

## **ADMINISTRATIVE PANEL DECISION**

Jemella Group Limited v. Client Care, Web Commerce Communications Limited

Case No. D2022-4552

### **1. The Parties**

The Complainant is Jemella Group Limited, United Kingdom, represented by Studio Barbero S.p.A., Italy.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

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

The disputed domain names <ghdaustria.com>, <ghdbelgium.com>, <ghdcolombia.com>, <ghd-denmark.com>, <ghdhaustraliaasalesite.com>, <ghdhaircanada.com>, <ghdhairchile.com>, <ghdhair-deutschland.com>, <ghdhairfinland.com>, <ghdhair-france.com>, <ghdhairirelandsale.com>, <ghdhair-norge.com>, <ghdhairportugal.com>, <ghdhairstraightenerzsale.com>, <ghdhairstraightenerukshop.com>, <ghdhairusasale.com>, <ghdhungary.com>, <ghd-indonesia.com>, <ghditaliano.com>, <ghd-malaysia.com>, <ghdmexico.com>, <ghd-nl.com>, <ghd-philippines.com>, <ghdromania.com>, <ghd-schweiz.com>, <ghd-singapore.com>, <ghd-sweden.com>, and <ghduaestore.com> (the “Disputed Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 29, 2022. On November 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On December 1, 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 December 9, 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 December 9, 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 December 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 6, 2023.

The Center appointed Mariya Koval as the sole panelist in this matter on January 27, 2023. 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 United Kingdom company, which is engaged in retail sale of hair styling irons, shampoos, conditioners, brushes, dryers, styling and finishing products, and other hair styling accessories under the GHD trademark (the “GHD Trademark”). The GHD brand, created in 2001 by three British hairstylists, within two years, rapidly achieved great success due to the use in connection with innovative hair-style products. Currently, the Complainant operates globally, having entered in several markets around the world, including Australia, South Africa, Europe (in particular, Spain, Italy, Scandinavia, Germany, and France), and North America.

In 2016, Coty Inc. acquired the Complainant and its GHD Trademark for USD 511 million. In 2020, Coty Inc. announced the sale of a majority stake in its Professional and Retail Hair business, including the GHD Trademark, to the United States of America (“United States”) global investment company Kohlberg Kravis Roberts & Co. L.P. The GHD brand turnover in 2020 was around USD 170 million and increased up to over USD 200 million in 2021. The GHD Trademark was and presently is strongly supported by global advertising campaigns through television and other media such as with international magazines, partnerships with numerous fashion luxury brands, and has been a sponsor of several fashion shows, including the 2014 Victoria Secret Fashion Show. Moreover, many celebrities have been testimonials of the GHD brand, including the influencer Chiara Ferragni, the pop singer Katy Perry, and the Spanish actress Blanca Suarez.

The Complainant owns numerous GHD Trademark registrations all over the world, among which are:

- European Union Trade Mark No. 002860518, and registered on April 21, 2004, in respect of goods in classes 3, 8, 9, 11, 21, and 25;
- United Kingdom Trademark No. UK00002471848, registered on April 24, 2009, in respect of goods and services in classes 3, 8, 9, 11, 16, 21, 25, 26, 38, 41, 42, and 44;
- United States Registration No. 3746988, registered on February 9, 2010, in respect of goods and services in classes 8, 9, 11, 16, 21, 25, 26, 38, 41, 42, and 44; and
- Chinese Registration No. G969553, registered on November 16, 2017, in respect of goods and services in classes 3, 8, 9, 11, 16, 21, 25, 26, 41, and 44.

The Complainant has a significant online presence, operating, among others, the main domain name <ghdhair.com> and promoting its GHD Trademark and goods via the Internet, in particular through the most popular social media, *i.e.*, on Facebook, Instagram, and YouTube.

The Disputed Domain Names were registered on June 25 and June 27, 2022. As at the date of this decision, all the Disputed Domain Names resolve to websites in different languages, which all are visually similar to the Complainant’s official website “www.ghdhair.com”. The Respondent is using the GHD

Trademark, products visuals, and official images, as well as offering for sale allegedly GHD counterfeit products at discounted prices on the websites under the Disputed Domain Names.

## 5. Parties' Contentions

### A. Complainant

The Complainant asserts that its GHD brand turnover in 2020 was around USD 170 million and increased up to over USD 200 million in 2021. These figures show that the GHD Trademark has increasingly gained a reputation in the hairstyle industry for the quality and innovation of its products, becoming one of the most popular brands among consumers.

The Complainant claims that the Disputed Domain Names are confusingly similar to the GHD Trademark in which the Complainant has rights. Indeed, all Disputed Domain Names reproduce the Complainant's GHD Trademark in its entirety with the addition of geographical terms, namely: Malaysia, Schweiz (Switzerland), Singapore, Sweden, Philippines, Romania, Austria, Belgium, Colombia, Denmark, Australia, Canada, Chile, Deutschland (Germany), Finland, France, Ireland, Norge (Norway), Portugal, Hungary, Indonesia, and Mexico, the acronyms "uae", "nx", "uk", "usa", and "nl", and the adjective "italiano" (italian)), and in some instances in combination with hyphens and/or generic or descriptive terms (namely, "store", "sale", "site", "hair", "hair straightener", and "shop").

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names in view of the following:

- the Respondent is not a licensee, authorized agent of the Complainant, or in any other way authorized to use the Complainant's GHD Trademark. Specifically, the Respondent is not an authorized reseller of the Complainant and has not been authorized to register and use the Disputed Domain Names;
- the Respondent is not commonly known by the Disputed Domain Names as an individual, business, or other organization and its family name does not correspond to "ghd" or to the Disputed Domain Names;
- the Respondent has not provided the Complainant with any evidence of the use of, or demonstrable preparations to use, the Disputed Domain Names in connection with a *bona fide* offering of goods or services before any notice of this proceeding. The Disputed Domain Names redirect to websites reproducing the look and feel of the Complainant's official website, misappropriating the GHD Trademark, official images, and products visuals and offering for sale *prima facie* counterfeit GHD products at discounted prices. Moreover, no disclaimer has been published on the websites under the Disputed Domain Names apt to inform users as to the Respondent's lack of relationship or affiliation with the Complainant;
- the unauthorized publication of the Complainant's GHD Trademark and the use of the GHD Trademark to identify the activity and products promoted on the Respondent's websites are certainly apt to induce Internet users to believe that the websites to which the Disputed Domain Names resolve are owned or controlled by the Complainant or one of its affiliated companies;
- by offering for sale *prima facie* counterfeit GHD products on the websites corresponding to the Disputed Domain Names, the Respondent has engaged in an illegitimate activity that is undoubtedly commercial and not *bona fide* in nature. Indication of the counterfeit nature of the products offered for sale by the Respondent under the Complainant's GHD Trademark can be found in the circumstances that the products are offered for sale at substantially lower prices than the prices of original GHD products and that the Respondent has failed to provide any contact information on the websites to which the Disputed Domain Names resolve;

- the Respondent's use of the Disputed Domain Names cannot be considered a legitimate noncommercial or fair use without intent for commercial gain in view of the Respondent has undoubtedly attempted to gain from the sales of purported GHD products featured on its websites; and
- considering that all the Disputed Domain Names reproduce the GHD Trademark as prefix, with the addition of other non-distinctive elements, namely geographical and generic/descriptive terms, they carry a high risk of implied affiliation.

The Complainant further contends that the Respondent registered and is using the Disputed Domain Names in bad faith based on the following:

- in light of the fact that the Complainant's GHD Trademark has been registered and used in several countries as early as 2001, it is inconceivable that the Respondent was unaware of the existence of the Complainant and its GHD Trademark, with which the Disputed Domain Names are confusingly similar;
- in view of the Respondent's use of the Complainant's GHD Trademark on the websites to which the Disputed Domain Names resolve, it is possible to infer that the Respondent was indeed well aware of the Complainant's GHD Trademark and registered the Disputed Domain Names with the clear intention to target the Complainant's Trademark;
- the use of the Disputed Domain Names in connection with websites that reproduce the Complainant's GHD Trademark and the look and feel of the Complainant's official website, and offer for sale the GHD products at discounted prices, clearly indicates that the Respondent's purpose in registering the Disputed Domain Names, which incorporate the Complainant's GHD Trademark, was indeed to capitalize on the reputation of the Complainant's Trademark by intentionally attracting and diverting Internet users seeking GHD branded products to its own websites for commercial gain, by creating a likelihood of confusion with the Complainant's GHD Trademark as to the source, sponsorship, affiliation, or endorsement of its websites and/or the products promoted through said websites; and
- the Respondent has clearly registered the Disputed Domain Names in order to prevent the Complainant from reflecting its GHD Trademark in corresponding domain names and the Respondent has engaged in a pattern of such conduct, since it registered (at least) 28 Disputed Domain Names confusingly similar to the GHD Trademark with an obstructive intent.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

## 6.1 Substantive Issues

### A. Identical or Confusingly Similar

The Complainant has established rights in its GHD Trademark in view of large number of registrations around the globe.

The Disputed Domain Names incorporate the Complainant's GHD Trademark in its entirety, with addition of:

- geographical terms, namely, the country names: Austria, Belgium, Colombia, Denmark, Australia, Canada, Chile, Deutschland (Germany), Finland, France, Ireland, Norge (Norway), Portugal, Hungary, Indonesia, Malaysia, Mexico, Philippines, Romania, Schweiz (Switzerland), Singapore, Sweden; and/or
- the acronyms "uae", "nx", "uk", "usa", and "nl" and the adjective "italiano" (italian); and/or
- hyphens in some instances; and/or
- descriptive terms, namely, "hair", "sale", "site", "hair straightener", "shop", and "store"; and
- the generic Top-Level Domain ("gTLD") ".com".

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, where the relevant trademark is recognizable within the domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. Furthermore, in accordance with section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. In this case, the addition of the abovementioned geographical and descriptive terms, as well as the hyphens and acronyms to the GHD Trademark does not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant's GHD Trademark.

Also, the use of a hyphen in some Disputed Domain Names is irrelevant in a finding of confusing similarity, see, e.g., *Royale Indian Rail Tours Limited v. Divino Indian Memoirz Tours Pvt. Ltd.*, WIPO Case No. [D2010-2107](#) ("In the present case, the Panel finds that [...] adding a hyphen between the two words 'maharaja' and 'express' in the disputed domain name are insignificant modifications that do not reduce the confusing similarity between the disputed domain name and the Complainant's mark").

It is also well established that the gTLD, in this case ".com", is viewed as a standard registration requirement and as such is typically disregarded under the first element confusingly similarity test. See, [WIPO Overview 3.0](#), section 1.11.1.

Therefore, the Panel finds that the Disputed Domain Names are confusingly similar to the GHD Trademark in which the Complainant has rights. Accordingly, the Complainant has satisfied the first element in paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

In accordance with the Policy, paragraph 4(a)(ii), the Complainant has to demonstrate that the Respondent has no rights or legitimate interests in the Disputed Domain Names.

The Complainant has used its GHD Trademark since 2001 and its domain name <ghdhair.com> since 2002, that is, twenty years before the Respondent registered the Disputed Domain Names in 2022.

The Respondent is not affiliated with the Complainant in any way. The Complainant has not authorized, licensed, or permitted the Respondent in any way to register or use the Disputed Domain Names, incorporating the Complainant's GHD Trademark. Therefore, the Panel finds that there is a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Names. Thus, the burden is on the Respondent to produce evidence to rebut this presumption.

The Panel is of opinion that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names. On the contrary, at the date of this decision and on the date of the filing of the Complaint, all Disputed Domain Names resolve to active websites in different languages, depending on geographical terms included in them, where the products, allegedly counterfeit, under the GHD Trademark are offered for sale for discounted prices. Moreover, all websites under the Disputed Domain Names contain the Complainant's GHD Trademark at the top. Furthermore, all websites contain a lot of the Complainant's official product images and marketing materials without the Complainant's authorization. Such use of the Disputed Domain Names obviously strengthens the false impression of an affiliation with the Complainant.

According to the [WIPO Overview 3.0](#), section 2.8.1, UDRP panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

As is seen from the circumstances of this case, none of the websites under the Disputed Domain Names disclose the relationship between the Complainant and the Respondent. On the contrary, it creates a false impression that all websites are the Complainant's official websites or related to the Complainant. Thus, the Respondent does not satisfy the conditions of the Oki Data test.

The Panel concludes that such use of the Disputed Domain Names cannot in any case be considered as a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the Disputed Domain Names, without intent for commercial gain, to misleadingly divert the Complainant's consumers.

Also, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term (at the second or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Therefore, the addition of the geographical and dictionary terms, as well as the acronyms, to the Complainant's GHD Trademark in the Disputed Domain Names also evidences that the Respondent was well aware of the GHD Trademark at the time of registration of the Disputed Domain Names and has done so for the only purpose to create an impression that the Disputed Domain Names are connected with the Complainant's GHD Trademark.

In light of the above, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Names. Therefore, the Panel finds that the second element of the Policy has been met by the Complainant.

### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy indicates some circumstances, without limitation, that if found by the panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you [respondent] 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 Panel comes to the conclusion that the Disputed Domain Names were registered and are being used in bad faith in view of the following.

The Complainant's products under the GHD Trademark are well-known. The Disputed Domain Names were registered long after the Complainant registered its GHD Trademark. All Disputed Domain Names incorporate the Complainant's GHD Trademark in whole and redirect to the websites that creates a strong likelihood of confusion with the Complainant's GHD Trademark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Names. The Internet users might have well been under the impression that they are websites created and operated by a certified service provider of the Complainant, which is not true. Moreover, such use of the Disputed Domain Names indicates that the Respondent was well aware of the Complainant's products and GHD Trademark when it registered the Disputed Domain Names.

The Respondent obviously chose to register the Disputed Domain Names, which are confusingly similar to the Complainant's GHD Trademark, for the purpose of attracting, for commercial gain, the Internet users to its competing websites by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and of the products sold on it. The Panel also is of opinion that the Respondent may also have registered the Disputed Domain Names in order to prevent the Complainant from reflecting the GHD Trademark in corresponding domain names. The registration of twenty-eight Disputed Domain Names incorporating the GHD Trademark is sufficient to show a pattern of conduct in registering domain names in order to prevent the Complainant from reflecting its GHD Trademark in corresponding domain names.

Moreover, according to the evidence presented by the Complainant (Annex C to the Complaint) the Respondent appears to be a serial cybersquatter in view that it has been involved in several prior UDRP proceedings which were concluded with the transfer, or the cancellation, of the concerned disputed domain names to the concerned complainants.

Finally, the Respondent, not participating in the proceeding, has failed to indicate any facts and/or evidence, which would show the good faith registration or use of the Disputed Domain Names.

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, the Disputed Domain Names have been registered and are 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 Names <ghdaustria.com>, <ghdbelgium.com>, <ghdcolombia.com>, <ghd-denmark.com>, <ghdhairaustraliasalesite.com>, <ghdhaircanada.com>, <ghdhairchile.com>, <ghdhair-deutschland.com>, <ghdhairfinland.com>, <ghdhair-france.com>, <ghdhairelendsale.com>, <ghdhair-norge.com>, <ghdhairportugal.com>, <ghdhairstraightenerzsale.com>, <ghdhairstraightenerukshop.com>, <ghdhairusasale.com>, <ghdhungary.com>, <ghd-indonesia.com>, <ghditaliano.com>, <ghd-malaysia.com>, <ghdmexico.com>, <ghd-nl.com>, <ghd-philippines.com>, <ghdromania.com>, <ghd-schweiz.com>, <ghd-singapore.com>, <ghd-sweden.com>, and <ghduaestore.com> be transferred to the Complainant.

*/Mariya Koval/*

**Mariya Koval**

Sole Panelist

Date: February 10, 2023