Panel Decision for dispute CAC-ADREU-008601

Case number	CAC-ADREU-008601
Time of filing	2024-04-11 14:50:22
Domain names	esthederm.eu

Case administrator

	Olga Slanařová (Case admin)

Complainant

Organization	NAOS

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	March Tilley

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceeding regarding the disputed domain name.

FACTUAL BACKGROUND

The Complainant is established in France. It is a major player in skincare with its three brands BIODERMA, INSTITUT ESTHEDERM and ETAT PUR. The Complainant is ranked among the top 10 independent beauty companies, and has more than 3100 employees in 48 subsidiaries in different countries. The Complainant's website for its INSTITUT ESTHEDERM brand is located at the domain name <esthederm.com>.

The Complainant is the owner of the following trademark registrations for the sign "INSTITUT ESTHEDERM" (collectively, the "INSTITUT ESTHEDERM trademark"):

- the French trademark INSTITUT ESTHEDERM with registration No. 1590412, registered on 27 April 1990 for goods and services in International Classes 3, 5 and 44; and

- the European Union trademark INSTITUT ESTHEDERM PARIS with registration No. 003440451, registered on 14 March 2005 for goods and services in International Classes 3 and 44.

The Respondent appears to be a physical person.

The disputed domain name <esthederm.eu> (the "disputed domain name") was registered with Key-Systems GmbH (the "Registrar") on 8 March 2021, and resolves to a parking webpage with commercial links, where it is offered for sale for 9500 US Dollars.

A. COMPLAINANT

According to the Complainant, the disputed domain name is confusingly similar to its INSTITUT ESTHEDERM trademark, because the deletion of the term "institut" is not sufficient to escape the confusing similarity.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by the disputed domain name, is not affiliated with nor authorized by the Complainant in any way, and the Complainant has no business with the Respondent. According to the Complainant, the Respondent is not carrying out a bona fide offering of goods or services or

making a legitimate non-commercial or fair use of the disputed domain name, because it resolves to a parking webpage with commercial links and is offered for sale for 9500 US Dollars.

The Complainant notes that the disputed domain name is confusingly similar to its INSTITUT ESTHEDERM trademark and was registered several years after the same trademark, and all results of an Internet search of the term "esthederm" are related to the Complainant. In view of this, given the distinctiveness of the Complainant's INSTITUT ESTHEDERM trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain name with knowledge of the same trademark. Furthermore, the disputed domain name resolves to a parking webpage with commercial links. According to the Complainant, this shows that the Respondent attempts to attract Internet users to its own website for commercial gain, exploiting the Complainant's INSTITUT ESTHEDERM trademark. Finally, the disputed domain name is offered for sale for 9500 US Dollars, which shows that the Respondent has registered it primarily for the purpose of selling it for valuable consideration in excess of its documented out of pocket costs directly related to the disputed domain name.

B. RESPONDENT

The Respondent did not file a Response in this proceeding.

DISCUSSION AND FINDINGS

According to Article 4 of Regulation (EU) 2019/517 of the European Parliament and of the Council of 19 March 2019 on the implementation and functioning of the .eu top-level domain name and amending and repealing Regulation (EC) No 733/2002 and repealing Commission Regulation (EC) No 874/2004 ("the Regulation"), a domain name may also be revoked, and where necessary subsequently transferred to another party, following an appropriate ADR or judicial procedure, in accordance with the principles and procedures on the functioning of the .eu TLD laid down pursuant to Article 11, where that name is identical or confusingly similar to a name in respect of which a right is established by Union or national law, and where it:

(a) has been registered by its holder without rights or legitimate interest in the name; or

(b) has been registered or is being used in bad faith.

Under Article 11(d)(1) of the .eu Alternative Dispute Resolution Rules (the "ADR Rules"), the Panel shall issue a decision granting the remedies requested under the ADR Rules in the event that the Complainant proves in an ADR Proceeding where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated, that:

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and;

either

(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) The domain name has been registered or is being used in bad faith.

According to the information available to the Panel, the Respondent has confirmed that it would not file a Response in this ADR proceeding.

Is the disputed domain name identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law?

Article 4 of the Regulation and Article 11(d)(1)(i) of the ADR Rules refer to trademarks in respect of which a right is recognized or established by the national law of a Member State and/or European Union law.

The Panel finds that Complainant is the owner of the INSTITUT ESTHEDERM trademark, details of which are given above, and for which the Complainant has provided evidence which was not disputed by the Respondent. This trademark registration gives rise to rights of the Complainant in the name INSTITUT ESTHEDERM within the meaning of Article 4 of the Regulation and Article 11(d)(1)(i) of the ADR Rules, i.e., rights established by the national law of a Member State (France) and European Union law.

It is widely accepted that the suffix ".eu" is not relevant for the purposes of the test for identity or confusing similarity under Article 4 of the Regulation. Therefore, the dominant element of the disputed domain name, which has to be analysed for the purpose of this test is the element "esthederm". This element is identical to the distinctive element "esthederm" of the INSTITUT ESTHEDERM trademark, which makes the trademark easily recognizable in the disputed domain name.

For these reasons, the Panel finds that the disputed domain name is confusingly similar to the INSTITUT ESTHEDERM trademark, in respect of which a right of the Complainant is established by the national law of a Member State (France) and European Union law. Therefore, the first condition set forth under Article 4 of the Regulation and Article 11(d)(1)(i) of the ADR Rules is fulfilled.

Has the Respondent registered the disputed domain name without having rights or legitimate interests in it?

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by it, is not affiliated with or authorized by the Complainant in any way, and has no business with the Complainant. According to the Complainant, the Respondent is not carrying out a bona fide offering of goods or services or making a legitimate non-commercial or fair use of the disputed domain name, because it resolves to a parking webpage with commercial links and is offered for sale for 9500 US Dollars.

As discussed in section IV.5 of the Overview of CAC Panel Views on Selected Questions of the Alternative Dispute Resolution for .EU Domain Name Disputes, 2nd Edition ("CAC .EU Overview 2.0"), the overall burden of proof lies with the complainant. Cases have shown that it is often impossible for a complainant to prove negative facts because some required information is only within the knowledge of the respondent. Therefore, the complainant is only able to make a "prima facie" case that the respondent lacks rights and legitimate interests in the disputed domain name. The burden of proof shifts to the respondent then. If the respondent fails to show evidence of rights or legitimate interests it is deemed to have none.

The Respondent was given a fair opportunity to respond to the Complaint and to present its case, but has not done so and has not challenged the allegations and the evidence submitted by the Complainant. It has not provided any explanation why it has acquired the disputed domain name and how it intends to use it. The Respondent has also failed to contend that any of the circumstances described in Article 11(E) of the Regulation - or indeed any other circumstance - is present in its favour.

As discussed in section IV.11 of the CAC .EU Overview 2.0, the use of a domain name to post parking pages or mere pay-per-click links does not of itself confer rights or legitimate interests, especially if links lead to websites of the right holder's competitors.

The evidence in the case file shows that the disputed domain name has been used for a parking webpage containing commercial links to various third-party offerings, including for cosmetic products and services, which are competitive to the Complainant's products and services.

In view of the above, and in the absence of any evidence leading to a different conclusion, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name, and that the condition under Article 4(a) of the Regulation and Article 11(d)(1)(ii) of the ADR Rules is satisfied.

This finding would be sufficient to provide a requested transfer of the disputed domain name, but the Panel assessed also the third element claimed by the Complainant – bad faith.

Has the disputed domain name been registered or is it being used in bad faith?

As noted by the Complainant, the disputed domain name was registered several years after the distinctive INSTITUT ESTHEDERM trademark, and all results of an Internet search of the term "esthederm" refer to the Complainant. In view of this and the absence of any evidence supporting a conclusion that the Respondent may have independently created the disputed domain name, it is more likely than not that the Respondent has registered and used the disputed domain name with knowledge of the Complainant's trademark.

The evidence shows that the disputed domain name resolves to a parking webpage containing commercial links to third party websites, which offer various products and services, many of which relate to cosmetics, which makes them competitive to the offerings of the Complainant. The Respondent has not explained why it has registered the disputed domain name and how it intends to use it.

Taking the above into account, the Panel concludes that it is more likely than not that, by registering and using the disputed domain name, the Respondent attempts to attract Internet users to its own website and to third-party competitive offerings for commercial gain, by exploiting the goodwill of the Complainant's INSTITUT ESTHEDERM trademark. This supports a conclusion that the disputed domain name was registered and is being used in bad faith under Article 4(b) of the Regulation and Article 11(f)(4) of the ADR Rules.

It is also notable that the webpage to which the disputed domain name resolves offers it for sale for 9500 US Dollars. In the totality of the circumstances of the present case, this supports a conclusion that it is more likely than not that the disputed domain name was registered primarily for the purpose of selling it to the Complainant, which is evidence of bad faith under Article 11(f)(1) of the ADR Rules.

Therefore, the Panel finds that the disputed domain name was registered and is being used in bad faith under Article 4(b) of the Regulation and Article 11(d)(1)(iii) of the ADR Rules.

Eligibility

The remedy sought by the Complainant is the transfer of the disputed domain name to the Complainant. As the Complainant has its registered office in France, it satisfies the general eligibility criteria for registration of the disputed domain name set out in Article 3 of the Regulation. Therefore, the Complainant is entitled to request the transfer of the disputed domain name.

Taking all the above into account, the Panel finds that Complainant has established the prerequisites under the Regulation for the transfer of the disputed domain name.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name esthederm.eu be transferred to the Complainant

PANELISTS

Name	**Assen Alexiev**

DATE OF PANEL DECISION 2024-04-11

Summary

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: esthederm.eu

II. Country of the Complainant: France, country of the Respondent: Spain

III. Date of registration of the domain name: 8 March 2021

IV. Rights relied on by the Complainant (B(11)(f) ADR Rules) on which the Panel based its decision:
1. the French trademark INSTITUT ESTHEDERM with registration No. 1590412, registered on 27 April 1990 for goods and services in International Classes 3, 5 and 44; and

2. the European Union trademark INSTITUT ESTHEDERM PARIS with registration No. 003440451, registered on 14 March 2005 for goods and services in International Classes 3 and 44.

V. Response submitted: No

VI. Domain name is confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (B(11)(f) ADR Rules):
1. No
2. Why: the disputed domain name has been used for a parking webpage containing commercial links to various third-party offerings, including for cosmetic products and services, which are competitive to the Complainant's products and services.

VIII. Bad faith of the Respondent (B(11)(e) ADR Rules):
1. Yes
2. Why: by registering and using the disputed domain name, the Respondent attempts to attract Internet users to its own website and to third-party competitive offerings for commercial gain, by exploiting the goodwill of the Complainant's INSTITUT ESTHEDERM trademark. The webpage to which the disputed domain name resolves offers it for sale for 9500 US Dollars, which supports a conclusion that it is more likely than not that the disputed domain name was registered primarily for the purpose of selling it to the Complainant.

IX. Other substantial facts the Panel considers relevant: N/A

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: N/A

XII. If transfer to Complainant - Is Complainant eligible? Yes