

ADMINISTRATIVE PANEL DECISION

L'Oréal v. Domain Administrator, See PrivacyGuardian.org / Gerry Fredericksen
Case No. D2022-1837

1. The Parties

The Complainant is L'Oréal, France, represented by Dreyfus & associés, France.

The Respondent is Domain Administrator, See PrivacyGuardian.org / Gerry Fredericksen, United States of America ("United States").

2. The Domain Names and Registrar

The disputed domain names <lorealnft.xyz>, <lorealparisnfts.xyz>, <lorealparisnft.xyz> ("the Disputed Domain Names") are registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 20, 2022. On May 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On May 23, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 24, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On May 26, 2022, the Complainant requested to suspend the proceeding to negotiate a settlement with the Respondent. On May 27, the Center suspended the proceeding. As the parties were unable to settle the case, the Center reinstated the proceeding on June 14, 2022. The Complainant filed an amended Complaint on June 14, 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 17, 2022. In accordance with the Rules, paragraph 5,

the due date for Response was July 7, 2022. The Respondent did not submit any response. Accordingly, the Center commenced the panel appointment process on July 8, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on July 13, 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 a French multinational company that operates a business with over 86,000 employees and sells cosmetics, hair care products and fragrances in more than 150 countries. The Complainant holds registrations for the trademark L'OREAL in numerous countries, including, for example, United States trademark No. 4945102, filed for the mark L'OREAL registered on April 26, 2016.

The Complainant owns a number of domain names that comprise of, or contain, the trademark L'OREAL, including the domain name <loreal.com>, which was registered on October 24, 1997 and <lorealparis.com> registered on June 5, 1998.

Each of the Disputed Domain Names <lorealnft.xyz>, <lorealparisnfts.xyz>, <lorealparisnft.xyz> were registered on March 24, 2022. The Disputed Domain Names <lorealnft.xyz>, <lorealparisnfts.xyz> are inactive. The Disputed Domain Name <lorealparisnft.xyz> resolved to a website purporting to offer for sale L'OREAL branded unique digital collectibles secured by the blockchain otherwise known as non-fungible tokens (NFTs).

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations for L'OREAL and L'OREAL PARIS in various countries as *prima facie* evidence of ownership.

The Complainant submits that the trademark L'OREAL is highly distinctive and that its rights in that trademark predate the Respondent's registration of the Disputed Domain Names. It submits that the Disputed Domain Names are confusingly similar to its trademarks, because the Disputed Domain Names incorporate in their entirety the L'OREAL trademark - and in the case of two of the Disputed Domain Names, the L'OREAL PARIS trademark - and that the confusing similarity is not affected by the addition, respectively, of the abbreviation "NFT" or "NFTs" or the word "Paris" and addition of the generic Top-Level Domain ("gTLD") ".xyz".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names and that "it is not possible to conceive a plausible circumstance in which Respondent could legitimately use the disputed domain names, as it would invariably result in misleading diversion and taking unfair advantage of Complainant's rights."

Finally, the Complainant alleges that the registration and use of the Disputed Domain Names was, and currently is, in bad faith, contrary to the Policy and the Rules. It submits that "given Complainant's goodwill and renown, and the nature of the disputed domain names, Respondent could simply not have chosen the domain names <lorealnft.xyz>, <lorealparisnft.xyz> and <lorealparisnfts.xyz> for any reason other than to deliberately cause confusion amongst Internet users as to its source in order to take unfair advantage of Complainant's goodwill and reputation, which clearly constitutes bad faith."

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark L'OREAL. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Names are identical or confusingly similar to the L'OREAL trademark, the Panel observes that the Disputed Domain Names comprise:

- In the case of <lorealnft.xyz> (a) an exact reproduction of the Complainant's L'OREAL trademark; (b) followed by the acronym "nft"; and (c) followed by the gTLD ".xyz".
- In the case of <lorealparisnfts.xyz> (a) an exact reproduction of the Complainant's L'OREAL trademark; (b) followed by the geographical term "Paris"; (c) followed by the acronym "nfts"; and (d) followed by the gTLD ".xyz".
- In the case of <lorealparisnft.xyz> (a) an exact reproduction of the Complainant's L'OREAL trademark; (b) followed by the geographical term "Paris"; (c) followed by the acronym "nft"; and (d) followed by the gTLD ".xyz".

It is well established that the gTLD used as technical part of a domain name may be disregarded (see section 1.11 of the [WIPO Overview 3.0](#)). The gTLD chosen appears to have no special significance in this proceeding. The relevant comparison to be made is with the second-level portion of each Disputed Domain Name, specifically: "lorealnft", "lorealparisnfts" and "lorealparisnft", respectively.

It is also well established that 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 (see [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Names. The Policy also places the burden of proof on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Names.

Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because it has not licensed, permitted or authorized the Respondent to use the Complainant's trademark and for that reason the Respondent is not making a *bona fide* offering of goods or services. The Complainant cites its prior rights and submits that "Respondent is neither affiliated with Complainant in any way nor has it been authorized by Complainant to use and register its trademark, or to seek registration of any domain name incorporating said trademark."

The Respondent is not a reseller, and there is no disclaimer on the websites at the Disputed Domain Name <lorealparisnft.xyz>, therefore it cannot meet the tests set out in *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Nor, alternatively, is the Respondent commonly known by any of the Disputed Domain Names. The Panel accepts the Complainant's uncontested submission that the Disputed Domain Names "the domain names <lorealnft.xyz> and <lorealparisnfts.xyz> resolve to a page indicating 'Page Success' without any particular content, while the domain name <lorealparisnft.xyz> directs to a page offering exclusive access to the L'Oréal NFT universe and reproducing Complainant's visual without its authorization."

This Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because the Disputed Domain Names suggest some association or implied affiliation with the Complainant for the probable purpose of misleading consumers based on users seeking out NFTs or digital collectibles associated with the Complainant's mark L'OREAL and opportunistically using the Complainant's trademark to divert Internet traffic for its own ends, particularly noting the use of the Disputed Domain Name <lorealparisnft.xyz>.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that a complainant must also demonstrate is that the disputed domain name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both.

The evidence that the Respondent has registered and used the Disputed Domain Names in bad faith is overwhelming. This Panel finds it most unlikely that the Respondent might have registered the Disputed Domain Names without knowing of the trademark (see *L'oreal v. Liao quanyong*, WIPO Case No. [D2007-1552](#) ("Given the worldwide reputation of Complainant's L'OREAL marks in the beauty market, the compelling conclusion is that Respondent, by choosing to register and use a domain name which is identical or confusingly similar to Complainant's widely known and distinctive trademark, intended to ride on the goodwill of the Complainant's trademark in an attempt to exploit, for commercial gain, Internet traffic destined for Complainant"); *L'Oréal and Lancôme Parfums et Beauté et Compagnie v. Deco Trends & Art, K. Plooyer* WIPO Case No. [D2011-0524](#) ("the addition of the geographical term "paris" in one of the disputed domain names, which corresponds to the location of the head-office of both Complainants conveys that Respondent was aware of the existence of Complainants and their trademarks at the time of registering the disputed domain names"))).

Previous UDRP panels have held that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see: *L'Oréal, Laboratoire Garnier & Compagnie v. Australian Internet Investments Pty Ltd*, WIPO Case No. [D2008-1640](#) and [WIPO Overview 3.0](#), section 3.1.4).

Further, a gap of several years between registration of the Complainant's trademark and the Respondent's registration of the Disputed Domain Names (containing the trademark) can in certain circumstances be an indicator of bad faith (see *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. D2007 1415). In this case, the Panel's search of global trademark records indicates that the Complainant's rights in its trademark predate any rights that could possibly flow from the Respondent's registration by at least 55 years¹.

On the issue of use, the Panel notes that two of the Disputed Domain Names were inactive and the other was used to resolve to an online website that purportedly offered NFTs for sale. In line with prior UDRP panel decisions, the Panel finds that the conduct in relation to the Disputed Domain Name <lorealparisnft.xyz> is an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (see [WIPO Overview 3.0](#), section 3.1.4 and 3.2.1).

Turning to the two Disputed Domain Names that do not currently resolve to an active website <lorealnft.xyz> and <lorealparisnfts.xyz>, previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. "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 [WIPO Overview 3.0](#), section 3.3). This Panel notes that the evidence is that all four of these factors are present in this proceeding in relation to the Disputed Domain Names <lorealnft.xyz> and <lorealparisnfts.xyz>.

In the absence of a reply, and any submissions or evidence contending otherwise, this Panel finds that the Respondent has taken the Complainant's trademark L'OREAL and incorporated it in the Disputed Domain Names without the Complainant's consent or authorization, for the purpose of capitalizing on the reputation of the trademark by deliberately sewing confusion with Internet users who are looking for digital collectibles associated with Complainant's brand, conduct that comprises bad faith registration and use under the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 Disputed Domain Names, <lorealnft.xyz>, <lorealparisnfts.xyz>, and <lorealparisnft.xyz> be transferred to the Complainant.

Nicholas Weston

Sole Panelist

Date: July 27, 2022

¹ Panels do commonly undertake limited factual research into matters of public record where such information may be useful to assessing the case merits and reaching a decision, (see [WIPO Overview 3.0](#), section 4.8). WIPO Global Brand Database accessed on July 15, 2022 reveals, for example, Bulgarian Trademark Registration No.0000477 for the mark L'OREAL registered from March 14, 1966.