

ADMINISTRATIVE PANEL DECISION

Deciem Beauty Group Inc. v. Host Master, 1337 Services LLC
Case No. D2022-4420

1. The Parties

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

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

2. The Domain Name and Registrar

The disputed domain name <the-ordinary24.com> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 18, 2022. On November 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 21, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the 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 24, 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 on November 30, 2022.

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 of the Complaint, and the proceedings commenced on December 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 24, 2022.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on January 3, 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. In particular, the Complainant produces the advanced functional skin care products under The Ordinary brand.

The Complainant is the owner of numerous THE ORDINARY trademark registrations, including:

- the European Union Trade Mark Registration THE ORDINARY No. 15761182 registered on December 8, 2016;
- the United States Trademark Registration THE ORDINARY No. 5203537 registered on May 16, 2017;
- the Canadian Trademark Registration THE ORDINARY No. TMA1014737 registered on February 7, 2019.

The Complainant's official domain name incorporating its THE ORDINARY trademark is <theordinary.com>.

The Domain Name was registered on July 5, 2022.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has resolved to a website offering the Complainant's The Ordinary skincare products for sale (the "Website").

5. Parties' Contentions

A. Complainant

The Complainant requests that the Domain Name be transferred to the Complainant. According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Name is confusingly similar to THE ORDINARY trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant contends that the Domain Name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

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

- (ii) the Respondent has no rights or legitimate interests in the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid THE ORDINARY trademark registrations which precede the registration of the Domain Name. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of a dash and digits “24” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant’s THE ORDINARY trademark. UDRP panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms, whether descriptive, geographical, pejorative, meaningless, or otherwise, would not prevent a finding of confusing similarity under the first element. See section 1.8, [WIPO Overview 3.0](#).

The Top-Level Domain (“TLD”) “.com” in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant’s THE ORDINARY trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of 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 Domain Name.

The Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the Domain Name, even if it has not acquired any trademark rights; or
- (iii) that it is making a legitimate, noncommercial or fair use of the Domain Name without intent for commercial gain to mislead consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainant’s THE ORDINARY trademark

registrations predate the registration of the Domain Name. There is no evidence in the record that the Complainant has licensed or otherwise permitted the Respondent to use its THE ORDINARY trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it does not result from the evidence in the record that the Respondent makes use of the Domain Name in connection with a *bona fide* offering of goods or services, or it makes a legitimate, noncommercial or fair use of the Domain Name without intent for commercial gain.

On the contrary, the Complainant presented evidence that the Domain Name is used to attract Internet users to the Website offering the Complainant's The Ordinary skincare products for sale without any authorization of the Complainant. The Website prominently displays the Complainant's THE ORDINARY trademark, as well as the Complainant's official products' images and descriptions, without any disclaimer regarding the association with the Complainant. Thus, the Website falsely suggests that it is an official Complainant's website or of an entity affiliated to or endorsed by the Complainant such as its official dealer. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The third requirement the Complainant must prove is that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in its THE ORDINARY trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the Domain Name. This finding is supported by the content of the Website impersonating the Complainant. Moreover, it has been proven to the Panel's satisfaction that the Complainant's THE ORDINARY trademark is well known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of products under this trademark.

In sum, the Respondent in all likelihood registered the Domain Name with expectation of taking advantage of the reputation of the Complainant's THE ORDINARY trademark.

Moreover, the Complainant presented evidence that the Domain Name is being used in bad faith by the Respondent to attract Internet users to the Website which offers the Complainant's products for sale. By reproducing the Complainant's THE ORDINARY trademark in the Domain Name, as well as displaying this trademark together with the Complainant's official products' images and descriptions on the Website, the Respondent intends to benefit or profit from the confusion created with Internet users, as it suggests association with the Complainant. In consequence, the Panel finds that the evidence in the record demonstrates that the Respondent registered and uses the Domain Name deliberately in order to take advantage of the Complainant's reputation and to give credibility to its services.

Thus, for the reasons discussed above, this Panel finds that the Respondent used the Domain Name in an attempt to attract, for commercial gain, Internet users to the Website by creating a likelihood of confusion with THE ORDINARY trademark as to the source, sponsorship, affiliation, or endorsement of the Website or the activity carried out through the Website by the Respondent.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements under 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 Domain Name <the-ordinary24.com> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: January 17, 2023