

ADMINISTRATIVE PANEL DECISION

Sothys Auriac v. Nonie Creme
Case No. D2022-3862

1. The Parties

The Complainant is Sothys Auriac, France, represented by PROMARK, France.

The Respondent is Nonie Creme, United States of America (“United States”), represented by Atkins Intellectual Property, PLLC, United States.

2. The Domain Name and Registrar

The disputed domain name <beautygarde.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 October 14, 2022. On October 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 17, 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 October 17, 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 October 18, 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 October 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2022. The Response was filed with the Center on November 8, 2022. The Respondent elected for a three-member Administrative Panel.

The Complainant submitted an unsolicited supplemental filing on November 18, 2022.

The Center appointed Adam Taylor, William Lobelson, and Robert A. Badgley as panelists in this matter on November 24, 2022. The Panel finds that it was properly constituted. Each member of 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 manufactures and distributes high-end cosmetic products to professionals in beauty institutes, spas and luxury hotels under the mark “Beauty Garden”.

The Complainant owns a number of word and figurative trade marks for BEAUTY GARDEN including:

- French trade mark no. 96629811, filed on June 10, 1996, registered on January 31, 1997, in classes 3, 14, and 35;
- United Kingdom trade mark no. 903456134, filed on October 28, 2003, registered on April 8, 2005, in classes 3, 5, 29, 30, and 32;
- Canadian trade mark no. 1208797, filed on March 8, 2004, registered on March 24, 2010, in class 3;
- Australian trade mark no. 1268563, filed on May 20, 2008, registered on March 2, 2009, in classes 5, 29, 30, and 32;
- European Union trade mark no. 007260516, filed on September 25, 2008, registered on June 21, 2009, in classes 35, 41, and 44; and
- United States trade mark no. 5510672, filed on January 9, 2016, registered on July 10, 2018, in classes 3, 5, 29, 30, and 32.

The Complainant sells its products via a website at “www.beautygarden.com”.

The Respondent, who describes herself as “a serial entrepreneur in the beauty interest and a recognized beauty expert”, is the founder of BeautyGarde, LLC, which was incorporated in the United States on December 29, 2016. References to “the Respondent” below should be taken as including the company unless stated otherwise.

The disputed domain name was registered on January 13, 2017, on behalf of the Respondent. Shortly thereafter, the Respondent launched a website at the disputed domain name headed “BEAUTY GARDE”, which offered eyelash and other beauty products that were branded with this mark.

The Respondent owns a number of trade marks for BEAUTYGARDE in class 3, including United States trade mark no. 5498862, filed on March 9, 2017, registered on June 19, 2018, as well as later-filed trade marks dating from January 8, 2018, in Australia, Canada, Mexico, South Korea, and the United Kingdom.

On October 6, 2021, the European Intellectual Property Office (“EUIPO”) rendered a default decision (“the EUIPO Decision”) invalidating the Respondent’s International Registration no. 1,395,524 for BEAUTYGARDE insofar as it applied to the European Union.

As of October 11, 2022, the disputed domain name resolved to a website headed “BEAUTY GARDE”, which offered cosmetic products including nail polish, skincare products, vitamins, makeup removers, eyelash glue, shampoo and conditioners, as well as related content such as tutorials about manicures and articles about various beauty topics.

5. Parties' Contentions

A. Complainant

The following is a summary of the Complainant's contentions.

The disputed domain name is confusingly similar to the Complainant's trade mark.

The Complainant's mark has had a substantial reputation in France and abroad for almost 20 years.

Without authorisation, the Respondent is using an almost identical sign to sell products that are identical or very similar to those of the Complainant.

The omission of "n" at the end of the disputed domain name does not render it visually, phonetically or conceptually different to the Complainant's mark sufficient to eliminate a likelihood of confusion with the Complainant's earlier marks, as confirmed in the EUIPO Decision, which the Respondent did not appeal.

The trade mark is substantially contained in the disputed domain name apart from omission of the final letter, which constitutes typosquatting.

The Respondent lacks rights or legitimate interests in the disputed domain name.

There is no evidence that the Respondent used the disputed domain name before the Complainant's registration of its prior rights.

The Complainant has not authorised the Respondent to use its trade mark, including in a domain name.

The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Instead, the Respondent is using the disputed domain name commercially to associate itself with the Complainant's well-known products, despite knowing that the Complainant could not accept this, given the likelihood of confusion recognised in the EUIPO Decision.

The Respondent did not register, and is not using, the disputed domain name in a *bona fide* manner. On the contrary, the Respondent has used the Complainant's marks in the disputed domain name to confuse consumers into thinking that the Respondent's website is officially connected with the Complainant and without an appropriate disclaimer. The Respondent's use even suggests that the Respondent is the owner of the Complainant's trade marks.

The Respondent is not commonly known by the disputed domain name.

The disputed domain name was registered and is being used in bad faith.

The Respondent is using the disputed domain name, which comprises the Complainant's mark without the final letter "n", to attract Internet users to its website by making them believe that it is connected with the Complainant, and to offer them products similar to those of the Complainant.

The Complainant's rights predate the disputed domain name.

The Respondent must have been aware of the reputation of the Complainant's trade marks, given that it operates in the same area as the Complainant, and given that the Complainant contested the Respondent's mark in the EUIPO proceedings.

The Respondent has engaged in opportunistic bad faith vis-à-vis the Complainant's well-known trade mark.

The Respondent did not reimburse the Complainant's costs of the EUIPO proceedings. The presumption of bad faith is strengthened by the fact that the Respondent failed to respect the EUIPO Decision as it continues to use its name as a trade mark and the disputed domain name to attract consumers, despite EUIPO recognition of the likelihood of confusion.

The Respondent's concealment of its identity is further evidence of bad faith.

B. Respondent

The following is a summary of the Respondent's contentions.

The disputed domain name is not identical or confusingly similar to the Complainant's trade mark.

By registering both parties' trade marks, the trade mark offices in Australia, Canada, the United Kingdom, and the United States have each determined that the parties' trade marks are not confusingly similar to each other. If so, then the disputed domain name is not confusingly similar to the Complainant's mark either.

The EUIPO Decision is limited to the European Union, and it was in any case obtained without the Respondent's knowledge or participation.

The EUIPO Decision acknowledges that in English-speaking markets, the disputed domain name is not confusingly similar to the Complainant's trade mark because English-speaking consumers understand that "garde" and "garden" mean completely different things whereas the EUIPO Decision was based on the potential for confusion among customers who reside far outside the Respondent's target market.

The Complainant has made various misleading statements about the EUIPO Decision and has exaggerated its importance, including: questioning the Respondent's right to maintain the disputed domain name after the EUIPO Decision despite the Respondent's ownership of other trade marks; concealing the EUIPO's finding that the parties' respective trade marks were distinguishable among English speakers; and invoking the Respondent's failure to appeal and alleged refusal to reimburse costs, when the Respondent was not aware of the decision.

The Respondent possesses rights and legitimate interests in respect of the disputed domain name.

The Respondent has used the mark BEAUTYGARDE in connection with a *bona fide* offering of goods for more than four years before becoming aware of the current dispute.

The Respondent's multiple registrations of BEAUTYGARDE as a trade mark long before the dispute further demonstrate its rights and legitimate interests.

The Complainant is wrong to claim that the Respondent is not commonly known by the disputed domain name, as this contains the distinctive element of the Respondent's business name and registered trade mark. It is also incorrect that the Respondent's use implies that it is the owner of the Complainant's trade marks.

Here, there are two distinct parties, each of which has had legitimate trade mark rights in multiple jurisdictions for a period of years – as recognised by multiple trade mark offices. The Respondent does not use the Complainant's mark or sell the Complainant's products.

The disputed domain name was not registered and is not being used in bad faith.

The Respondent had never heard of the Complainant until the present dispute.

The Respondent uses the disputed domain name in connection with a legitimate company which it formed years before it learned of this dispute and through which it has sold millions of dollars' worth of its branded

goods, which have no connection with the Complainant. The Respondent's products have been widely advertised in the media.

The Respondent never offered to sell the disputed domain name to the Complainant and would only sell it as part a sale of all its assets. The Respondent does not mention the Complainant on its website or attempt to pass itself off as the Complainant in any way.

The Respondent has always provided a means for the public to contact it through the website associated with the disputed domain name. Its corporate information is also publicly available. The Respondent's only use of a proxy service was to protect privacy.

The Complainant has engaged in Reverse Domain Name Hijacking.

The Complainant should have raised its concerns in a proper forum and not attempt to suddenly strip the Respondent of the disputed domain name it has used for almost six years in connection with goods that have nothing to do with the Complainant.

Apart from the European Union trade mark, the Complainant has never opposed the Respondent's trade marks, which have peacefully coexisted with the Complainant's marks for years.

The Complainant attempted to misleading the Panel by distorting the content and meaning of the EUIPO Decision, suggesting the EUIPO controls the world with respect to trade mark registrations and the disputed domain name use, and portraying the Respondent's lack of knowledge of the Complainant or its mark as evidence of deliberate wrongdoing. This is particularly true since the Complainant is a large and sophisticated company that is represented by counsel that presumably knows what it is doing.

Despite certifying to the contrary, the Complainant deliberately misrepresented key facts and made arguments that have no legal basis whatsoever. The Complainant has wasted this Panel's time, as well as the Respondent's, in a bad faith effort to harass the Respondent and disrupt its business.

C. Complainant's Supplemental Filing

The following is a summary of the Complainant's contentions in its supplemental filing.

The Respondent's trade marks and company name all postdate the Complainant's trade marks in Australia, Canada, the European Union, the United States, and the United Kingdom.

The Complainant is surprised that the Respondent did not conduct availability searches before applying for its own trade marks. The Complainant cannot be blamed for this.

Nor can the Complainant be blamed for initiating an EUIPO proceeding which was served on an old address of the Respondent. The Complainant simply used the address mentioned on all the Respondent's trade mark certificates. The Respondent should have updated its address and/or designated an EUIPO representative in anticipation of this situation.

The Respondent's website does not include a valid postal address. The Complainant used the online form to contact the Respondent but received no response. Nor did the Respondent's address appear on the Whois database. All of this shows that the Respondent did not want to be contacted and reinforces the Respondent's bad faith.

The Complainant filed the Complaint in good faith to protect its prior trade mark rights. The Complaint was supported by the EUIPO Decision, which recognised the risk of confusion between the parties' marks. The Complainant also took account of the fact that, despite this decision, the Respondent could not be contacted and was continuing to sell its branded products via the website at the disputed domain name. The Complainant has never misrepresented the facts.

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Supplemental Filing – Preliminary Issue

The Complainant has made an unsolicited supplemental filing.

Section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that UDRP panels have repeatedly affirmed that the party submitting an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response, e.g., owing to some "exceptional" circumstance.

In this case, the Panel has decided to admit the filing also because the Complainant should be entitled to respond to the allegation of Reverse Domain Name Hijacking in the Response.

B. Identical or Confusingly Similar

It is unnecessary to consider this element in light of the Panel's finding under the second element.

C. Rights or Legitimate Interests

As explained in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the consensus view is that, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If not, the complainant is deemed to have satisfied the second element.

Paragraph 4(c) of the Policy gives examples of circumstances which, if proved, suffice to demonstrate that a respondent possesses rights or legitimate interests.

The Respondent has submitted evidence that, for some six years and therefore starting long before any notice of the dispute, the Respondent has used the disputed domain name in connection with a *bona fide* offering of goods in accordance with paragraph 4(c)(i) of the Policy. In its recent tax year ending 2021, the Respondent has used the website at the disputed domain name to generate over USD 1 million in sales of its cosmetic products under the BEAUTYGARDE mark, in respect of which the Respondent owns trade marks in the United States and five other territories. See section 4 above.

In the Panel's view, and without elaboration, the Complainant places far too much weight on the EUIPO Decision and arguably reads too much into it.

The Panel also considers that the Respondent has established that it has been commonly known by (the operative part of) the disputed domain name for the purposes of paragraph 4(c)(ii) of the Policy.

For the above reasons, the Panel concludes that the Complainant has failed to establish the second element of paragraph 4(a) of the Policy.

D. Registered and Used in Bad Faith

It is unnecessary to consider this element in light of the Panel's finding under the second element.

E. Reverse Domain Name Hijacking ("RDNH")

Paragraph 15(e) of the Rules provides that, if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding". RDNH is defined under the Rules as "using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name".

See examples of the reasons articulated by panels for finding RDNH at section 4.16 of the [WIPO Overview 3.0](#). These include: "[...] (v) the provision of intentionally incomplete material evidence - often clarified by the respondent [...]". The Panel considers that this factor applies here.

In particular, the Complainant failed to disclose the crucial point that the Respondent owned some six registered trade marks for BEAUTYGARDE, *i.e.*, aside from the one invalidated by the EUIPO Decision. The Panel thinks it inconceivable that the Complainant was unaware of the existence of those marks when it filed its Complaint, and indeed the Complainant's supplemental filing does not deny the Respondent's assertion that the Complainant did know about them.

The Complainant must have appreciated that the existence of those six trade marks seriously undermined its case under the second element, and no doubt that is the reason that they were not produced to the Panel. If this case had not been defended, as happened with the EUIPO proceeding, an injustice may well have been done.

For the above reasons, the Panel declares that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding

Finally, the Panel would observe that it expects that the Complainant itself was unaware of the matters constituting RDNH and that, most likely, the fault lies solely with the Complainant's representatives.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Adam Taylor/
Adam Taylor
Presiding Panelist

/William Lobelson/
William Lobelson
Panelist

/Robert A. Badgley/
Robert A. Badgley
Panelist
Date: December 8, 2022