

ADMINISTRATIVE PANEL DECISION

NAOS v. Nguyen Van Hieu
Case No. D2024-0068

1. The Parties

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

The Respondent is Nguyen Van Hieu, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <bioderma-store.online> (the “Disputed Domain Name”) is registered with Nhan Hoa Software Company Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 9, 2024. On January 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 11, 2024, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 15, 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 15, 2024.

On January 15, 2024 the Center informed the parties in Vietnamese and English, that the language of the registration agreement for the Disputed Domain Name is Vietnamese. On January 15, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in both English and Vietnamese, and the proceedings commenced on January 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 13, 2024.

The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 15, 2024.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on February 23, 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, founded in France 40 years ago, is doing business in skincare industry, selling its products under the brand BIODERMA in over 90 countries.

The Complainant owns some BIODERMA trademarks such as follows:

- International Registration No. 267207 for BIODERMA, registered on March 19, 1963;
- International Registration No. 510524 for BIODERMA, registered on March 9, 1987;
- International Registration No. 678846 for BIODERMA, registered on August 13, 1997, designating among others Viet Nam.

Furthermore, the Complainant owns some domain names consisting of the word "bioderma" such as <bioderma.com>, registered on September 25, 1997, which is used for its official website.

The Disputed Domain Name was registered on December 7, 2023. As shown on the Complainant's evidence, the Disputed Domain Name used to resolve to an online store displaying the Complainant's BIODERMA trademark and logo and selling allegedly unauthorized Bioderma products at discounted prices.

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.

The Complainant contends that the Disputed Domain Name is confusingly similar to its BIODERMA trademark, because the BIODERMA trademark is included in its entirety. The addition of the generic term "store", is not sufficient to avoid the likelihood of confusion.

Moreover, the addition of the generic Top-Level Domain ("gTLD") ".online" does not change the overall impression of the designation as being connected to the BIODERMA trademark.

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

First, the Complainant argues that the Respondent is not identified in the Whois as the Disputed Domain Name and has not acquired trademarks right on this term.

Second, the Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use the BIODERMA trademark in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Furthermore, the Disputed Domain Name used to resolve to a website displaying the Complainant's BIODERMA trademark and offering allegedly unauthorized or counterfeited Bioderma goods at discounted prices.

Third, the Complainant asserts that there is no precise information/disclaimer on the page of the website under the Disputed Domain Name to identify its owner. Therefore, the Respondent failed at least one of the elements of the Oki Data test.

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

Given the confusing similarity between the Disputed Domain Name and the Complainant's BIODERMA trademark and the Complainant's trademark and goods were displayed on the website, the Complainant opines that the Respondent registered the Disputed Domain Name in knowledge of the Complainant and its trademark.

Furthermore, the Disputed Domain Name used to resolve to an online store displaying the Complainant's trademark and selling allegedly unauthorized or counterfeited Bioderma goods at discounted prices. Thus, the Complainant also contends that the Respondent uses the Disputed Domain Name to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and goods purportedly advertised therein.

B. Respondent

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

6. Discussion and Findings

The Respondent's Identity

The Panel notes that at the time the Complaint was filed on January 9, 2024, the Respondent was identified as "Unknown", addressed in "Viet Nam". On January 11, 2024, the Registrar revealed the underlying registrant of Disputed Domain Name as "Nguyen Van Hieu" with detailed contact information. The Center sent an email communication to the Complainant on January 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On January 15, 2024, the Complainant filed an amended Complaint, adding the underlying registrant and contact information disclosed by the Registrar.

Language of the Proceeding

The language of the Registration Agreement for the Disputed Domain Name is Vietnamese. 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 (i) English language is the language most widely used in international relations and is one of the working languages of the Center; and (ii) the use of Vietnamese in this case would impose a burden on the Complainant as it has to retain specialized translation services.

The Respondent did not make any specific 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, and noting that the Respondent was informed of the proceeding in Vietnamese, but chose not to submit any reply, 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 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 BIODERMA trademark, which was 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. Although the addition of another term "store" and a hyphen may bear on assessment of the second and third elements, the Panel finds the addition of such addition 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.

In addition, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD ".online" to the Disputed Domain Name does not constitute an element as to avoid confusing similarity for the purposes of the Policy (see, e.g., *LEGO Juris A/S v. Nguyen Xuan Hau*, WIPO Case No. [D2023-4439](#); *Philip Morris Products S.A. v. Маханьков Михаил Владимирович / Makhankov Mikhail*, WIPO Case No. [D2020-2793](#); *Philip Morris Products S.A. v. Anatoliy Harin.*, WIPO Case No. [D2020-2400](#); *Skyscanner Limited v. Khaled Samir.*, WIPO Case No. [D2020-2669](#); 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 BIODERMA trademark 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 "Bioderma". Thus, the Panel finds that the Respondent has no rights in the trademark "BIODERMA".

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 in Annex 7 of the Complaint, the Disputed Domain Name resolves to an active website selling cosmetic products bearing BIODERMA trademark. On such website, the Panel found that the Respondent used the Complainant's BIODERMA trademark 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.

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 BIODERMA trademark 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 notes 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 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 BIODERMA trademark has been registered in a variety of jurisdictions around the world. In addition, the BIODERMA trademark has been put in use for a number of years and has gained certain reputation in the sector of cosmetic products. The Complainant's registrations of the BIODERMA trademarks predate the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the Complainant's BIODERMA trademark in its entirety. Given the extensive use of the BIODERMA trademark 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 BIODERMA trademark when it registered the Disputed Domain Name. The Panel considers the registration of the Disputed Domain Name as an attempt by the Respondent to take unfair advantage of the Complainant's goodwill and the reputation of the BIODERMA trademark.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it resolves to a website showing the content “Tên miền của bạn đã được trở thành công! Vui lòng xuất bản Landing Page với tên miền trên để sử dụng dịch vụ. Xin cảm ơn!” (in English “Your domain name has been successfully pointed! Please create a Landing Page with the above domain name to use the service. Thank you!”). However, it is well proven and evidenced by the Complainant that the website under the Disputed Domain Name used to offer for sale of cosmetic products bearing BIODERMA trademark. In addition to adoption of the BIODERMA trademark as a uniquely distinctive part in the Disputed Domain Name, the Respondent used the Complainant’s BIODERMA trademark on the website thereunder.

The Panel takes the view that any Internet users seeking to purchase the Complainant's BIODERMA 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, <bioderma-store.online>, be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: March 8, 2024