

ADMINISTRATIVE PANEL DECISION

L'Oréal v. Tran Thi Tuyet Nhung
Case No. D2024-1183

1. The Parties

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

The Respondent is Tran Thi Tuyet Nhung, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <lancome-cosmetics.com> 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 March 19, 2024. On March 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 22, 2024, 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 March 26, 2024, 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 March 27, 2024.

On March 26, 2024, the Center informed the Parties in Japanese and English, that the language of the Registration Agreement for the disputed domain name is Japanese. On March 27, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

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 April 4, 2024. In accordance with the

Rules, paragraph 5, the due date for Response was April 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 25, 2024.

The Center appointed Haig Oghigian as the sole panelist in this matter on May 6, 2024. 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, L'Oréal was founded in 1909, and has grown into one of the world's largest cosmetics and beauty companies. Incorporated and headquartered in Paris, France, the Complainant has a portfolio of 36 international brands that covers all lines of cosmetics, including but not limited to: hair care, coloring, skin care, make-up, and perfume. The Complainant employs over 86,000 employees and is present in 150 countries.

Lancôme Parfums Beauté et Cie (hereafter Lancôme), a subsidiary of the Complainant, was founded in 1935, and is widely recognized as a world leading brand in women's skincare and make-up.

The Complainant is the owner of numerous registered trademarks including the sign LANCÔME, alone or combined with another element, registered worldwide including but not limited to the following:

- International trademark LANCÔME, No. 157412, dated November 12, 1951, designating numerous jurisdictions, inter alia, Viet Nam;
- International trademark LANCÔME, No. 514803, dated July 21, 1987, duly renewed, designating, inter alia, Austria, Germany, Hungary, and Democratic People's Republic of Korea; and
- Vietnamese trademark LANCÔME, No. 4-0171183-000, dated September 7, 2011.

The Complainant operates, among others, the following domain names reflecting its trademark in order to promote its activity:

- <lancome.com> registered on July 8, 1997; and
- <lancomecosmetics.com> registered on November 26, 2004.

The Complainant notes that its earliest "LANCÔME" domain name registration (the aforementioned July 8, 1997 registration), pre-date the registration of the disputed domain name by over 25 years.

According to the Whois records, the disputed domain name was registered on December 9, 2023.

According to the provided record, it appears the disputed domain name at one time contained a presentation of the Complainant's products and a commercial video displaying the Complainant's trademark. At present, the disputed domain name resolves to a website which displays a "404 error" message in Vietnamese that confirms the disputed domain name "has been successfully registered". There is no element whatsoever on the website to display the relationship, if any, between the Respondent and the Complainant.

Additionally, the Respondent has failed to respond to any correspondence from the Center.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant's contentions are as follows.

As to whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, the Complainant contests the only difference is the Respondent's addition of a hyphen between the words "lancome" and "cosmetics". The Complainant notes that the addition of a hyphen demonstrates direct targeting of its official domain name <lancomecosmetics.com>, deliberately intending to confuse Internet users and reroute traffic from the Complainant's official website. Beyond a misspelling or similar change that is typical of "typosquatting" cases, the Complainant stresses that the inclusion of a hyphen does not affect the appearance or pronunciation of the disputed domain name in any way.

The Complainant stressed that in numerous UDRP cases, it has been held that a domain name which wholly incorporates a complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the Policy. The Complainant highlights numerous UDRP panels who have agreed that supplementing or modifying a trademark with a hyphen or other punctuation fails to make them any less "identical or confusingly similar" for purposes of satisfying this first element under the Policy set forth in paragraph 4(a)(i). For example, *Express Scripts, Inc. v. Whois Privacy Protection Service, Inc. / Domaindeals, Domain Administrator*, WIPO Case No. [D2008-1302](#); *Sanofi v. Domains By Proxy, LLC / domain name*, WIPO Case No. [D2013-0368](#); and *Schneider Electric S.A. v. Domain Whois Protect Service / Cyber Domain Services Pvt. Ltd.*, WIPO Case No. [D2015-2333](#).

As a result of the above, the Complainant submits that the disputed domain name is identical to a trademark in which the Complainant has rights.

Regarding whether the Respondent has rights or legitimate interests in respect of the disputed domain name, the Complainant contends that the Respondent has no prior rights, trademarks, related to the "LANCÔME" name, nor is commonly known by a similar name.

Furthermore, the Complainant confirms the Respondent is not a licensee of the Complainant and has not received any permission, consent, or acquiescence from the Complainant to use its name and mark in association with the registration of the disputed domain name or, indeed, any domain name, service, or product. The Complainant contends that the disputed domain name is so similar to the trademarks of the Complainant that the Respondent cannot reasonably pretend it was intending to develop a legitimate activity through registering the disputed domain name.

The Complainant points to previous UDRP decisions in which panels found that in the absence of any license or permission from the complainant to use such widely-known trademarks, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed (*LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Additionally, the Complainant notes that the Respondent's registration of the disputed domain name with a privacy shield service in order to hide its identity and avoid contact from the Complainant is typical of "typosquatting" cases, and demonstrates a lack of rights or legitimate interests on behalf of the Respondent. Taking into account the afore mentioned, the Complainant, therefore, concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name, in accordance with paragraph 4(a)(ii) of the Policy.

Concerning whether the disputed domain name was registered and is being used in bad faith, the Complainant argues that it is implausible that the Respondent was unaware of the Complainant when the disputed domain name was registered.

The Complainant contends that bad faith can be established where a respondent "knew or should have known" of the complainant's trademark rights and, nevertheless registered a domain name in which he or

she had no rights or legitimate interests, referencing *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. [D2009-0320](#); and *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#).

Given the long-standing use and reputation of the Complainant's trademark, the Complainant contends that the Respondent's primary motive in registering and using the disputed domain name was to capitalize on or otherwise take advantage of the Complainant's trademark rights, through the creation of initial interest confusion. This behavior is likely to mislead the Internet users to link the site to which the disputed domain name is directed to that of the Complainant. The Complainant submits that such use can be considered neither as a bona fide offering of goods or services nor as a legitimate noncommercial or fair use of the disputed domain name, and that such willful conduct clearly shows, to the contrary, the Respondent's intention to abusively benefit from the Complainant's reputation.

In addition, the Complainant stresses the Respondent's registration of the disputed domain name through a privacy shield service to hide its identity and contact details, thus, preventing the Complainant from contacting it. The Complainant points to prior UDRP panel decisions that support a deliberate concealment of identity and contact information may in itself indicate registration in bad faith (*Schering Corporation v. Name Redacted*, WIPO Case No. [D2012-0729](#); and *TTT Moneycorp Limited. v. Diverse Communications*, WIPO Case No. [D2001-0725](#)). The Complainant also points out attempts to resolve the matter amicably by contacting the Respondent through the Privacy Shield. However, the Respondent never replied to the Complainant's contact, thus showing evident bad faith in registering the disputed domain name.

The Complainant concludes that this constitutes registration and use in bad faith, clearly targeting the Complainant.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Japanese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Complainant has no knowledge of Japanese, and would therefore have to retain specialized translation services at a cost that is likely to be higher than the overall cost for the present proceeding to continue in Japanese.

The Complainant references previous UDRP decisions that have recognized that using the registration agreement's language, which in the present case could be Japanese, would lay an undue burden on the Complainant (*L'Oréal v. Whois Privacy Protection Service by onamae.com / Motoko Fujii*, WIPO Case No. [D2016-0593](#)).

The Panel notes that the disputed domain name is formed by terms in Roman characters (ASCII) and not in Japanese script and that the Respondent did not make any submissions with respect to the language of the proceeding despite the fact that the Center sent a notification regarding the language of the proceeding to the Parties by email both in English and Japanese.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all

relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: sale of alleged counterfeit goods or illegal pharmaceuticals, impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent deliberately and knowingly impersonated the Complainant in order to create initial interest confusion and capitalize or otherwise take advantage of the Complainant's trademark. Although not currently active, the Panel finds that conduct where the Respondent sought or realized commercial gain, by creating a likelihood of confusion with the Complainant's trademarks especially noting that the Complainant also owns the domain name <lancomecosmetics.com> and impersonating an official reseller of the Complainant clearly indicates the Respondent's bad faith.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: sale of alleged counterfeit goods or illegal pharmaceuticals, impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

At present, the disputed domain name resolves to an inactive website. Panels have found that the current non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 name <lancome-cosmetics.com> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: May 20, 2024