

## **ADMINISTRATIVE PANEL DECISION**

**Exclusive Beauty Club, LLC v. Domains By Proxy, LLC, United States / Leah Parks, Parks Avenue, United States**  
Case No. D2022-2374

### **1. The Parties**

The Complainant is Exclusive Beauty Club, LLC, United States of America (“United States”), represented by Berger Singerman LLP, United States.

The Respondent is Domains By Proxy, LLC, United States / Leah Parks, Parks Avenue, United States.

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

The disputed domain name <exclusivebeauty.com> (the “Disputed Domain Name”) 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 June 29, 2022. On June 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 1, 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 July 4 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 July 4, 2022. The Center received an email communication from the Respondent on July 4, 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 July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. The Center received an online submission from the Respondent on July 26, 2022. The Center notified the commencement of Panel appointment process on August 4, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on August 11, 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 is a boutique e-retailer located in Florida that offers a curated catalog of premium skin care and beauty products. The Complainant owns the following trademark registrations with the United States Patent and Trademark Office: EXCLUSIVE BEAUTY CLUB and design, United States Registration No. 5,394,132, registered on February 6, 2018; in international class 35; indicating as first use in commerce July 13, 2016; EXCLUSIVE BEAUTY and design, United States Registration No. 5,794,918, registered on July 2, 2019, in international class 35; the aforementioned trademarks will hereinafter be referred to collectively as the “EXCLUSIVE BEAUTY Mark”; and EXCLUSIVE BEAUTY CLUB and design, United States Serial No.90,872,962, filed on August 9, 2021, in international classes 18 and 35 (office action pending).

The Complainant owns the domain name <exclusivebeautyclub.com>, which resolves to the Complainant’s official website at “www.exclusivebeautyclub.com”.

The Disputed Domain Name was created on February 14, 2004, and was acquired later on (probably in 2020, and at least after May 10, 2018,<sup>1</sup> for which the Respondent purportedly paid a significant price to the Registrar. According to the website located at “www.exclusivebeauty.com”, the website is operated by an entity called “Exclusive Beauty”. The owner of the website, listed on the “About page” at “www.exclusivebeauty.com/about”, is “Leah”, with no last name provided. The Disputed Domain Name resolves to a Facebook page that provides <skinbeautifulrx.com> as its domain name and provides “[...]@skinbeautifulrx.com” as the contact email address. The website at “www.skinbeautifulrx.com” states that “Exclusive Beauty” is its skincare spa in the Columbus, Ohio area.

#### **5. Parties’ Contentions**

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

The following are the Complainant’s contentions:

- the Disputed Domain Name is confusingly similar to the Complainant’s trademark or trademarks.
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.
- the Disputed Domain Name was registered and is being used in bad faith.
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

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<sup>1</sup> The Panel notes that according to the Whois history provided by the Complainant, in May 10, 2018 the Whois listed an entity located in Spain (with a name and address different to the Respondent), and the disputed domain name was registered with the registrar Register.com, Inc. The first reference to the registrant organization Parks Avenue occurred on October 6, 2020. While the Whois results showed a privacy service as the registrant during 2019 and part of 2020, the Panel notes the change of registrar to the current one and the change of the name servers on October 6, 2020, which was the first time the Respondent Parks Avenue appeared listed as the registrant organization for the Disputed Domain Name.

## B. Respondent

The Respondent submitted a reply to the Complainant's contentions on July 26, 2022 as follows:

- At first the Respondent requested that the Panel deny the remedy requested by the Complainant.
- The Respondent then stated it was unaware of the existence of the similarly-named domain name.
- Finally, the Respondent acknowledged that it would cancel the use of the Disputed Domain Name, although it would not transfer ownership of the Disputed Domain Name to the Complainant.

## 6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)(i-iii)):

- (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

This element consists of two parts: first, does the Complainant have rights in a relevant trademark and, second, is the Disputed Domain Name identical or confusingly similar to that trademark. The Panel concludes that the Disputed Domain Name is confusingly similar to the EXCLUSIVE BEAUTY Mark as set forth below.

It is uncontroverted that the Complainant has established rights in the EXCLUSIVE BEAUTY Mark based on its several years of use plus its registered trademarks for the EXCLUSIVE BEAUTY Mark. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the EXCLUSIVE BEAUTY Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1.

The Disputed Domain Name consists of the EXCLUSIVE BEAUTY Mark in its entirety and then followed by the generic Top-Level Domain ("gTLD") ".com". It is well established that a domain name that wholly incorporates a trademark may be identical or confusingly similar to that trademark for purposes of the Policy.

Further, the addition of a gTLD such as ".com" in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11. Thus, the Panel concludes that the Disputed Domain Name is identical or confusingly similar to the Complainant's EXCLUSIVE BEAUTY Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.



when it acquired the disputed domain name, and has used it to take unfair advantage of the confusing similarity with the Complainant's EXCLUSIVE BEAUTY Mark.

Moreover, the current inactive or passive holding of the Disputed Domain Name by the Respondent (as here) does not prevent a finding of bad faith. See *Advance Magazine Publishers Inc. and Les Publications Condé Nast S.A. v. ChinaVogue.com*, WIPO Case No. [D2005-0615](#); *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties*, WIPO Case No. [D2005-1085](#). It has long been held in UDRP decisions that the passive holding of a domain name that incorporates a trademark without a legitimate purpose may indicate that the disputed domain name is being used in bad faith under paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#). Here, the Disputed Domain Name resolves to a landing page with no content, and considering the previous use of the Disputed Domain Name, the Panel notes that the current passive holding does not prevent a finding of bad faith under the Policy.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

## 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 <exclusivebeauty.com> be transferred to the Complainant.<sup>3</sup>

/Lynda M. Braun/

**Lynda M. Braun**

Sole Panelist

Date: August 25, 2022

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<sup>3</sup> The Panel finds that the Respondent's suggestion to cancel the Disputed Domain Name is insufficient under the current circumstances, and thus has concluded that the Disputed Domain Name should be transferred to the Complainant.