

ADMINISTRATIVE PANEL DECISION

Deciem Beauty Group Inc. v. 曾祥和 (cengxianghe)
Case No. D2022-4387

1. The Parties

The Complainant is Deciem Beauty Group Inc., Canada, represented by Gowling WLG (Canada) LLP, Canada.

The Respondent is 曾祥和 (cengxianghe), China.

2. The Domain Name and Registrar

The disputed domain name <theordinaryasia.com> (the “Disputed Domain Name”) is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 17, 2022. On November 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 22, 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 November 22, 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 amendment to the Complaint in English on November 30, 2022.

On November 22, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant requested that English be the language of the proceeding on November 30, 2022. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment to the 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 Chinese of the Complaint, and the proceedings commenced on December 5, 2022. In accordance with

the Rules, paragraph 5, the due date for Response was December 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 27, 2022.

The Center appointed Peter J. Dernbach as the sole panelist in this matter on January 5, 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 the Rules, paragraph 7.

4. Factual Background

The Complainant is a skin care and beauty company headquartered in Canada with brands including THE ORDINARY. Since its launch in 2013, the Complainant has more than 50 products sold in markets and its products have been promoted and sold around the world.

The Complainant is the owner of THE ORDINARY series trademarks in many jurisdictions, including:

- China trademark THE ORDINARY, registration number 21258391, registered since November 14, 2017;
- China trademark THE ORDINARY, registration number 29262142, registered since January 14, 2019;
- United States of America trademark THE ORDINARY, registration number 5203537, registered since May 16, 2017;
- European Union Trade Mark THE ORDINARY, number 015761182, registered since December 8, 2016;
- Hong Kong, China trademark THE ORDINARY, registration number 303893987, registered since September 6, 2016; and
- Hong Kong, China trademark THE ORDINARY, registration number 305538150, registered since February 18, 2021.

The Disputed Domain Name <theordinaryasia.com> was registered on July 14, 2022 and the Disputed Domain Name resolves to an inactive website. However, an email address associated with the Disputed Domain Name was copied on a fraudulent email impersonating the Complainant sent by the Respondent from a different email address.

5. Parties' Contentions

A. Complainant

The Complainant's submissions may be summarized as follows:

- (i) The Disputed Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The Complainant is the owner of THE ORDINARY trademark. The Complainant argues that the Disputed Domain Name is confusingly similar to its THE ORDINARY trademark as the Disputed Domain Name incorporates the Complainant's THE ORDINARY trademark in its entirety. The addition of the generic Top-Level Domain ("gTLD") is without legal significance in determining the issue of similarity. Furthermore, the inclusion of the term "asia" does not diminish confusion but rather enhances the confusion between the Complainant's registered THE ORDINARY trademark and the Disputed Domain Name. When the Disputed

Domain Name is used as part of the email address, it would mislead the recipients into believing that the email emanates from a department of the Complainant that deals with Asian countries.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant argues that there is no evidence suggesting that the Respondent has ever used, or has demonstrated preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. There is no evidence suggesting that the Respondent has been commonly known by the Disputed Domain Name. In addition, there has never been any relationship between the Complainant and the Respondent, and the Respondent is not licensed or authorized by the Complainant to register or use the THE ORDINARY trademarks in any manner, including in, or as part of, a domain name.

The Complainant further argues that the Respondent registered the Disputed Domain Name as part of a fraudulent scheme to secure permission to sell the Complainant's goods on online marketplace platforms. By using the Disputed Domain Name as part of an email address, the Respondent creates the false impression that the email was copied to the Complainant. Thus, the Respondent's activities undermine any claim of rights in the Disputed Domain Name.

In light of the above, the Complainant concludes that the Respondent's activities do not correspond to any of the circumstances set forth in the Policy paragraph 4(c).

(iii) The Disputed Domain Name was registered and is being used in bad faith.

The Complainant argues that the Respondent knew of the Complainant's THE ORDINARY trademarks at the time of the registration of the Disputed Domain Name given the notoriety and highly distinctive nature of the Complainant's THE ORDINARY trademarks.

In addition, the Disputed Domain Name is being used in bad faith. The Respondent has been masquerading as the Complainant and providing fake authorizations to sell the Complainant's goods on online marketplace platforms by using the Disputed Domain Name in the email address. A marketplace platform has been misled and mistakenly believed that the Complainant had provided authorization to the account holder to sell its products. Although the Disputed Domain Name resolves to an inactive website, the Disputed Domain Name as a whole was designed to deceive end users as to source or sponsorship and the Respondent's use of the email address associated with the Disputed Domain Name in connection to the fraudulent scheme constitutes evidence of bad faith. Therefore, the Disputed Domain Name is being used in an attempt to intentionally attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

Paragraph 11(a) of the Rules provides that "[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

Paragraph 10(b) of the Rules provides that “[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case”; and paragraph 10(c) of the Rules provides that “[t]he Panel shall ensure that the administrative proceeding takes place with due expedition [...]”

The language of the Registration Agreement is Chinese, and the Complaint is filed in English. On November 22, 2022, the Center notified both Parties in English and Chinese that the language of the Registration Agreement is Chinese and invited both Parties to comment on the language of the proceeding. The Complainant submitted its request that the language of the proceeding be English on November 30, 2022, while the Respondent did not make any comments on the language of the proceeding and did not submit any arguments on the merits.

The Panel has considered the following elements of this case:

- (i) The Complainant’s request that the language of the proceeding be English;
- (ii) The Disputed Domain Name consists of English words only;
- (iii) The Respondent did not comment on the language of the proceeding and did not submit arguments on the merit;
- (iv) The fraudulent email from the Respondent was written in English, which suggests the Respondent is conversant in English; and
- (v) Using Chinese as the language of the proceeding could lead to unwarranted delay and costs for the Complainant and unnecessary delays to the administrative proceeding.

Given the above considerations, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

In accordance with paragraph 4(a) of the Policy, in order to succeed in this administrative proceeding and obtain the requested remedy (in this case, transfer of the Disputed Domain Name), the Complainant must prove that each of the three following 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 Complainant has established that it is the owner of valid trademark rights in the THE ORDINARY trademarks. The Disputed Domain Name is a combination the Complainant’s THE ORDINARY trademark, the word “asia”, and the gTLD “.com”. The Panel finds that the Disputed Domain Name incorporates the entirety of the Complainant’s THE ORDINARY trademark. The addition of the geographical term “asia” after the THE ORDINARY trademark does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s THE ORDINARY trademark.

As found in past UDRP decisions, gTLDs may generally be disregarded when evaluating the identity or confusing similarity between the disputed domain name and the complainant’s trademark. In the current case, the inclusion of the gTLD “.com” does not prevent the confusing similarity between the Disputed

Domain Name and the Complainant's THE ORDINARY trademark.

For the reasons above, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark, and the condition of paragraph 4(a)(i) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that [...] (ii) [the respondent has] no rights or legitimate interests in respect of the [disputed] domain name[.]”

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, the Disputed Domain Name, for the purposes of paragraph 4(a)(ii) of the Policy:

“(i) before any notice to [the respondent] of the dispute, [the respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or

(iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy, the Complainant is required to first establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. The burden of production would then shift to the Respondent to come forward with appropriate evidence demonstrating rights or legitimate interests in the Disputed Domain Names.

The Complainant states that it has neither licensed nor authorized the Respondent to register or use the Complainant's THE ORDINARY trademarks in any manner, including in, or as part of, a domain name. According to the information provided by the Registrar, the Respondent's name, “cengxianhe (曾祥和)”, does not appear to be related to the Disputed Domain Name. There is no evidence suggesting that the Disputed Domain Name is being used in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, and the burden of production shifts to the Respondent. The Respondent has not submitted any argument or evidence in response. Moreover, the Disputed Domain Name has been used in a fraudulent email scheme impersonating the Complainant. Such use can never confer rights or legitimate interests on the Respondent (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.13).

Therefore, the Panel concludes that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative dispute resolution service providers], in compliance with the Rules of Procedure, that [...] (iii) [the respondent's] domain name has been registered and is being used in bad faith.”

Paragraph 4(b) of the Policy explicitly states, in relevant part, that “the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] web site or other online 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 [the respondent’s] we site or location.

The Complainant’s THE ORDINARY trademarks have been registered in many jurisdictions around the world before the registration of the Disputed Domain Name. The Disputed Domain Name is confusingly similar to the Complainant’s THE ORDINARY trademarks and contain the Complainant’s trademark in its entirety. Moreover, the use of the Disputed Domain Name points to knowledge of the Complainant and its trademarks. The Panel therefore finds that the Disputed Domain Name has been registered in bad faith.

Although the Disputed Domain Name resolves to an inactive website, the Respondent has used the Disputed Domain Name as part of an email address in providing confirmation of authorization to sell the Complainant’s goods on online marketplace platforms. According to the email provided by the Complainant, the Respondent has used the Disputed Domain Name in connection with the Complainant’s other trademarks and the personal information of one of the Complainant’s employees to create the false impression that the Respondent is associated with the Complainant. A third party has been misled and mistakenly believed that the authorization was provided by the Complainant. This further demonstrates that the Respondent’s use of the email address associated with the Disputed Domain Name in the furtherance of a fraudulent scheme constitutes evidence of use of the Disputed Domain Name in bad faith. The Panel therefore finds that by using the Disputed Domain Name, the Respondent intentionally attempted to attract, for commercial gain, Internet users, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation.

The Panel therefore finds that the Disputed Domain Name was registered and used in bad faith, and thus the condition of paragraph 4(a)(iii) of the Policy has been fulfilled.

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 <theordinaryasia.com> be transferred to the Complainant.

/Peter J. Dernbach/

Peter J. Dernbach

Sole Panelist

Date: January 19, 2023