

## **ADMINISTRATIVE PANEL DECISION**

The Procter & Gamble Company v. Le Van Phu  
Case No. D2023-5047

### **1. The Parties**

The Complainant is The Procter & Gamble Company, United States of America (“United States”), represented by BMVN International LLC, Viet Nam.

The Respondent is Le Van Phu, Viet Nam.

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

The disputed domain name <sk-ii.asia> (the “Disputed Domain Name”) is registered with Mat Bao Corporation (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 5, 2023. On December 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 6, 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 (Ong Le Van Phu) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 7, 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 December 12, 2023. On December 8, 2023, the Respondent sent an email communication in Vietnamese to the Center, asking the Center to provide more information of the case.

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 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 2, 2024. The Respondent did not submit a formal Response but sent several email communications to the Center on December 14 and 21, 2023. On December 20, 2023, the Center forwarded the Notification of Complaint and Commencement of

Administrative Proceeding to the Parties in Vietnamese, explaining the Respondent's rights and obligations. The Center notified the Commencement of Panel Appointment Process on January 10, 2024.

The Center appointed Pham Nghiem Xuan Bac 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**

The Complainant is a United States-based company founded in 1837 and has been one of world-leading companies in the field of consumer products. According to the Complainant, the SK-II brand was launched in December 1980 for high-end cosmetic products which has been endorsed by some world-famous celebrities.

The Complainant's SK-II trademarks have been registered in some classes, including class 03 for cosmetic products in a variety of countries including Viet Nam (where the Respondent resides) under the Vietnamese Registrations No. 73314 for SK-II (combined mark), registered on June 29, 2006, No. 265516 for SK-II (combined mark), registered on July 12, 2016, and No. 262789 for SK-II MAGNETIC WAND (combined mark), registered on May 23, 2016; and European Union Trade mark registration No. 001569664 for SK-II, registered on August 10, 2001.

In addition, the Complainant is the registrant of a number of domain names featuring the trademarks SK-II, notably the domain names <sk-ii.com>, <sk-ii.co.uk>, <sk-ii.jp>, and <sk-ii.co.th>.

The Disputed Domain Name was registered on July 25, 2019. As shown on the Complainant's evidence, the Disputed Domain Name resolves to an active website using the Complainant's SK-II trademarks and purporting to sell cosmetic products under SK-II brand and others.

#### **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, as follows:

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

First, the Complainant submits that it has rights in and to the SK-II trademarks which are registered and have obtained a well-known status for cosmetic and other personal care products globally, including in Viet Nam;

Second, the Complainant contends that the Disputed Domain Name is confusingly similar to its SK-II trademarks, because it fully incorporates such trademarks in their entirety. The remaining generic Top-Level Domain ("gTLD") ".asia" only serves to indicate the type and code level of the Disputed Domain Name.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant submits that it has not licensed or otherwise permitted the Respondent to use its SK-II trademarks or the Disputed Domain Name. Moreover, the Respondent is not an authorized distributor of the Complainant regarding SK-II products. The Respondent also does not own and cannot lawfully obtain any trademark or intellectual property rights in the SK-II Trademarks or any words or phrases that incorporate or are confusingly similar to the SK-II Trademarks.

Second, the Complainant argues that the Respondent registered and used the Disputed Domain Name to direct Internet traffic to the website thereunder. This proves the Respondent's clear intent to disrupt the Complainant's business, deceive consumers and trade off the Complainant's reputation by creating an unauthorized association between the Respondent and the SK-II Trademarks;

Furthermore, the Complainant contends that there is no evidence that the Respondent has become commonly known by the Disputed Domain Name.

Third, the Complainant submits that the website under the Disputed Domain Name fails to accurately represent that the Respondent is an independent business entity that is totally unrelated to the Complainant, and that the Respondent is not authorized to use the Complainant's registered trademark in the URL. In contrast, by calling itself as "SK-II Asia", displaying the Complainant's copyrighted materials and offering other products for sale alongside SK-II products on the website under the Disputed Domain Name, the Respondent undeniably misleads Internet users and relevant consumers about its relationship with the Complainant.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant argues that the Respondent must have been aware of the Complainant's SK-II trademarks at the time of registering the Disputed Domain Name, given the contents of the website thereunder and strong reputation of the SK-II trademarks in Viet Nam where the Respondent is domiciled. This awareness itself is evidence of the Respondent's bad-faith registration.

Second, the Complainant asserts that the Respondent's uses of the Complainant's SK-II trademarks and various copyrighted materials on the website under the Disputed Domain Name will no doubt create a false association between the Complainant and the Respondent. This certainly proves that the Respondent is using the Disputed Domain Name to lure consumers to the Respondent's website for commercial gain, which is indicative of bad faith.

Finally, the Complainant argues that the high likelihood of Internet users mistakenly believing that the Disputed Domain Name is connected to or associated with the Complainant establishes the Respondent's bad faith.

## **B. Respondent**

The Respondent has not furnished a formal reply or submitted a Response to the Complainant's contentions. However, on December 21, 2023, the Respondent transmitted an email in Vietnamese, with the following main contents:

- The Disputed Domain Name has never been listed as the Complainant's domain name. Instead, the Disputed Domain Name belongs to the Respondent;
- On the website under the Disputed Domain Name, the Respondent has clearly stated that their SK-II products were bought in Japan and then resold in Viet Nam, which is not prohibited by the Complainant;
- Instead of filing the Complaint, the Complainant should have asked the Respondent to correct the website under the Disputed Domain Name, making it more transparent, so that the number of confused customers could be low. In this regard, the Respondent submits that it has corrected the website.
- In Viet Nam, there are hundreds of people buying and reselling SK-II products, including e-commerce platforms. SK-II does not prohibit this.

## 6. Discussion and Findings

### The Respondent's Identity

The Panel notes that at the time the Complaint was filed on December 5, 2023, the Respondent was identified as "Ong Le Van Phu", addressed at "HCM, VN". On December 6, 2023, the Registrar revealed the underlying registrant of Disputed Domain Name as "Le Van Phu" with different contact information. The Center sent an email communication to the Complainant on December 7, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

On December 12, 2023, the Complainant filed an amended Complaint, adding the underlying registrant and contact information disclosed by the Registrar.

### Language of the Proceeding

The Complaint was filed in English. On December 6, 2023, the Registrar confirmed that the languages of the Registration Agreement were English and Vietnamese.

On December 14 and 21, 2023, the Respondent sent two email communications to the Center, stating that it needed the Vietnamese translations of the relevant documents and only communicated in Vietnamese.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the 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.

Similarly to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

- The languages of the Registration Agreement are both English and Vietnamese;
- The Respondent has been notified of the present proceeding in both English and Vietnamese;
- The fact that the Complainant, a United States-based entity, does not appear to be able to communicate in Vietnamese and therefore, if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;
- The Disputed Domain Name itself contains the English TLD "asia"; as shown at Annex 4 of the Complaint and the Center's screenshot, the website under the Disputed Domain Name also used to contains many English words, such as, Asia, advanced cream, liquid, treatment, best sellers, etc.; these suggest that the Respondent has knowledge of the English language and would be able to communicate in English.

Therefore, noting that the Respondent has been in a position to submit Vietnamese submissions which the Panel has considered, and for the purpose of easy comprehension of the Complainant of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph

11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

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 has evidenced that it has rights in and to the trademarks SK-II, which were registered in a number of countries including Viet Nam (where the Respondent resides) before the registration of the Disputed Domain Name.

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

In addition, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD ".asia" to the Disputed Domain Name does not constitute an element as to avoid confusing similarity for the purposes of the Policy (see, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. [D2012-2066](#); *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#))

Based on the foregoing findings, 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 a domain name 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.

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

“(i) before any notice to you of the dispute, your use of, or demonstrable 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; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 or service mark at issue.”

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant’s asserted facts, that no license, permission or authorization in any kind to use the Complainant’s trademarks SK-II has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction related to “sk-ii”. Thus, the Panel finds that the Respondent has no rights in the trademarks “sk-ii”.

A reseller or distributor may be making a *bona fide* offering of goods or services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Oki Data Americas, Inc. v. ASD, Inc*, WIPO Case No. [D2001-0903](#) (“*Oki Data*”), including:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods or services (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods);
- the site itself must accurately and prominently disclose the respondent’s relationship with the trademark owner; and
- the respondent must not try to “corner the market” in domain names that reflect the trademark, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

In this particular case, as shown on the Complainant’s evidence at Annex 4 of the Complaint, the Disputed Domain Name resolves to an active website selling cosmetic products bearing SK-II trademarks and other brands such as REFA. On such website, the Panel found that the Respondent claimed itself as “SK-II ASIA”, used the Complainant’s SK-II trademarks, marketing materials and did not place any statement or disclaimer disclosing accurately and prominently its relationship with the Complainant. These may mislead consumers into believing in a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality. In addition, the Panel found that the Respondent also advertised cosmetic products under third parties’ brands on the website under the Disputed Domain Name.

The Panel furthermore notes that the composition of the disputed domain name, being identical to the Complainant’s trademark without the addition of other terms, coupled with the use of the disputed domain name resolving to a website displaying the Complainant’s trademark, logo and products, as well as the disputed domain name containing the geographical TLD “.asia”, gives the overall impression that the website at the disputed domain name is hosted or authorized by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

With such a view, the Panel finds that the use of the Disputed Domain Name does not meet the *Oki Data* criteria and thus, does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that there is no evidence that would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, as it appears following the Complainant’s assertions and evidence with

regard to the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the SK-II trademarks and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Based on the foregoing findings, 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, including:

“(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.”

In the present case, the Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not formally reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence with regard to the Respondent's bad faith registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's SK-II trademarks have been registered in a variety of jurisdictions around the world. In addition, the SK-II trademarks have been put in use for a number of years and have gained certain reputation in the sector of cosmetic products. The Complainant's registration of the SK-II trademarks predates the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the Complainant's SK-II trademarks in its entirety. Given the extensive use of the SK-II trademarks for cosmetics by the Complainant, which occurs in numerous countries, including in Viet Nam, where the Respondent resides, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name, the Panel is of the view that the Respondent obviously knew of the Complainant and its SK-II trademarks when it registered the Disputed Domain Name. The Panel considers the registration of the Disputed Domain Name is an attempt by the Respondent as to take unfair advantage of the Complainant's goodwill and the reputation of the SK-II trademarks.

It is well proven and evidenced by the Complainant and the Center that the website under the Disputed Domain Name used to offer for sale of cosmetic products bearing SK-II trademarks. In addition to adoption of the trademarks SK-II as a uniquely distinctive part in the Disputed Domain Name, the Respondent claimed itself as “SK-II ASIA” and used the Complainant's SK-II trademarks and marketing materials on the website thereunder.

The Panel takes the view that any Internet users seeking to purchase the Complainant's SK-II products would likely mistakenly believe that the Respondent is either connected to or associated with the Complainant, while no such connection exists in fact. The Panel therefore finds that by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website on its website, which is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Based on the foregoing findings, 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 <sk-ii.asia> be transferred to the Complainant.

*/Pham Nghiem Xuan Bac/*

**Pham Nghiem Xuan Bac**

Sole Panelist

Date: January 30, 2024