

ADMINISTRATIVE PANEL DECISION

A.S. Watson (Health & Beauty Continental Europe), B.V. v. rf fw
Case No. D2024-1394

1. The Parties

Complainant is A.S. Watson (Health & Beauty Continental Europe), B.V., Netherlands (Kingdom of the), represented by Fencer BV, Belgium.

Respondent is rf fw, France.

2. The Domain Name and Registrar

The disputed domain name <iciparisxl-be.shop> is registered with Dynadot Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 2, 2024. On April 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 3, 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 Complainant on April 8, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 9, 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 Respondent of the Complaint, and the proceedings commenced on April 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 14, 2024.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on May 24, 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

Complainant is a company organized under the laws of the Netherlands (Kingdom of the) that is active in the beauty products industry. Since 2002, N.V. PARFUMERIE ICI PARIS XL has been part of Complainant.

Complainant has provided evidence that N.V. PARFUMERIE ICI PARIS XL is the registered owner of numerous trademarks, inter alia, but not limited to, to the following:

- word mark ICI PARIS XL, European Union Intellectual Property Office, registration number 002564540, registration date: April 7, 2006, status: active;
- word mark ICI PARIS XL, World Intellectual Property Organization, registration number 843660, registration date: November 16, 2004, status: active.

In addition, Complainant has provided evidence that it is the registered owner, inter alia, of:

- word mark ICI PARIS XL - DARE TO BE YOU, World Intellectual Property Organization, registration number 1382963, registered date: September 19, 2017, status: active.

Moreover, Complainant has demonstrated to own various domain names relating to its ICI PARIS XL trademark and brand, inter alia, the domain names <iciparisxl.nl> as well as <iciparisxl.be>, which resolve to Complainant's main websites at "www.iciparisxl.nl" and "www.iciparisxl.be/nl/", used to promote Complainant's products in the beauty industry.

Respondent, according to the disclosed registrant information for the disputed domain name, is located in France. The disputed domain name was registered on December 21, 2023. By the time of rendering this Decision, the disputed domain name does not resolve to any relevant content on the Internet. Complainant, however, has demonstrated that, at some point before the filing of the Complaint, the disputed domain name resolved to a website at "www.iciparisxl-be.shop", allowing Internet users to access a web shop via mobile devices only, which appeared to offer perfume and beauty care products at reduced prices, thereby prominently displaying Complainant's ICI PARIS XL trademark and copying substantial parts (including images and texts) from Complainant's official website.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the three elements required under the Policy for a transfer of the disputed domain name. Notably, Complainant contends to be the world's largest international health & beauty retailer and that it - together with its legal predecessors - has been continuously using the ICI PARIS XL brand since 1968, which has meanwhile gained significant notoriety in the Benelux countries due to such longstanding and extensive use.

Complainant submits that the disputed domain name is confusingly similar to Complainant's ICI PARIS XL trademark, as it contains the latter in its entirety, and the additional letters "be" are purely descriptive as they refer to "Belgium". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name, since Complainant has in no way authorized the use of its ICI PARIS

XL trademark or any similar sign to third parties, including Respondent. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith, because (1) Complainant can in no way vouch for the authenticity of the products sold on this website, nor for safety office uses or the quality of the delivery, and (2) the use of the disputed domain name, thus, has the sole purpose of misleading consumers into thinking that they are shopping on a (trusted) web shop of Complainant, whereas that is in no way the case.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

A. Identical or Confusingly Similar

First, 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.

Complainant has shown rights in respect of the ICI PARIS XL trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of this ICI PARIS XL trademark is reproduced within the disputed domain name, together with the term "be" and a hyphen. Accordingly, the disputed domain name is confusingly similar to Complainant's trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Although the addition of the term "be" and a hyphen 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 ICI PARIS XL trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel, therefore, holds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Second, 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

In particular, Respondent has neither been granted a license nor has it been otherwise authorized by Complainant to use its ICI PARIS XL trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain name, and Respondent does not appear to have any trademark rights associated with e.g., the terms "ici" and/or "paris" and/or "xl" on its own. Finally, the disputed domain name resolved at some point in the past to a website at "www.iciparisxl-be.shop", allowing Internet users to access a web shop via mobile devices only, which appeared to offer perfume and beauty care products at reduced prices, thereby prominently displaying Complainant's ICI PARIS XL trademark and copying substantial parts (including images and texts) from Complainant's official website, with no authorization to do so. Such use of the disputed domain name, therefore, neither qualifies as bona fide nor as legitimate noncommercial or fair within the meaning of paragraph 4(c) of the Policy. In this context, panels have also long 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.

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

C. Registered and Used in Bad Faith

Finally, 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.

The circumstances in this case leave no doubt that Respondent was fully aware of Complainant's beauty products business and its rights in the ICI PARIS XL trademark when registering the disputed domain name and that the latter clearly is directed thereto. Moreover, using the disputed domain name to run to a website at "www.iciparisxl-be.shop", allowing Internet users to access a web shop via mobile devices only, which appeared to offer perfume and beauty care products at reduced prices, thereby prominently displaying Complainant's ICI PARIS XL trademark and copying substantial parts (including images and texts) from Complainant's official website, without any authorization to do so, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with Complainant's ICI PARIS XL trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. In this context, panels have also long held that the use of a domain name for illegal activity (here: impersonation/passing-off) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Last, it also carries weight in the eyes of the Panel that Respondent obviously provided incorrect or incomplete contact information at the moment of registration of the disputed domain name, so that the Written Notice on the Notification of Complaint dated April 18, 2024, could not be sent to Respondent by postal courier. This fact at least throws a light on Respondent's behavior which further supports the Panel's bad faith finding.

Having reviewed the record, the Panel, therefore, holds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy, so that Complainant has established the third element of the Policy, too.

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, <iciparisxl-be.shop>, be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: June 5, 2024