

ADMINISTRATIVE PANEL DECISION

The Gillette Company LLC v. Nghi Huynh Quoc
Case No. D2023-3239

1. The Parties

The Complainant is The Gillette Company LLC, United States of America, represented by BMVN International LLC, Viet Nam.

The Respondent is Nghi Huynh Quoc, Viet Nam.

2. The Domain Name and Registrar

The Disputed Domain Name <oralbvn.com> is registered with Nhan Hoa Software Company Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on July 27, 2023. On July 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 1, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On August 2, 2023, the Center informed the Parties in Vietnamese and English, that the language of the registration agreement for the Disputed Domain Name is Vietnamese. On August 3, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

The Center verified that 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 Vietnamese and English of the Complaint, and the proceedings commenced on August 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 3, 2023. The Respondent did not submit any response. However, an email communication as received from the

Respondent on August 23, 2023, stating: “Tên miền không còn kinh doanh bàn chải điện nữa, hiện đang kinh doanh saffron. Không ảnh hưởng tới” (in English: The domain name is no longer used for doing business in relation to the electric toothbrush, it is currently engaged in saffron business. No impact on it.). Accordingly, the Center notified the Commencement of the Panel Appointment Process on September 11, 2023.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on September 18, 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 the exclusive owner of the ORAL-B trademark throughout the world, used since 1950 in connection with toothpaste, toothbrushes, electric toothbrushes, and mouthwashes. Since 2006, the Complainant has been a subsidiary of Procter & Gamble (“P&G”).

The Complainant holds many registered trademarks that consist of or contain the words “Oral-B” (the “ORAL-B trademarks”) in many jurisdictions worldwide, including, but not limited to the Vietnamese Registration No. 4-0005878-000 for ORAL-B, registered on September 12, 1992, in Classes 3, 5, 10, 21, and Vietnamese Registration No. 4-0038300-000 for ORAL-B CLASSIC, registered on September 11, 2001, in Class 21.

In addition, the Complainant is the owner of numerous domain names featuring the ORAL-B trademarks, among which the notable one is <oral-b.com>.

The Disputed Domain Name was registered on April 26, 2020. As of the date of this Decision, the Disputed Domain Name currently directs users to a website featuring saffron products. However, the Disputed Domain Name previously resolved to another website promoting electric toothbrush goods bearing the ORAL-B trademarks.

5. Parties’ Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

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

First, the Complainant contends that the Complainant is the registered owner of the ORAL-B trademarks in various countries across the globe. Further, the Complainant asserts that the ORAL-B trademarks are well-known, and have been recognized in previous UDRP decisions.

Second, the Complainant argues that the Disputed Domain Name is confusingly similar to the Complainant’s ORAL-B trademarks because it fully incorporates such trademarks in their entirety. The addition of the letter “vn”, which is the abbreviation used to designate Viet Nam, is not sufficient to differentiate the Disputed Domain Name from the ORAL-B trademarks.

Third, the Complainant submits that the addition of the generic Top-Level Domain (“gTLD”) “.com” in the Disputed Domain Name should be disregarded under the first element.

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

First, the Complainant alleges that the Respondent does not own any trademark registration for the Disputed Domain Name or any part of it.

Second, the Complainant submits that the Respondent is not affiliated in any way with ORAL-B trademarks, and the Complainant never authorized the Respondent to register the Disputed Domain Name reproducing the ORAL-B trademarks. The Complainant further argues that by way of registration and use of the Disputed Domain Name, the Respondent intends to disrupt the Complainant's business, and trade-off of the Complainant's goodwill and reputation by creating an unauthorized association between it and the ORAL-B trademarks.

Third, the Complainant asserts that there is no evidence that the Respondent has become commonly known by reference to the Disputed Domain Name.

Further, the Complainant contends that the Respondent's use of the Disputed Domain Name is not for a *bona fide* offering of goods or services, but is instead an attempt to capitalize on the Complainant's goodwill and reputation in the ORAL-B trademarks. Particularly, the Complainant submits evidence supporting that the previous website under the Disputed Domain Name ("Contested Website") failed to accurately represent the Respondent as an independent business entity without a relationship with the Complainant. In contrast, the Respondent pretended to be the Complainant or affiliated with the Complainant, by using the logo "Oralbvn.com | OFFICIAL STORE" and also the Complainant's marketing materials on the Contested Website, which undeniably misled Internet users and relevant consumers for commercial gain.

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

First, the Complainant asserts that the Respondent registered the Disputed Domain Name long after the ORAL-B trademarks were registered and became famous through exclusive use by the Complainant. Besides, the Complainant submits that the Respondent sold products bearing the Complainant's ORAL-B trademarks on the Contested Website. These suggest the Respondent was aware of the Complainant's rights in the ORAL-B trademarks when they registered the Disputed Domain Name.

Second, the Complainant contends that the Respondent registered and has used the Disputed Domain Name in bad faith for profit, leveraging consumer confusion. This involves tactics like incorporating "P&G Authorized Store" term in various images and using the logo "Oralbvn.com | OFFICIAL STORE" to falsely imply affiliation with the Complainant. In addition, the Contested Website displayed copyrighted product images and marketing materials owned by the Complainant and its affiliates.

Third, the Complainant argues that the Respondent engaged in bad faith because there is a significant likelihood that Internet users will wrongly believe the Disputed Domain Name is linked to the Complainant. This initial confusion, arising from the trademark's prominence in both the Disputed Domain Name and on the Contested Website, is posited as a compelling indication of bad faith.

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

The Respondent has not furnished a formal reply or submitted a Response to the Complainant's contentions. However, on August 23, 2023, the Respondent transmitted an email in Vietnamese. In this correspondence, the Respondent conveyed that the Disputed Domain Name is no longer used for the sale of electric toothbrushes. Instead, it presently features saffron products, thereby does not affect (the Complainant or their ORAL-B trademark).

6. Discussion and Findings

A. Procedural Issue: Language of the Proceeding

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement is Vietnamese.

As the Complaint was filed in English, the Center, in its email of the language of proceeding dated August 2, 2023, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Vietnamese, or (iii) a substantiated request for English to be the language of the proceeding.

On August 3, 2023, the Complainant confirmed its request that English be the language of proceedings. The Respondent did not give any comment on this issue.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the 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.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred, and the possibility of delay in the proceeding in the event translations are required and other relevant factors (see, *e.g.*, *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

- (i) the fact that the Complainant, an American entity, does not appear to be able to communicate in Vietnamese, and therefore if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation; and
- (ii) the English language is quite popular in Viet Nam, where the Respondent resides, and the Contested Website contained English words, such as "official store", "sale", and "big combo"; these suggest that the Respondent has knowledge of the English language; and
- (iii) the Respondent did not object to English being the language of the proceeding;
- (iv) the Panel is familiar with both English and Vietnamese and has considered the email communication sent by the Respondent in Vietnamese.

Therefore, for easy comprehension of the Complainant of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

B. Identical or Confusingly Similar

The Complainant is required to establish the two following elements: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First, the Complainant has clearly established that it has trademark rights in the ORAL-B trademarks, which have been registered in numerous countries all over the world, including Viet Nam, where the Respondent resides. These registrations are well before the registration date of the Disputed Domain Name.

Second, the Disputed Domain Name incorporates the Complainant's ORAL-B trademarks, whose fame has been confirmed in numerous previous UDRP decisions. The sole disparity between the Disputed Domain Name and the Complainant's trademarks is the omission of the hyphen and the inclusion of the letters "vn", which represents the common abbreviated form of "Viet Nam", the name of the country in which the Respondent resides. In this context, the Panel finds the ORAL-B trademarks remain clearly recognizable in the Disputed Domain Name, and the addition of the term "vn" does not prevent confusing similarity for the purposes of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, "[WIPO Overview 3.0](#)").

Third, the Panel finds, similarly to other UDRP panels, that the gTLD, in this case, ".com", is disregarded as it is a technical requirement (see section 1.11.1 of the [WIPO Overview 3.0](#)).

Based on the foregoing findings, the Panel finds that the Disputed Domain Name is confusingly similar to the ORAL-B trademarks, and paragraph 4(a)(i) of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular, but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

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

The Panel finds that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent's email communication is insufficient to refute the Complainant's contentions, as discussed further below.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the complainant, once a *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the Disputed Domain Name (see section 2.1 of the [WIPO Overview 3.0](#)). In the present case, the Respondent failed to make such a demonstration.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that the Respondent was not given any license, permission, or authorization to register or use the ORAL-B trademarks or the Disputed Domain Name. Further, there is no indication that the Respondent possesses any registered or unregistered trademark rights in any jurisdiction pertaining to the ORAL-B trademarks or the Disputed Domain Name. Therefore, the Panel determines that the Respondent has no trademark rights in the ORAL-B trademarks.

As mentioned in section 2.8.2 of [WIPO Overview 3.0](#), in the absence of prior agreement between the parties regarding the registration or use of a domain name incorporating the complainant's trademark, a reseller or distributor may be making a *bona fide* offering of goods and services and thus have rights or legitimate interests in a domain name if its use meets certain requirements, which are described in the decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("Oki Data"), including:

- the respondent must actually be offering the goods or services at issue;
- the respondent must use the site to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods);
- the site itself must accurately disclose the respondent's relationship with the trademark owner; and
- the respondent must not try to "corner the market" in all relevant domain names, thus depriving the trademark owner of the ability to reflect its own mark in a domain name.

In this particular case, the Panel finds that the Disputed Domain Name comprises the ORAL-B trademarks in its entirety, merely combined with the geographic identifier "vn", evidently referring to the name of Viet Nam where the Respondent resides. Further, it is proven and evidenced by the Complainant that the Disputed Domain Name used to resolve to a website displaying the logo "Oralbv.com | OFFICIAL STORE", which is confusingly similar to the Complainant's trademark ORAL-B, while no statement or disclaimer disclosing accurately the relationship between the Complainant and the Respondent is placed. In addition, such a website contained various product images accompanied by the signs "P&G Authorized Store", "Oral-B", and "Oralbv.com | OFFICIAL STORE". These indications may mislead consumers into believing that there is a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality.

As of the date of this Decision, the Panel observes that the Disputed Domain Name resolves to another website offering for sales of saffron products. This change does not alter the Panel's perspective regarding the potential exploitation of the ORAL-B trademarks within the Disputed Domain Name to lure consumers and subsequently redirect them to other products. Moreover, it remains evident that the nature of the Disputed Domain Name, encompassing the ORAL-B trademarks in its entirety and merely coupled with the geographic identifier "vn" denoting the name of Viet Nam where the Respondent resides, carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#)).

With such a view, the Panel finds that the use of the Disputed Domain Name does not meet the *Oki Data* criteria and, thus, does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds no evidence would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, following the Complainant's assertions and evidence regarding the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the ORAL-B trademarks and intended to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests regarding the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy, is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular, but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

"(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 the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, 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 the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The above four circumstances are not exhaustive, and the Panel may find bad faith alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not formally reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel finds that the Disputed Domain Name comprises the ORAL-B trademarks in its entirety, with the removal of the hyphen "-" and the addition of the geographical identifier "vn" at the end. Given the Complainant's extensive use and registration of the ORAL-B trademarks in many countries, it is highly unlikely that the Respondent registered the Disputed Domain Name by chance or coincidence. Moreover, after examining the contents of the Contested Website which was previously resolved from the Disputed Domain Name, the Panel is of the view that the Respondent had knowledge of the Complainant and its ORAL-B trademarks when registering the Disputed Domain Name. The Panel considers such registration as an attempt by the Respondent to take advantage of the Complainant's goodwill (see section 3.2.1 of the [WIPO Overview 3.0](#)).

On the date of this Decision, the Panel accesses the Disputed Domain Name <oralbvn.com> and finds that it was redirected to a website offering for sales of saffron products. However, it is well proven and evidenced by the Complainant that the Contested Website was used to offer for sale the electric toothbrushes bearing the ORAL-B trademarks. The Panel would add that, besides the adoption of the Complainant's ORAL-B trademarks as a uniquely distinctive part of the Disputed Domain Name, the Respondent placed the logo "Oralbvn.com | OFFICIAL STORE" along with the usage of the Complainant's logo, product images and official marketing materials on the website thereunder. These indications clearly gave Internet users the impression that the Contested Website was either an official website of the Complainant or a website that was affiliated with the Complainant, which is not the case. Hence, the Panel takes the view that the Respondent has intentionally used the Disputed Domain Name for commercial gain by creating a likelihood of confusion, to attract Internet users to its website. This supports a finding of bad faith use under paragraph 4(b)(iv) of the Policy.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith, and the third element under paragraph 4(a)(iii) of the Policy is established.

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 <oralbvn.com> be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: October 2, 2023