

## **ADMINISTRATIVE PANEL DECISION**

Elemis USA, Inc. v. 李思恒 (li si heng)

Case No. D2023-0934

### **1. The Parties**

The Complainant is Elemis USA, Inc., United States of America (“United States” or “US”), represented by IP Twins, France.

The Respondent is 李思恒 (li si heng), China.

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

The disputed domain name <elemisskincare.com> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 2, 2023. On March 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 3, 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 (Unknown Respondent) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 3, 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 in English on the same day.

On March 3, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On the same day, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on March 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2023. The Respondent did not submit any

response. However, an email was received from the Respondent on March 6, 2023, indicating “This site has been deleted”. Accordingly, the Center notified Commencement of Panel Appointment Process on March 31, 2023.

The Center appointed Rachel Tan as the sole panelist in this matter on April 6, 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 was founded in 1989. It is part of the L’Occitane group of companies. It manufactures and distributes face and body skincare products which are sold in more than 20 countries.

The Complainant is the owner of the ELEMIS mark in multiple jurisdictions, including European Trade Mark Registration No. 3880366 registered on October 10, 2005 in class 44; Canadian Trade Mark Registration No. TMA758305 registered on January 29, 2010 in classes 3 and 5; and New Zealand Trade Mark Registration No.224940 registered on February 27, 1996 in class 3.

The Complainant is also the owner of domain names which incorporate the ELEMIS mark, such as <elemis.com> which was registered since 1997.

The disputed domain name was registered on January 5, 2023. According to the evidence provided by the Complainant, the disputed domain name previously resolved to a website in English which allegedly displayed the Complainant’s registered ELEMIS mark and offered ELEMIS-branded products for sale. However, at the time of this decision, the disputed domain name does not resolve to an active website.

#### **5. Parties’ Contentions**

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

The Complainant contends that the disputed domain name is highly similar to its well-known ELEMIS mark. The disputed domain name reproduces the ELEMIS mark together with the term “skincare”. The additional term “skincare” does nothing to diminish the likelihood of confusion between the ELEMIS mark and the disputed domain name. As “skincare” is very closely connected to the Complainant’s activities, Internet users of average attention will likely believe that the disputed domain name is affiliated with or endorsed by the Complainant.

The Complainant further alleges that the Respondent has no rights or legitimate interests in the disputed domain name. There is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization. The Complainant has not authorized the use of its earlier ELEMIS mark or terms similar thereto in the disputed domain name in any manner or form. Further, the disputed domain name resolved to a website offering ELEMIS-branded products for sale and gave a false impression that it is owned, operated or endorsed by, or affiliated with, the Complainant. The resolved website does not display any element to clarify or disclaim the relationship between the Respondent and the Complainant. Hence, the Complainant claims such use should not be considered to be a *bona fide* offering of goods or services.

The Complainant finally asserts that the Complainant’s trade mark registration significantly predates the registration date of the disputed domain name. The Respondent necessarily had the Complainant’s name and trade mark in mind when registering the disputed domain name. The use of the disputed domain name in connection with an online store is further evidence of bad faith. It is clear that the Respondent is actively trying to benefit from the renown and fame of the Complainant and its brands to make commercial gain, by creating confusion in the mind of the Internet user of average attention.

## B. Respondent

The Respondent did not reply to the Complainant's contentions, however, an email was received from the Respondent on March 6, 2023, indicating "This site has been deleted".

## 6. Discussion and Findings

### 6.1 Language of the Proceeding

Initially, the Panel must address the language of the proceeding. Paragraph 11(a) of the Rules provides that the language of the administrative proceeding shall be the language of the Registration Agreement unless otherwise agreed by the parties, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The panel may choose to write a decision in either language, or request translation of either party's submissions.

In this case, the Registrar has confirmed to the Center that the language of the Registration Agreement as used by the registrant for the disputed domain name is Chinese. However, the Complainant has requested that English be adopted as the language of the proceeding for the reasons summarized below:

- (a) the Complainant is a US entity which is not able to communicate in Chinese. It is not in a position to conduct this proceeding in Chinese without a great deal of additional expense and delay due to the need for translation of the Complaint; and
- (b) the Respondent is in a position to understand English and undergo the proceeding in the English because the disputed domain name contains the English generic term "skin care" and the website associated with the disputed domain name is fully available in English only.

It is established practice to take paragraphs 10(b) and (c) of the 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.

The Panel having considered the circumstances finds that English shall be the language of this proceeding. The reasons are set out below:

- (a) the Complainant is based in the United States. Requiring the Complainant to submit documents in Chinese would lead to delay and cause the Complainant to incur translation expenses;
- (b) the disputed domain name contains an English term "skincare" and previously resolved to a website in English;
- (c) even if the Respondent does not possess a sufficient command of English to understand the Complaint, there were ample opportunities for the Respondent to raise an objection. The Center notified the Parties in English and Chinese of the Complainant's request for English to be the language of the proceeding, but the Respondent did not protest against this request;
- (d) the Respondent sent an email communication to the Center in English on March 6, 2023; and
- (e) the Complaint has been submitted in English. No foreseeable procedural benefit may be served by requiring Chinese to be used. On the other hand, the proceeding may proceed expeditiously in English.

## 6.2 Analysis of Substantive Issues

### A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has adduced evidence to demonstrate their established rights in the ELEMIS mark.

The Panel notes that the disputed domain name consists of the ELEMIS mark in addition to the English term “skincare”. In cases where a domain name incorporates the entirety of a trade mark, 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 UDRP standing. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Further, it is accepted by previous UDRP panels that the addition to the complainant’s trade mark of other words or terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element of the Policy. Accordingly, the additional English term “skincare” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s ELEMIS mark. See section 1.8 of the [WIPO Overview 3.0](#).

It is permissible for the Panel to ignore the generic Top-Level Domain, in this case “.com”. See section 1.11.1 of the [WIPO Overview 3.0](#). Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s ELEMIS mark.

Accordingly, the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

In circumstances where the Complainant possesses exclusive rights to the ELEMIS mark, whereas the Respondent seems to have no trade mark rights, and considering the facts and arguments set out above, the Panel is satisfied that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the burden of production shifts to the Respondent. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not provided evidence of a legitimate noncommercial or fair use of the disputed domain name or reasons to justify the choice of the term “elemis”. There is no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. In addition, the Complainant has not granted the Respondent a license or authorization to use the Complainant’s ELEMIS mark or register the disputed domain name.

The Panel notes that the disputed domain name previously resolved to a website in English which allegedly offered ELEMIS-branded products and displayed the Complainant’s ELEMIS mark. The website did not accurately and prominently disclose the lack of a relationship between the Complainant and the Respondent. Therefore, the facts do not support a claim of fair use under the “Oki Data test”. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, the Complainant has satisfied the second element under paragraph 4(a) of the Policy.

### C. Registered and Used in Bad Faith

The Complainant’s ELEMIS mark is registered before the registration of the disputed domain name. Through use and advertising, the Complainant’s ELEMIS mark is known throughout the world. Search results using the term “elemis” on the Internet direct users to the Complainant and its products, which

indicates that an exclusive connection between the ELEMIS mark and the Complainant has been established. The Panel further notes that the disputed domain name previously resolved to a website allegedly offering ELEMIS-branded products and displaying the Complainant's ELEMIS mark. As such, the Respondent clearly knew of the Complainant's ELEMIS mark when registering the disputed domain name, see section 3.2.2 of the [WIPO Overview 3.0](#). The Panel is of the view that the Respondent intentionally created a likelihood of confusion with the Complainant's ELEMIS mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. This demonstrates bad faith registration and use of the disputed domain name, as provided in paragraph 4(b)(iv) of the Policy.

The Panel notes that the disputed domain name currently does not resolve to any active website. The current inactive use of the disputed domain name in this case would not prevent a finding of bad faith under the doctrine of passive holding. In its determination, the Panel considers the degree of distinctiveness and reputation of the Complainant's ELEMIS mark. Although the Respondent indicated "This site has been deleted" in the email received on March 6, 2023 by the Center, the Respondent's has failed to formally respond in the proceeding, especially in the face of the Complainant's allegations of bad faith, as well as the implausibility of any good faith use that the disputed domain name may be put. See section 3.3 of the [WIPO Overview 3.0](#).

Taking into account these circumstances, the Panel finds that the Respondent must have known of the Complainant before registering the disputed domain name and, considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain name as discussed above, the Panel is led to conclude that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the third element under paragraph 4(a) 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 <elemisskinicare.com> be transferred to the Complainant.

*/Rachel Tan/*

**Rachel Tan**

Sole Panelist

Date: April 20, 2023