

## ADMINISTRATIVE PANEL DECISION

Ljulja Beauty Inc. d/b/a Makeup By Mario v. 李晓飞 (XiaoFei Li)  
Case No. D2023-4961

### 1. The Parties

The Complainant is Ljulja Beauty Inc. d/b/a Makeup By Mario, United States of America (“United States”), represented by Kelley Drye & Warren, LLP, United States.

The Respondent is 李晓飞 (XiaoFei Li), China.

### 2. The Domain Name and Registrar

The disputed domain name <makeupbymarios.com> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on November 29, 2023. On November 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 30, 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 (Registration Private) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 30, 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 December 4, 2023.

On November 30, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On December 7, 2023, the Complainant requested English to be 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 the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 11, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on January 16, 2024. 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**

Mario Dedivanovic, the Complainant's predecessor-in-interest and the namesake of the MAKEUP BY MARIO brand, is a globally renowned and influential makeup artist. In 2020, after 20 years in the industry as an innovative and leading makeup artist, Mr. Dedivanovic launched his namesake beauty brand, MAKEUP BY MARIO, consisting of high-quality formulas and easy-to-use products intended to recreate Mr. Dedivanovic's signature techniques and deliver an accessible luxury and professional makeup experience to consumers. The Complainant's goods and services are offered for sale via the Complainant's retail website, and via over 2,000 points of brick-and-mortar distribution.

The Complainant owns an international portfolio of registered trademarks for MAKEUP BY MARIO, including but not limited to United States Trademark Registration number 6222626, registered on December 15, 2020, and International Trademark Registration number 1487506, registered on May 11, 2019 and designating jurisdictions including the European Union and China. The Complainant also has a strong online presence, including through social media platforms, and owns and uses a portfolio of domain names including <makeupbymario.com>.

The disputed domain name was registered by the Respondent on October 27, 2023, and points to a website in English, featuring the Complainant's trademarks, images and text content taken from the Complainant's website, and offering for sale what are purported to be the Complainant's products.

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

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it is the owner of a number of registered trademarks consisting of MAKEUP BY MARIO (word marks and logo marks) and that it has a strong reputation for the products under this trademark. The Complainant asserts that the disputed domain name is confusingly similar to the abovementioned trademarks since it incorporates such marks in their entirety, adding only the geographical acronym "us", commonly standing for the United States. The Complainant essentially contends that the Respondent has linked the disputed domain name to an imposter website and offers counterfeit products via such website, and that the Respondent is impersonating the Complainant for undue commercial gain. The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name, and that such use made of the disputed domain name does not confer any rights or legitimate interests and that it proves that the Respondent is using it in bad faith.

##### **B. Respondent**

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

## 6. Discussion and Findings

### Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Respondent appears to be familiar with the English language as the disputed domain name includes the terms “makeup” and “by”, which are English words, and resolves to a website that displays content exclusively in English, the fact that the disputed domain name is in Latin letters and not in Chinese characters, and that the Complainant is not able to communicate in Chinese, and for this reason, the Complainant would incur substantial expenses for translation and the administrative proceedings would be unduly delayed.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

### A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the Complainant’s marks MAKEUP BY MARIO are clearly recognizable within the disputed domain name, since the disputed domain name fully incorporates these marks. Accordingly, the disputed domain name is confusingly similar to these marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of another term, here “us”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 domain names may result in the difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds 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 rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, upon review of the facts and evidence, the Panel notes that the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. Instead, upon review of the facts and the evidence submitted in this proceeding, the Panel notes that the disputed domain name directs to an active website which shows a clear intent on the part of the Respondent to misleadingly pass it off as the Complainant’s website, for commercial gain. In fact, said website prominently displays the Complainant’s trademarks and even uses some of the Complainant’s own product images and text content likely protected by copyright, thereby misleading consumers into believing that the Respondent is at least licensed by, or affiliated with the Complainant and/or its trademarks. Moreover, the Panel also accepts that, given the unclear origin, the lack of any accurate and prominent disclaimer and false suggestions of affiliation on the Respondent’s website, it is very likely that the products offered by the Respondent on such website are counterfeit products. Moreover, even if the products were legitimate products, it is clear to the Panel from the foregoing elements that the Respondent is not a good faith provider of goods or services under the disputed domain name, see also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and that there are no other circumstances conferring any rights or legitimate interests on the Respondent. Given the abovementioned elements, the Panel concludes that the Respondent’s use does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Given the intensive use, strong reputation of the Complainant’s prior registered trademarks, the Panel finds that the subsequent registration of the disputed domain name, which is confusingly similar to such marks, clearly and consciously targeted the Complainant’s prior registered trademarks. The Panel therefore deducts from the Respondent’s efforts to consciously target the Complainant’s reputable prior trademarks that the Respondent knew of the existence of the Complainant’s trademarks at the time of registering the disputed domain name. This finding is confirmed by the fact that the website linked to the disputed domain name is used to offer for sale presumably counterfeit products imitating the Complainant’s products, since this proves that the Respondent was fully aware of the Complainant’s business and its prior trademarks. In the Panel’s view, the foregoing elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directs to an active website which shows a clear intent on the part of the Respondent to misleadingly pass it off as the Complainant's website, displaying the Complainant's trademarks, some of its official product images and text content (thereby likely violating the Complainant's copyrights), and offering products for sale that are likely counterfeit products. The Panel concludes from these facts that the Respondent is intentionally attracting Internet users for commercial gain to such website, by creating consumer confusion between the website associated with the disputed domain name and the Complainant's trademarks. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. The Panel therefore finds that it has been demonstrated that the Respondent has used and is using the disputed domain name in bad faith.

The Panel finds that the Complainant has established the third element 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 disputed domain name <makeupbymarious.com> be transferred to the Complainant.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: January 19, 2024