

## **ADMINISTRATIVE PANEL DECISION**

Deciem Beauty Group Inc. v. Mikhail Dmitruk  
Case No. D2023-0865

### **1. The Parties**

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

The Respondent is Mikhail Dmitruk, Russian Federation.

### **2. The Domain Name and Registrar**

The disputed domain name <the-ordinary.net> is registered with Registrar of Domain Names REG.RU LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on February 25, 2023. On February 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 28, 2023, 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 March 3, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same date, the Center sent a document to the Parties in English and Russian in relation to the language of the proceeding. On March 14, 2023, the Complainant filed an amendment to the Complaint and requested that English be the language of the proceeding. The Respondent sent two informal communications in English to the Center on March 3 and 17, 2023, and did not make any comments in relation to 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 of the Complaint, and the proceedings commenced on March 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 6, 2023. The Respondent did not submit a formal Response.

Accordingly, the Center notified the Commencement of Panel Appointment Process on April 11, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on April 21, 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, launched in 2013. The Complainant submits that it offers more than 50 products in different markets around the world, and that its global sales of products under the brand THE ORDINARY exceed USD 1 billion.

The Complainant is the owner of the following trademark registrations for the brand “THE ORDINARY” (the “trademark THE ORDINARY”):

- the European Union Trade Mark THE ORDINARY with registration No. 015761182, registered on December 8, 2016 for goods in International Class 3;
- the United States trademark THE ORDINARY with registration No. 5203537, registered on May 16, 2017 for goods in International Class 3;
- the Russian Federation trademark THE ORDINARY with registration No. 646967, registered on March 5, 2018 for goods in International Class 3; and
- the Russian Federation trademark THE ORDINARY with registration No. 680163, registered on November 2, 2018 for services in International Class 35.

The Complainant is also the owner of the domain name <theordinary.com>, which resolves to the Complainant’s official website offering skincare and beauty cosmetic products.

The disputed domain name was registered on January 22, 2022. It currently redirects to a Russian language website at the domain name <the-ord.ru> where products under the trademark THE ORDINARY are being offered for sale. The website states that it is the official website for THE ORDINARY cosmetics in the Russian Federation.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain name is confusingly similar to its trademark THE ORDINARY, which is incorporated entirely with the addition of a hyphen which does not affect the confusing similarity of the disputed domain name with the trademark.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by the disputed domain name, there has never been any relationship between the Parties, and the Respondent is not authorized to register or use the trademark THE ORDINARY in any manner, including in a domain name.

The Complainant maintains that the Respondent has never used the disputed domain name in connection with a *bona fide* offering of goods or services, but has engaged in the wholesale misappropriation of the trademark THE ORDINARY and of the Complainant’s copyrighted works through the registration and use of the disputed domain name and the associated website which sells the Complainant’s products and is designed to mislead visitors into believing that the Respondent is authorized by the Complainant. The

Complainant points out that the Respondent falsely declares on this website that “We are the official distributor of The Ordinary brand in Russia”, while the “About Us” section of the website refers not to the Respondent’s own company, but to the Complainant’s, and indicates a contact email address containing the disputed domain name. The Complainant adds that the Respondent’s website includes a forged letter in the name of the Complainant’s authorized dealer in Poland, whereby the Respondent is fraudulently confirmed to be a commercial partner of that dealer.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the Respondent passes itself off as the Complainant and competes with it through the website at the disputed domain name. According to the Complainant, the use of the disputed domain name is disruptive to its business, as potential consumers are likely be misled into believing that the Respondent is somehow affiliated with or sponsored by the Complainant. The Complainant maintains that the purpose of the registration and use of the disputed domain name was to piggyback on the goodwill associated with its trademark THE ORDINARY to attract, for commercial gain, Internet traffic properly destined for the Complainant.

## **B. Respondent**

The Respondent did not formally reply to the Complainant’s contentions.

With its informal emails to the Center, the Respondent made only the following statements:

“We will delete the-ordinary.net domain” (email of March 3, 2023); and

“we have deactivated the domain” (email of March 14, 2023).

## **6. Discussion and Findings**

### **6.1. Procedural issue - Language of Proceedings**

The Complainant requests that English be the language of the proceeding. It points out that the disputed domain name contains only English words and submits that the selection of Russian as the language of the proceeding would cause undue delay and burden it with translation expenses. The Complainant adds that the Respondent would not be prejudiced if the proceeding was conducted in English.

According to the information provided by the Registrar, the language of the Registration Agreement for the disputed domain name is Russian. Under paragraph 11 of the Rules, unless 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.

The Center has sent all its communications to the Parties in both English and Russian and has invited them to express their views on the language of the proceeding. The Respondent has not submitted a Response or any objections to the Complainant’s request that the proceedings be held in English. Notably, it has sent two informal communications in English.

The above satisfies the Panel that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient.

Therefore, in exercise of its powers under paragraph 11 of the Rules, the Panel decides that the language of this administrative proceeding be English.

## 6.2. Substantive issues

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]”

The Respondent however did not submit a formal Response in this proceeding and did not address the Complainant’s statements.

### A. Identical or Confusingly Similar

The Complainant has provided evidence that it is the owner of the trademark THE ORDINARY and has thus established its trademark rights for the purposes of the Policy.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the generic Top-Level Domain (“gTLD”) for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel sees no reason not to follow the same approach here, so it will disregard the “.net” gTLD of the disputed domain name.

The relevant part of the disputed domain name is the sequence “the-ordinary”, which reproduces the trademark THE ORDINARY in its entirety with the addition of a hyphen. The trademark is easily recognizable in the disputed domain name. As discussed in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the trademark THE ORDINARY in which the Complainant has rights.

### B. Rights or Legitimate Interests

While 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 often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, as it was not authorized by the Complainant to use its trademark THE ORDINARY and is not using the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, the Respondent is using the disputed domain name in relation to a website that offers the Complainant's products and prominently features the trademark THE ORDINARY while falsely claiming being the official distributor of the Complainant's products for the Russian Federation. The Complainant adds that the Respondent's website also includes a forged letter from the Complainant's distributor in Poland, which falsely confirms the Respondent's affiliation to it. Thus, 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 alleged that it has rights and legitimate interests in the disputed domain name and has not disputed the Complainant's allegations in this proceeding. Rather, in its informal emails to the Center, the Respondent has confirmed that it was ready to cancel the registration of the disputed domain name or that it has already cancelled it.

The disputed domain name is confusingly similar to the trademark THE ORDINARY, which was registered several years before it, including in the Russian Federation, where the Respondent is located. The evidence in the case file confirms that it resolves to a Russian language website that features the Complainant's products, includes the trademark THE ORDINARY of the Complainant and contains a statement that it is the official distributor of the Complainant's products in the Russian Federation. This makes it likely that Internet users may regard the disputed domain name as being an official online location offering the Complainant's products for the Russian market.

On the basis of the above, the Panel is satisfied that the Respondent is well aware of the goodwill of the Complainant's THE ORDINARY trademark and is likely to have registered and used the disputed domain name in an attempt to exploit this goodwill to attract the attention of Internet users and to mislead them that the disputed domain name and the associated website represent an official online location approved by the Complainant for the sale of its products under the trademark THE ORDINARY, without disclosing the lack of any relationship with the Complainant. In the Panel's view, such conduct does not appear to be legitimate and giving rise to rights and legitimate interests of the Respondent in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The provisions of paragraph 4(b) of the Policy are without limitation, and bad faith registration and use may be found on grounds otherwise satisfactory to the Panel.

As discussed above, the disputed domain name is confusingly similar to the Complainant's trademark THE ORDINARY, which was registered in the Russian Federation, where the Respondent is located, several years before the registration of the disputed domain name. The Respondent does not deny that the associated website features the Complainant's products for which the trademark THE ORDINARY is registered and displays this trademark, while claiming that it is the official distributor of the Complainant for the Russian market.

In view of the above, the Panel accepts that the Respondent is likely to have registered the disputed domain name with knowledge of the Complainant and targeting its THE ORDINARY trademark in an attempt to attract traffic to the disputed domain name by confusing Internet users that they are reaching an official online location of the Complainant. The website at the disputed domain name may further confuse Internet users that it is an official or an authorized online location offering the Complainant's products. This supports a finding that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website at the disputed domain name, by creating a likelihood of confusion with the Complainant's THE ORDINARY trademark as to the affiliation or endorsement by the Complainant of the Respondent's website and of the products offered on it.

Therefore, the Panel finds that the disputed domain name was registered and is being used in bad faith.

## **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 <the-ordinary.net> be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: April 27, 2023