

## **ADMINISTRATIVE PANEL DECISION**

Clarins v. Privacy Service Provided by Withheld for Privacy ehf / Do Thanh Luan

Case No. D2022-1322

### **1. The Parties**

The Complainant is Clarins, France, represented by Tmark Conseils, France.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Do Thanh Luan, Viet Nam.

### **2. The Domain Names and Registrar**

The disputed domain names <clarins-th.live> and <clarins-th.shop> are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2022. On April 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 13, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 14, 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 amended Complaint on April 15, 2022.

The Center verified that the Complaint together with the amended 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 April 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 10, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on May 13, 2022. 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, based in France, is a major international company in the cosmetics and make-up sector and has operated for approximately 60 years under the CLARINS mark. It owns numerous trade mark registrations internationally for CLARINS including the French trade mark registration no. 1637194 registered on January 7, 1991, and Thai trade mark registration no. Kor76352 registered on March 24, 1988. The Complainant operates various domain names that incorporate its CLARINS mark and which resolve to websites promoting the Complainant's CLARINS products. These include <clarins.com>, registered on March 16, 1997, and <clarins.co.th>, registered on May 21, 2013.

The disputed domain names are both registered in the name of the same privacy service and the Registrar verification confirmed that they are both owned by the Respondent based in Viet Nam. The disputed domain name <clarins-th.live> was registered on December 6, 2021, and the disputed domain name <clarins-th.shop> was also registered on December 6, 2021. Neither of the disputed domain names resolve to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant submits that it owns registered trade mark rights for the CLARINS mark as set out above. It says that each of the disputed domain names wholly incorporate the CLARINS word mark and each is therefore confusingly similar to the Complainant's registered trade mark rights. According to the Complainant, the addition of the geographic reference "-th" does not prevent a finding of confusing similarity under the Policy.

The Complainant submits that the Respondent is not affiliated with the Complainant and has never been authorised to use or register the CLARINS name or mark or to use it in a domain name. The Complainant has submitted evidence of trade mark database searches indicating that the Respondent does not own any trade mark registrations for CLARINS. Neither, says the Complainant, is the Respondent making a noncommercial or fair use of either of the disputed domain names since neither of them resolve to active websites. In these circumstances and in view of the degree of renown attaching to the CLARINS mark, the Complainant submits that there can be no legitimate reason why the Respondent registered each of the disputed domain names.

The Complainant notes that it has used the CLARINS mark in France and internationally for 60 years, long before the registration of each of the disputed domain names in 2021. It says that its mark is well known worldwide and was so at the respective date of registration of each of the disputed domain names and for these reasons and as set out below, the Respondent must have been aware of the Complainant's CLARINS mark when it registered each of the disputed domain names. The Complainant says that it is obvious that the Respondent was aware of this prior use as he has also registered two other domain names being <clarins-th.com> and <clarins-th.net> which resolved to websites that used without authorisation the Complainant's trade mark, its red cartridge device mark including the CLARINS word mark and which promoted or offered for sale infringing examples of the Complainant's CLARIS Double Serum product.

The Complainant submits that this is a classic case of passive holding in bad faith in view of the following factors: (1) the long standing use and reputation attaching to the CLARINS mark; and (ii) the fact that CLARINS is distinctive and is not a descriptive or dictionary word; and (iii) that the disputed domain names were recently created and have never been actively used and that their use of the CLARINS mark would

necessarily confuse and mislead Internet users; and (iv) that the Respondent has previously registered two other similar domain names being <clarins-th.com> and <clarins-th.net> which were used in order to gain click through commissions by diverting Internet users to the Respondent's own websites.

The Complainant says that on this basis it is hard to believe that the filing of the disputed domain names was mere coincidence and in view of the degree of renown attaching to the CLARINS mark it is not possible to conceive of any plausible or contemplated active use of the disputed domain names that could be legitimate and which would not amount to a passing off of the Complainant's rights. On this basis the Complainant submits that the disputed domain names were both registered and used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainant has demonstrated that it owns registered trade mark rights in various countries for its CLARINS trade mark including the French trade mark registration no. 1637194 registered on January 7, 1991, and Thai trade mark registration number Kor76352 registered on March 24, 1988. Each of the disputed domain names wholly incorporate the CLARINS word mark and the Panel therefore finds that each of them is confusingly similar to the Complainant's registered trade mark rights for CLARINS. The addition of "-th" (which appears to be a geographic reference for Thailand) does not prevent a finding of confusing similarity. As a result, the Panel finds that each of the disputed domain names is confusingly similar to the Complainant's registered CLARINS mark and that the Complaint therefore succeeds under the first element of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant's CLARINS mark is very well reputed in many countries as a consequence of long use in relation to the Complainant's cosmetic and skin care products. The Complainant has submitted that the Respondent is using its marks without authority, that he is not affiliated with the Complainant and has never been authorised to use or to register the CLARINS name or mark or to use it in a domain name. The Complainant has also submitted evidence of trade mark database searches which suggest that the Respondent does not own any trade mark registrations for CLARINS.

Neither of the disputed domain names resolve to an active website and there is no evidence that the Respondent is making a noncommercial or a fair use of each of the disputed domain names. Considering the very significant degree of renown attaching to the CLARINS mark and also this Panel's previous decision in *Clarins v. Privacy service provided by Withheld for Privacy ehf / Do Thanh Luan, Lilla Group*, WIPO Case No. [D2022-1178](#) in which this Panel found that the Respondent had no rights or legitimate interests in either of <clarins-th.com> or <clarins-th.net> and had also registered and used both of these domain names in bad faith, it is difficult to see how the Respondent could make any plausible argument that it has a legitimate right or interest in either of the present disputed domain names. It is notable and unlikely to be a mere coincidence that the disputed domain names were registered on the same day as the <clarins-th.net> domain name.

On this basis, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in either of the disputed domain names. The Respondent has failed to respond to or to rebut the Complainant's case and for these reasons and for the reasons set out under Part C below, the Panel accordingly finds that the Complaint also succeeds under this element of the Policy.

### C. Registered and Used in Bad Faith

The Complainant's CLARINS mark is very well reputed in France and internationally as a consequence of long use and promotion well before the registration of each of the disputed domain names in 2021. The Complainant also owns registered trade mark rights in Thailand and has its own website at the domain name <clarins.co.th> which is aimed at Thai Internet users and is very likely to have appeared in any Internet search undertaken by the Respondent. The CLARINS mark is also highly distinctive and these findings coupled with the fact that the Respondent used the CLARINS mark and CLARINS red cylinder device in order to promote the Complainant's Double Serum product on the website to which each of <clarins-th.com> and <clarins-th.net> domain names formerly resolved, as discussed in WIPO Case No. [D2022-1178](#) noted above, suggests very strongly that the Respondent was well aware of the Complainant's CLARINS mark when it registered each of the disputed domain names and therefore did so in bad faith.

Neither of the disputed domain names resolve to an active website. Previous panels have found that the passive use of a disputed domain name may amount to evidence of bad faith based on a consideration of factors such as (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 3.3)

The Complainant's CLARINS mark is highly distinctive and enjoys a very considerable global reputation. The Respondent has failed to submit a response or to provide any evidence of actual or contemplated good-faith use. The Panel further notes that the Respondent used a privacy service in relation to each of the disputed domain names in an attempt to conceal its identity. As discussed under Part 6 (B) above, in light of the Panel's findings in relation to the Respondent's unauthorised use of the CLARINS mark in WIPO Case No. [D2022-1178](#) (noted *infra*) and also of the very substantial renown attaching to the CLARINS mark, the Panel finds it highly unlikely that the Respondent could put either of the disputed domain names to any good faith use.

Overall, the Panel agrees with the Complainant that it is hard to believe that the filing of the disputed domain names was mere coincidence and cannot conceive of any plausible or contemplated active use of each of the disputed domain names that could be legitimate and which would not amount to a passing off of the Complainant's rights. Therefore, the Panel finds that each of the disputed domain names are being passively held in bad faith and that the Complaint also succeeds under this element 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 names, <clarins-th.live> and <clarins-th.shop> be transferred to the Complainant.

*/Alistair Payne/*

**Alistair Payne**

Sole Panelist

Date: May 24, 2022