

ADMINISTRATIVE PANEL DECISION

Deciem Beauty Group Inc. v. Name Redacted

Case No. D2023-0555

1. The Parties

The Complainant is Deciem Beauty Group Inc., Canada, represented by Gowling WLG (Canada) LLP, Canada.

The Respondent is Name Redacted¹.

2. The Domain Name and Registrar

The disputed domain name <deciebrands.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 February 7, 2023. On February 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 10, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

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”).

¹ The Respondent appears to have used the name of the Complainant when registering the disputed domain name. In light of the identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2023. The Respondent did not submit a formal response, however sent an email communication to the Center on February 14, 2023. The Center informed the Parties that it will proceed to panel appointment on March 15, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on March 20, 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 global skin care and beauty company. Since its launch in 2013, the Complainant has more than 50 products sold in markets around the world under the company name Deciem Beauty.

The Complainant is the owner of numerous trademarks consisting of the word “Deciem” around the world including (hereafter the “DECIEM Trademark”):

- The Canadian Trademark DECIEM No. TMA884741, registered on August 26, 2014, in classes 35 and 36;
- The European Union Trade Mark DECIEM No. 012914644, registered on October 20, 2014, in classes 35 and 36;
- The Chinese trademark DECIEM No. 17096399, registered on October 28, 2016, in class 3;
- The United States Trademark DECIEM No. 5754274, registered on May 21, 2019, in classes 35 and 44;
- The United States Trademark DECIEM No. 5731100, registered on April 23, 2019, in class 3.

The Complainant also operates a website at the domain name <deciem.com>.

The Disputed Domain Name <deciembrands.com> was registered on February 15, 2022, and resolves to an inactive website. However, the Complainant has provided evidence that the Disputed Domain Name has been used to impersonate the Complainant.

5. Parties' Contentions

A. Complainant

First of all, the Complainant asserts that the Disputed Domain Name is confusingly similar to its earlier DECIEM Trademark, since it incorporates the whole of its DECIEM Trademark. The Complainant adds that the fact that the Disputed Domain Name includes the word “brands” does nothing to diminish confusion. Despite this addition, the Disputed Domain Name remains very similar to the DECIEM Trademarks in appearance, sound and in the ideas suggested.

Secondly, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, since the Respondent is not licensed, or otherwise authorized, be it directly or indirectly, to register or use, the DECIEM Trademark in any manner whatsoever, including in, or as part of, a domain name. The Complainant adds that there is no evidence to suggest that the Respondent has ever used, or demonstrated preparations to use, the Disputed Domain Name, or a name corresponding to same, in connection with a *bona fide* offering of goods or service. On the contrary, the Respondent has engaged in the wholesale misappropriation of the DECIEM Trademark and copyrighted works.

Lastly, the Complainant asserts that the Disputed Domain Name was registered and is being used in bad faith. The Complainant contends that the Respondent registered the Disputed Domain Name in order to disrupt the business of the Complainant. The Complainant adds that the Respondent referred to itself as

“Deciem Beauty Group Inc.”, which is the Complainant, and that it is reasonable to infer that the Respondent not only knew this diversion would be disruptive, but also intended it to be so. Finally, the Complainant argues that given the nature of the Respondent’s website, the only plausible conclusion is that the Respondent had actual knowledge of the DECIEM Trademark at the time of registration, thereby supporting a finding of bad faith.

B. Respondent

The Respondent did not reply to the Complainant’s contentions. The Respondent sent an email communication to the Center on February 14, 2023 stating: “We have discontinued the domain name and will let it expire”.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has right;
- (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

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the DECIEM Trademark.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the Disputed Domain Name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#))).

Regarding the Disputed Domain Name, the Panel finds that it is composed of:

- the DECIEM Trademark;
- the word “brands”; and
- the generic Top-Level Domain (“gTLD”) “.com”, it being specified that the gTLD in a domain name is viewed as a standard registration requirement and as such is usually disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

According to prior UDRP panel decisions, it is sufficient that the disputed domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of descriptive or geographical term to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

Regarding the Disputed Domain Name, the Panel finds that it incorporates the DECIEM Trademark in its entirety and considers that the insertion of the word “brands” after the DECIEM Trademark does not prevent a finding of confusing similarity.

Therefore, the Panel holds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute to the respondent, the respondent’s 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
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is 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.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceeding is on the complainant, previous UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* that a respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Indeed, it appears that the Respondent has not received any authorization to use the DECIEM Trademark in any manner, including in domain names.

Moreover, it appears that the Disputed Domain Name has been used to impersonate the Complainant so that the Respondent was not using or has not prepared to use the Disputed Domain Name with a *bona fide* offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain.

Finally, the Panel notes that the Respondent used the Complainant’s name at the time of registering the Disputed Domain Name and indicated that it will discontinue the use of it.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainant has established that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on the respondent's website or location.

According to prior UDRP decisions, particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion), (ii) the chosen top-level domain (e.g., particularly where corresponding to the complainant's area of business activity or natural zone of expansion), (iii) the content of any website to which the domain name directs, including any changes in such content and the timing thereof[...], (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant (see section 3.2.1 of the [WIPO Overview 3.0](#)).

First of all, the Panel finds that it is established that the Complainant's trademarks were registered and used before the registration of the Disputed Domain Name. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name given that it reproduces the Complainant's DECIEM Trademark in its entirety.

The association of the Complainant's DECIEM Trademark with the term "brands" demonstrates the Respondent's intention to target the Complainant, which is confirmed by:

- the fact that the Disputed Domain Name has been used to impersonate the Complainant; and
- the Respondent falsely registered itself under the name of the Complainant when registering the Disputed Domain Name.

Therefore, there is no doubt that the Respondent was aware of the Complainant and its DECIEM Trademark and has precisely chosen and registered the Disputed Domain Name in bad faith.

Finally, the Panel finds that by impersonating the Complainant on the website to which the Disputed Domain Name directed, the Respondent has intentionally attempted either to attract Internet users for commercial gain or to disrupt the business of the Complainant.

The current non-use of the Disputed Domain Name does not change the Panel's finding of the Respondent's bad faith.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

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, <deciembrands.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: March 28, 2023