

## **ADMINISTRATIVE PANEL DECISION**

ZO Skin Health, Inc. v. Oleg Parashchenko  
Case No. D2023-3371

### **1. The Parties**

The Complainant is ZO Skin Health, Inc., United States of America (“United States”), represented by ZwillGen PLLC, United States.

The Respondent is Oleg Parashchenko, Ukraine.

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

The disputed domain name <zoskin.health> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 4, 2023. On August 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 7, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Redacted for Privacy, Privacy service provided by Withheld for Privacyehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 15, 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 on August 15, 2023.

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 August 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2023. The Response was filed with the Center on September 11, 2023.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on September 28, 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. Further Procedural Considerations**

Under paragraph 10(b) and 10(c) of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

The Respondent's mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification. Thus, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10(b) and 10(c) of the Rules, whether the proceeding should continue.

First, the Panel notes that the Complaint together with the amended to the Complaint were successfully delivered to the Respondent's email address, as provided by the Registrar.

Second, the Respondent has filed the Response with the Center on September 11, 2023. This further confirms that the Respondent has been effectively notified of the Complaint.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition. The Panel will proceed to a Decision accordingly.

#### **5. Factual Background**

The Complainant is a medical skincare company. It was first launched in 2006. Currently, the Complainant sells its products in over one hundred countries.

The Complainant is the owner of several ZO and ZO SKIN HEALTH Trademark registrations ("Trademarks"), including:

- the United States Trademark Registration for ZO (word) No. 4,688,942, registered on February 17, 2015;
- the United States Trademark Registration for ZO (design) No. 5,252,365, registered on July 25, 2017;
- the Russian Trademark Registration for ZO (design) No. 743071, registered on January 21, 2020; and
- the European Union Trade Mark for ZO SKIN HEALTH No. 008708711, registered on May 27, 2010.

The Domain Name was registered on June 18, 2022.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has resolved to an online shop in Russian purportedly selling the Complainant's products to Russian consumers (the "Website").

## 6. Parties' Contentions

### A. Complainant

The Complainant requests the transfer of the Domain Name. According to the Complainant, each of three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Name is confusingly similar to the Trademarks in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant submits that the Domain Name was registered and is being used in bad faith.

### B. Respondent

The Respondent submits that the Complainant's allegations in support of its claim constitute "false accusations". According to the Respondent, the Complainant has not provided any evidence to support this claim.

Moreover, the Respondent alleges that the products sold through the Website are not counterfeits of the Complainant's original products. They were purchased from an authorized representative of the Complainant in Russia.

## 7. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

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

The requested remedy may only be granted if the above criteria are met. At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

### A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid Trademarks. The Domain Name incorporates the ZO trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term “skin” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant’s ZO trademark. UDRP panels have consistently held that 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. See section 1.8, [WIPO Overview 3.0](#).

Moreover, the dominant feature of the ZO SKIN HEALTH trademark, namely the terms “zo” and “skin”, is recognizable in the Domain Name. UDRP panels have consistently held that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. See section 1.7, [WIPO Overview 3.0](#).

The Top-Level Domain (“TLD”) in the domain name is viewed as a standard registration requirement and as such is normally disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#). However, where the applicable TLD and the second-level portion of the domain name in combination contain the relevant trademark, panels may consider the domain name in its entirety for purposes of assessing confusing similarity. See section 1.11.3 of the [WIPO Overview 3.0](#). In the present case, the Domain Name contains the terms “zo” and “skin”, as well as the generic Top-Level Domain (“gTLD”) “health”, which together constitute the ZO SKIN HEALTH trademark in its entirety.

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant’s Trademarks. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

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

Under the second element, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the Domain Name, even if it has not acquired any trademark rights; or
- (iii) that it 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 trademark.

The Complainant’s Trademarks predate the Respondent’s registration of the Domain Name. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the Trademarks or to register the Domain Name incorporating these Trademarks. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a *bona fide* offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name. On the contrary, the Domain Name resolves to the Website which features the online shop offering the products bearing the Complainant’s Trademarks and displaying these Trademarks together with the Complainant’s official marketing materials.

The Respondent could make a *bona fide* offering of goods and services as a reseller or distributor of the Complainant’s products, and thus have a legitimate interest in the Domain Name, if this use meets certain requirements as set out in *Ok! Data Americas, Inc. v ASD, Inc.*, WIPO Case No. [D2001-0903](#). These requirements are that: (1) the Respondent must actually be offering the goods or services at issue; (2) the Respondent must use the Website to sell only the trademarked goods, otherwise, it could be using the

trademark to bait Internet users and then switch them to other goods; (3) the Website must accurately disclose the Respondents' relationship with the trademark owner; and (4) the Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in the Domain Name.

In the present case and despite the Respondent's allegations, not all of the above referred requirements are met.

The Domain Name and the Website suggest at least an affiliation with the Complainant and its Trademarks. The Panel believes that the use of the Complainant's Trademarks in the Domain Name and on the Website misleads consumers regarding the relationship between the Respondents and the Complainant, as Internet users may falsely believe that the Respondent is an official/endorsed distributor of the Complainant's products. At the same time, the relationship between the Respondent and the Complainant (or a lack thereof) is not disclosed on the Website. This further perpetuates the false impression of a relationship between the Respondent and the Complainant.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

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

Under the third element, the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1 of the [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the Trademarks predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's Trademarks at the time of registration. This finding is supported by the content of the Website offering the Complainant's products and displaying the Complainant's Trademarks together with the Complaint's official product images. Moreover, it has been proven to the Panel's satisfaction that the Complainant's Trademarks are well-known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of products under these Trademarks. In sum, the Respondent in all likelihood registered the

Domain Name with the expectation of taking advantage of the reputation of the Complainant's Trademarks. Furthermore, the Domain Names were being used in bad faith by the Respondent to offer for sale the Complainant's products. There is little doubt that the Respondent intended to earn profit from the confusion created with Internet users. In consequence, the Panel finds that the Respondent registered and used the Domain Name deliberately in order to take advantage of the Complainant's reputation and to give credibility to their operations.

Finally, the Respondent's use of privacy services that concealed registrant information is a further evidence of bad faith.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements under paragraph 4(a)(iii) of the Policy.

## **8. 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 <zoskin.health> be transferred to the Complainant.

*Piotr Nowaczyk*

**Piotr Nowaczyk**

Sole Panelist

Date: October 12, 2023