

ADMINISTRATIVE PANEL DECISION

L'Oréal v. Артем Волик
Case No. DUA2023-0001

1. The Parties

The Complainant is L'Oréal, France, represented by Dreyfus & associés, France.

The Respondent is Артем Волик, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <nyxcosmetic.com.ua> is registered with Imena.ua. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on July 20, 2023. On July 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 25, 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 (Whois privacy protection service) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 25, 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 26, 2023.

The Registrar also indicated that the language of the registration agreement is Ukrainian. On July 25, 2023, the Center sent an email communication to the Parties in both Ukrainian and English inviting the Complainant to submit satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English; or submit the Complaint translated into Ukrainian; or submit a request for English to be the language of the administrative proceedings.

The Complainant filed a request for English to be the language of the proceedings on July 26, 2023. The Respondent did not comment on the language of the proceedings.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of .UA Domain Name Dispute Resolution Policy (the ".UA Policy"), the .UA Rules for .UA Domain Name Dispute Resolution Policy (the ".UA Rules"), and the WIPO Supplemental Rules for .UA Domain Name Dispute Resolution Policy (the "WIPO Supplemental Rules").

In accordance with the .UA Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint in both Ukrainian and English, and the proceedings commenced on August 11, 2023. In accordance with the .UA Rules, paragraph 5(a), the due date for Response was August 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 5, 2023.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on September 19, 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 .UA Rules, paragraph 7.

4. Factual Background

The Complainant is a French industrial group specialized in the field of cosmetics and beauty. It has a portfolio of 36 brands, 21 research centers, employs 88,000 employees, and is present in 150 countries. The Complainant's main website is located at "www.loreal.com".

The Complainant and its Group's four divisions are all represented in Ukraine, with 273 employees and 20 brands available, including NYX PROFESSIONAL MAKEUP. L'Oréal Ukraine was founded in 2004. The first shipment was made in April 2005. With its portfolio of 20 diverse and complementary brands represented in Ukraine, L'Oréal Ukraine is present across the following distribution networks: perfumeries, department stores, pharmacies and drugstores, hair salons, branded retail and ecommerce.

The NYX PROFESSIONAL MAKEUP trademark was created in 1999 and is a global brand available in over 70 countries at thousands of retailers consisting of specialty beauty and fashion stores, freestanding shops, and beauty supply stores, as well as on the Complainant's website "www.nyxcosmetics.com".

The Complainant is the holder of the registered trademark rights in the NYX trademark, which are granted under the following trademark registrations:

- International Trademark Registration No. 1052316 for NYX (figurative), dated August 25, 2010, duly renewed, designating *inter alia* Bulgaria, Belarus, Poland, Romania, Russian Federation and covering goods in class 3;
- International Trademark Registration No. 1184769 for NYX (figurative), dated October 31, 2013, designating *inter alia* Ukraine and covering goods and services in classes 18, 21 and 35;
- International Trademark Registration No. 1155413 for NYX PROFESSIONAL MAKEUP, dated February 19, 2013, designating *inter alia* Austria, Belarus, China, United Kingdom and Poland, covering goods and services in classes 3, 18, 21 and 35.

In addition, the Complainant and its subsidiary operate, among others, the following domain names reflecting its NYX trademark in order to promote its services:

- <nyxcosmetics.com.ua> created on August 30, 2011;
- <nyxcosmetic.com> created on January 31, 2013;
- <nyxcosmetics.com> created on March 16, 2001.

The disputed domain name was created on July 30, 2014 and used to resolve to the commercial website purportedly being that of the official dealer of the Complainant in Ukraine and reproducing the Complainant's NYX PROFESSIONAL MAKEUP trademark, the Complainant's visuals, and offering for sale the Complainant's NYX products. At the time of this Decision the website under the disputed domain name is inactive. The disputed domain name used to be associated with the YouTube account with a published video named "NYX PROFESSIONAL MAKEUP в Україні" reproducing the Complainant's visuals without its authorization.

Before starting the present proceeding, the Complainant made some efforts to resolve this matter amicably.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The Complainant contends that the disputed domain name and the NYX trademark are confusingly similar.

According to the Complainant's contentions, the disputed domain name fully incorporates the Complainant's NYX trademark. The disputed domain name is confusingly similar to its mark in that it only differs by the addition of the term "cosmetic".

The Complainant avers that incorporation of a well-known trademark in its entirety may be sufficient to establish that the domain name is identical or confusingly similar to complainant's trademark.

The fact that the disputed domain name contains the term "cosmetic" succeeding the Complainant's trademark does not prevent a confusing similarity. When combined with the Complainant's NYX trademark, the term "cosmetic", does not dispel any possibility of confusion but instead does the opposite and increases the potential for confusion among Internet users.

The Complainant submits that the applicable country code Top-Level Domain ("ccTLD") in the disputed domain name should be viewed as a standard registration requirement and as such should be disregarded under the first element confusing similarity test.

No Rights or Legitimate Interests

The Complainant submits that the Respondent is not a licensee of the Complainant and has not received any permission or consent from it to use its NYX trademark.

The Complainant further contends that the Respondent has no prior rights or legitimate interests in the disputed domain name. The registration of the NYX trademarks precedes the registration of the disputed domain name.

The Complainant submits that the disputed domain name is so identical to the Complainant's NYX trademark and to the Complainant's official domain names, that the Respondent cannot reasonably pretend it was intending to develop a legitimate activity through the disputed domain name.

According to the Complainant that, before any notice of the dispute, the Respondent has not used or has not made any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

The previous use of the disputed domain name in connection to the commercial website in Russian presenting itself as an exclusive distributor of NYX cosmetics in Ukraine, displaying the Complainant's NYX and NYX PROFESSIONAL MAKEUP trademarks, visuals and offering products for sale without the Complainant's authorization, creating thus a false affiliation with the Complainant, does not constitute a fair use of the disputed domain name.

Registered and Used in Bad Faith

The Complainant submits that given the Complainant's goodwill and renown, and the nature of the disputed domain name, the Respondent could simply not have chosen the disputed domain name for any reason other than to deliberately cause confusion amongst Internet users as to its source in order to take unfair advantage of the Complainant's goodwill and reputation, which clearly constitutes bad faith.

The Complainant further submits that the Respondent registered the disputed domain name through a privacy shield service to hide its identity and contact details, thus, preventing the Complainant from contacting it. A deliberate concealment of identity and contact information may in itself indicate registration in bad faith.

The Complainant avers that the use of the disputed domain name for potential phishing activity could never give the Respondent legitimate interests in the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural Issue – Language of the Proceedings

The language of the Registration Agreement for the disputed domain name is Ukrainian. Paragraph 11(a) of the .UA Rules provides that "Unless otherwise agreed by the Parties, the language of the administrative proceeding shall be the language of the Registration Agreement (which shall be in English, Russian or Ukrainian), subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". In particular, it is established practice to take paragraphs 10(b) and (c) of the .UA Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the Parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the Parties and undue delay to the proceeding. (See, e.g., *Chewy Inc v. Rostislav Karyi / Ростислав Карый*, WIPO Case No. [DUA2020-0007](#); *Crocs, Inc. v. Матвеева Анжела Геннадьевна / Matveeva Angela*, WIPO Case No. [DUA2020-0015](#)).

The Complainant filed the Complaint in English and requested English to be the language of this proceeding referring to the potential unfairness or unwarranted delay in ordering the Complainant to translate the Complaint, and to the fact that English is the primary language for international relations.

The Center has provided both Parties with an opportunity to comment on the language of the proceedings by sending both Parties a Language of Proceedings notification, as well as all other communications in both Ukrainian and English. The Complainant has provided submissions regarding the proper language of proceedings, while the Respondent did not raise any objection or reply thereto.

The Complainant communicates in English and would be prejudiced, should it be required to translate the Complaint and participate in this proceeding in Ukrainian. Requiring the Complainant to translate the Complaint and all documents into Ukrainian would cause delay in contravention to paragraph 10(c) of the .UA Rules, which requires that "[t]he Panel shall ensure that the administrative proceeding takes place with

due expedition.” See *Michael Kors (Switzerland) International GmbH. v. Minakova Maria*, WIPO Case No. [DUA2020-0002](#) (finding that the registration agreement was in Russian, but that the proceeding should be conducted in English since “the Panel has to balance [the language requirement that is provided for in paragraph 11(a) of the .UA Rules] against the other considerations of ensuring that the proceeding takes place with due expedition and that the parties are treated fairly and given a fair opportunity to present their case. The Panel is of the view that the language requirement should not cause any undue burden on the parties or undue delay”).

Furthermore, the Panel establishes that English is not the native language of the Complainant. In previous similar cases, panels after considering the totality of the circumstances found that it would be fair to the parties not having English as their native language and one of which is not familiar with the respondent’s native language to designate English as the language of the proceeding (see *OPPO Pte. Ltd. v. Alexander Leonidovich Shirkov*, WIPO Case No. [DUA2019-0001](#)).

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties’ ability to understand and use the proposed language, time and costs. See, e.g., *Facebook Inc. v. Private Registration / Denis Khakimov*, WIPO Case No. [DUA2019-0002](#).

Considering that both Parties have been given fair opportunities to present their cases and the Respondent has been given an opportunity to object to the proceedings being conducted in English but has not responded, the Panel finds that in the circumstances of this case, paragraph 11(a) of the .UA Rules is best served by allowing the proceedings to be conducted in English in accordance with the Complainant’s request as the Complainant could suffer significant disadvantage if the proceedings are conducted in Ukrainian.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the .UA Rules that the language of the proceeding shall be English.

6.2. Further Procedural Considerations

Under paragraph 10 of the .UA Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent’s mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the .UA Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel notes that the Center sent the Notification of Complaint by email to the Respondent at its email address as registered with the Registrar and to a postmaster email address as specified by the .UA Rules. There is no evidence that the case notification email to the first email address was not successfully delivered. Moreover, the Respondent appears to be capable of continuing to control the disputed domain name, as the use of the disputed domain name has changed.

It is moreover noted that, for the reasons which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of any Response) that the Respondent registered and has used the disputed domain name in bad faith and with the intention of unfairly targeting the Complainant’s goodwill in its trademark.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

6.3 Substantive Elements of the .UA Policy

The Panel now proceeds to consider this matter on the merits in light of the Complaint, the lack of the Response, the .UA Policy, the .UA Rules, the WIPO Supplemental Rules, and other applicable legal authority pursuant to paragraph 15(a) of the .UA Rules.

Paragraph 15(a) of the .UA Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the .UA Policy, these .UA Rules and any rules and principles of law that it deems applicable.”

Considering that the Respondent did not reply to the Complainant’s contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the .UA Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the .UA Policy and the .UA Rules. Under paragraph 14(b) of the .UA Rules, where a Party does not comply with any provision of the .UA Rules, the Panel “shall draw such inferences therefrom as it considers appropriate”.

Paragraph 4(a) of the .UA Policy directs that the Complainant must prove each of the following: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the 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 has been registered or is being used in bad faith.

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. The Complainant submitted evidence that the NYX trademark enjoys protection under international trademark registrations. Thus, the Panel finds that the Complainant’s rights in the NYX trademark have been established pursuant to the first element of the .UA Policy. See, e.g., *Fonbet Corp. v. Геннадія П. Пастушенка*, WIPO Case No. [DUA2020-0010](#).

The disputed domain name consists of the Complainant’s distinctive NYX trademark followed by the term “cosmetic”, and followed by the ccTLD “.com.ua”.

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. The nature of such additional term may however bear on assessment of the second and third elements. See, e.g., *Alticor Inc. v. Alex Istreamco*, WIPO Case No. [DUA2021-0026](#).

While each case is judged on its own merits, 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 .UA Policy.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the .UA Policy, the Panel may ignore the ccTLD, See, e.g., *Luigi NYX S.p.A. v. Ольховский Михаил Викторович / Ol'khovskij Mikhail Viktorovich*, WIPO Case No. [DUA2021-0017](#).

It is the view of the Panel that it is readily apparent that the Complainant's NYX trademark remains recognizable in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the NYX trademark in which the Complainant has rights.

The first element of paragraph 4(a) of the .UA Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the .UA Policy, the Complainant must make at least a *prima facie* showing that the Respondent possesses no rights or legitimate interests in disputed domain name. According to prior decisions under the .UA Policy, once the Complainant makes such a *prima facie* showing, the burden of production shifts to the Respondent, though the burden of proof always remains on the Complainant. If the Respondent fails to come forward with evidence showing rights or legitimate interests, the Complainant will have sustained its burden under the second element of the .UA Policy. (See, e.g., *Google LLC v. Александр Дмитриевич Бутенко*, WIPO Case No. [DUA2020-0009](#); *AB Electrolux v. Захаров Евгений*, WIPO Case No. [DUA2020-0006](#); *Хармен Интернешенл індастріз, Інк. (Harman International Industries, Inc.) v. Александр Коллегаева*, WIPO Case No. [DUA2020-0005](#)).

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its NYX trademark.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *Facebook Inc. v. Private Registration / Denis Khakimov*, WIPO Case No. [DUA2019-0002](#).

The evidence provided by the Complainant shows that the disputed domain name, that incorporates the Complainant's NYX trademark in its entirety, resolved towards a website in Russian presenting itself as an official distributor of NYX cosmetics in Ukraine, displaying the Complainant's NYX trademark, visuals and offering products for sale without the Complainant's authorization, creating thus a false affiliation with the Complainant, which does not constitute a fair use of the disputed domain name. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any accurate and prominent disclosure of the registrant's relationship with the complainant on the website at the disputed domain name, renders any fair use safe harbor inapplicable in this instance. See, e.g., *Alticor Inc. v. Alex Istreamco*, WIPO Case No. [DUA2021-0026](#).

Similarly, the disputed domain name is virtually identical to the Complainant's official domain names easing eventual typing error by Internet users; thus, resulting to diversion from the Complainant's site to that of the Respondent.

Such behaviour cannot be regarded as a legitimate or fair use of the disputed domain name.

At the time of this Decision the website under the disputed domain name is inactive. However, passive holding of the disputed domain name does not count on the legitimate noncommercial or fair use of the disputed domain name. Given the Complainant's goodwill and renown worldwide, and the nature of the disputed domain name that is confusingly similar to the Complainant's NYX trademark, it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the disputed domain name, as it would invariably result in misleading diversion and taking unfair advantage of the Complainant's rights.

Respectively, based on the case records, the Panel can draw the inference that the Respondent's use of the disputed domain name is not in connection with the *bona fide* offering of goods or services such as to confer on the Respondent rights or legitimate interests for the purposes of the .UA Policy. On the contrary, its use of the disputed domain name takes unfair advantage of the confusing similarity of the disputed domain name with the Complainant's NYX trademark, in order to divert Internet users seeking information about the Complainant and its goods, to the Respondent's website.

In making this finding, the Panel takes into account that the website to which the disputed domain name used to resolve has been used to sell the Complainant's NYX branded products, the website did not accurately disclose the Respondent's (lack of) relationship with the Complainant, and included use of the Complainant's copyright protected material without permission.

Furthermore, by not submitting a Response, the Respondent has failed to invoke any circumstances which could demonstrate any rights or legitimate interests in the disputed domain name. Under such circumstances the Panel draws adverse inferences from this failure, where appropriate, in accordance with the .UA Rules, paragraph 14(b).

The second element of paragraph 4(a) of the .UA Policy is therefore satisfied.

C. Registered or Used in Bad Faith

The .UA Policy requires a complainant to establish that the disputed domain name was registered or is being used in bad faith. The .UA Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the .UA Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] web site or other on-line location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] web site or location or a product or service on [respondent's] web site or location".

Given that the Complainant's NYX trademark is a famous trademark worldwide, and factoring the previous use of the disputed domain name for the commercial website at which the Complainant's NYX branded products have been sold, it is unconceivable that the Respondent was not aware of the rights the Complainant has in the NYX trademark, and the value of the said trademark, at the point of the registration. The facts that the Respondent's disputed domain name is misleadingly similar not only to the Complainant's NYX trademark, but also to the Complainant's official website under the domain name <nyxcosmetics.com.ua>, indicate not only that the Respondent had a prior knowledge about the Complainant's business and trademark, but also that it registered the disputed domain name to potentially attract Internet users to the Respondent's website for commercial gains by creating confusion.

It is next necessary to consider whether the currently inactive status of the disputed domain name prevents a finding of bad faith under the doctrine of passive holding. Each of these considerations points to the Respondent's passive holding of the disputed domain name being in bad faith. Specifically: (i) the Complainant's NYX trademark is distinctive and well established, (ii) the Respondent has failed to submit a response to the Complaint or provide any evidence of good-faith use, (iii) there is no conceivable good faith use to which the disputed domain name could be put by the Respondent, (iv) the earlier use of the disputed domain name has been performed in bad faith.

The Panel therefore finds the Respondent to have registered and used the disputed domain name in bad faith.

The evidence provided by the Complainant also demonstrates the bad faith use as the Respondent's activities were to attract, for commercial gain, Internet users to the Respondent's commercial website, by creating a likelihood of confusion with the Complainant's trademark NYX as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and of its business promoted therein.

Therefore, it is clear that the Respondent registered and has used the disputed domain name in order to attempt to attract Internet users to its website for commercial gain, by causing a likelihood of confusion and association with the Complainant and its NYX trademark. See, e.g., *Luigi NYX S.p.A. v. Ильин Алексей Павлович*, WIPO Case No. [DUA2021-0006](#).

The third element of paragraph 4(a) of the .UA Policy is therefore satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the .UA Policy and 15 of the .UA Rules, the Panel orders that the disputed domain name, <nyxcosmetic.com.ua>, be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: October 10, 2023