

## **ADMINISTRATIVE PANEL DECISION**

L'Oréal and L'Oreal USA Creative, Inc. v. Jinsoo Yoon  
Case No. D2022-1335

### **1. The Parties**

The Complainants are L'Oréal ("First Complainant"), France, and L'Oreal USA Creative, Inc. ("Second Complainant"), United States of America ("United States") (jointly the "Complainants"), represented by Dreyfus & associés, France.

The Respondent is Jinsoo Yoon, United States.

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

The disputed domain name <urbandecaymakeup.com> is registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 13, 2022. On April 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 13, 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 Complainants on April 21, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on April 22, 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 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 20, 2022.

The Center appointed Andrew F. Christie as the sole panelist in this matter on June 1, 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 First Complainant, L’Oreal, is a French industrial group specialized in the field of cosmetics and beauty. Created in 1909 by a French chemist, it is now one of the world’s largest groups in the cosmetic industry, present in over 140 countries. It markets more than 30 global brands, including URBAN DECAY, and thousands of products in all sectors of the beauty business.

The Second Complainant, L’Oreal USA Creative, Inc., is the largest subsidiary of the First Complainant. Headquartered in New York City, the Second Complainant employs more than 12,000 people working in facilities across 14 states, and generates more than USD 7 billion in sales annually.

The URBAN DECAY brand was founded in January 1996, offering numerous high-performance cosmetics, from velvety-soft shadows and creamy lipsticks to weightless complexion products and high-tech sprays.

The First Complainant is the owner of European Union Trademark Registration No. 002099968 (filed on February 22, 2001, and registered on July 18, 2002) for the word trademark URBAN DECAY. The Second Complainant is the owner of United States Trademark Registration No. 2449408 (filed on February 18, 1997, and registered on May 8, 2001) for the word trademark URBAN DECAY.

The Second Complainant is the owner of the domain name <urbandecay.com> (registered on November 2, 1995), which the Complainants use to promote their products and services.

The disputed domain name was registered on January 18, 2005. The Complainants have provided a screenshot, taken on October 7, 2021, showing that it resolved to a parking page with commercial links related to cosmetics, and offering the disputed domain name for sale. A second screenshot, taken on February 9, 2022, showed that the disputed domain name resolved to a parking page with commercial links related to cosmetics, but no longer stating that the disputed domain name was for sale.

On October 7, 2021 (and followed up with several reminders), the Complainants sent a notification to the hosting company, requesting it to deactivate the website resolving from the disputed domain name. The hosting company did not respond. On November 2, 2021 (and followed up with several reminders), the Complainants sent a cease and desist letter to the email address displayed on the website resolving from the disputed domain name (which was also the registrant contact email address for the disputed domain name, as subsequently confirmed by the Registrar), requesting cancellation of the disputed domain name. The registrant contact responded on November 18, 2021, stating that it had purchased the disputed domain name at auction for USD 551, and offering to transfer it for USD 950. The Complainants insisted on a transfer of the disputed domain name free of charge, on the basis of their prior rights. No further communication was received from the registrant contact. At the time of this decision, the disputed domain name resolves to a parking page similar to that provided by the Complainant in its screenshot of February 9, 2022.

#### **5. Parties’ Contentions**

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

The Complainants made the following contentions to establish that the disputed domain name is confusingly similar to a trademark in which they have rights. The disputed domain name reproduces in its entirety the Complainants’ trademark URBAN DECAY with the addition of the generic term “make up”. The term “make

up” increases the likelihood of confusion since it corresponds to the Complainants’ field of activity and products. Due to the composition of the disputed domain name, Internet users may be led into believing the disputed domain name is endorsed by the Complainants or that it will direct them to an official website promoting the Complainants’ products. The dominant feature of the disputed domain name consists of the Complainants’ trademark URBAN DECAY. The generic Top-Level Domain (“gTLD”) “.com” is not to be taken into consideration when examining the similarity between the Complainants’ trademark and the disputed domain name.

The Complainants made the following contentions to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not affiliated with the Complainants in any way, and has not been authorized by the Complainants to use and register their trademark or to seek registration of any domain name incorporating their trademark. The Respondent cannot claim prior rights or legitimate interests in the disputed domain name, as the URBAN DECAY trademarks precede the registration of the disputed domain name by years. The Respondent is not commonly known by the disputed domain name or the name URBAN DECAY. The Respondent cannot assert that, before any notice of this dispute, it was using, or had made demonstrable preparations to use, the disputed domain name or a name corresponding to it in connection with a *bona fide* offering of goods or services, as it initially resolved to a parking page with commercial links related to cosmetics, directly targeting the Complainants’ field of activity, and offering the disputed domain name for sale. The Respondent replied to the Complainants’ cease and desist letter by offering the disputed domain name for sale, thereby failing to show any intention of noncommercial or fair use of the disputed domain name. Given the Complainants’ goodwill and renown worldwide, and the nature of the disputed domain name, it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the disputed domain name, as it would invariably result in misleading diversion and taking unfair advantage of the Complainants’ rights.

The Complainants made the following contentions to establish that the disputed domain name was registered and is being used in bad faith. As the Respondent tried to sell the disputed domain name to the Complainants for a higher price than the one paid to acquire it, it is clear that the Respondent registered the disputed domain name for profit. It is implausible that the Respondent was unaware of the Complainants when it registered the disputed domain name as the Complainants are well-known throughout the world, and the disputed domain name is composed of the Complainants’ trademark URBAN DECAY and the generic term “make up”, which is the Complainants’ main product covered by this trademark. The Complainants’ URBAN DECAY trademark registrations significantly predate the registration date of the disputed domain name. A quick trademark search for URBAN DECAY would have revealed to the Respondent the existence of the Complainants and their trademark. The Respondent could not have chosen the disputed domain name for any reason other than to deliberately cause confusion amongst Internet users as to its source in order to take unfair advantage of the Complainants’ goodwill and reputation. The Respondent is a notorious cybersquatter who has already faced several URDP procedures in the past. The disputed domain name initially pointed to a parking page with commercial links related to cosmetics, directly targeting the Complainant’s field of activity, and offering the disputed domain name for sale. Currently, the disputed domain name is not offered for sale, but the commercial links targeting the Complainants’ field of activity remain active. Several e-mail servers have been initially configured on the disputed domain name and thus there might be a risk that the Respondent was engaged in a phishing scheme. The use of an email address with the disputed domain name presents a significant risk where the Respondent could aim at stealing valuable information such as credit card details from the Complainants’ clients or employees. It is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the disputed domain name, as it would invariably result in misleading diversion and taking unfair advantage of the Complainants’ rights.

## **B. Respondent**

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

Once the gTLD “.com” is ignored (which is appropriate in this case), the disputed domain name consists of the Complainants’ URBAN DECAY trademark, followed by the word “makeup”. The Complainants’ trademark is clearly recognizable within the disputed domain name. The addition of the word “makeup”, which describes a product in respect of which the Complainants use their trademark, does not avoid a finding of confusing similarity of the disputed domain name with the Complainants’ trademark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainants have rights.

### B. Rights or Legitimate Interests

The Respondent is not a licensee of the Complainants, is not otherwise affiliated with the Complainants, and has not been authorized by the Complainants to use their URBAN DECAY trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name. The evidence provided by the Complainants shows that the disputed domain name has been used to resolve to a parking page with what appears to be pay-per-click links to various skincare and beauty products, and which, at one time, included a statement that the disputed domain name was for sale. Given the confusing similarity of the disputed domain name to the Complainants’ trademark, the absence of any relationship between the Respondent and the Complainants, and the risk of implied false affiliation with the Complainants, the Respondent’s use of the disputed domain name is neither a *bona fide* use nor a legitimate noncommercial or fair use.

The Complainants have put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

### C. Registered and Used in Bad Faith

The disputed domain name was registered many years after the Complainants first registered their URBAN DECAY trademark. It is inconceivable that the Respondent registered the disputed domain name ignorant of the existence of the Complainants’ trademark, given that the disputed domain name consists of the Complainants’ trademark with the addition of the descriptive word “makeup”, which is the Complainants’ area of business.

Given the Respondent’s lack of rights or legitimate interests in the disputed domain name and the confusing similarity of the disputed domain name to the Complainants’ trademark, any use of the disputed domain name by the Respondent almost certainly implies an affiliation with the Complainants that does not exist. The Respondent’s registration of the disputed domain name in these circumstances is a bad faith registration.

Furthermore, the evidence on the record provided by the Complainants indicates that the Respondent has offered the disputed domain name for sale for an amount that is in excess of the Respondent’s admitted out-of-pocket costs directly related to it. In addition, the evidence on the record provided by the Complainants indicates that the Respondent has used the disputed domain name in an attempt to attract, almost certainly for commercial gain, Internet users to a website by creating confusion in the minds of the public as to an association between the website and the Complainants. The Respondent’s use of the disputed domain name in this manner is a bad faith use.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

## 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, <urbandecaymakeup.com> be transferred, at the election of the Complainants, to either the First Complainant or the Second Complainant.

*/Andrew F. Christie/*

**Andrew F. Christie**

Sole Panelist

Date: June 6, 2022