

## **ADMINISTRATIVE PANEL DECISION**

Herbalife International, Inc. v. Tang Minh Duc  
Case No. D2024-4251

### **1. The Parties**

The Complainant is Herbalife International, Inc., United States of America (“United States”), represented by SafeBrands, France.

The Respondent is Tang Minh Duc, Viet Nam.

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

The disputed domain name <suaherbalife.com> (the “Disputed Domain Name”) is registered with Mat Bao Corporation (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on October 15, 2024. On October 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 17, 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 contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 2024, providing the contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 22, 2024.

On October 17, 2024, the Center informed the parties in Vietnamese and English, that the language of the registration agreement for the Disputed Domain Name is Vietnamese. On October 22, 2024, the Complainant requested English to 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, and the proceedings commenced on October 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 15, 2024.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on November 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 company incorporated in the United States, and a manufacturer and retailer of dietary supplements, nutritional supplements, and personal care products, marketed and sold under the HERBALIFE trademark since 1980. The Complainant operates in more than 90 countries worldwide with USD 5.1 billion net sales in 2023.

The Complainant owns numerous HERBALIFE trademark registrations, including but not limited to United States Registration No. 1254211, registered on October 18, 1983; United States Registration No. 1969346, registered on April 23, 1996. The HERBALIFE trademark has also been protected in Viet Nam (e.g., Viet Nam Trademark Registration No. 40017232000, registered on July 10, 1995; Viet Nam Trademark Registration No. 40012123000, registered on June 8, 1996), where the Respondent resides.

The Complainant is also the owner of numerous domain names featuring the trademark HERBALIFE, among which the notable one is <herbalife.com> registered in 1998.

The Disputed Domain Name was registered on September 21, 2021. The Disputed Domain Name resolves to an active website offering products bearing the Complainant's HERBALIFE trademark.

#### **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, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark, in which the Complainant has rights.

The Complainant contends that the Disputed Domain Name is confusingly similar to its HERBALIFE trademark, because the HERBALIFE trademark is included in its entirety, being the most distinctive element in the Disputed Domain Name. The addition of the generic term "sua", which means "milk" in English, does not prevent a finding of confusing similarity.

Further, the Complainant argues that the addition of the generic Top-Level Domain ("gTLD") ".com" does not serve as a distinguishing feature under the Policy.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First, the Complainant submits that the Respondent is not commonly known by the name "Herbalife". The Complainant also contends that the Respondent is not affiliated with/related to, nor licensed/authorized by, the Complainant in any way to use the Complainant's HERBALIFE trademark or to sell "Herbalife" products.

Second, the Respondent is using the Disputed Domain Name in an unauthorized manner. The Disputed Domain Name resolves to a Vietnamese website that reproduces the Complainant's trademark, logo, copyrighted photos, in order to sell heavily discounted goods supposedly coming from the Complainant. There is nothing at the website to accurately disclose the relationship, if any, between the Respondent and the Complainant.

Furthermore, given the long-standing use and reputation of the Complainant's trademark, the Complainant asserts that the Respondent has intent to, for commercial gain, mislead Internet users into believing that the Respondent is associated with the Complainant, and divert Internet users looking for the Complainant's products to the Respondent's website. Thus, the Complainant asserts that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant submits that the Respondent registered the Disputed Domain Name in bad faith. Taken into account the use of the Complainant's trademark for over 40 years, the nature of the Disputed Domain Name, the high repute of the Complainant throughout the world, and in particular in Viet Nam, the Respondent could by no mean have ignored the existence of the Complainant's HERBALIFE trademark rights at the time of the registration of the Disputed Domain Name.

Second, the Complainant submits that the Respondent registered and is using the Disputed Domain Name for commercial gain and to profit from the resulting consumer confusion that the Disputed Domain Name website is endorsed by or associated with the Complainant. Particularly, the Disputed Domain Name resolves to an unauthorized and misleading website which offers for sale products supposedly coming from the Complainant at discounted price. Despite the Complainant's efforts with a view to resolving the matter amicably, the Respondent did not collaborate and remained silent to the Complainant's cease-and-desist letter.

Therefore, the Complainant considers that the Respondent registered and is using the Disputed Domain Name in bad faith under the Policy paragraph 4(b)(iii).

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **Language of the Proceeding**

The language of the Registration Agreement for the Disputed Domain Name is Vietnamese. 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:

- i. The Disputed Domain Name is identical to a distinctive and well-known Latin trademark and could not be aimed specifically to Vietnamese people.
- ii. The Complainant is based in the United States of America with no knowledge of the Vietnamese language.

- iii. The use of Vietnamese in this case would entail significant additional costs and delay due to the need for translation of the Complaint and supporting annexes.
- iv. The Disputed Domain Name resolves to a website displaying some content in English language; thus, it is safe to assume that the Respondent understands English.

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.

### **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 a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the Complainant has evidenced that it has rights in and to the HERBALIFE trademark, which was registered in several countries before the registration of the Disputed Domain Name.

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the Vietnamese term "sua", which means "milk" in English, 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.

In addition, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD ".com" to the Disputed Domain Name may be disregarded under the first element confusing similarity test because it is viewed as a standard registration requirement. [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.

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.

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that no license, permission, or authorization in any kind to use the Complainant's HERBALIFE trademark has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction related to “Herbalife”. Thus, the Panel finds that the Respondent has no rights in the HERBALIFE trademark.

A reseller or distributor may be making a bona fide offering of goods and services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Oki Data Americas, Inc. v. ASD, Inc., supra* (“Oki Data”), WIPO Case No. [D2001-0903](#), including:

- the Respondent must actually be offering the goods or services at issue;
- the Respondent must use the site to sell only the trademarked goods or services (otherwise, there is the possibility that the Respondent is using the trademark in a domain name to bait consumers and then switch them to other goods or services);
- the site itself must accurately and prominently disclose the Respondent's relationship with the trademark owner; and
- the Respondent must not try to “corner the market” in domain names that reflect the trademark, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

In this particular case, the Disputed Domain Name resolves to a website in Vietnamese, featuring the Complainant's trademark, and offering discounted products bearing the Complainant's HERBALIFE trademark. On such website, the Panel finds that the Respondent did not place any statement or disclaimer accurately and prominently disclosing its relationship with the Complainant. These indications may mislead consumers into believing in a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality.

With such a view, the Panel finds that the use of the Disputed Domain Name, wholly incorporating the Complainant's HERBALIFE trademark, does not meet the Oki Data criteria and thus, does not constitute a bona fide use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that there is no evidence that would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of

the Disputed Domain Name. In fact, as it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the HERBALIFE trademark and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Based on the foregoing findings, 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, including:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

In the present case, the Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not formally reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence relating to the Respondent's registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's HERBALIFE trademark has been registered and put in use in, among other countries, Viet Nam where the Respondent resides. These trademark registrations well predate the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the Complainant's HERBALIFE trademark in its entirety, adding only the non-distinctive term “sua”, which means “milk” in English, at the beginning. Given the extensive use of the HERBALIFE trademark for dairy supplements and nutritional supplements by the Complainant, which occurs in numerous countries, including in Viet Nam, where the Respondent resides, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name and the content of the website at the Disputed Domain Name, the Panel is of the view that the Respondent obviously knew the Complainant and its HERBALIFE trademark when it registered the Disputed Domain Name, and the Panel considers the registration is an attempt by the Respondent as to take advantage of the reputation and goodwill of the Complainant's trademark.

The Complainant provided evidence that the Disputed Domain Name resolves to an active website offering products bearing the Complainant's HERBALIFE trademark. In addition to the adoption of the Complainant's HERBALIFE trademark as a uniquely distinctive part of the Disputed Domain Name, the Respondent uses the Complainant's trademark and logo on the website, which falsely represented itself as the Complainant or the Complainant's associated entity.

The Panel takes the view that any Internet users seeking the Complainant's HERBALIFE goods would very likely mistakenly believe that the Respondent is either the Complainant or associated with the Complainant, while no such connection exists in fact. The Panel, therefore, finds that by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website on its website, which is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Based on the foregoing findings, 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 <suaherbalife.com> be transferred to the Complainant.

*/Pham Nghiem Xuan Bac/*

**Pham Nghiem Xuan Bac**

Sole Panelist

Date: December 5, 2024