

## **ADMINISTRATIVE PANEL DECISION**

NAOS v. Hoang Van Dung  
Case No. D2024-0030

### **1. The Parties**

The Complainant is NAOS, France, represented by Nameshield, France.

The Respondent is Hoang Van Dung, Viet Nam.

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

The disputed domain name <biodermavietnam.shop> (the “Domain Name”) is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 5, 2024. On January 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 9, 2024, 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 (NOT IDENTIFIED) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 16, 2024, 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 January 16, 2024.

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 January 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2024.

The Center appointed Olga Zalomiy as the sole panelist in this matter on March 7, 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 French skincare company founded more than 40 years ago. The Complainant owns several trademark registrations for its BIODERMA trademark, such as:

- The International registration No. 267207, for the BIODERMA mark, registered on March 19, 1963;
- The International registration No. 510524, for the BIODERMA mark, registered on March 9, 1987;
- The International registration No. 678846, for the BIODERMA mark registered August 13, 1997.

The Complainant registered multiple domain names that include its BIODERMA trademark, such as: <bioderma.com>, registered on September 25, 1997.

Prior panels recognized the well-known status of the Complainant's BIODERMA trademark for cosmetics.<sup>1</sup>

The Respondent, who is purportedly located in Viet Nam, registered the Domain Name on May 15, 2023. The Respondent is used the Domain Name to direct to a website that is designed to look like it is affiliated with the Complainant. The website that prominently displays the Complainant's trademark offers for sale purported BIODERMA products at discounted prices.

#### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

Notably, the Complainant contends that the Domain Name is similar to the Complainant's BIODERMA trademarks because the addition of the term "vietnam" does not prevent finding of confusing similarity because the Complainant's mark is recognizable in the Domain Name. In the Complainant's view, the addition of the Top-Level Domain ("TLD") suffix ".shop" to the Complainant's mark in the Domain Name does not impact the confusing similarity, because it is disregarded from the assessment under the confusing similarity test.

The Complainant argues that the Respondent has no rights or legitimate interests in the Domain Name because the Respondent, who is not identified in the Whois database, is not commonly known under the Domain Name. and has not acquired a trademark or service mark under that name. The Complainant contends that it did not grant any license or authorization to use its mark in the Domain Name. The Complainant asserts that the Domain Name directs to the website displaying its trademark BIODERMA, which purportedly sells BIODERMA branded products at discounted prices. The Complainant argues that the Respondent attempted to impersonate the Complainant and mislead consumers into thinking that the goods purportedly offered for sale on the website originate from the Complainant. In the Complainant's view, the Respondent's actions do not amount to bona fide offering of goods or legitimate interest because the Respondent is trying to create a likelihood of confusion with the Complainant's entity operating in Viet Nam by representing itself as "Bioderma laboratoire dermatologique" and "Bioderma Vietnam".

The Complainant states that the Respondent registered the Domain Name in bad faith because its registration of the Domain Name incorporating the Complainant's well-known mark indicates that it was aware of the Complainant and its trademark at the time of the Domain Name registration. The Complainant contends that the Respondent is using the Domain Name to direct to a website that is designed to look like it is connected to the Complainant, which supports its argument about registration of the Domain Name in bad faith. The Complainant argues that based on the Respondent's registration and use of the Domain Name, the Respondent acquired the Domain Name with an intent to attract for commercial gain Internet users to the

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<sup>1</sup>See, e.g., *NAOS v. Bioderm Medical Center*, WIPO Case No. [DRO2020-0007](#), *NAOS v. 吴二依 (Er Nong Wu)*, WIPO Case No. [D2020-2746](#).

Respondent's website because the Respondent sells unauthorized or counterfeit products on its website.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the Domain Name:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### **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 the mark is recognizable within the Domain Name. Accordingly, the Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The inclusion of the generic Top-Level Domain ("gTLD") ".shop" is typically disregarded in the context of the confusing similarity assessment, being a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.

Although the addition of other terms, here, "vietnam" 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 Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

As per the record set out above, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the 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 Domain Name such as those enumerated in the Policy or otherwise.

The evidence on record shows that the Respondent is not commonly known by the Domain Name. Nor is the Respondent making a legitimate noncommercial or fair use of the Domain Name, because the Domain Name was used to direct to a website, which looked very similar to the design of the Complainant's official website. Therefore, it is likely that the Respondent planned to use the Domain Name for fraudulent activity. [WIPO Overview 3.0](#), section 2.13.

The Respondent's use of the Domain Name does not satisfy requirements of bona fide offering of goods and services. Previous UDRP panels have recognized that resellers or distributors using domain names containing the complainant's trademark to undertake sales of the complainant's goods may be making a bona fide offering of goods and thus have a right or legitimate interest in such domain names in some situations.

Outlined in the *Oki Data* case<sup>2</sup>, the following cumulative requirements must be satisfied for the respondent to make a bona fide offering of goods and services:

- “(i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to corner the market in domain names that reflect the trademark.”

The Panel finds the Respondent's use of the Domain Name does not amount to a bona fide offering of goods and services because that the website at the Domain Name suggests affiliation between the Complainant and the Respondent by displaying official images of the Complainant's products and the Complainant's trademark, and purportedly offering for sale purported BIODERMA products at lower prices than the prices of the Complainant's products. The website under the Domain Name does not provide any specific information about its owner or its lack of affiliation with the Complainant and the Respondent, let alone accurately and prominently discloses its relationship with the Complainant.

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.

In the present case, the Panel notes that the Respondent registered the Domain Name that incorporates the Complainant's well-known mark and used it to direct to a website that sold purported BIODERMA products. Therefore, it is likely that that the Respondent knew about the Complainant and its trademarks and registered the Domain Name with the purpose of benefiting from their reputation. Such registration is in bad faith.

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<sup>2</sup> *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The Complainant contends and the Respondent does not rebut that it is using the Domain Name to direct to an active website that offered for sale purported BIODERMA products at a lower price than the price of BIODERMA products that the Complainant's sells on its website. The Panel finds that the Respondent registered the Domain Name with the purpose of intentionally attempting to create a likelihood of confusion with the Complainant's trademark as to the Domain Name's source, sponsorship, affiliation or endorsement. [WIPO Overview 3.0](#), section 3.1.4.

Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Domain Name constitutes bad faith under the Policy.

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 Domain Name <biodermavietnam.shop> be transferred to the Complainant.

*/Olga Zalomiy/*

**Olga Zalomiy**

Sole Panelist

Date: March 20, 2024