

## **ADMINISTRATIVE PANEL DECISION**

NAOS v. logan kerls  
Case No. D2024-3727

### **1. The Parties**

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

The Respondent is logan kerls, Brazil.

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

The disputed domain name <lojabioderma.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 13, 2024. On September 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 13, 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 (Not disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 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 September 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 September 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 9, 2024.

The Center appointed Gonçalo M. C. Da Cunha Ferreira as the sole panelist in this matter on October 21, 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. Ranked among the top 10 independent beauty companies, it is a major player in skincare thanks to its three brands: Bioderma, Institut Esthederm and Etat Pur.

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; and
- The International registration No. 678846, for the BIODERMA mark registered August 13, 1997.

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

The disputed domain name was registered on September 11, 2024 and on the date this Complaint was filed it resolved to a website displaying the Complainant's BIODERMA trademark and offering unauthorized or counterfeited BIODERMA goods at discounted prices.

Prior panels recognized the well-known status of the Complainant's BIODERMA trademark for cosmetics.

Today the access to the disputed domain name is blocked.

#### **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:

1. the disputed domain name is confusingly similar to its trademark BIODERMA and its domain names associated.
2. the addition of the terms "loja", meaning "store" in Portuguese, is not sufficient to avoid the likelihood of confusion.
3. the addition of the generic Top-Level-Domain ("gTLD") ".com" does not change the overall impression of the designation as being connected to the trademark BIODERMA.
4. the Respondent's name is not identified in the Whois as the disputed domain name and the Respondent has not acquired trademarks rights on this term.
5. the Respondent is not affiliated with the Complainant nor authorized by it in any way to use the trademark BIODERMA in a domain name or on a website.
6. the Complainant does not carry out any activity for, nor has any business with the Respondent.
7. the disputed domain name resolves to a website displaying the trademark BIODERMA and offering allegedly unauthorized or counterfeited BIODERMA goods at discounted prices.
8. it is used to host a website to impersonate the Complainant and attempt to mislead consumers into thinking that the goods purportedly offered for sale on the website originate from the Complainant.
9. once the Complainant's trademark and goods are displayed on the website it is clear that the Respondent registered the disputed domain name in knowledge of the Complainant and its trademarks.

10. 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.
11. the disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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 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, "loja" 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 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.

Panels have held that the use of a domain name for illegal activity here claimed: sale of counterfeit goods can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Also, the Panel considers that the composition of the disputed domain name carries a risk of implicit affiliation. [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.

In the present case, the Panel notes that the Respondent registered the disputed 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 most likely that the Respondent knew about the Complainant and its trademarks and registered the disputed domain name with the purpose of benefiting from their reputation. Such registration clearly demonstrates bad faith.

The Complainant contends and the Respondent does not rebut that it is using the disputed domain name to direct to an active website that offers 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 disputed domain name with the purpose of intentionally attempting to create a likelihood of confusion with the Complainant's trademark as to the disputed 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 disputed 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 disputed domain name <lojabioderma.com> be transferred to the Complainant.

*/Gonçalo M. C. Da Cunha Ferreira/*

**Gonçalo M. C. Da Cunha Ferreira**

Sole Panelist

Date: November 4, 2024