

## **ADMINISTRATIVE PANEL DECISION**

NAOS v. nguyen van sang, van sang  
Case No. D2022-4152

### **1. The Parties**

The Complainant is NAOS, France, represented by Nameshield, France.

The Respondent is nguyen van sang, van sang, Viet Nam.

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

The disputed domain name <biodermavietnam.online> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on November 3, 2022. On November 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 4, 2022, 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 November 4, 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 in English on November 4, 2022.

On November 4, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On November 4, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on November 10, 2022. In accordance

with the Rules, paragraph 5, the due date for Response was November 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 1, 2022.

The Center appointed Keiji Kondo as the sole panelist in this matter on December 6, 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 engaged in skincare business, having three brands: Bioderma, Institut Esthederm, and Etat Pur. The Complainant has more than 3,100 employees located around the world through its international presence based on 48 subsidiaries and long-term partnerships with local distributors. To sell its branded products Bioderma in over 130 countries, the Complainant operates under the name Bioderma.

The Complainant owns a portfolio of trademarks including the wording "bioderma" in several jurisdictions, such as:

- the International trademark BIODERMA n° 267207, registered since March 19, 1963;
- the International trademark BIODERMA n° 510524, registered since March 9, 1987; and
- the International trademark BIODERMA n° 678846, registered since August 13, 1997.

Furthermore, the Complainant owns multiple domain names consisting in the wording "bioderma", such as <bioderma.com> registered since September 25, 1997, and used for its official website.

The disputed domain name was registered on October 25, 2022, and redirects to the website displaying the Complainant's trademark and logo BIODERMA, and allegedly selling Bioderma branded products.

#### 5. Parties' Contentions

##### A. Complainant

The disputed domain name is confusingly similar to the Complainant's trademark BIODERMA. The addition of the geographic term "vietnam" is not sufficient to avoid the likelihood of confusion. 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". Moreover, past UDRP panels commonly stated that the generic Top-Level Domain ("gTLD") ".online" is not relevant in the appreciation of confusing similarity.

According to the *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#), a 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 out, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Respondent is not identified in the Whois as the disputed domain name. Past UDRP panels have held that a respondent was not commonly known by a domain name if the Whois information was not similar to the domain name. Thus, the Respondent is not known as the disputed domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks BIODERMA, or apply for registration of the disputed domain name by the Complainant. Furthermore, the disputed domain name

redirects to the website displaying the Complainant's trademark and logo BIODERMA, and allegedly selling Bioderma branded products. The Complainant asserts that it is used to host a website to impersonate the Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from the Complainant. Such use demonstrates neither a *bona fide* offering of goods nor a legitimate interest of the Respondent. Furthermore, the Respondent presents itself as "BIODERMA LABORATOIRE DERMATOLOGIQUE". Thus, the Complainant contends the Respondent attempts to create a likelihood with the Complainant's entity operating in Viet Nam.

Therefore, the Respondent failed at least in one of the elements of the Oki Data test, *i.e.*, the website linked to the disputed domain name does not disclose accurately and prominently the registrant's relationship with the trademark holder.

Accordingly, the Respondent has no rights or legitimate interests in the disputed domain name.

The disputed domain name is confusingly similar to the Complainant's trademark, which is displayed on the website. Besides, all the Google results for the term "bioderma vietnam" refers to the Complainant, its trademarks and products. Thus, given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

Moreover, the content of the website gives the impression that it originates from the Complainant, prominently displaying BIODERMA signs on the website, thereby giving the false impression that the website emanates from the Complainant. This further supports registration in bad faith reinforcing the likelihood of confusion, as Internet users are likely to consider the disputed domain name as in some way endorsed by or connected with the Complainant.

Based on the above, the Complainant contends that he Respondent acquired the disputed domain name with the only intention to attract for commercial gain Internet users to the Respondent's website.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

The Complainant requests the Panel that the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Language of the Proceeding**

In the Complaint, the Complainant acknowledges that the language of the Registration Agreement for the disputed domain name is Japanese, but the Complaint was submitted in English. On November 4, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On November 4, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

Considering the following circumstances, the Panel, exercising its authority to determine the language of the proceeding under paragraph 11(a) of the Rules, has decided English as the language of the proceeding:

- the Complaint was filed in English;
- the Complainant is a French entity, and represented by a French law firm;
- the Respondent's address is in Viet Nam;

- the Complainant has submitted its request that English be the language of the proceeding, but the Respondent did not comment on the language of the proceeding;
- the Respondent did not reply to the Complainant's contentions in any manner; and
- ordering the translation of the Complaint would only result in extra delay of the proceeding and additional cost for the Complainant.

## 6.2. Substantive Issues

### A. Identical or Confusingly Similar

The first element functions primarily as a standing requirement. In this case, the disputed domain name incorporates the entirety of the Complainant's trademark, and, even with the addition of "vietnam", the Complainant's trademark is recognizable in the disputed domain name. The gTLD ".online" is not relevant in the appreciation of confusing similarity.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, paragraph 4(a)(i) of the Policy is satisfied.

### B. Rights or Legitimate Interests

The Respondent's name is "nguyen van sang, van sang", which is in no way similar to the disputed domain name, or its distinctive part "bioderma". The Complainant has not authorized the Respondent to use the Complainant's trademark although the Respondent identifies itself as "BIODERMA LABORATOIRE DERMATOLOGIQUE" in its website. Therefore, the Panel finds that the Respondent has never been commonly known by the disputed domain name or the Complainant's trademark.

The disputed domain name resolves to the website displaying the Complainant's trademark and logo BIODERMA, and allegedly selling Bioderma branded products. Regardless of whether the goods sold at the website is genuine or not, it is obviously a commercial use, and does not fall into the category of legitimate noncommercial or fair use.

Since the Respondent's use of the disputed domain name is of commercial nature, it must be determined whether it is used in connection with a *bona fide* offering of goods or services. In cases where the respondent uses the domain name in connection with sales or repairs related to the complainant's goods or services, "Oki Data test" is usually applied to determine whether the use is in connection with a *bona fide* offering of goods or services. For finding a *bona fide* offering of goods or services, "Oki Data test" applies the following cumulative requirements:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

In this case, the Respondent identifies itself as "BIODERMA LABORATOIRE DERMATOLOGIQUE" in its website suggesting that it has some business relationship with the Complainant although the Respondent is not a licensee, a distributor, an affiliate company, or any other entity relating to the Complainant. Therefore, it is obvious that the third requirement of "Oki Data test" is not satisfied.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

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

One of the Complainant's trademarks was registered in 1963, while the disputed domain name was registered on October 25, 2022. The disputed domain name resolves to the website displaying the Complainant's trademark and logo BIODERMA, and allegedly selling Bioderma branded products. In addition, the Respondent identifies itself as "BIODERMA LABORATOIRE DERMATOLOGIQUE", suggesting that it has some relationship with the Complainant. These facts clearly demonstrate that the Respondent knew the Complainant's trademark at the time of registration of the disputed domain name, registered the disputed domain name in an attempt to create a likelihood of confusion with the Complainant, and is using it to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Accordingly, paragraph 4(a)(iii) of the Policy is satisfied.

### **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, <biodermavietnam.online>, be transferred to the Complainant.

*/Keiji Kondo/*

**Keiji Kondo**

Sole Panelist

Date: December 20, 2022