

ADMINISTRATIVE PANEL DECISION

Deciem Beauty Group Inc. v. John Cena

Case No. D2022-4394

1. The Parties

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

The Respondent is John Cena, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <theordinary.world> 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 November 17, 2022. On November 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 21, 2022, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 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 November 30, 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 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 23, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on January 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 is a global skincare and beauty company which was founded in 2013 and, since its launch, has had more than 50 products sold in markets around the world and generated over a billion dollars in revenue.

The Complainant is the owner of over 400 trademark registrations for THE ORDINARY around the world including the following, as per trademark certificates submitted as annexes to the Complaint:

- Canada trademark registration No. TMA1014737 for THE ORDINARY (word mark), registered on February 7, 2019, in International Class 3;
- Canada trademark registration No. TMA1017744 for THE ORDINARY (word mark), registered on March 20, 2019, in International Classes 35 and 44;
- China trademark registration No. 29262142 for THE ORDINARY (word mark), registered on January 14, 2019, in International Class 35;
- China trademark registration No. 21258391 for THE ORDINARY (word mark), registered on November 14, 2017, in International Class 3;
- European Union Trade Mark No. 015761182 for THE ORDINARY (word mark), registered on December 8, 2016, in International Class 3;
- Hong Kong, China trademark registration No. 305538150 for THE ORDINARY (word mark), registered on February 18, 2021, in International Class 44;
- Hong Kong, China trademark registration No. 303893987 for THE ORDINARY (word mark), registered on September 06, 2016, in International Class 3;
- United States trademark registration No. 5203537 for THE ORDINARY (word mark), registered on May 16, 2017, in International Class 3;
- United Kingdom trademark registration No. UK00003289451 for THE ORDINARY (word mark), registered on May 11, 2018, in International Classes 3 and 35;
- Australia trademark registration No. 1794388 for THE ORDINARY (word mark), registered on September 5, 2016, in International Class 3;
- Australia trademark registration No. 1852820 for THE ORDINARY (word mark), registered on June 19, 2017, in International Classes 35 and 44.

The Complainant is also the owner of the domain name <theordinary.com>, which was registered on December 29, 1998, and is used by the Complainant to promote its skincare products under the trademark THE ORDINARY.

The disputed domain name was registered on March 14, 2021, and resolves to a website in Vietnamese, publishing the Complainant's trademarks and copyrighted images and offering for sale purported THE ORDINARY products.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the trademark THE ORDINARY in which the Complainant has rights.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is not commonly known by the disputed domain name and is not making, or intending to make, a legitimate noncommercial or fair use of the disputed domain name.

The Complainant further highlights 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 services and underlines that there has never been any relationship between the Complainant and the Respondent. The Complainant underlines that the Respondent is not licensed, or otherwise authorized, be it directly or indirectly, to register or use, the THE ORDINARY trademark in any manner whatsoever, including in, or as part of, a domain name.

Moreover, the Complainant submits that the Respondent's activities completely undermine any claim of rights or legitimate interests, since the Respondent appears to have engaged in the wholesale misappropriation of the THE ORDINARY trademarks and copyrighted works and contends that the disputed domain name is designed to dupe end users into believing that the Respondent is authorized by the Complainant. The Complainant also notes that the Respondent is using an email address associated with the disputed domain name, while also claiming to be an official store of the Complainant, which is not the case.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent has passed itself off as the Complainant rendering the Respondent a competitor of the Complainant and submits that the disputed domain name seems to suggest that the Respondent is authorized by the Complainant, which it is not. In addition, the Complainant submits that the Respondent refers to itself as a "Genuine Ordinary Distributor In Vietnam" on the website at the disputed domain name, which is not the case.

In addition, the Complainant contends that the website featured the Complainant's intellectual property in such a manner as to suggest a connection or authorization by the Complainant and that the use of the disputed domain name is disruptive to the Complainant, as potential consumers are likely to be confused or misled into believing that the Respondent was somehow affiliated with, or sponsored by, the Complainant.

The Complainant further emphasizes that the disputed domain name is being used in an attempt to intentionally attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's THE ORDINARY trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

The Complainant underlines that the Respondent has actively sought to pass itself off as the Complainant, leaving the only plausible conclusion that the Respondent had actual knowledge of the Complainant and its THE ORDINARY trademark at the time of registration, which undoubtedly supports a finding of bad faith.

Lastly, the Complainant asserts that the registrant information provided by the Respondent for the disputed domain name is false and submits that such circumstance further evidences the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: “A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Complainant has provided evidence of ownership of numerous trademark registrations for THE ORDINARY in several jurisdictions, as mentioned under section 4 above.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity 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 disputed domain name.

In the case at hand, the Complainant’s trademark THE ORDINARY is entirely reproduced in the disputed domain name, with the mere deletion of the space between the words “the” and “ordinary” and the addition of the Top-Level Domain “.world”, which is commonly disregarded under the first element confusing similarity test (section 1.11 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is identical to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

“(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.”

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not submitting a Response, has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks.

In addition, there is no indication before the Panel that the Respondent is commonly known by the disputed domain name nor that it has made preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, considering the disputed domain name has been pointed to a website displaying the Complainant's trademarks and copyrighted images as well as misleading indications apt to suggest that the website, offering purported THE ORDINARY products, is operated by an authorized distributor of the Complainant.

In view of the above-described use of the disputed domain name, the Panel finds that the Respondent is also not using the same for a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark. Moreover, as stated in section 2.5.1 of the [WIPO Overview 3.0](#), "UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation".

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to bad faith at the time of the registration, the Panel notes that, in light of the prior registration and use of the Complainant's trademark THE ORDINARY in connection with the Complainant's skincare products in several countries and also online via the Complainant's website "www.theordinary.com", the Respondent was or should have been aware of the Complainant's trademark when it registered the disputed domain name.

Moreover, in view of the identity of the disputed domain name with the Complainant's trademark THE ORDINARY and its domain name <theordinary.com>, and considering the use made by the Respondent of the disputed domain name to advertise and offer for sale purported THE ORDINARY products, publishing the Complainant's trademarks and images without authorization, the Panel finds that the Respondent was indeed well aware of, and intended to target, the Complainant and its trademark.

The Panel also finds that, by pointing the disputed domain name to a website promoting and offering for sale purported THE ORDINARY products, publishing the Complainant's trademarks and official images, and falsely asserting to be an authorized distributor of the Complainant, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the trademark THE ORDINARY as to the source, sponsorship, affiliation or endorsement of its website and the products promoted therein according to paragraph 4(b)(iv) of the Policy.

As an additional circumstance suggesting bad faith, the Panel notes that there has been no Response, nor any explanation of the clear attempt to suggest an affiliation with the Complainant that does not exist.

Lastly, the Panel notes that the registrant information according to the Registrar-provided Whois records is clearly incorrect, since it mentions only "United States" in the "Street" and "City" fields whilst indicating Viet Nam as country and the zip code of Beijing, China. The Panel also notes that the registrant's name corresponds to the name of a famous wrestler, whose name, under the circumstances of the case, may have been misappropriated by the Respondent to shield its true identity. The Panel considers the false information provided by the Respondent in the Whois records of the disputed domain name as an additional indication of the Respondent's bad faith, concurring with the views expressed *inter alia* in *Steelcase Development Corporation v. Admin, Domain*, WIPO Case No. [D2005-1352](#).

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) 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 <theordinary.world> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: January 17, 2023