case; it is then for the respondent to come forward with evidence demonstrating rights or legitimate interests;

(ii) Paragraph 4(c) of the Policy sets out a non-exhaustive list of circumstances any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, namely (in brief) that the respondent has been using or making preparation to use the domain name in connection with a *bona fide* offering of goods or services; or has been commonly known by the domain name; or "is making a legitimate non-commercial 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."

(iii) A respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner (Section 2.5) and if it is identical to the complainant's trade mark it carries a high risk of implied affiliation. (Section 2.5.1)

(iv) Where the domain name consists of the complainant's trade mark and an additional term it cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. (Section 2.5.1)

The Complainant asserts that it has no association with the Respondent and specifically has granted the Respondent no permission to use its ELEMIS trade mark. While the Complainant has not set out its case under this element citing the sub-paragraphs of paragraph 4(c) of the Policy, it has dealt with the first and third of those sub-paragraphs by contending that the unauthorised use of the ELEMIS trade mark by the Respondent falsely to associate the Respondent's website with the Complainant is clearly *mala fide* and both unjustified and unfair.

Sub-paragraph 4(c)(ii), not addressed by the Complainant, is plainly inapplicable, there being nothing before the Panel to suggest that the Respondent is or has been commonly known by the Domain Name.

The Panel is satisfied that the Complainant has made out a *prima facie* case under this element of the Policy; in other words, a case calling for an answer from the Respondent. The Respondent has not provided an answer and the Panel finds on the balance of probabilities that the Respondent can have no proper answer to the Complainant's contentions.

The history of the Respondent's use of the Domain Name (see section 4 above) commences, according to the Complainant, with connection to a website offering the Complainant's ELEMIS products at a discount and featuring copyright images taken from the Complainant's website. By the date of the Complaint that website was inactive. By the date that the case papers reached the Panel the Domain Name was connected to a parking page hosted by the Registrar with sponsored links to cosmetics-related offerings, some involving the Complainant's products and some involving the cosmetic products of other companies.

The Complaint did not include screenshots evidencing the first of those uses, but the Panel accepts on the balance of probabilities that the Complainant's contention is well-founded and assumes that the failure to produce screenshots stems from the fact that the use ceased before anybody thought to secure screenshots of that use. The Panel does not rely solely on the failure of the Respondent to challenge that contention of the Complainant. The Domain Name itself proclaims that it is an online shop selling ELEMIS cosmetics.

None of the three stages of use of the Domain Name supports any suggestion that the Respondent might have rights or legitimate interests in respect of the Domain Name and, as indicated above, the Respondent has not sought to contend otherwise. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances, which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. Paragraph 4(b)(iv)

provides: “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 evidence, unchallenged by the Respondent, overwhelmingly supports the Complainant's contention that the Respondent selected the Domain Name with knowledge of the Complainant's ELEMIS range of cosmetics with a view to setting up an online shop for those cosmetics and did so without permission from the Complainant. The Respondent will have known and intended that visitors to its shop would believe that they were visiting a shop of or authorised by the Complainant.

While the current use of the Domain Name is to connect to a parking page hosted by the Registrar and featuring sponsored links to various websites offering a variety of cosmetic products for sale (some being products of the Complainant and others being products of other producers) that too would be likely to constitute bad faith registration and use under this element of the Policy (Section 3.5 [WIPO Overview 3.0](#)).

However, the Panel prefers to base its finding on the Respondent's first use of the Domain Name for an unauthorised online shop offering the Complainant's products for sale. That use has now ceased, but in the view of the Panel while the Domain Name remains in the hands of the Respondent, that use could be re-introduced at any time and, as such, representing a malicious threat hanging over the head of the Complainant and a continuing bad faith use of the Domain Name.

The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraphs 4(a)(iii) and 4(b)(iv) of the Policy.

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 Domain Name, <elemiscosmetics.shop>, be transferred to the Complainant.

/Tony Willoughby/

Tony Willoughby

Sole Panelist

Date: November 17, 2022