

ADMINISTRATIVE PANEL DECISION

Noxell Corporation v. Zhou Zaoliang
Case No. D2022-4670

1. The Parties

The Complainant is Noxell Corporation, United States of America (“U.S.”), represented by Studio Barbero S.p.A., Italy.

The Respondent is Zhou Zaoliang, China.

2. The Domain Name and Registrar

The disputed domain name <mx-factor.com> (the “Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2022. On December 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 7, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 December 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 5, 2023.

The Center appointed Karen Fong as the sole panelist in this matter on January 25, 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 U.S. company and a subsidiary of Coty Inc., which in 2015 purchased some beauty brands, including MAX FACTOR from Procter & Gamble. The MAX FACTOR line of cosmetics has its origins back in the early 20th century.

The Complainant is the owner of several trade mark registrations worldwide for MAX FACTOR including European Union registration No. 000273730 (registered on October 6, 1998); U.S. registration No. 1373314 (registered on December 3, 1985); and Chinese registration No. 147016 (registered on May 30, 1981) (individually and collectively, the "Trade Mark").

The MAX FACTOR trade mark has been used by the Complainant or its predecessors for more than 100 years in connection with beauty care and cosmetic products. It has been used in China, where the Respondent is *prima facie* based, since 1980. The MAX FACTOR brand is widely promoted and has a strong presence online through social media. The Complainant has registered numerous domain names worldwide consisting of or comprising the mark MAX FACTOR including, amongst others <maxfactor.com> and <maxfactor.cn> registered on August 25, 1995 and May 31, 2010, respectively. The Complainant's main website for the MAX FACTOR brand is at "www.maxfactor.com".

The Respondent registered the Domain Name on November 28, 2020. At the time the Complainant became aware of the Domain Name and until recently, it resolved to a website in Chinese displaying, without any disclaimer of non-affiliation with, or authorization from the Complainant, the Trade Mark, the Complainant's official images from its website, and offered for sale MAX FACTOR products at discounted prices (the "Website").

The Complainant's representative wrote a number of cease and desist letters (and reminders) to the Respondent using the varying contact information available to it; the Respondent had changed its contact information on a number of occasions following the sending of the cease and desist letters. The Respondent did not respond to these letters. The Respondent also changed hosting providers several times following deactivation of the Website by these providers upon requests by the Complainant. The Website was deactivated and reactivated a number of times but at the time of writing the decision, the Domain Name resolves to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name was registered and is being used in bad faith. The Complainant requests transfer of the Domain Name to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. General

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

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

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established that it has registered rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case, the Domain Name contains the Trade Mark in its entirety except for a missing “a” in the first word “max” and a hyphen between the two words comprising the Trade Mark. It is well established that domain names which consist of a common, obvious, or intentional misspelling of a trade mark are considered to be confusingly similar to the relevant mark for the purposes of the first element. This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark (see section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). This is a typical typosquatting case as the Trade Mark is clearly recognisable within the Domain Name.

For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain (“gTLD”) which in this case is “.com”. It is viewed as a standard registration requirement (section 1.11.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Domain Name is confusingly similar to the Trade Mark in which the Complainant has rights, and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trade mark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established that, as it is put in section 2.1 of [WIPO Overview 3.0](#), a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made out, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with relevant evidence of rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that the Respondent has not at any time been commonly known by the Domain Name. Further, the Respondent does not appear to hold any trade mark rights to the Domain Name. The offer for sale of discounted goods which appear to bear the Trade Mark on the Website suggests a connection, sponsorship, or endorsement by the Complainant, when this is not the case, and as such cannot be considered as legitimate noncommercial use or fair use.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Name.

The Panel notes the lack of any clarifying statement as to the Website's affiliation, or lack thereof, to the Complainant. This further reinforces the Panel's finding that such use cannot constitute fair use. Generally, the act of impersonating or selling heavily discounted goods indicates that the goods are highly likely to be counterfeit goods. Such acts can never confer rights or legitimate interests on the Respondent. See section 2.13 of the [WIPO Overview 3.0](#).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. The fact that the Domain Name does not currently resolve to an active website does not obviate the Panel's finding of lack of rights or legitimate interests.

In all the circumstances, the Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

To succeed under the Policy, the Complainant must show that the Domain Name has been both registered and used in bad faith. It is a double requirement.

The Panel is satisfied that the Respondent was aware of the Trade Mark when it registered the Domain Name, given the reputation of the Trade Mark and the fact that it was registered substantially prior to the registration of the Domain Name. The very incorporation of the Trade Mark in the Domain Name, use of images bearing the Complainant's goods, the display of the Trade Mark and the offer for sale of most likely non-genuine MAX FACTOR products on the Website, confirm the Respondent's awareness of the Trade Mark. It is therefore implausible that the Respondent was unaware of the Complainant when it registered the Domain Name.

[WIPO Overview 3.0](#), section 3.2.2, states as follows:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

The above together with the fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the Domain Name are also significant factors to consider. The Panel finds that the Respondent's registration is in bad faith.

The Panel also finds that the actual use of the Domain Name is in bad faith. The products offered for sale on the Website are likely to be counterfeit MAX FACTOR products considering the discounted prices and the fact that there is no relationship between the Parties. The use by a respondent of a domain name which includes a well-known trade mark to resolve to a website which offers and sells counterfeit products under that trade mark is evidence of bad faith registration and use. (See *Burberry Limited v. Jonathan Schefren*, WIPO Case No. [D2008-1546](#); and *Prada S.A. v. Domains for Life*, WIPO Case No. [D2004-1019](#)).

The content of the Website is calculated to give the impression that it has been authorised by or connected to the Complainant when this is not the case. The Website was set up to deliberately mislead Internet users that it is connected to, authorised by, or affiliated with the Complainant. From the above, the Panel concludes that the Respondent intentionally attempted to attract, for commercial gain, by misleading Internet users into believing that the Website is and the products sold on it are those authorised or endorsed by the Complainant.

In addition to the above, the Respondent has a record of registering domain names which correspond to the marks of third party brand owners in the cosmetics field. The Respondent has also been involved in another UDRP case against the Complainant which had resulted in an order for the domain name to be transferred (*Noxell Corporation v. Zhouzaoliang*, WIPO Case No. [D2020-2463](#)). The above is an indication that the Respondent is engaged in a pattern of bad faith conduct (section 3.1.2 of [WIPO Overview 3.0](#)).

The Panel therefore concludes that the Domain Name was registered and has been used in bad faith under paragraphs 4(b)(ii) and (iv) of the Policy. The current non-use of the Domain Name does not change the Panel's finding of the Respondent's bad faith.

In all the circumstances, the Panel finds that the Complainant has fulfilled 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 Domain Name, <mx-factor.com>, be transferred to the Complainant.

/Karen Fong/

Karen Fong

Sole Panelist

Date: February 24, 2023