

## **ADMINISTRATIVE PANEL DECISION**

OBAGI Holdings Company Limited v. nguyen van tu, van tu  
Case No. D2023-2824

### **1. The Parties**

The Complainant is OBAGI Holdings Company Limited, Cayman Islands, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is nguyen van tu, van tu, Viet Nam.

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

The disputed domain name <obagivn.site> is registered with GMO Internet Group, Inc. d/b/a Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 30, 2023. On July 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 4, 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 (GMO-Z.com RUNSYSTEM JSC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 8, 2023 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 in English on July 11, 2023.

On July 8, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 11, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on July 14, 2023. In accordance with paragraph 5 of the Rules, the due date for Response was August 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 4, 2023.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on August 24, 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 paragraph 7 of the Rules.

#### **4. Factual Background**

The Complainant, which was founded by leading skin care experts in 1988, is a global skincare products company rooted in research and skin biology.

The Complainant has registered its trademark OBAGI (the "OBAGI Trademark") in over 60 countries, including Viet Nam, as follows:

- International Registration No. 1495947A for the OBAGI Trademark, registered on July 31, 2019; and
- Viet Nam Trademark Registration No. 4-0106470-000 for the OBAGI Trademark, registered on August 4, 2008.

In addition, the Complainant operates the domain name <obagi.com>, which is used for its website to promote its products and services.

The disputed domain name was registered on September 11, 2022 and resolves to an active website seemingly offering cosmetics with the OBAGI Trademark in the Vietnamese language, at heavily discounted prices.

#### **5. Parties' Contentions**

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

The Complainant's contentions may be summarized as follows:

The additional term "VN" to OBAGI Trademark in the disputed domain name is causing likelihood of confusion for ordinary Internet users that the disputed domain name relates to the Complainant and its products. The generic Top-Level Domain ("gTLD") ".site" in the disputed domain name should be viewed as a standard registration requirement and disregarded. The Complainant has registered its first OBAGI Trademark more than 20 years ago and has been actively using it for almost 20 years, and hence the Complainant has gained global fame. Consequently, the public has learned to perceive the goods and services offered under the OBAGI Trademark as being those of the Complainant.

The Respondent is not affiliated with the Complainant in any way and has not been authorized by the Complainant to use and register its OBAGI Trademark or to seek registration of any domain name incorporating the OBAGI Trademark. The Respondent has not been commonly known by the name "OBAGI" nor "OBAGIVN". It cannot be inferred that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name due to the Respondent's clear intention of commercial gain by leading Internet users to believe that there is a business link between the Complainant and the Respondent and to free riding on the reputation of the Complainant and its well-known OBAGI Trademark.

It is implausible that the Respondent was unaware of the Complainant and its products when it registered the disputed domain name. The Respondent employs a privacy shield to prevent the Complainant and panel from knowing the identity of the actual registrant of the disputed domain name. There is little doubt in this case that, at all times, the Respondent was aware that OBAGI Trademark enjoys a substantial reputation worldwide, and especially in Viet Nam, since the Vietnamese language is exclusively used on the webpage associated with the disputed domain name. Furthermore, it is likely that the Respondent registered the disputed domain name in order to prevent the Complainant from using its OBAGI Trademark in the disputed domain name and specially to prevent the Complainant from registering the domain name corresponding to its OBAGI Trademark and company name in addition to the term "VN" with its specific meaning, within the gTLD ".site".

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise having regard to the circumstances of the administrative proceeding. The language of the Registration Agreement for the disputed domain name is Japanese.

However, the Complainant requests that English be the language of this proceeding with the reasons that the Complainant is a multinational company with English as a working language within the company and externally with all third parties, the Complainant's official website <obagi.com> is provided in English, the disputed domain name includes only Latin characters which strongly suggests that the Respondent has knowledge of languages other than Japanese, and English is the primary language for international relations and one of the working languages of the Center.

The Respondent had the opportunity to submit an objection to the Complainant's request to proceed in English of which the Center had notified the Parties by email both in English and Japanese. But the Respondent did not submit any comment on the language of the proceeding. The Center also notified the Respondent in English and Japanese of the commencement of the proceeding and indicated that the Respondent may file a Response in either English or Japanese. The Respondent chose not to file any Response.

Having regard to the circumstances of the administrative proceeding including that there is no indication that the Respondent is conversant with the Japanese language, the Panel decides that English should be the language of the proceeding.

### **6.2 Substantive Elements of the Policy**

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three 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 disputed domain name incorporates the Complainant's OBAGI Trademark in its entirety with the abbreviation "VN" corresponding to the ISO 3166-1 alpha-2 two letter country code for Viet Nam, and a gTLD ".site". The Complainant's OBAGI Trademark is clearly recognizable within the disputed domain name, and the addition of other terms, such as the term "VN", would not prevent a finding of confusing similarity. See section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The gTLD ".site" is viewed as a standard registration requirement. Thus, the gTLD ".site" in the disputed domain name may be disregarded in determining confusing similarity with the Complainant's OBAGI Trademark. See sections 1.11.1 and 1.11.2 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the OBAGI Trademark in which the Complainant has rights.

## **B. Rights or Legitimate Interests**

As the Complainant asserts, it can be said that the Respondent is neither commonly known by the name "OBAGI" or "OBAGIVN" nor affiliated with the Complainant nor authorized by the Complainant to register and use its OBAGI Trademark or to seek registration of any domain name incorporating the OBAGI Trademark.

The Respondent also did not demonstrate any use of the disputed domain name in connection with a *bona fide* offering of goods or services. The disputed domain name resolves to a website displaying what is purported to be an authorized OBAGI reseller or distributor, but the website seems to be a fake ecommerce site because most of the buttons on the website cannot be clicked. The Respondent is neither an official reseller, distributor nor representative of the Complainant. Therefore, the use of the Complainant's OBAGI Trademark on the website cannot be considered as a fair use.

Where the Complainant makes out a *prima facie* case that the Respondent lacks rights or legitimate interests, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the requirement of paragraph 4(a)(ii) of the Policy. See Section 2.1 of the [WIPO Overview 3.0](#).

Consequently, the Panel concludes that the Respondent has no rights or legitimate interests in respect to the disputed domain name.

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

The Complainant's OBAGI Trademark is well-known in the field of skincare products. Since the registration of the domain name <obagi.com> on January 26, 1998 predates the registration of the disputed domain by more than 24 years and a simple Google search using the keyword "OBAGI" shows that all the results on the first page relate to the Complainant's products, it is difficult to imagine that the Respondent did not have the Complainant in mind when registering the disputed domain name. Moreover, the fact that the Complainant's logo and the images of the Complainant's products were used on the website under the disputed domain name is the clear evidence that the Respondent knew the Complainant when registering and using the disputed domain name. By operating the website under the disputed domain name, the Respondent is considered to have intentionally attempted to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's OBAGI Trademark as to the source, sponsorship, affiliation, or endorsement of the website or of the Complainant's product or service in accordance with Paragraph 4(b)(iv) of Policy.

The pattern of abusive domain name registrations by the Respondent appeared on previous UDRP decisions ordering the Respondent to transfer its domain names (see *L'Oréal v. nguyen van tu, van tu*,

WIPO Case No. [D2023-0447](#); see also *NAOS v. nguyen van tu*, WIPO Case No. [D2023-1831](#)) suggests a clear intent of registration of the disputed domain name in bad faith.

According to the email correspondence filed by the Complainant, on June 5, 2023, the Complainant sent to the Respondent a Cease-and-Desist letter to the address indicated on the webpage to which the disputed domain name resolves, in order to try to reach an amicable solution and arrange the transfer of the disputed domain name. However, the Complainant was informed that the email could not be delivered, as the recipient was not found, most likely due to the fact that the email address does not exist, further indicating that false information was presented on the webpage to which the disputed domain name resolves. The Complainant proceeded by sending a request for revealing of the Respondent's identity to the Registrar in order to obtain the information needed to contact the Respondent. This communication was subsequently forwarded by the Registrar to their reseller, TENTEN.VN, who accepted to forward the Complainant's message to the Respondent, but no response was received from the Respondent before the filing of the Complaint. Thus, the Respondent must have used the disputed domain name in bad faith.

In view of the abovementioned circumstances, it is established that the Respondent both registered and is using the disputed domain name 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 <obagivn.site> be transferred to the Complainant.

*/Yuji Yamaguchi/*

**Yuji Yamaguchi**

Sole Panelist

Date: September 7, 2023