

ADMINISTRATIVE PANEL DECISION

Clarins v. DOMAIN ADMINISTRATOR

Case No. D2022-4191

1. The Parties

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

The Respondent is DOMAIN ADMINISTRATOR, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <clarinswaterlipstain.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 4, 2022. On November 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 7, 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 the same day 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 November 18, 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 November 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 14, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on December 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 actors in the field of cosmetics and make-up goods, it has been doing business in France for more than 50 years and it is also well established worldwide.

The Complainant is the exclusive owner of a number of registered trademarks consisting of the word “clarins”, including:

- French trademark registration No. 1637194 for CLARINS (word), registered on June 14, 1991, and registered for goods and services in, *inter alia*, classes 3 and 44;
- European Union trademark registration No. 005394283 for CLARINS, registered on October 5, 2010 and registered for goods and services in, *inter alia*, classes 3 and 44;
- European Union trademark registration No. 018713734, for CLARINS WATER LIP STAIN, registered on September 22, 2022 and registered for goods and services in international class 3;
- United Kingdom trademark registration No. 00905394283 for CLARINS (word), registered on October 5, 2010 and registered for goods in international classes 3 and 4;
- Canada trademark registration No. TMA645123 for CLARINS, registered on July 29, 2005 and registered for goods in international class 3;
- United States trademark registration No. 73746658, for CLARINS, registered on January 2, 1990 and registered for goods in international class 3;
- United States trademark registration No. 72361433 for CLARINS, filed on June 2, 1970 and registered for goods in international class 3; and
- International trademark registration No. 208808 for CLARINS, registered on April 10, 1958 and registered for beauty care services in international classes 3, 5, 7, 9 10, 11, 21 and 28.

The disputed domain name was registered on June 7, 2022 and redirects to a parking page where the disputed domain name is listed for sale.

5. Parties' Contentions

A. Complainant

The Complainant is a French beauty company with global reach, doing business in Europe, Australia, North and South America, Asia, where the Complainant promotes its products, services and related activities directly or – where applicable – via partners and authorized distributors.

The disputed domain name reproduces identically in first position the registered trademark CLARINS.

The addition of the expression “water lip stain” is not sufficient to differentiate the disputed domain name from the registered trademark, as these elements are descriptive for one of the Complainant’s make-up product.

The trademark CLARINS has been in use for a long time and is enjoying reputation world-wide in the cosmetic industry.

The term “Clarins” is not a generic term but a registered distinctive trademark owned by the Complainant.

The Respondent has no genuine activity under the trademark CLARINS name.

The disputed domain name is not redirecting toward any active website. On the contrary, it is offered for sale.

The Respondent has no rights or legitimate interests on the disputed domain name and that he is not making a fair use of it.

The Complainant has never licensed or otherwise authorized in any way the Respondent to use the term “Clarins”.

The Respondent was aware of the existence of the prior registered rights concerning the Complainant’s trademark CLARINS. The disputed domain name was registered on the same day as the filing by the Complainant of the European Union trademark registration No. 018713734.

The Respondent has registered the disputed domain name for the sole purpose of selling, renting or transferring it at a very expansive price whereas it is composed of the Complainant’s prior well-known trademarks.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (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.

Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

The Panel holds that the disputed domain name is confusingly similar to the Complainant’s CLARINS trademarks.

The Respondent’s incorporation of the Complainant’s trademarks CLARINS, and CLARINS WATER LIP STAIN trademark, in full in the disputed domain name is evidence that the disputed domain name is confusingly similar to the Complainant’s marks.

If compared to the Complainant’s trademark CLARINS, the mere addition of the dictionary terms “water”, “lip” and “stain” as suffix to the Complainant’s mark does not prevent a finding of confusing similarity under the first element. The nature of such term(s) may however bear on assessment of the second and third elements. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). If compared to the Complainant’s trademark CLARINS WATER LIP STAIN trademark the Panel finds that the disputed domain name is identical to the mentioned trademark. In addition, this Panel finds, similarly to other UDRP panels, that the addition of the generic Top-Level Domain “.com” to the disputed domain names does not constitute a relevant element for purposes of the first element of the Policy, as it is a technical requirement (see: *Carlsberg A/S v. Xu Guo Xing*, WIPO Case No. [D2017-0301](#); *Philip Morris USA Inc. v. Shimei Wang*, WIPO Case No. [D2016-2517](#); and *Livelle v. Martijn Noordermer*, WIPO Case No. [D2016-2524](#)).

The Panel is satisfied that the disputed domain name is identical or confusingly similar to the Complainant’s mark and the Complainant has fulfilled the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent will lead to this ground being set forth.

The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain name.

The Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's CLARINS and CLARINS WATER LIP STAIN trademarks in a domain name or in any other manner.

The Respondent did not submit a formal Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

Refraining from submitting a Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights or legitimate interests in the disputed domain name.

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct;
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on its website or location.

In the Panel's view a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. In this case, the worldwide commercial recognition and notoriety of the Complainant's CLARINS trademarks is such that the Respondent, must have had knowledge of the trademark CLARINS before registering the disputed domain name. In addition, as noted above, the Respondent registered the disputed domain name on the

same date of the Complainant's filing of its application for the trademark CLARINS WATER LIP STAIN, which cannot be a coincidence particularly noting the composition of the disputed domain name. On the contrary, the Panel finds that the common date strongly points to the Respondent's intention of securing the disputed domain name for the purposes of selling, renting, or otherwise transferring the disputed domain name to the Complainant.

As to use in bad faith, the Complainant says that, the disputed domain name has not been put to any use in connection with an active website but simply redirects to a parking page offering the disputed domain name for sale. If such use was to be considered from the perspective of not resolving to an active website, it has long been held in UDRP decisions that the inactive or passive holding of a domain name that incorporates a registered trademark, without a legitimate purpose, does not prevent a finding of bad faith under paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#). The [WIPO Overview 3.0](#), at section 3.3, describes the circumstances under which the passive holding of a domain name will be considered to be in bad faith: "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put". See *Andrey Ternovskiy dba Chatroulette v. WhoisGuard Protected, WhoisGuard, Inc. / Armando Machado*, WIPO Case No. [D2018-0082](#).

The Panel further notes that the disputed domain name is also being used in bad faith since the disputed domain name redirects to a parking page offering it for sale. The Panel finds that the Respondent has registered the disputed domain name primarily for the purpose of selling it, for valuable consideration in excess of its documented out-of-pocket costs directly related to the disputed domain name, in an attempt to capitalize upon the Complainant's reputation, goodwill, and nascent trademark rights.

The Panel finds that the evidence produced in this case taken as a whole clearly supports a finding that the Respondent registered and is using the disputed domain name in bad faith. Therefore, the Panel concludes that the requirement of paragraph 4(a)(iii) of the Policy has been met.

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 <clarinswaterlipstain.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: January 3, 2023