

ADMINISTRATIVE PANEL DECISION

CLARINS v. NETLOCAL CONSULTING PTY LTD

Case No. DAU2023-0016

1. The Parties

The Complainant is CLARINS, France, represented by Tmark Conseils, France.

The Respondent is NETLOCAL CONSULTING PTY LTD, Australia.

2. The Domain Name and Registrar

The disputed domain name <clarins.au> is registered with Drop.com.au Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 8, 2023. On March 9, 2023, the Center transmitted by email to Drop.com.au Pty Ltd a request for registrar verification in connection with the disputed domain name. On March 14, 2023, Drop.com.au Pty Ltd 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 .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 4, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was April 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 2, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on May 16, 2023. 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 manufactures and distributes cosmetics and make-up products under and by reference to the trade mark CLARINS. According to the Complaint, it has been doing so for more than 60 years.

The Complainant's Facebook page has over 2.8 million followers. Its official Instagram page has 739,000 followers. Its official Australia and New Zealand Instagram account has over 31,000 followers.

The Complainant promotes its products, amongst other things, from websites to which <clarins.com> (which the Complainant registered in 1997) and <clarins.com.au> resolve.

The Complaint includes evidence that the Complainant has numerous registered trade marks for CLARINS around the world. These include:

- (a) Australian Registered Trade Mark No. 272254, CLARINS, which has been registered for perfume and cosmetic and beauty care products in International Class 3 with effect from September 13, 1973; and
- (b) Australian Registered Trade Mark No. 1393707, CLARINS, which has been registered with effect from September 29, 2010, in respect of cosmetic and beauty care services in International Class 44.

It is not clear from the Complaint or the Registrar's verification response when the disputed domain name was first registered. As it became possible to register domain names directly in the ".au" domain space only from March 24, 2022,¹ it must have been after then. It may well have been much later as direct registration was only possible for persons who already held a corresponding ".au" domain name registered in a second level domain such as ".com.au" or ".net.au" until September 20, 2022.²

So far as the record in this proceeding shows, the disputed domain name has not resolved to an active website or otherwise been in use.

On January 25, 2023, however, a person claiming to be a domain broker representing the Respondent contacted the Complainant, stating that the domain broker had recently been appointed by its client "to manage the sale of the recently released domain clarins.au".

5. Discussion and Findings

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules.

Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present their case.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights; and

¹ <https://assets.auda.org.au/a/2022-09/au%20direct%20fact%20sheet%2020220912.pdf?VersionId=NVyggjuBu16mirEBdcWsNoxR0ChgEvY>

² https://assets.auda.org.au/a/2022-09/Priority%20Allocation%20Process%20Fact%20Sheet%20120922.pdf?VersionId=yvKhA.NtCbGuW0JqQGggqRZxz9.iA_VC

- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (ii) the disputed domain name has been registered or subsequently used in bad faith.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's name, trade mark or service mark.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a name, trade mark or service mark at the date the Complaint was filed and, if so, the disputed domain name must be identical or confusingly similar to the name or mark.

The Complainant has proven that it owns at least the registered trade marks for CLARINS referred to in Section 4 above.

On the question of identity or confusing similarity, what is required is simply a visual and aural comparison and assessment of the disputed domain name itself to the Complainant's trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd.*, WIPO Case No. [DAU2002-0001](#). This test is narrower than and thus different to the question of "likelihood of confusion" under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any impugned use is involved, geographical location or timing. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

Typically and as is appropriate in this case, it is permissible to disregard the country code Top Level Domain ("ccTLD"), ".au", as a functional component of the domain naming system. Prior to the introduction of direct registration, this was the approach taken to second level and first level suffixed under the Policy. See for example auDA Overview of Panel Views on Selected auDRP Questions First Edition ("auDRP Overview 1.0"), section 1.2 (dealing with second Level Domains but the same principle applies). By parity of reasoning, it also applies to the first level suffix alone following the introduction of direct registration. See for example WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.10 dealing with generic Top Level Domains such as ".com" and ".net".³ The Panel notes that approach is also expected under the Overview of Panel Views on Selected auDRP Questions, Second Edition, section 1.11.

Disregarding the ccTLD, therefore, the Panel finds that the disputed domain name is identical to the Complainant's trade mark and the Complainant has established the first requirement under the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (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 (not being the offering or domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or

³ Although [WIPO Overview 3.0](#) is directed to the Uniform Domain Name Dispute Resolution Policy ("UDRP"), given the similarity between the UDRP and the auDRP, it is appropriate to have regard to these principles except to the extent that the auDRP diverges from the UDRP.

- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark 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 trade mark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Previous panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

In the present case, the disputed domain name has been registered long after the Complainant began using its trade mark and also long after the Complainant registered its trade mark.

The disputed domain name is not derived from the Respondent's name or either of the individual names identified by the Registrar as associated with the registration of the disputed domain name – M[...] E[...] and D[...] L[...]; Mr L[...] being identified by the Registrar as the account owner on Drop.com.au on which the disputed domain name resides and also the domain name broker who contacted the Complainant soliciting offers to buy the disputed domain name.

So far as the record shows, the Respondent does not hold any trade marks from which the disputed domain name could be derived.

The Complainant also states that the Respondent is not associated with the Complainant in any way and has not been licensed or authorised by the Complainant to register the disputed domain name.

The Respondent has not disputed any of these matters. Nor has the Respondent provided any evidence to support a claim for demonstrable preparations to use the disputed domain name in connection with a good faith offering of goods or services or, for that matter, some non-commercial or other fair use.

On the contrary, given the short time between registration of the disputed domain name (at the earliest March 24, 2022 and likely after September 20, 2022), the implicit offer to sell the disputed domain name, as discussed in section 5C below, constitutes registration and use in bad faith in the absence of rights or legitimate interests in the disputed domain name.

Even without regard to the implicit offer to sell the disputed domain name to the Complainant, these matters clearly satisfy the requirement of a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name. As noted above, therefore, the circumstances call for an explanation from the Respondent rebutting that *prima facie* case. No such attempt has been made.

Accordingly, the Panel finds that the Complainant has established the second requirement under the Policy also.

C. Registered or Subsequently Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent. In contrast to the UDRP, the requirements of registration or use are disjunctive. It is necessary for the Complainant to establish only one or the other.

Paragraph 4(b) of the Policy provides that:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (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 another person 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 a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location; or
- (v) if any of your representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

The instances of bad faith set out in paragraph 4(b) of the Policy are examples only, intended to illustrate types of conduct which is caught by the Policy.

Generally speaking, a finding that a domain name has been registered or is being used in bad faith requires an inference to be drawn that the respondent in question has registered or is using the disputed domain name to take advantage of its significance as a trade mark owned by (usually) the complainant.

In the present case, the Complainant's trade mark is a distinctive term which, so far as the materials before the Panel indicate, has significance only as the Complainant's trade mark. Further, having regard to the length and extent of use of the Complainant's trade mark, it appears to be very well known in the field of cosmetics and beauty care products.

Further, when the domain broker approached the Complainant to solicit an offer to buy the disputed domain name, the broker indicated he was doing so on the basis that the Complainant was already the owner of the domain name <clarins.com.au>. This approach, it should be remembered, was only a short time after registration of the disputed domain name.

In these circumstances, the Panel infers the Respondent was well aware of the Complainant's trade mark or at least that the Complainant was using the domain name <clarins.com.au> when the Respondent registered the disputed domain name. Further, having regard to the timing of the domain broker's invitation, the Panel infers that the Respondent registered the disputed domain name for the purpose to which the Respondent has used the disputed domain name: to solicit an offer to buy the disputed domain name from the Complainant. In that connection, it is important to bear in mind that direct registration in the ".au" domain has only recently become possible. Accordingly, the Panel infers that the Respondent registered the disputed domain name primarily with the intention of selling, renting or otherwise transferring the disputed domain name to the Complainant.

This is sufficient for a finding of registration in bad faith. The implicit offer to sell the disputed domain name further constitutes use in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. Decision

For all 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, <clarins.au>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: May 30, 2023