

ADMINISTRATIVE PANEL DECISION

OBAGI HOLDINGS COMPANY LIMITED v. KathleenCarter

Case No. D2024-4002

1. The Parties

Complainant is OBAGI HOLDINGS COMPANY LIMITED, United Kingdom, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

Respondent is KathleenCarter, United States of America (“United States”).

2. The Domain Names and Registrar

The disputed domain names <obagibeautystore.shop>, <obagimedicalbeauty.shop> and <obagiskincarecenter.shop> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 29, 2024, including the disputed domain names and an additional domain name. On September 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 1, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Not Disclosed) and contact information in the Complaint.

The Center sent an email communication to Complainant on October 3, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. On October 8, 2024, Complainant filed an amended Complaint and a request to withdraw one domain name with different underlying registrant details from the Complaint. The partial withdrawal was duly notified on October 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 Respondent of the Complaint, and the proceedings commenced on October 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on November 7, 2024.

The Center appointed Gabriel F. Leonardos as the sole panelist in this matter on November 14, 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 global company known for their skincare products, which result from the company's investments in research of skin biology.

Over the past 35 years, Complainant engaged in transformational skincare, being the first brand to clinically test products on all skin types and tones and achieving an excellent reputation for medical-grade skincare.

Complainant is the owner of trademark registrations throughout the world for OBAGI and OBAGI MEDICAL trademarks, and operates the domain name <obagi.com>, registered since January 26, 1998.

Some examples of Complainant's trademarks registrations for OBAGI and OBAGI MEDICAL can be found below:

Registration	Trademark	Jurisdictions	International Class	Registration Date
1495947A	OBAGI	International	3, 5, 35, 41, 44	July 31, 2019
1592492A	OBAGI MEDICAL	International	3, 35	March 29, 2021
2203028	OBAGI	United States	3	November 10, 1998
2786594	OBAGI	United States	44	November 25, 2003

The disputed domain names were registered on July 31, 2024, and used to resolve to online shops in which Respondent apparently sold various goods, including OBAGI products. The disputed domain names currently resolve to inactive webpages.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Complainant argues that the disputed domain names are confusingly similar to the trademarks OBAGI and/or OBAGI MEDICAL, as well as with Complainant's domain name <obagi.com>, since the disputed domain names fully incorporate OBAGI and/or OBAGI MEDICAL, with the sole addition of generic words such as "beauty", "store", "skincare" and "center" and the generic Top-Level Domain ("gTLD") ".shop".

Therefore, according to Complainant, the disputed domain names are confusingly similar with Complainant's trademarks OBAGI and OBAGI MEDICAL, fulfilling paragraph 4(a)(i) of the Policy.

Moreover, Complainant contends that Respondent is not affiliated with Complainant and that no business or activities are conducted between them. Additionally, Complainant states that no license or authorization has been given for the use of the trademarks OBAGI and OBAGI MEDICAL or for the registration of the disputed domain names by Respondent.

Complainant states that Respondent did not make bona fide use of the websites which purports from the disputed domain names. When Complainant became aware of the disputed domain names, they used to resolve to online shops offering Complainant's products. In addition, Complainant informs that now the disputed domain names resolve to inactive websites.

Furthermore, Complainant claims that Respondent has not been commonly known by the name "obagi" nor by any variation matching the disputed domain names such as "obagi beauty store", "obagi medical beauty", or "obagi skincare center", nor does Respondent own any trademarks for such terms.

In this manner, Complainant states that no legitimate use of the disputed domain names could be reasonably claimed by Respondent, thus paragraph 4(a)(ii) of the Policy has been fulfilled.

Complainant asserts that their business and the trademarks OBAGI and OBAGI MEDICAL are well-known worldwide, considering the company's worldwide presence for over 35 years. Complainant further notes that Respondent used to offer Complainant's products on the websites under the disputed domain names.

Consequently, Complainant pledges that Respondent was necessarily aware of Complainant's reputation in the field of skincare products when registering the disputed domain names; and that Respondent intentionally tried to create confusion with Complainant's rights and reputation in the beauty sector to attract Internet users to its websites to obtain undue commercial gain.

After the deactivation of said websites, Complainant also notes that the current passive holding of the disputed domain names is a sign of bad faith, since it is likely that Respondent is doing that to prevent Complainant from registering domain names using terms such as "skincare" and "store", which are closely linked to Complainant's business.

Thus, according to Complainant, the requirements for the identification of a bad faith registration and use of the disputed domain names have been fulfilled, pursuant to paragraph 4(a)(iii) of the Policy.

Accordingly, Complainant requests transfer of the disputed domain names to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

To succeed in a UDRP complaint, complainants must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) 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.

The burden of proving these elements is upon Complainant.

Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the complaint, in the absence of exceptional circumstances, the panel's decision shall be based upon the complaint.

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.

Based on the available record, the Panel finds 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 trademark OBAGI is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds that the disputed domain names are confusingly similar to Complainant's trademarks OBAGI and/or OBAGI MEDICAL, with the sole addition of terms such as "beauty", "store", "skincare" and "center", which by themselves are not sufficient to prevent a finding of confusing similarity between the disputed domain names and Complainant's trademarks. [WIPO Overview 3.0](#), section 1.8.

The disputed domain names contain also of the gTLD ".shop". The applicable gTLD in a domain name, such as ".shop" in this case, is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

The Panel notes that Complainant argues that Respondent was at the time they became aware of the disputed domain names likely using the disputed domain names to create confusion among Internet users and create the impression that Respondent's websites are affiliated with or endorsed by Complainant. Respondent has failed to refute said claim. Moreover, the composition of the disputed domain names by itself carries a risk of implied affiliation to Complainant, and as such, cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, Respondent is not entitled to any trademark, trade name, or any other right associated with the disputed domain names. Additionally, Respondent has not been authorized by

Complainant to use the OBAGI trademark, and there is no commercial relationship between the Parties. Respondent is not commonly known by the disputed domain names, and the Panel notes that the disputed domain names used to resolve to websites in which Respondent allegedly offered Complainant's products amongst third-party products. In light of these circumstances, the Panel finds that no rights or legitimate interests can be found on behalf of Respondent.

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 Respondent has registered disputed domain names that are confusingly similar to Complainant's trademarks OBAGI and/or OBAGI MEDICAL, as explained above in 6.A. Also, based on the available record, Respondent has no affiliation with Complainant and the trademarks OBAGI and OBAGI MEDICAL, nor has it sought authorization or a license to utilize the referred trademarks. Respondent also does not own any trademarks containing the term "obagi".

Furthermore, considering Complainant's significant worldwide reputation in connection with skincare products, Respondent evidently knew or should have known of the existence of Complainant's prior trademark rights and domain name, which were matters of public record, before registering the disputed domain names. Thus, Respondent must have had knowledge of Complainant's pre-existing rights in OBAGI and OBAGI MEDICAL as trademarks and domain name.

Therefore, it may be inferred that the registration of the disputed domain names was intentionally done with the aim of profiting from the reputation of Complainant's trademarks in question. This action creates a likelihood of confusion among Internet users, considering specially that Respondent allegedly used to sell Complainant's products in the now deactivated websites which purports from the disputed domain names, suggesting an association with Complainant and implying that the disputed domain names are associated or belongs to Complainant.

A further element to be considered and which corroborates Respondent's bad faith is its choice of contact information, since Respondent chose to register its address at a well-known museum. Such choice of contact details, that can only be false and hint to irony, cannot indicate Respondent's good faith.

The disputed domain names used to resolve to online shops in which Respondent allegedly offered to sell Complainant's products and third-party products, in an attempt to create likelihood of confusion amongst Internet users to attract undue commercial gain boosted by Complainant's trademarks OBAGI and OBAGI MEDICAL reputation.

The Panel finds that the circumstances of the present case allow for a finding of bad faith in the registration and use of the disputed domain names, considering that (i) Respondent likely had the intention to obtain commercial gain by using confusingly similar domain names to Complainant's trademark; and (ii) Respondent was most likely aware of Complainant's rights on the trademarks OBAGI and OBAGI MEDICAL, considering specially that Respondent offered Complainant's products on the websites under the disputed domain names, and aimed to create a likelihood of confusion within Internet users to suggest an affiliation with Complainant.

Respondent currently hosts inactive websites in the disputed domain names. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding.

Lastly, the Panel finds it is relevant that Respondent has not provided any evidence of good faith registration or use, or otherwise participated in this proceeding.

Based on the available record, the Panel finds that 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 names <obagibeautystore.shop>; <obagimedicalbeauty.shop>; and <obagiskincarecenter.shop> be transferred to Complainant.

/Gabriel F. Leonardos/

Gabriel F. Leonardos

Sole Panelist

Date: December 2, 2024