

ADMINISTRATIVE PANEL DECISION

NAOS v. vu thanh dat
Case No. D2024-1017

1. The Parties

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

The Respondent is vu thanh dat, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <biodermavietnam.website> is registered with GMO Internet, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 7, 2024. On March 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 8, 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 (GMO-Z.com RUNSYSTEM JSC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 8, 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 March 8, 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 March 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 8, 2024.

The Center appointed Zoltán Takács as the sole panelist in this matter on April 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

Founded in France more than 40 years ago, the Complainant is a major player in skincare, ranked among the leading independent beauty companies.

One of the Complainant's major brands is Bioderma, which is sold in over 130 countries through subsidiaries and long-term partnerships with local distributors.

The Complainant's portfolio of trademark registrations for the mark BIODERMA include by way of example the International Trademark Registration No. 267207 registered since March 19, 1963 for cosmetics.

The Complainant's corporate website is available at "www.bioderma.com". The corresponding domain name was registered on September 25, 1997.

The disputed domain name was registered on March 2, 2024 and was used to resolve to a Vietnamese language website that prominently featured the Complainant's trademark, purporting to offer the Complainant's BIODERMA line of cosmetics which the Complainant alleges were counterfeit goods at discounted prices.

Currently the disputed domain name does not resolve to any active website.

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:

- the disputed domain name, which fully incorporates its BIODERMA trademark is confusingly similar to it because the addition of the term "vietnam" to the trademark in the disputed domain name is not sufficient to prevent a finding of confusing similarity between the disputed domain name and the trademark;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name since it is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy;
- the use of the disputed domain name for a website that offered for sale counterfeit BIODERMA cosmetics is evidence of bad faith registration and use of the disputed domain name.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

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

6. Discussion and Findings

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (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 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 entirety of the Complainant's BIODERMA mark is reproduced within the disputed domain name. The addition of the term "vietnam" to the mark in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy.

Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.8.

The Panel finds that 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.

According to the evidence submitted by the Complainant, the Respondent used the disputed domain name to deceive Internet users looking for the Complainant through redirecting them to its own website at which the Respondent appeared to have offered for sale the Complainant's BIODERMA cosmetics which the Complainant assumes were counterfeit.

There is not sufficient evidence as to conclude whether the goods offered for sale on the Respondent's website at the disputed domain name were counterfeit (for example, the Panel notes that some of the products are being offered with an apparent discount of 60%, but it is unclear what would be the general retail price for these products in Viet Nam) or "genuine", or whether any of those products ultimately existed. The Panel notes that the website at the Domain Name displays the text "BIODERMA LABORATOIRE DERMATOLOGIQUE", and in some occasions appear a message "Official Store" together with the images of the products. Consequently, even if the products that appeared on the Respondent's website under the disputed domain name would have existed and were genuine, given the overall impression of the website at the disputed domain name, identifying the website as an "official store", coupled with the composition of the disputed domain name, the Panel finds that the Respondent's website would still not qualify as fair use.

It is clear that the Complainant has not authorized, licensed, or allowed the Respondent to use its BIODERMA trademark through the disputed domain name or in any other way that would confer validity or legitimacy upon such usage.

In the Panel's view it is also clear that the Respondent was impersonating the Complainant by using on its website at the disputed domain name the Complainant's trademark, logo and product images. Panels have held that the use of a domain name for illegal activity, here impersonation/passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, the inherently misleading nature of the disputed domain name, incorporating the Complainant's trademark and a descriptive term, carries risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds that 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.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

In the present case, the Panel notes that the Complainant's BIODERMA trademark is inherently distinctive for the corresponding goods and its priority predates the date of registration of the disputed domain name.

A basic Internet search against the disputed domain name returns solely the Complainant and its BIODERMA cosmetics. The website at the disputed domain name prominently featured the Complainant's BIODERMA trademark, logo and product images. Thus, in view of the Panel, it is clear that the Respondent had actual knowledge of the Complainant and its trademark and registered the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark. Paragraph 4(b)(iv) of the Policy.

The Respondent's intent to target the Complainant's trademark can be readily inferred from the contents of the Respondent's website at the disputed domain name that sought to impersonate the Complainant by directing Internet traffic to its website in order to gain illegitimate profit through impersonation or false association. Visitors of the Respondent's website at the disputed domain name might have reasonably believed that it was connected to or approved by the Complainant as it appeared to offer for sale cosmetics under the Complainant's trademark, logo and imagery and gave impression that the site attached to the disputed domain name was official or at least approved by the Complainant, while that was clearly not the case. Panels have held that the use of a domain name for illegal activity, in this case impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

As mentioned above, currently the disputed domain name does not resolve to any active website. However, this does not prevent a finding of bad faith when considering the totality of the circumstances.

[WIPO Overview 3.0](#), section 3.3.

In this context the Panel notes the distinctiveness and reputation of the Complainant's trademark, the composition of the disputed domain name as mentioned above, the Respondent's failure to submit a response, and that any good faith use to which the inherently misleading disputed domain name may be put appears to be implausible. The Panel finds that in these circumstances the current passive holding of the disputed domain name does not prevent a finding of 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 disputed domain name <biodermavietnam.website> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: April 30, 2024