

ADMINISTRATIVE PANEL DECISION

OBAGI Holdings Company Limited v. Michael Nguyen, S-Cosmetics
Case No. D2023-2823

1. The Parties

The Complainant is OBAGI Holdings Company Limited, Cayman Islands, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is Michael Nguyen, S-Cosmetics, Canada.

2. The Domain Name and Registrar

The disputed domain name <obagi-medical.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 June 30, 2023. On July 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 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 July 6, 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 amended Complaint on July 10, 2023.

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 July 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 1, 2023.

The Center appointed Miguel B. O’Farrell as the sole panelist in this matter on August 2, 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 products company founded in 1988 by leading skin experts and for the past 35 years has been active in the skin care sector.

The Complainant is the owner of several trademark registrations for or including OBAGI in more than 60 countries, including the following:

- International Trademark Registration No. 1495947A OBAGI, registered on July 31, 2019, in classes 3, 5, 35, 41, and 44;
- International Trademark Registration No. 1592492A OBAGI MEDICAL, registered on March 29, 2021, in classes 3 and 35;
- Viet Nam Trademark Registration No. 4-0106470-000 OBAGI, registered on August 4, 2008, in classes 3 and 5;
- Viet Nam Trademark Registration No. 4-0039395-000 OBAGI C, registered on December 25, 2001, in class 3.

In addition, the Complainant operates the domain name <obagi.com>, which it uses for its website to promote its products and services.

The disputed domain name <obagi-medical.com> was registered on December 19, 2019 and resolves to a webpage offering OBAGI branded products, creams, serums and other skincare products in Vietnamese language, with important discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant, in essence, claims that the disputed domain name is identical to the trademark OBAGI MEDICAL and confusingly similar with the trademark OBAGI in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Complainant has no relationship or affiliation with the Respondent.

The Complainant has not authorized or licensed the use of the trademarks OBAGI MEDICAL nor OBAGI to the Respondent or to register a domain name containing them.

At the top of the Respondent's website home page there is a OBAGI MEDICAL logo which is confusingly similar to the mark which is used at the Complainant's official website "obagi.com", where it is also placed at the top of the webpage.

The Respondent's website not only displays the Complainant's trademarks, but also it falsely presents the existence of commercial relationship with the Complainant by stating that the Complainant's products are exclusively available by the website, and by using a language that implies a direct partnership or collaboration between the Complainant and the website. This misrepresentation misleads visitors into believing that they are engaging with an authorized or official platform of the Complainant, when in fact no such relationship exists.

The Complainant has also noticed that the e-mail server (MX Records) is configured on the disputed domain name. Thus, a risk of fishing cannot be ruled out.

On June 5, 2023, the Complainant sent the Respondent a cease and desist letter, followed by several reminders, which remained unanswered.

By using the disputed domain name for its website the Respondent is fraudulently and intentionally attracting customers for commercial gain, by creating confusion with the Complainant's marks.

Finally, the Complainant requests the Panel to issue a decision ordering 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

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar to the Complainant's trademarks OBAGI MEDICAL and OBAGI.

The disputed domain name <obagi-medical.com> incorporates the Complainant's trademark OBAGI MEDICAL in its entirety, with the addition of a hyphen in the middle, which does not prevent a finding of confusing similarity.

The disputed domain name is also confusingly similar to the Complainant's OBAGI trademark. In fact, the disputed domain name includes this trademark in its entirety with the addition of the term "medical", which does not prevent a finding of confusing similarity.

Section 1.8 of [WIPO Overview 3.0](#) provides that when the relevant trademark is recognizable within the disputed domain name - as it occurs in this case - the addition of other terms would not prevent a finding of confusing similarity under the first element.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademarks OBAGI

MEDICAL and OBAGI in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, 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
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleads consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather that it intends to use the disputed domain name for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the site to which the disputed domain name relates is an official site of the Complainant.

As established in section 2.5 of [WIPO Overview 3.0](#): "Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry." Here, the nature of the disputed domain name carries a high risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant and the Complainant's

trademark OBAGI mentioned in section 4 above (Factual Background) when it registered the disputed domain name on December 19, 2019.

In accordance with section 3.1.4 of [WIPO Overview 3.0](#), the Panel considers that the inclusion of the Complainant's OBAGI trademark in the disputed domain name creates a presumption of bad faith. The Complainant has submitted evidence to support that the trademark OBAGI mentioned in section 4 above was widely registered and used many years before the Respondent registered the disputed domain name.

The Respondent when registering the disputed domain name has targeted the Complainant's trademark OBAGI with the intention to confuse Internet users and capitalize on the fame of the Complainant's trademark.

The inclusion of the term "medical" related to the Complainant's business in the disputed domain name only contributes to create confusion among Internet users who will think that the website to which the disputed domain resolves is an official website of the Complainant.

The clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name is also a significant factor to consider that the disputed domain name was registered in bad faith (as stated in section 3.2.1 of [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has registered and is using the disputed domain name in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

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 <obagi-medical.com> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: August 14, 2023