

ADMINISTRATIVE PANEL DECISION

Shiseido Americas Corporation v. Domain Ecommerce
Case No. D2024-3404

1. The Parties

The Complainant is Shiseido Americas Corporation, United States of America (“United States”), represented by Ladas & Parry, United States.

The Respondent is Domain Ecommerce, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <narsconcealer.store> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 20, 2024. On August 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 20, 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 (“Registrant of <narsconcealer.store>”) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 21, 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 August 22, 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 August 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 15, 2024. The Response was filed with the Center on August 28, 2024. Pursuant to paragraph 6 of the Rules, the Center commenced the panel appointment process on September 2, 2024.

The Center appointed Mihaela Maravela as the sole panelist in this matter on September 18, 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

According to information in the Complaint, the Complainant is a leading manufacturer of cosmetics with operations in approximately 120 countries. The Complainant and its parent organization was founded in 1872, employs approximately 40,000 individuals and was ranked number #1 among Asian cosmetic manufactures.

The Complainant is the holder of a number of trademarks for NARS, such as the United States trademark No. 6003095 for NARS registered on March 3, 2020 for class 3. The Complainant is also the owner of the domain name <narscosmetics.com> that it uses to conduct its business.

The disputed domain name was registered on March 25, 2024, and at the date of the Complaint it resolved to a website featuring the text “UNLEASH YOUR INNER BEAUTY” and advertising a wide variety of cosmetics, inter alia, the Complainant’s NARS branded cosmetics, and related accessories, and when Internet users clicked on the link to buy one of the products, they were redirected to “www.amazon.com”.

Furthermore, the disputed domain name used to contain a button with the text “Want To Secure This domain? – Click Here”. When clicking the button Internet users were redirected to a website where the disputed domain name was listed for sale for USD 4,999, with instructions to email the Respondent if interested in purchasing the disputed domain name. This section has since been removed from the website.

At the date of the Decision, the disputed domain name resolves to a “403 Forbidden” landing page.

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 is nearly identical to its NARS trademark as it wholly incorporates such trademark, simply adding to it the term “concealer,” which is related to the Complainant’s field of activity. The addition of a generic term to a domain name that otherwise incorporates a mark in its entirety typically does not prevent a finding of confusing similarity. Furthermore, the addition of the term “concealer” may have the effect of increasing confusion considering that the Complainant is an industry leader in cosmetic products, such as concealers, and visitors may believe that the disputed domain name is associated with the Complainant’s business.

As regards the second element, the Complainant submits that the Respondent registered the disputed domain name without the Complainant’s authorization or consent, and that the disputed domain name resolves to a website that advertises a wide variety of cosmetics, and related accessories, and when a visitor clicks on the link to buy one of the products, they are redirected to the “www.amazon.com” website which ostensibly offers for purchase the respective product. The Complainant contends that the Respondent’s selection of a domain name that incorporates the Complainant’s NARS trademark in its entirety, combined with the term “concealer,” as well as the redirection of the disputed domain name to product listings on “www.amazon.com,” is not bona fide use and does not confer any rights or legitimate interests on the Respondent.

With respect to the third element, the Complainant submits that it has no affiliation with the Respondent and has not authorized them to sell its goods. Therefore, the Respondent registered and is using the disputed domain name in bad faith because they are attempting to mislead consumers into a false affiliation between the Respondent and the Complainant. Further, the Respondent is attempting to directly benefit from the advertising and/or deception by directing visitors to land on “www.amazon.com” product pages, therefore, the Respondent has registered and used the disputed domain name in bad faith pursuant to Policy 4(b)(iv). Furthermore, the disputed domain name was listed for sale to the general public for \$4,999. Also, the Respondent registered the disputed domain name using a privacy shield in order to hide its identity and prevent the Complainant from contacting it.

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

As such, the Respondent submits that while the disputed domain name includes NARS, it also features the term “concealer” and operates under the Top-Level Domain (“TLD”) “.store”, and that the combination of these elements makes it clear that the website is focused on a specific product category— concealers— within the beauty industry, which is a common descriptive term and does not imply that the website is exclusively associated with the NARS brand.

As regards the second element, the Respondent argues that it has a legitimate interest in the disputed domain name, because it was registered to operate a website that provides consumers with information and reviews on concealer products, some of which include NARS products, but also feature products from other brands. According to the Respondent, the website at the disputed domain name includes affiliate links, which direct visitors to purchase these products from legitimate online retailers. In addition, the Respondent submits that affiliate marketing is a well-recognized and legitimate form of e-commerce and that the website at the disputed domain name clearly indicates that it is an independent platform designed to help users make informed purchasing decisions by providing them with detailed reviews and direct links to buy the products. The inclusion of multiple brands in the reviews, and the transparency about the affiliate nature of the links, further establishes that the Respondent is not attempting to mislead consumers into believing the website is officially associated with NARS or any other single brand.

With respect to the third element, the Respondent argues that it did not register the disputed domain name in bad faith, as it was registered with the clear intention of providing an informative and commercial platform where users could find reviews and purchase links for concealer products. Also, the Respondent’s use of the disputed domain name to promote affiliate sales is a legitimate commercial activity. There is no evidence that the Respondent sought to capitalize on the Complainant’s trademark in bad faith. The website does not imply that it is the official NARS website, nor does it exclusively promote NARS products. Instead, it provides a broad range of options from different brands, making it clear to consumers that it is an independent resource.

6. Discussion and Findings

The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”, and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.2.

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed 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 disputed domain name, and (iii) the disputed 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 3.0](#), section 1.7.

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

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

The Panel agrees that the TLD ".store" is disregarded in the confusing similarity test, as it does not form part of the comparison as it is a standard registration requirement for technical reasons ([WIPO Overview 3.0](#), section 1.11.1).

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.

The Respondent argues that it has rights or legitimate interests in the disputed domain name because affiliate marketing is a well-recognized and legitimate form of e-commerce and that the website at the disputed domain name clearly indicates that it is an independent platform designed to help users make informed purchasing decisions by providing them with detailed reviews and direct links to buy the products. It also claims that the disputed domain name was registered to operate a website that provides consumers with information and reviews on concealer products, some of which include NARS products, but also feature products from other brands. The Respondent relies on the criteria for fair use enumerated in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

However, according to the evidence in the case file, the disputed domain name was used to resolve to a website promoting various beauty and related products, not only concealers, such as creams, lipsticks, face foundation, and make-up bags, and displayed trademarks of other brand owners. Such products are competing with those offered by the Complainant under its NARS trademark. Moreover, the disputed domain name also includes links that redirect Internet users to third party retailers that compete with the Complainant. Also, although the Respondent claims that the website at the disputed domain name clearly indicates that it is an independent platform designed to help users make informed purchasing decisions by providing them with detailed reviews and direct links to buy the products, the Panel found no evidence in the

case file of any visible disclaimer as to the lack of any relationship with the Complainant. On the contrary, the referenced disclaimer is only available through a hyperlinked “Disclaimer” button found on the footer of the website and does not identify its lack of relationship with the Complainant nor even identify the owners of the trademarks being exhibited on the website. In the Panel’s view, the Respondent’s use of the disputed domain name in the above circumstances is not in connection with a bona fide offering of goods or services as contemplated by the first circumstance of paragraph 4(c) of the Policy and fails the applicable safeguards found in “Oki Data”.

Also, the Respondent did not claim, and there is no evidence in the case file showing that the Respondent holds any right for NARS trademarks. The Panel also notes that there is no evidence showing that the Respondent is authorized or licensed to use the NARS trademark, nor has the Respondent claimed it would hold such authorization or license. Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

Furthermore, the disputed domain name incorporates the Complainant’s mark in its entirety with the additional term “concealer”, which is descriptive of goods and services associated with the Complainant’s industry. Such composition carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

According to the assertions of the Complainant, its reputed NARS trademarks were registered and widely used in commerce well before the registration of the disputed domain name. The Respondent did not contest these assertions. The disputed domain name is confusingly similar to the Complainant’s trademarks and contains a term pertaining to the Complainant’s industry (i.e. concealer). The website to which the disputed domain name resolved, displayed the Complainant’s NARS trademark along with various other third party trademarks in the cosmetic industry. In its Response, the Respondent has not denied knowledge of the Complainant and its trademarks. Rather, the Respondent claimed that the website does not imply that it is the official NARS website, nor does it exclusively promote NARS products. However, these arguments still reflect the Respondent’s intentional registration of a domain name composed of the Complainant’s trademark and for purposes of promoting competing products, which is prima facie bad faith insofar as it reflects the Respondent’s mala fide intent with respect the Complainant’s trademark.

As regards the use of the disputed domain name, from the evidence on file it results that the disputed domain name resolved to a website displaying the Complainant’s NARS trademark without authorization from the Complainant, to promote goods bearing the Complainant’s NARS trademark and other competing goods. Such use creates a false impression of an association with the Complainant. The Complainant failed to credibly explain why it needed to include the Complainant’s trademark in the disputed domain name to promote concealer products of various other brand owners. In addition, other goods in the beauty industry were promoted, in addition to concealers. The Respondent submits that affiliate marketing is a well-recognized and legitimate form of e-commerce, thereby acknowledging that it derives commercial benefit from such activity. As the Respondent is not authorised by the Complainant to use the Complainant’s NARS trademarks and is not associated with the Complainant in any way, such use is in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. Accordingly, the Panel finds that the Respondent has registered

and used the disputed domain name with the intention of taking advantage of the fame and reputation of the Complainant's trademark for the commercial benefit of the Respondent.

Further, the Panel notes that according to the un rebutted evidence put forward by the Complainant, the disputed domain name was put for sale at a minimum price of USD 4,999. This is an additional element that reinforces the Panel's view of bad faith registration and use of the disputed domain name, primarily for the purpose of selling it to the Complainant under paragraph 4(b)(i) of the Policy.

The switch to a "403 Forbidden" notice does not in the circumstances described above change the Panel's finding of bad faith registration and use of the disputed domain name. Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation and long use of the Complainant's trademark, the composition of the disputed domain name, and the fact that the Respondent set up a website promoting directly competing goods using the Complainant's NARS trademark to confuse and mislead Internet users before the disputed domain name led to an inactive page, and finds that in the circumstances of this case the 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 <narsconcealer.store> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: September 26, 2024