

## **ADMINISTRATIVE PANEL DECISION**

Noxell Corporation v. max Mursaleen  
Case No. D2023-0423

### **1. The Parties**

The Complainant is Noxell Corporation, United States of America (“United States”), represented by Studio Barbero, Italy.

The Respondent is max Mursaleen, Pakistan.

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

The disputed domain name <maxfactorstore.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2023. On February 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 1, 2023, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 2, 2023, 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 February 3, 2023.

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 February 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 27, 2023.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on March 3, 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, Noxell Corporation, claims to be a subsidiary of Coty Inc., which in 2015 purchased some beauty brands, including MAX FACTOR, from the Procter & Gamble company.

The Complainant is the owner of several registered trademarks for MAX FACTOR, including the following:

- MAX FACTOR, European Union Trade mark registered under No. 000273730 on October 6, 1998, in classes 3 and 21, and;
- MAX FACTOR, United States trademark registered under No. 1373314 on December 3, 1985, in class 3.

The Disputed Domain Name was registered on June 13, 2022. According to the Complainant's evidence, the Disputed Domain Name appeared to resolve to a parking page containing pay-per-click ("PPC") links to third-party online stores offering for sale products of competitors of the Complainant. The Panel observes that the Disputed Domain Name does not resolve to any active website at the time of drafting this decision.

The Complainant sent a cease & desist letter and several reminders to the email address mentioned in the WHOIS records of the Disputed Domain Name, but claims that these communications remained unanswered.

#### **5. Parties' Contentions**

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

The Complainant considers the Disputed Domain Name to be confusingly similar to a trademark in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant, the Respondent is neither affiliated with the Complainant nor has it been authorized to use the Complainant's marks or the Disputed Domain Name in any manner. Also, according to the Complainant, the Respondent cannot reasonably claim to be commonly known by the Disputed Domain Name and has not provided any evidence of use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services. The Complainant further claims that there is no evidence that the Respondent might have used the Disputed Domain Name in connection with a legitimate noncommercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, the Respondent was undoubtedly aware of the existence of the Complainant's trademark when registering the Disputed Domain Name and intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website linked to the Disputed Domain Name.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out his case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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.

The Panel will therefore deal with each of these requirements.

### **A. Identical or Confusingly Similar**

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are trademarks in which it has rights. The Complainant's MAX FACTOR trademark has been registered and used in connection to the Complainant's cosmetics products.

The Disputed Domain Name <maxfactorstore.com> incorporates the Complainant's MAX FACTOR trademark in its entirety and adds the word "store". Where the relevant trademark is recognizable within the disputed 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 (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Additionally, it is well established that generic Top-Level-Domains ("gTLDs"), here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's MAX FACTOR trademark.

### **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel notes that the Respondent has not apparently been commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is “max Mursaleen”. The Respondent’s use and registration of the Disputed Domain Name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent exists or existed.

Where a domain name consists of a trademark plus an additional term, 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 (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name incorporates the Complainant’s MAX FACTOR trademark in its entirety and simply adds the descriptive word “store”. Given the cosmetics business under the Complainant’s MAX FACTOR trademark, the Panel finds that the Disputed Domain Name can easily be considered to refer to a store of the Complainant. The Panel therefore finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainant and cannot constitute fair use in the circumstances of this case.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

In this case, the Panel is of the opinion that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. According to evidence provided by the Complainant, the Disputed Domain Name resolved to a parking page containing pay-per-click (“PPC”) links ultimately resolving to third-party online stores offering for sale cosmetics products of competitors of the Complainant.

Therefore, the Panel finds that such PPC links capitalize on the reputation and goodwill of the Complainant’s mark or may mislead Internet users, which cannot be considered as a use of the Disputed Domain Name in connection with a *bona fide* offering of goods or services (see section 2.9 of the [WIPO Overview 3.0](#)).

The Disputed Domain Name currently does not resolve to an active web page.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

### **C. Registered and Used in Bad Faith**

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 the website or location or of a product or service on the website or location.

In the present case, the Panel finds it very likely that the Respondent was aware of the Complainant and its trademark rights when it registered the Disputed Domain Name. The Complainant's marks predate the Disputed Domain Name by more than a decade and the Panel observes that previous UDRP panels have already acknowledged the well-known character of the Complainant's MAX FACTOR mark (see, e.g., *Noxell Corporation v. Zhouzaoliang*, WIPO Case No. [D2020-2463](#); *Noxell Corporation 诉于区伟光*, WIPO Case No. [DCN2020-0038](#)). Moreover, the Disputed Domain Name incorporates the Complainant's distinctive trademark in its entirety with the addition of the word "store", which can easily be linked to the Complainant's cosmetics business under the MAX FACTOR mark. In the Panel's view, the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#), where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trademarks in question, the inclusion of the entire trademark in the domain name, and the similarity of products implied by addition of a telecommunications services suffix ("voip") suggested knowledge of the complainant's rights in the trademarks).

According to the Complainant's evidence, the Respondent used the Disputed Domain Name to resolve to a parking page containing PPC links ultimately resolving to third-party online stores offering for sale cosmetics products of competitors of the Complainant. In the Panel's view, this indicates that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark. While the intention to earn click-through-revenue is not in itself illegitimate, the Panel finds that the use of the Disputed Domain Name that is confusingly similar to the Complainant's trademark (as is the case here) to obtain click-through-revenue constitutes bad faith use (see *Mpire Corporation v. Michael Frey*, WIPO Case No. [D2009-0258](#); *L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unasi, Inc*, WIPO Case No. [D2005-0623](#)). The fact that the PPC links may be automatically generated by a third party cannot discharge the Respondent of any responsibility for the content appearing on the website connected to the Disputed Domain Name under its control (see section 3.5 of the [WIPO Overview 3.0](#)).

The fact that the Disputed Domain Name currently does not resolve to an active website does not prevent a finding of bad faith. In any event, the combination of the Complainant's MAX FACTOR mark with a descriptive term, which can easily be linked to the Complainant's business makes it difficult to conceive any plausible legitimate future use of the Disputed Domain Name by the Respondent.

By failing to respond to the Complainant's cease & desist letters and to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is established that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last element of the Policy.

## 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 <maxfactorstore.com> be transferred to the Complainant.

*/Flip Jan Claude Petillion/*

**Flip Jan Claude Petillion**

Sole Panelist

Date: March 17, 2023