

ADMINISTRATIVE PANEL DECISION

NAOS v. BUI HUU NGUYEN

Case No. D2023-3751

1. The Parties

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

The Respondent is BUI HUU NGUYEN, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <biodermashopping.online> is registered with GMO Internet Group, Inc. d/b/a Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 8, 2023. On September 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 11, 2023, 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 (GMO-Z.com RUNSYSTEM JSC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 11, 2023, 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 September 12, 2023.

On September 11, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On September 12, 2023, the Complainant submitted a 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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 22, 2023. In accordance with paragraph 5 of the Rules, the due date for Response was October 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 13, 2023.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on October 23, 2023. 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 paragraph 7 of the Rules.

4. Factual Background

The Complainant was founded in France in more than 40 years ago by Jean-Noël Thorel, a pharmacist-biologist. The Complainant is a major player in skincare thanks to its three brands: "BIODERMA", "INSTITUT ESTHEDERM" and "etat pur". The Complainant owes its success to the dedication of more than 3,100 employees located around the world through its international presence in over 130 countries based on 48 subsidiaries and long-term partnerships with local distributors.

The Complainant owns a large portfolio of trademarks including the wording "BIODERMA" (the "BIODERMA Trademarks" or "BIODERMA Trademark") in several countries, such as the International trademark Nos. 267207 (registered since March 19, 1963), 510524 (registered since March 9, 1987) and 678846 (registered since August 13, 1997).

Furthermore, the Complainant owns multiple domain names consisting in the wording "BIODERMA", such as <bioderma.com> since September 25, 1997.

The disputed domain name was registered on August 8, 2023 and redirects to a parking page simply displaying the message in Vietnamese, "Tên miền của bạn đã được trở thành công! Vui lòng xuất bản Landing Page với tên miền trên để sử dụng dịch vụ. Xin cảm ơn! (Your domain name has been successfully pointed! Please publish a Landing Page with the above domain name to use the service. Thank you very much!)".

5. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

The addition of the term "shopping" and the Top-Level Domain suffix ".online" does not change the overall impression of the designation as being connected to the Complainant's BIODERMA Trademarks. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its BIODERMA Trademark.

The Respondent is not identified in the Whois database as the disputed domain name, but as "BUI HUU NGUYEN". The Respondent is not affiliated with nor authorized by the Complainant in any way. The Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 BIODERMA Trademark or apply for registration of the disputed domain name by the Complainant. The Respondent did not make any use of disputed domain name and has no demonstrable plan to use the disputed domain name.

All the results of a Google search of the terms “BIODERMA SHOPPING” are related to the Complainant and its products. Therefore, the Respondent must have been aware of the Complainant’s BIODERMA Trademarks at the time the Respondent registered the disputed domain name. It is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, in the absence of an agreement between the Parties, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. According to the Registrar, the language of the Registration Agreement for the disputed domain name is Japanese.

However, the Complainant requests that English be the language of the proceeding with the reasons that the choice of language is related to the combined fact that the English language is the language most widely used in international relations and is one of the working languages of the Center, the disputed domain name is formed by words in Roman characters (ASCII) and not in Japanese script, and the Complainant would have had to retain specialized translation services at a cost very likely to be higher than the overall cost of these proceedings in order to proceed in Japanese.

Although the Respondent does not expressly agree with the Complainant on the language of the proceeding, the Respondent did not submit any objection to the Complainant’s request that English be the language of the proceeding when the Center had sent a notification regarding the language of the proceeding to the Parties by email both in English and Japanese. Considering that the Respondent is located in Viet Nam, where English is quite popular, and even assuming that the Respondent is conversant in Japanese, the necessity for conducting the proceeding in Japanese will not be so critical to justify the costs of translation because the webpage which is now redirected from the disputed domain name is displayed in Vietnamese, but not in Japanese.

In view of these circumstances of the administrative proceeding, the Panel decides that English should be the language of the proceeding in the spirit of fairness and justice intended by the Policy.

6.2 Substantive Elements of the Policy

According to paragraph 4(a) of the Policy, the Complainant must assert and prove 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; and
- (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.

A. Identical or Confusingly Similar

The disputed domain name incorporates the BIODERMA Trademark in its entirety with the addition of the word “shopping” and a generic Top-Level Domain (“gTLD”) “.online”.

As noted in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element in paragraph 4(a) of the Policy. The addition of the term “shopping” does not prevent a finding of confusing similarity with the BIODERMA Trademark (see *LEGO Juris A/S v. Tech Domain Services Private Limited*, WIPO Case No. [D2009-1617](#) (<legoshopping.com>)).

As stated in section 1.11.1 of [WIPO Overview 3.0](#), the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element in paragraph 4(a) of the Policy. Thus, the gTLD “.online” is not relevant in the appreciation of confusing similarity. (See *NAOS v. nguyen van sang, van sang*, WPO Case No. [D2022-4152](#) (<biodermavietnam.online>)).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s BIODERMA Trademark.

B. Rights or Legitimate Interests

As the Complainant asserts, the Respondent is not identified as the disputed domain name and no evidence can be found indicating that the Respondent is affiliated with, licensed or authorized by the Complainant. Moreover, the Respondent did not make any use of disputed domain name by the parking page in connection with a *bona fide* offering of goods or services.

Therefore, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name, the burden of production on the second element in paragraph 4(a) of the Policy shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent failed to submit any response in this proceeding and no evidence of the existence of any rights or legitimate interests has been presented before the Panel.

As a result, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

Considering the Complainant’s international reputation for its skincare products (see *NAOS v. 吳二〇 (Er Nong Wu)*, WIPO Case No. [D2020-2746](#)) and the uniqueness of the term “BIODERMA” (see *NAOS v. nguyen van tu*, WIPO Case No. [D2023-1831](#)), the Respondent must have had knowledge about the Complainant’s BIODERMA Trademark when registering the disputed domain name.

As illustrated in section 3.3 of [WIPO Overview 3.0](#), the Respondent’s passive holding of the disputed domain name would not prevent a finding of bad faith by assessing the totality of the circumstances including (i) the high degree of distinctiveness or reputation of the Complainant’s BIODERMA Trademark, (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 by using the privacy registration service, and (iv) the implausibility of any good faith use to which the disputed domain name may be put.

Consequently, the Panel concludes that the Respondent has registered and is using the disputed domain name 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 <biodermashopping.online> be transferred to the Complainant.

/Yuji Yamaguchi/

Yuji Yamaguchi

Sole Panelist

Date: November 4, 2023