

ADMINISTRATIVE PANEL DECISION

Noxell Corporation v. wei zhang, hope
Case No. D2022-4673

1. The Parties

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

The Respondent is wei zhang, hope, China.

2. The Domain Name and Registrar

The disputed domain name <maxfactorchina.com> (the “Domain Name”) is registered with Network

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2022. On December 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 9, 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 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 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 5, 2023.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on January 17, 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 trademark registrations worldwide for MAX FACTOR including European Union registration No. 000273730 (word mark, registered on October 6, 1998), U.S. trademark registration No. 1373314 (word mark, registered on December 3, 1985) and Chinese trademark registration No. 147016 (word mark, registered on May 30, 1981), Chinese trademark registration No. 11747641 (stylized, registered on April 28, 2014) and Chinese trademark registration No. 10800903 (stylized, registered on July 14, 2013).

The MAX FACTOR trademark 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 Complainant's parent company, Coty Inc., 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 principal website dedicated to the MAX FACTOR brand is at "www.maxfactor.com", to which most of its domain names are redirected and that generates a significant number of visits by Internet users.

The Domain Name was registered on January 21, 2014. When the Complainant became aware of the Domain Name, it was redirected to a webpage, where the Domain Name was offered for sale without specifying the consideration of interest. At the time of the Complaint and the present Decision, the Domain Name is redirected to an error page.

The Complainant's representative wrote a number of cease and desist letters (and reminders) using the varying contact information available at the time indicated in the public WhoIs records as well as to the email address published on the website to which the Domain Name resolved. All communication remained unanswered.

5. Parties' Contentions

A. Complainant

The following is a brief summary of the main assertions of the Complainant.

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Domain Name incorporates the entire trademark, with the mere addition of the geographical term "china", which does not affect the confusing similarity. A domain name that wholly incorporates a trademark, in particular one as famous as MAX FACTOR, should be found to be confusingly similar for the purposes of the Policy, despite the fact that it may also contain, after the trademark, a generic or geographic term such as "china". In fact, the geographic term "china" is particularly apt to increase the likelihood of confusion and to induce Internet users to reach the website and believe that there is an association or affiliation with the Complainant.

The generic Top-Level Domain ("gTLD") ".com" is merely instrumental to the use of the Internet, so the Domain Name remains confusingly similar despite its inclusion.

The Respondent has no rights or legitimate interests in respect of the Domain Name.

The Respondent is not a licensee, an authorized agent or in any other way authorized to use the Complainant's MAX FACTOR trademark.

The mere registration of a domain name does not establish rights or legitimate interests.

The Complainant is not in possession of, nor aware of the existence of any evidence demonstrating that the Respondent, might be commonly known by a name corresponding to the Domain Name as an individual, business, or other organization.

The Respondent has not provided the Complainant with any evidence of use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services before or after any notice of the dispute herein. Moreover, there is no evidence that Respondent might have used the Domain Name in connection with a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

The Domain Name was originally redirected to a webpage, where the Domain Name was offered for sale and a phone number and an email address were indicated to contact the owner and request information as to the Domain Name. Such use clearly shows that the Respondent has never had any intention to use the Domain Name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use. The current redirection of the Domain Name to an error page cannot give rise to any possible rights or legitimate interests of the Respondent in view of the circumstances of this case.

In addition to the above, considering the distinctive and well-known character of the Complainant's trademark, encompassed in the Domain Name with the addition of geographic and non-distinctive element "china", the Domain Name carries a risk of an implied affiliation.

The Respondent did not reply to the merits of the cease and desist letters and subsequent reminders sent by the representative of the Complainant.

The Domain Name was registered and is being used in bad faith. Given the renown of the MAX FACTOR trademark worldwide, including in China where the Respondent is *prima facie* based, the Respondent was, when registering the Domain Name, undoubtedly aware of the existence of the Complainant's trademark and of the fact that the Domain Name was confusingly similar.

It should be noted that, notwithstanding the registration date of the Domain Name is January 21, 2014, the Domain Name was previously registered in the name of an individual or entity located in Hong Kong, China, and the first Whois showing the name of a Chinese individual is dated February 12, 2021. Therefore, the Complainant believes that the current Domain Name holder located in China, *i.e.*, the Respondent - which has changed several times its name and contact information after receipt of the Complainant's cease and desist letters - acquired the Domain Name only in 2021. However, should the current Domain Name holder be the registrant of the Domain Name since 2014, it would have anyway registered the Domain Name in bad faith, in view of the Complainant's prior registration and extensive use of its trademark MAX FACTOR incorporated in the Domain Name and the Respondent's consequent likely knowledge of such trademark. The mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Respondent registered the Domain Name with a clear intention of targeting the Complainant's trademark.

As to the bad faith use, the Domain Name was previously pointed to a webpage where the Domain Name was offered for sale and an email address and a phone number were provided to contact the Domain Name holder. Such use of the Domain Name confirms the Respondent's intention to derive profits from the sale of

the Domain Name, in all likelihood to the Complainant.

Even though the Domain Name presently points to an inactive website, this does not in itself prevent a finding that it is used in bad faith for the purposes of the Policy. In view of i) the confusingly similarity of the Domain Name with the Complainant's well-known trademark MAX FACTOR, ii) the Respondent's lack of any rights or legitimate interests in the Domain Name, and iii) the implausibility of any good faith use to which the Domain Name may be put, the Respondent's passive holding should not prevent a finding of bad faith use.

A respondent's failure to reply to cease and desist letters has also been taken into account in considering bad faith under the Policy.

Lastly, it should be noted that, following the receipt of the Complainant's cease and desist letter, the Respondent has changed several times its contact details in the public Whois records and has always indicated *prima facie* incomplete addresses located in China.

The Complainant requests that the Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark MAX FACTOR based on the trademark registrations cited under section 4 above.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain name to assess whether the trademark is recognizable within the disputed domain name (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Moreover, as found in a number of prior cases decided under the Policy and indicated in section 1.8 of the [WIPO Overview 3.0](#), where a trademark is recognizable within a domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

Furthermore, the Top-Level Domain ("TLD") is commonly disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

In the case at hand, the Complainant's trademark MAX FACTOR is entirely reproduced and clearly recognizable in the Domain Name. The mere addition of the geographical term "china" does not prevent a finding of confusing similarity.

Therefore, the Panel finds that the Complainant has proven that the Domain Name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since "proving a negative" can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the complainant show a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the respondent. If the respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not having submitted a Response, has failed to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy. Moreover, it has been repeatedly stated that when a respondent does not avail itself of its right to respond to a complaint, it can be assumed in appropriate circumstances that the respondent has no rights or legitimate interests in the disputed domain name.

There is no indication before the Panel that the Respondent is commonly known by the Domain Name or a name corresponding to the Domain Name.

In addition, the composition of the Domain Name, comprising the Complainant's distinctive and well-known trademark with the only addition of the geographic term "china", carries a risk of an implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Domain Name was originally redirected to a webpage, where it was offered for sale with contact information of the owner or a broker. Such use clearly shows that the Respondent has no intention to use the Domain Name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use. The current redirection of the Domain Name to an error page cannot give rise to any possible rights or legitimate interests of the Respondent in view of the circumstances of this case, including the fact that this change of redirecting occurred after the cease and desist letters were sent. The Respondent did not reply to the merits of these cease and desist letters sent by the representative of the Complainant, nor has the Respondent replied to this Complaint.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the Domain Name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the Domain Name was registered and is being used by the Respondent in bad faith.

One way a complainant may demonstrate bad faith registration and use, as envisaged by the non-exhaustive list of circumstances in paragraph 4(b) of the Policy, is to show that a respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant or to a competitor of the complainant, for valuable consideration in excess of the out-of-pocket costs directly related to the domain name.

The Complainant asserts that the Respondent acquired the Domain Name in 2021. According to the historical Whois information provided by the Complainant, the registrant information was changed to the Respondent's name sometime between May 31, 2022 and October 2, 2022. The Panel finds that it has no

material impact on this case whether or not the Respondent registered the Domain Name in 2014 or at a later date because the Complainant's MAX FACTOR trademark was registered long before 2014.

Given the dominant element - which is of course the Complainant's well-known MAX FACTOR trademark - in combination with term "china", where the Respondent is located, the Respondent was more likely than not aware of the Complainant's trademark at the time of the registration of the Domain Name.

Section 3.1.4 of the [WIPO Overview 3.0](#) states that "the mere registration of a domain name that is identical or confusingly similar (particularly domain name comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith".

By offering the Domain Name for sale it can be fairly readily assumed that the Respondent intended to gain (or had the opportunity to gain) some commercial benefit from the Domain Name.

The Domain Name is also ideally suited to misleading the public. The composition of the Domain Name suggests that the Domain Name redirects to a website of the Complainant, or a corporation associated with it, in China. The Respondent has sought to create a misleading impression of association with the Complainant.

For the sake of completeness however, and given the Domain Name now resolves to an inactive webpage, the Panel should also deal with the doctrine of passive holding. A passive holding (or non-use) of a domain name does not prevent a finding of bad faith. As section 3.3 of the [WIPO Overview 3.0](#) states, panels must "look at the totality of the circumstances in each case" and "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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put". There is no shortage of reasons to justify a finding of bad faith in this proceeding under the passive holding doctrine, particularly noting the well-known nature of the Complainant's MAX FACTOR trademark, and the implausibility of any good faith use to which the Domain Name may be put.

Given these circumstances and the facts that the Respondent failed to submit a response or to provide any evidence of actual or contemplated good-faith use, including failing to respond to the Complainant's cease and desist letters, the Panel is left to conclude that the Respondent's use of the Domain Name is also in bad faith.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the Domain Name in bad faith according to 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 <maxfactorchina.com> be transferred to the Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: January 30, 2023