

ADMINISTRATIVE PANEL DECISION

Clarins v. Privacy Service Provided by Withheld for Privacy ehf / Do Thanh Luan, Lilla Group
Case No. D2022-1178

1. The Parties

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Do Thanh Luan, Lilla Group, Viet Nam.

2. The Domain Names and Registrar

The disputed domain names <clarins-th.com> and <clarins-th.net> are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 5, 2022. On April 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 5, 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 April 6, 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 on April 11, 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 April 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 5, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on May 10, 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, based in France, is a major international company in the cosmetics and make-up sector and has operated for approximately 60 years under the CLARINS mark. It owns numerous trade mark registrations internationally for CLARINS including French trade mark registration no. 1637194, registered on January 7, 1991, and Thai trade mark registration no. Kor76352 registered on March 24, 1988. The Complainant operates various domain names that incorporate its CLARINS mark and which resolve to websites promoting the Complainant's CLARINS products. These include <clarins.com>, registered on March 16, 1997, and <clarins.co.th>, registered on May 21, 2013.

The disputed domain names are both registered in the name of the same privacy service and the Registrar verification confirmed that they are both owned by the Respondent based in Viet Nam. The disputed domain name <clarins-th.net> was registered on December 6, 2021, and the disputed domain name <clarins-th.com> was registered on November 30, 2021. At the time of the filing of the Complaint, each of the disputed domain names resolve to a separate website that purportedly advertises or offers products for sale under the CLARINS mark, features the CLARINS red cartridge device mark and appears to offer for sale in Thai the CLARINS Double Serum product. At the time of the decision, the disputed domain names resolve to inactive websites.

5. Parties' Contentions

A. Complainant

The Complainant submits that it owns registered trade mark rights for the CLARINS mark as set out above. It says that each of the disputed domain names wholly incorporate the CLARINS word mark and each is therefore confusingly similar to the Complainant's registered trade mark rights. According to the Complainant, the addition of the geographic reference "-th" does not prevent a finding of confusing similarity under the Policy.

The Complainant submits that the Respondent is not affiliated with the Complainant and has never been authorised to use or register the CLARINS name or mark or to use it in a domain name. The Complainant has submitted evidence of trade mark database searches indicating that the Respondent does not own any trade mark registrations for CLARINS. Neither, says the Complainant, is the Respondent making a noncommercial or fair use of either of the disputed domain names since they are used in relation to websites which promote or offer for sale the Complainant's Double Serum product under the Complainant's CLARINS mark and all without the Complainant's authority. The Complainant notes that both websites reproduce, without authorisation, the Complainant's trade mark, its red cartridge device mark including the CLARINS word mark and says the Complainant, promote or offer for sale infringing examples of the Complainant's CLARINS Double Serum product. The Complainant also asserts that the Respondent is using the disputed domain name <clarins-th.com> to obtain personal information from consumers through forms on the website.

The fundamental assertion of the Complainant is that the Respondent registered and is using each of the disputed domain names to divert Internet users from the Complainant's real and official websites to its own websites for its own commercial gain by taking unfair advantage of the goodwill and reputation attaching to the Complainant's CLARINS trade mark. This says the Complainant is not legitimate conduct and is in bad faith and therefore the Respondent has no rights or legitimate interests in either of the disputed domain names.

The Complainant notes that it has used the CLARINS mark in France and internationally for 60 years, long before the registration of each of the disputed domain names in 2021. It says that its mark is well known worldwide and was so at the respective date of registration of each of the disputed domain names and for these reasons and as set out below, the Respondent must have been aware of the Complainant's CLARINS mark when it registered each of the disputed domain names.

As far as use in bad faith is concerned, the Complainant submits that the numerous similarities between the websites at each of the disputed domain names, together with the use of the CLARINS mark and red cylinder device mark on each of them is no coincidence and is indicative of the Respondent knowingly using each of the disputed domain names in bad faith for the purpose of creating a likelihood of confusion with the Complainant's trade mark in order to divert Internet users and to confuse them as to the source, sponsorship or affiliation of the disputed domain names and of the websites to which they each resolve. The Complainant says that the Respondent gains click through commissions from such diversion and that this amounts to use in bad faith of each of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns registered trade mark rights in various countries for its CLARINS trade mark including the French trade mark registration no. 1637194 registered on January 7, 1991 and Thai trade mark registration number Kor76352 registered on March 24, 1988. Each of the disputed domain names wholly incorporate the CLARINS word mark and the Panel therefore finds that each of them is confusingly similar to the Complainant's registered trade mark rights for CLARINS. The addition of "-th" (which appears to be a geographic reference for Thailand) does not prevent a finding of confusing similarity. As a result, the Panel finds that each of the disputed domain names is confusingly similar to the Complainant's registered CLARINS mark and that the Complaint therefore succeeds under the first element of the Policy.

B. Rights or Legitimate Interests

The Complainant's CLARINS mark is very well reputed in many countries as a consequence of long use in relation to its cosmetic and skincare products. The Complainant has submitted that the Respondent is using its marks without authority, that he is not affiliated with the Complainant and has never been authorised to use or to register the CLARINS name or mark or to use it in a domain name. The Complainant has also submitted evidence of trade mark database searches which suggest that the Respondent does not own any trade mark registrations for CLARINS.

Based on the evidence of the respective websites to which the disputed domain names resolve, it is apparent that they have each been used to promote or offer for sale to a Thai speaking audience the Complainant's Double Serum product under the Complainant's CLARINS mark and using its distinctive red cartridge mark as if the website belonged to, or was authorised by, the Complainant when no such authority has been given. This is neither a noncommercial nor a fair use of each of the disputed domain names. Neither is it *bona fide* or legitimate conduct for the Respondent to use each of the disputed domain names to confuse and divert Internet users seeking the Complainant's website to its own websites which masquerade as if they belong to, or are affiliated with, the Complainant for its own commercial gain by taking unfair advantage of the goodwill and reputation attaching to the Complainant's CLARINS trade mark. This says the Complainant is not legitimate conduct and is in bad faith and therefore the Respondent has no rights or legitimate interests in either of the disputed domain names.

On this basis, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in either of the disputed domain names. The Respondent has failed to respond to or to rebut the Complainant's case and the Panel accordingly finds that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The Complainant's CLARINS mark is very well reputed in France and internationally as a consequence of long use and promotion well before the registration of each of the disputed domain names in 2021. The CLARINS mark is also highly distinctive and these findings, coupled with the fact that the Respondent has used the CLARINS red cylinder device on the websites to which each of the disputed domain names resolve, together with representations of the Complainant's Double Serum product, is a very strong indicator that the Respondent was very well aware of the Complainant's CLARINS mark when it registered each of the disputed domain names.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of a disputed domain name in bad faith where a respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

It is apparent, as described above, that the Respondent has intentionally used each of the disputed domain names to resolve to a website that uses representations of the CLARINS mark and of the Complainant's red cylinder mark and of the CLARINS Double Serum product in an effort to attract Internet users and to confuse them into thinking that each website belongs to, or is authorised by, the Complainant. It appears that the Respondent has done this either with a view to selling unauthorised or infringing CLARINS products to consumers, or to obtain click through revenue commissions or possibly to obtain personal information when unsuspecting consumers complete forms on the site. In any event, it is clear that the Respondent has attempted to masquerade on each website as if it is the Complainant or has the right to use the Complainant's marks and to sell its products, for its own commercial purposes and that this conduct amounts to use in bad faith.

In the circumstances, the use of a privacy service to conceal the identity of the registrant of each of the disputed domain names only further affirms the Panel's view of the Respondent's bad faith.

Accordingly, the Panel finds that both of the disputed domain names have been registered and used in bad faith and that the Complaint also succeeds under this 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 names <clarins-th.com> and <clarins-th.net> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: May 24, 2022