

ADMINISTRATIVE PANEL DECISION

Bora Creations, S.L, Cosnova GmbH v. louis overlock
Case No. D2024-4179

1. The Parties

The Complainants are Bora Creations, S.L, Spain (“First Complainant”), and Cosnova GmbH, Germany (“Second Complainant”), represented by Squire Patton Boggs (US) LLP, Germany.

The Respondent is louis overlock, Brazil.

2. The Domain Name and Registrar

The disputed domain name <essencemake.com> is registered with Squarespace Domains LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2024. On October 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 11, 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 Name / REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainants filed an amended Complaint on October 17, 2024.

On October 15, 2024, the Center informed the parties in Portuguese and English, that the language of the registration agreement for the disputed domain name is Portuguese. On October 17, 2024, the Complainants confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in English and Portuguese, and the proceedings commenced on October 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 11, 2024.

The Center appointed Gonalo M. C. Da Cunha Ferreira as the sole panelist in this matter on November 13, 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 First Complainant is a Spanish company that is the owner of the registered cosmetics brand ESSENCE used extensively for a broad range of cosmetics, including but not limited to lip liners, lip glosses, make-up, mascara, eyeliner as well as corresponding services sold worldwide.

Amongst others, the First Complainant owns the following trademark registrations:

- The European Union Trade Mark No. 009128711, for the ESSENCE mark, registered on November 8, 2010;
- the International Trademark registration No. 1536098, for the ESSENCE mark, registered on November 13, 2019; and
- The Brazilian Trademark registration No. 918126789, for the ESSENCE mark, registered on January 4, 2022.

The Second Complainant is the licensee of the above trademarks, and the authorized seller of the products marked under those trademarks.

The disputed domain name was registered on August 1, 2024.

At the time of the filing of the Complaint, the disputed domain name resolved to a website impersonating the Complainant and purportedly offering the Complainants products. At the time of this Decision, the disputed domain name resolves to a website displaying the message "Sorry, this store is currently unavailable".

5. Parties' Contentions

A. Complainant

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name, and accordingly request transfer of the disputed domain name to the First Complainant.

Notably, the Complainants contend that:

1. the disputed domain name is confusingly similar to the well-known brand ESSENCE;
2. the disputed domain name incorporates the term "essence" identically as its initial element and adds the term "make";
3. the disputed domain name is identical in its significant and distinctive part;
4. the addition of term "make" relates to the make-up and cosmetic sector, in which the Complainants operate;
5. the Respondent has no rights or legitimate interests in the disputed domain name and is not affiliated with the Complainants or licensed to use the First Complainant's ESSENCE trademarks;

6. the Respondent is neither commonly known by the disputed domain name nor has it acquired any trademark rights in the name through a bona fide offering of goods or services;
7. the use of the First Complainant's well-known ESSENCE trademarks by the Respondent appears to be aimed solely to make Internet users believe that the website available under the disputed domain name is operated by the Complainants and thus to attract consumers to that website;
8. the fact that the Respondent does not only use prominently the term "essence" on the website available under the disputed domain name but rather copied the entire look and feel, particularly the color scheme, of the websites operated by the Second Complainant under its domain names <essence.eu/pt-br> and <essence.eu/en-gb> emphasized the Respondent's sole intention to make Internet users believe that the website available under the disputed domain name is an official online shop of the Complainants;
9. the disputed domain name was registered and is used in bad faith as it uses the First Complainant's trademarks to attract Internet users to the Respondent's website based on a likelihood of confusion with the well-known ESSENCE trademarks;
10. the Respondent's use of the disputed domain name is a deliberate use of the confusion created by the similarity of the disputed domain name to the trademarks of the First Complainant.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Portuguese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that:

- a) the composition of the disputed domain name consists of two English words;
- b) the website available under the disputed domain name features various English terms, for example "Main Menu", "Home", "Catalog", and "Contact", which adds to the indication that the Respondent understands English;
- c) the Complainants are not able to efficiently communicate in Portuguese as they are not in a position to conduct the proceedings in Portuguese without a great deal of additional expense and delay;
- d) to provide a translated Complaint with its corresponding annexes would imply additional costs and cause delay in the procedure.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

Consolidation of Complainants

The Complaint was filed by two Complainants. The Complainants allege that they have a specific common grievance against the Respondent. The Complainants requests the consolidation of the Complaint pursuant to paragraph 10(e) of the Rules.

In addressing the Complainants' request, the Panel will consider whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation. See [WIPO Overview 3.0](#), section 4.11.1.

As regards a specific common grievance, the Panel notes that the First Complainant is the owner of the ESSENCE trademarks and the Second Complainant is a licensee of the ESSENCE trademarks, operating related domain names offering goods under the ESSENCE trademarks. The Panel is satisfied that the Complainants have a specific common grievance against the Respondent and that it would be equitable and procedurally efficient for the proceedings to be consolidated.

Accordingly, the Panel decides to consolidate the disputes regarding the Complainants (referred to below as "the Complainant", unless specified otherwise) in a single proceeding.

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, "make", 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 illegitimate activity, here claimed impersonation, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 mark and used it to resolve to a website which impersonated the websites hosted under the Complainant's domain names <essence.eu/pt-br> and <essence.eu/en-gb>. 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 intentionally attempting to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark. Such registration and use clearly demonstrates bad faith.

Panels have held that the use of a domain name for illegitimate activity, here, claimed impersonation, 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 <essencemake.com> be transferred to the First Complainant, Bora Creations, S.L.

/Gonçalo M. C. Da Cunha Ferreira/

Gonçalo M. C. Da Cunha Ferreira

Sole Panelist

Date: November 22, 2024