

ADMINISTRATIVE PANEL DECISION

Obagi Holdings Company Limited v. Bergeron Richard
Case No. D2024-4261

1. The Parties

The Complainant is Obagi Holdings Company Limited, United Kingdom, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is Bergeron Richard, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <obagibeautyessentials.shop> is 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 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 confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 8, 2024.

The Center appointed Simone Huser 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

The Complainant is a global skincare products company with a focus on research and skin biology. Founded in 1988, the Complainant has developed and marketed skincare products for over 35 years under the sign “obagi”.

The Complainant holds the domain name <obagi.com>, which hosts its main website.

The Complainant, by itself or through its affiliated companies, owns numerous trademark registrations in several jurisdictions, including:

- United States Trademark Registration No. 2203028 for OBAGI, registered on November 10, 1998;
- European Union Trademark Registration No. 000164509 for OBAGI, registered on July 10, 1998;
- International Registration No. 1495947A for OBAGI, registered on July 31, 2019.

Because the Respondent did not file a Response, not much is known about the Respondent.

The disputed domain name was registered on August 7, 2024.

According to the evidence submitted with the Complaint, initially, the website associated with the disputed domain name appeared to offer various goods, including products under the trademark OBAGI.

The website posted under the disputed domain name provided an address that is the address of Sherlock Holmes Museum in London, United Kingdom. The same address was used for an online shop which was posted under the domain name <obagibeauty.shop> and which was subject to a recent UDRP proceeding (*Obagi Holdings Company Limited v. mike simon*, WIPO Case No. [D2024-2672](#)).

Currently, the disputed domain name resolves to an inactive 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 as follows:

The disputed domain name is confusingly similar to the OBAGI trademark, in which the Complainant has rights, because it incorporates this trademark in its entirety, and the addition of the descriptive terms “beauty” and “essentials” is not sufficient to avoid confusing similarity.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The trademark OBAGI has been extensively used to identify the Complainant and its products. The Respondent has not been authorized by the Complainant to use this trademark, is not commonly known by the disputed domain name, and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain name in connection with a bona fide offering of goods and services.

The disputed domain name was registered in bad faith because it is obvious that the Respondent had knowledge of both the Complainant and its trademark OBAGI at the time it registered the disputed domain name. The Respondent offering the Complainant's products on the website posted under the disputed domain name confirms that the Respondent had the Complainant in mind when registering the disputed

domain name.

The Respondent used the disputed domain name in bad faith, by seemingly offering products with the OBAGI trademark, albeit those products were of unknown origin. Since there was no agreement, or other authorization given by the Complainant to the Respondent for such activity, there is a possibility that the Respondent had been selling counterfeit products using the disputed domain name. Additionally, the Respondent has used false contact information on the website to which the disputed domain name used to resolve.

Currently the disputed domain name resolves to an inactive page. By passively holding the disputed domain name the Respondent is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

(i) the disputed domain name is identical or confusingly similar to the 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 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 Panel finds the entirety of the mark is reproduced within the disputed domain name.

Although the addition of other terms such as here "beauty" and "essentials" may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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 addition of the generic Top-Level Domain ("gTLD") ".shop" in the disputed domain name is a standard registration requirement and as such may be disregarded under the confusing similarity test under the Policy, paragraph 4(a)(i). See [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 Complainant has shown that the Respondent posted a website under the disputed domain name purporting to offer the Complainant’s products, and doubts whether those products were genuine or counterfeit. Even if those products were genuine, the Respondent’s use of the disputed domain name would not meet the “Okidata Test”, established on *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), because the website did not disclose the lack of relationship between the Respondent and the Complainant. [WIPO Overview 3.0](#), section 2.8.

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.

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.

In the view of the Panel, noting that that the Complainant’s trademark predates the registration of the disputed domain name and considering that the Complainant’s trademark is widely known, and the disputed domain name initially resolved to a website featuring the Complainant’s trademark and depictions of its products, it is inconceivable that the Respondent could have registered the disputed domain name without knowledge of the Complainant’s trademark. In the circumstances of this case, this is evidence of registration in bad faith.

Furthermore, the Respondent’s previous use of the Complainant’s trademark in the disputed domain name to sell beauty care products was a deliberate attempt by the Respondent to attract Internet users 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 in the sense of Policy, paragraph 4(b)(iv). The impression given by this website would cause Internet users to believe that the Respondent is somehow associated with Complainant when, in fact, it is not.

In particular, the use of false contact information on the website, which is the address of Sherlock Holmes Museum in London, United Kingdom (as reported above) and the Respondent's failure to participate in these proceedings further support the inference of registration and use in bad faith.

The Panel notes that currently the disputed domain name resolves to an inactive page. However, this does not preclude a finding of bad faith: 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. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and the Respondent's use of false contact details on the website previously posted under the disputed domain name.

Therefore, the Panel 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.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy with regard to the disputed domain name.

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 <obagibeautyessentials.shop> be transferred to the Complainant.

/Simone Huser/

Simone Huser

Sole Panelist

Date: November 25, 2024