

ADMINISTRATIVE PANEL DECISION

NAOS v. Reza Poorlatifi
Case No. DIR2023-0010

1. The Parties

The Complainant is NAOS, France, represented by Nameshield, France.

The Respondent is Reza Poorlatifi, Iran (Islamic Republic of).

2. The Domain Name and Registry

The disputed domain name <institut-esthederm.ir> is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2023. On September 13, 2023, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On September 17, 2023, IRNIC 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 (Not identified) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 18, 2023.

The Center verified that the Complaint and the amended Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir 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 September 19, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was October 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 10, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on October 13, 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 is a company operating in the field of skincare, founded more than 40 years ago. The Complainant has trademark registrations for the trademark INSTITUT ESTHEDERM. For example, French Trademark Registration No. 1590412, registered on October 19, 1990.

The Respondent registered the disputed domain name on August 19, 2023. The disputed domain name resolves to a website which purports to sell the Complainant's products.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The disputed domain name incorporates the Complainant's trademark in its entirety with the addition of a hyphen, which does not eliminate confusing similarity. The addition of the country code Top-Level Domain ("ccTLD") does not prevent the likelihood of confusion.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name. The Respondent is not authorized by the Complainant to use its trademark nor is it affiliated with the Complainant. The Respondent is attempting to impersonate the Complainant. There is no *bona fide* offering of goods or services nor is there a legitimate noncommercial or fair use.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant's trademark is used worldwide. The Respondent refers to the Complainant's products and its company name. The Complainant's trademark is distinctive. The Respondent must have known of the Complainant's trademark. The Respondent is attempting to attract Internet users to its website possibly offering fraudulent products while impersonating the Complainant or at minimum be in competition with the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns many trademark registrations for the trademark INSTITUT ESTHEDERM. Accordingly, the Panel is satisfied that the Complainant has established its ownership of the trademark INSTITUT ESTHEDERM. The disputed domain name incorporates the Complainant's trademark INSTITUT ESTHEDERM in its entirety, solely adding a hyphen, which does not eliminate confusing similarity. The ccTLD ".ir" can be ignored when assessing confusing similarity as it is a standard registration requirement.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant

asserts, amongst other things, that the Respondent is not authorized by the Complainant to use its trademark. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

According to the Policy, the use of the disputed domain name would be legitimate if it is used in connection with a *bona fide* offering of goods or services. The website to which the disputed domain name resolves purportedly offers products of the Complainant. Therefore, there may be an argument that the disputed domain name is being used in connection with a *bona fide* offering of products. In line with the *Okidata* test, a number of requirements have to be met (see *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)):

- (i) “Respondent must actually be offering the goods or services at issue”;
- (ii) “Respondent must use the site to sell only the trademarked goods”;
- (iii) “The site must accurately disclose the registrant’s relationship with the trademark owner”; and
- (iv) “The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name”.

The Panel analyzes each of these requirements below:

- Requirement No. 1: It would appear that this requirement is met in view of the offerings at the disputed domain name, though the Panel is doubtful whether such offerings can actually be purchased and delivered in view of the circumstances of this proceeding;
- Requirement No. 2: This requirement is met;
- Requirement No. 3: This requirement is not met as the website does not include a statement demonstrating that it does not belong or is not affiliated with the Complainant;
- Requirement No. 4: This requirement is met.

Therefore, it is the Panel’s view that the requirements of the *Okidata* test have not been met.

Moreover, the Respondent has not provided any evidence to show that it has any rights or legitimate interests in the disputed domain name. In addition, even if the disputed domain name had met the *Okidata* test enshrined above, given the nearly identical nature of the disputed domain name as compared to the Complainant’s trademark, the risk of implied affiliation to the Complainant would render any fair use implausible. [WIPO Overview 3.0](#), section 2.5.1.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered or Used in Bad Faith

The Respondent must have known about the Complainant’s business and trademark as the disputed domain name resolves to a website offering the Complainant’s products. The disputed domain name was registered more than 30 years after the registration of the Complainant’s trademark. The nature of the disputed domain name suggests affiliation with the Complainant as it incorporates the Complainant’s trademark in its entirety. The display of the Complainant’s product images reinforces the impression that the disputed domain name is affiliated with the Complainant.

Such conduct of using a domain name, to attract Internet users for commercial gain, would fall squarely within the meaning of paragraph 4(b)(iv) of the Policy, and accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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, <institut-esthederm.ir>, be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: October 17, 2023