

ADMINISTRATIVE PANEL DECISION

Deciem Beauty Group Inc. v. 曾祥和 (cengxianghe)
Case No. D2022-4386

1. The Parties

The Complainant is Deciem Beauty Group Inc., Canada, represented by Gowling WLG (Canada) LLP, Canada.

The Respondent is 曾祥和 (cengxianghe), China.

2. The Domain Name and Registrar

The disputed domain name <deciem.group> (the “Disputed Domain Name”) is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 17, 2022. On November 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 22, 2022, 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 named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 2022 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 amendment to the Complaint in English on November 30, 2022.

On November 22, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant requested that English be the language of the proceeding on November 30, 2022. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment to 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 in English and Chinese of the Complaint, and the proceedings commenced on December 5, 2022. In accordance with

the Rules, paragraph 5, the due date for Response was December 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 27, 2022.

The Center appointed Peter J. Dernbach as the sole panelist in this matter on January 5, 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 skin care and beauty company headquartered in Canada. Since its launch in 2013, the Complainant has more than 50 products sold in markets and its products have been promoted and sold around the world.

The Complainant owns a large international portfolio of trademarks for DECIEM, including the following:

- Canadian trademark registration number 884741, registered on August 26, 2014;
- European Union Trade Mark number 012914644, registered on October 20, 2014; and
- Chinese trademark registration number 17096399, registered on October 28, 2016.

The Complainant also operates an official website at "www.deciem.com" to offer its services.

The Disputed Domain Name <deciem.group> was registered on July 14, 2022, and the Disputed Domain Name resolves to an inactive website. However, the Complainant has provided evidence that the Disputed Domain Name has been used to send at least one fraudulent email impersonating the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant's submissions may be summarized as follows:

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

The Complainant is the owner of the DECIEM trademarks. The Disputed Domain Name incorporates the Complainant's DECIEM trademark in its entirety. The generic Top-Level Domain ("gTLD") is without legal significance in determining the issue of similarity. Thus, the Disputed Domain Name is confusingly similar to the Complainant's DECIEM trademarks.

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

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant argues that there is no evidence suggesting that the Respondent has ever used, or has demonstrated preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. There is no evidence suggesting that the Respondent has been commonly known by the Disputed Domain Name. In addition, there has never been any relationship with between the Complainant and the Respondent and the Respondent is not licensed or authorized by the Complainant to register or use the DECIEM trademarks in any manner, including in, or as part of, a domain name.

The Complainant further argues that the Respondent registered the Disputed Domain Name as part of a fraudulent scheme to secure permission to sell the Complainant's goods on online marketplace platforms. By using the Disputed Domain Name as part of an email address, the Respondent creates the false impression that the email was sent by the Complainant. Thus, the Respondent's activities undermine any claim of rights in the Disputed Domain Name.

In light of the above, the Complainant concludes that the Respondent's activities do not correspond to any of the circumstances set forth in the Policy paragraph 4(c).

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

The Complainant contends that given the distinctive nature and reputation of its DECIEM trademarks, the only plausible conclusion is that the Respondent knew, or should have known of the Complainant's DECIEM trademarks at the time it registered the Disputed Domain Name. This supports a finding of registration in bad faith.

The Complainant argues that the Respondent registered and used the Disputed Domain Name as part of a fraudulent scheme to secure permission to sell the Complainant's goods on various online marketplace platforms, and that the Disputed Domain Name was therefore registered and used in bad faith.

The Complainant requests the transfer of the Disputed Domain Name.

B. Respondent

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

6. Discussion and Findings

6.1. Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Paragraph 10(b) of the Rules provides that "[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case"; and paragraph 10(c) of the Rules provides that "[t]he Panel shall ensure that the administrative proceeding takes place with due expedition [...]."

The language of the Registration Agreement is Chinese, and the Complaint is filed in English. On November 22, 2022, the Center notified both Parties in English and Chinese that the language of the Registration Agreement is Chinese and invited both Parties to comment on the language of the proceeding. The Complainant submitted its request that the language of the proceeding be English on November 30, 2022, while the Respondent did not make any comments on the language of the proceeding and did not submit any arguments on the merits.

The Panel has considered the following elements of this case:

- (i) The Complainant's request that the language of the proceeding be English;
- (ii) The Disputed Domain Name consists of English words only;
- (iii) The Respondent did not comment on the language of the proceeding and did not submit arguments on the merit;

- (iv) The fraudulent email from the Respondent was written in English, which suggests the Respondent is conversant in English; and
- (v) Using Chinese as the language of the proceeding could lead to unwarranted delay and costs for the Complainant and unnecessary delays to the administrative proceeding.

Given the above considerations, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive Issues

In accordance with paragraph 4(a) of the Policy, in order to succeed in this administrative proceeding and obtain the requested remedy (in this case, transfer of the Disputed Domain Name), the Complainant must prove that each of the three following elements are present:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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

The Complainant has established that it is the owner of valid trademark rights in the DECIEM trademark.

The Panel finds that the Disputed Domain Name contains the Complainant's registered trademark DECIEM in its entirety.

Normally, in relation to the gTLD, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1 states: "The applicable Top-Level Domain ('TLD') (e.g., '.com', '.club', '.nyc') in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." The applicable gTLD ".group" in this case is viewed as a standard registration requirement, and may as such be disregarded by the Panel.

Thus, the Panel finds that the Disputed Domain Name is identical to a trademark or service mark in which the Complainant has rights, and the condition of paragraph 4(a)(i) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy provides that "[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative dispute resolution service provider], in compliance with the Rules of Procedure, that [...] (ii) [the respondent has] no rights or legitimate interests in respect of the [disputed] domain name[.]"

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, the Disputed Domain Name, for the purposes of paragraph 4(a)(ii) of the Policy:

"(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent has] acquired no trademark or service mark rights; or

(iii) [the Respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy, the Complainant is required to first establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The burden of production would then shift to the Respondent to come forward with appropriate evidence demonstrating rights or legitimate interests in the Disputed Domain Name.

The Complainant states that it has neither licensed nor authorized the Respondent to register or use the Complainant’s DECIEM trademark in any manner, including in, or as part of, a domain name. According to the information provided by the Registrar, the Respondent’s name, “cengxianhe (曾祥和)”, does not appear to be related to the Disputed Domain Name. There is no evidence suggesting that the Disputed Domain Name is being used in connection with a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, and the burden of production shifts to the Respondent. The Respondent has not submitted any argument or evidence in response. Moreover, the Disputed Domain Name has been used to send at least one fraudulent email impersonating the Complainant. Such use can never confer rights or legitimate interests on the Respondent (see [WIPO Overview 3.0](#), section 2.13).

Therefore, the Panel concludes that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out four circumstances, which, without limitation, shall be evidence of the registration and use of the disputed domain name in bad faith, namely:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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 the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s 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 the Respondent’s website or location or of a product or service on the website or location.

The Complainant’s DECIEM trademark has been registered in several countries around the world before the registration of the Disputed Domain Name. Further, the Complainant is also well established and known worldwide. The Disputed Domain Name is identical to the Complainant’s DECIEM trademark. Therefore, the Panel finds that the Respondent knew or should have known of the Complainant’s DECIEM trademark when it registered the Disputed Domain Name.

Given the distinctiveness and prior registration of the Complainant's trademark, the registration of the Disputed Domain Name was clearly intended to take unfair advantage of the Complainant's trademark. Moreover, the use of the Disputed Domain Name points to knowledge of the Complainant and its trademarks. Accordingly, the Panel finds that the Respondent has registered the Disputed Domain Name in bad faith.

As to use of the Disputed Domain Name in bad faith, there is no evidence of any use of the Disputed Domain Name for a *bona fide* offering of goods or services, nor of any demonstrable preparations for such an offering. On the contrary, there is evidence that the Disputed Domain Name has been used to send fraudulent emails. It is thus obvious to the Panel that the Respondent is using the Disputed Domain Name in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy are therefore fulfilled in this case.

The Panel therefore finds that the Disputed Domain Name was registered and used in bad faith, and thus the condition of paragraph 4(a)(iii) of the Policy has been fulfilled.

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 <deciem.group> be transferred to the Complainant.

/Peter J. Dernbach/

Peter J. Dernbach

Sole Panelist

Date: January 19, 2023