

## **ADMINISTRATIVE PANEL DECISION**

ICON S.R.L. v. Nguyen Van Nhanh  
Case No. D2022-2793

### **1. The Parties**

The Complainant is ICON S.R.L., Italy, represented by Studio Turini, Italy.

The Respondent is Nguyen Van Nhanh, Viet Nam.

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

The disputed domain name <owayvietnam.com> (the “Disputed Domain Name”) is registered with P.A. Viet Nam Company Limited (the “Registrar”).

### **3. Procedural History**

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 29, 2022. On July 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 1, 2022, 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 1, 2022, the Center sent an email in English and Vietnamese to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on August 1, 2022. The Respondent did not comment on the language of the proceeding.

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 English and Vietnamese of the Complaint, and the proceedings commenced on August 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2022.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on September 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 Complainant is an Italy-based company founded in 2000, and operating in the field of cosmetics. According to the Complaint, the Complainant has granted a worldwide exclusive license of the trademark O WAY to Rolland S.r.l., which is 99% owned by the Complainant. Rolland S.r.l. is also the owner of the domain name <oway.com>, registered on August 18, 1998.

The Complainant is the owner of numerous registrations for trademark O WAY in Classes 03 and 05 in various jurisdictions, including, but not limited to, the European Union Trademark No. 007361538 registered on May 27, 2009; the United States of America Trademark No. 3725751 registered on December 15, 2009; and International Registration No. 986654 registered on October 31, 2008 designating Viet Nam, where the Respondent resides.

The Disputed Domain Name was registered on June 16, 2021. At the date of this Decision, the Disputed Domain Name is resolving to an active website offering cosmetics.

#### **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 trademark O WAY in Classes 03 and 05 in many jurisdictions around the world, including International Trademark No. 986654 designating Viet Nam.

Second, the Complainant contends that the Disputed Domain Name is confusingly similar to the trademark owned by the Complainant as the Disputed Domain Name incorporates the Complainant's trademark O WAY in its entirety, and the addition of a geographical term "vietnam" could not alleviate the confusion.

Third, the Complainant submits that the addition of "vietnam" can be interpreted as a reference to the activities of the Complainant in Viet Nam. Thus, Internet users may mistakenly believe that the Disputed Domain Name is resolving to the Complainant's official website targeting Vietnamese market.

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

First, the Complainant asserts that the Respondent (as an individual, business or other organization) is not commonly known by the Disputed Domain Name.

Second, the Complainant submits that the Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the above-mentioned trademark. Further, the Respondent is not an authorized outsourcing factory or retailer of the Complainant's products, and has never had a business relationship with the Complainant. The Respondent also has not acquired any legitimate rights (including trademark right) in the Disputed Domain Name or any name corresponding to

the Disputed Domain Name.

Third, the Complainant argues that the Disputed Domain Name resolves to a website where the trademark O WAY is reproduced without any authorization by the Complainant and where products having very similar packaging with those of the Complainant are offered for sale. For this reason, the Complainant submits that the Respondent is neither making a legitimate noncommercial or fair use of the Disputed Domain Name nor using the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

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

First, the Complainant asserts that it is evident from the Respondent's use of the Disputed Domain Name and the well-known status of the Complainant's trademark O WAY, the Respondent was aware of the Complainant and its trademark prior to registering the Disputed Domain Name.

Second, the Complainant argues that by deliberately including the trademark O WAY in the Disputed Domain Name and incorporating the trademark O WAY throughout the text on the website associated with the Disputed Domain Name, the Respondent registered and used the Disputed Domain Name with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's trademark O WAY as to the source, sponsorship, affiliation or endorsement of its website or products/services. By doing so, the Respondent has misappropriated the reputation and commercial value of the trademark O WAY for its commercial advantages.

Furthermore, the Complainant submits that the use of the geographical term "vietnam" in the Disputed Domain Name removes any possible doubt that the registration of the Disputed Domain Name was intended to bring the Complainant and its business to the mind of Internet users reading the domain name in issue.

Therefore, the Complainant considers that the Respondent registered and is using the Disputed Domain Name in bad faith under Policy, paragraph 4(b)(iii).

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

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Procedural issues**

#### **(i) 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 communication dated August 1, 2022, 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 1, 2022, the Complainant responded the Center confirming its request that English be the language of the proceeding as indicated in section IV of the Complaint.

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) of the Rules 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 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 Italy-based business 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;

(ii) the English language is quite popular in Viet Nam, where the Respondent is located, and the website associated with the Disputed Domain Name contains the English words; these suggest that the Respondent appears to have knowledge of the English language and be able to communicate in English; and

(iii) the Respondent did not object for English to be the language of the proceeding and did not submit a response in either English or Vietnamese, although the Center sent the emails of the language of the proceeding and notification of the Complaint in both English and Vietnamese.

Therefore, 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.

#### **(ii) The Respondent's Failure to Respond**

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. [D2010-1413](#), and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

#### **B. Identical or Confusingly Similar**

The Complainant is required to establish the followings: (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 Panel finds that the Complainant has clearly evidenced that it has registered trademark rights to O WAY, well before the Disputed Domain Name was registered.

Second, the Disputed Domain Name consists of the Complainant's trademark O WAY, in which the Complainant has exclusive rights. The difference between the Disputed Domain Name and the trademark is the addition of the suffix "vietnam", which is the country of Viet Nam where the Respondent resides.

The Panel finds that "oway" remains the dominant element in the Disputed Domain Name. It is well established that the addition of geographical term (such as "vietnam") to a trademark does not prevent confusing similarity. Thus, in the Panel's view, the addition of the said suffix does nothing to prevent the trademark from being recognizable in the Disputed Domain Name, nor to dispel confusing similarity, as it

was found in previous UDRP decisions (see, e.g., *International Business Machines Corporation v. Le Van Hai*, WIPO Case No. [D2019-3000](#); *Philip Morris Products S.A. v. Nguyen Van Thanh*, WIPO Case No. [D2019-1867](#); *Royal Canid SAS v. Ong Pham Duc Thang*, WIPO Case No. [D2017-2567](#)).

Third, the Panel finds, similar to other UDRP panels, that the addition of the generic Top-Level Domain (“gTLD”) “.com” to the Disputed Domain Name does not constitute an element that may help avoid confusing similarity for the Policy purposes (see, e.g., *LEGO Juris A/S v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-4146](#); *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark O WAY, and the first element 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* evidence on that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent did not reply to the Complainant’s contentions and, therefore, did not refute them.

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 his rights or legitimate interests in the Disputed Domain Name (see e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. [D2001-0121](#)). In this present case, the Panel finds that the Respondent has failed to meet that burden since no response was submitted for evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant’s asserted facts, that no license, permission or authorization of any kind to use the Complainant’s trademark has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction. Thus, the Panel finds that the Respondent has no rights in the Disputed Domain Name.

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 *Okí Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“Okí 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, it is well proven and evidenced by the Complainant that the Disputed Domain Name is resolving to a website of the Respondent, as shown in the Annex 18 of the Complaint. On such website, the Panel finds the Respondent did not place any statement or disclaimer disclosing accurately its relationship with the Complainant.

In addition, the website under the Disputed Domain Name contained the terms "OWAY VIETNAM" and well presented the Complainant's trademark O WAY. On this website, products, which are very similar to those of the Complainant and Rolland S.r.l., are promoted and offered for sale. These indications may mislead consumers into believing in a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality.

With such a view, the Panel finds that the unauthorized use of the Disputed Domain Name wholly incorporating the Complainant's trademark O WAY 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 that there is no evidence that 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, as it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the trademark O WAY and had an intention 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 in respect of 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 website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The above four circumstances are not exhaustive and bad faith may be found by the Panel 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 reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence with regard to the Respondent's registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's trademark O WAY has been registered in many jurisdictions. In addition, the Complainant's trademark O WAY has been registered and put in use in, among other countries, Viet Nam where the Respondent resides. These trademark registrations well predate the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the trademark O WAY in its entirety, adding the geographical term “vietnam” at the end. Given the extensive use of the trademark O WAY for offering cosmetics by the Complainant, which occurs in numerous countries, including in Viet Nam, where the Respondent resides, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name and the contents of the website thereunder, the Panel is of the view that the Respondent obviously knew of the Complainant and its trademark O WAY when it registered the Disputed Domain Name, and the Panel considers the registration is an attempt by the Respondent as to take advantage of the Complainant's goodwill.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it resolves to an active website offering cosmetics branded with the Complainant's trademark O WAY. In addition to the adoption of the Complainant's trademark O WAY as a uniquely distinctive part in the Disputed Domain Name, the Respondent used the Complainant's trademark and falsely represented itself as the Complainant's Vietnamese branch by the terms “OWAY VIETNAM” on this website.

The Panel takes the view that any Internet users seeking to purchase the Complainant's O WAY cosmetics would very likely mistakenly believe that the Respondent is either the Complainant or associated with the Complainant, while no such connection exists in fact. Such misleading behavior is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy, on the part of the Respondent.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and 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 <owayvietnam.com> be transferred to the Complainant.

*/Pham Nghiem Xuan Bac/*

**Pham Nghiem Xuan Bac**

Sole Panelist

Date: September 14, 2022