

ADMINISTRATIVE PANEL DECISION

Laboratoires Filorga Cosmetiques v. Chen Li
Case No. D2023-1300

1. The Parties

The Complainant is Laboratoires Filorga Cosmetiques, France, represented by Fross Zelnick Lehrman & Zissu, PC, United States of America.

The Respondent is Chen Li, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <filorgastore.com> is registered with Stork R, informacijske storitve, d.o.o. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 25, 2023. On March 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 28, 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 (Whols Masked) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 29, 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 April 3, 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 April 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 2, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on May 22, 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 the registered owner of trademarks in several jurisdictions for FILORGA, e.g., International trademark registration No. 1392209 FILORGA (word), registered on November 23, 2017 for goods in classes 3, 5 and 10.

The disputed domain name was registered on December 3, 2021 and resolves to a website offering a number of FILORGA products as well as other products from another brand, further reproducing without any authorization the Complainant's trademark and the Complainant's copyrighted products images.

5. Parties' Contentions

A. Complainant

It results from the Complainant's undisputed allegations that the Complainant is a premium skin care company that was founded in 1978 in France. It offers numerous premium cosmetic skin care products under its FILORGA trademarks, including cleansers, serums, moisturizers, creams and facial masks. The Complainant was acquired by Colgate-Palmolive Company in 2019 and is now operating as a wholly-owned subsidiary.

The Complainant contends that its trademark FILORGA is distinctive and well known.

The Complainant uses the domain name <filorga.com> in order to promote its products.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademark, since it incorporates the Complainant's distinctive FILORGA trademark in its entirety, merely adding the non-distinctive term "store" and the ".com" generic Top-Level Domain ("gTLD").

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, at no time did the Complainant ever authorize or permit the Respondent's registration of the disputed domain name incorporating the Complainant's FILORGA trademark, and there is no relationship between the Complainant and the Respondent that would give rise to any license, permission or authorization for the Respondent to use or register the disputed domain name. The Respondent is not commonly known by the disputed domain name. In addition, the website at the disputed domain name purports to be a legitimate wholesaler that is selling genuine FILORGA products at discounted prices. The Respondent merely set up the website at the disputed domain name to lure traffic and buyers to the website at the disputed domain name. This is not a *bona fide* offering or use, but instead is nothing more than a form of parasitic exploitation of the Complainant's name and business. Even if the goods that were being sold at the Respondent's website are genuine, the Respondent's use of the disputed domain name would still not have been *bona fide*, as the site references non-FILORGA products and discontinued products that are no longer in production or offered for sale in any markets by the Complainant and also fails to disclose the lack of any relationship with the Complainant.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, given the widespread reputation of the FILORGA mark, the public is likely to be confused into thinking that the disputed domain name has a connection with the Complainant, contrary to the fact. By virtue of the use of the Complainant's FILORGA trademark at the website, the public is likely to be confused into believing, falsely, that the disputed domain name and the website associated therewith had a connection with the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “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 requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

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

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of various trademark registrations for FILORGA, as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 1.7.

This Panel shares this view and notes that the Complainant's registered trademark FILORGA is fully included in the disputed domain name, followed by the term “store”. Furthermore, it is the view of this Panel that the addition of the term “store” in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the gTLD “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the Complainant's trademark FILORGA, e.g., by registering the disputed domain name comprising said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, it results from the Complainant's non-contested evidence that the disputed domain name resolved to a website on which the Complainant's FILORGA goods were allegedly sold, and which did not accurately and prominently disclose the Respondent's relationship with the Complainant. Since this use is clearly commercial, it cannot be considered a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. Furthermore, such use cannot be qualified a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy and the *Oki Data* jurisprudence (e.g. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) as it is misleading and diverting consumers, making them erroneously believe that the Respondent is an authorized dealer, retailer, or re-seller of FILORGA products, and is authorized to promote sales of FILORGA products. This is reinforced by the following facts: (1) the Respondent did not add any note, information or disclaimer pointing out that it actually has no relationship with the Complainant; (2) the website was offering for sale third-party products in direct competition with the Complainant, and (3) the website is accessible under a domain name that comprises the Complainant's trademark entirely, see also [WIPO Overview 3.0](#), section 2.8.1: "Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Oki Data test', the following cumulative requirements will be applied in the specific conditions of a UDRP case: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark. The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

It is acknowledged that once the Panel finds that a *prima facie* case is made by the Complainant, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It results from the Complainant's documented allegations that the disputed domain name resolved to a website allegedly selling the Complainant's FILORGA goods and further reproducing without any authorization the Complainant's trademark and copyrighted products images. For the Panel, it is therefore evident that the Respondent knew the Complainant's mark. Consequently, and in the absence of any

evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant's registered trademark FILORGA followed by the term "store".

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain name (a domain name incorporating the Complainant's mark plus the addition of the term "store");
- (ii) the content of the website to which the disputed domain name directs, allegedly selling the Complainant's products and reproducing without any authorization the Complainant's trademark and copyrighted products images;
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name.

The Panel finds that the Complainant has therefore satisfied 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, <filorgastore.com>, be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: June 1, 2023