

## **ADMINISTRATIVE PANEL DECISION**

**Estée Lauder Inc., and Estée Lauder Cosmetics Ltd. v. Dang Xuan Hoa**  
**Case No. D2023-3307**

### **1. The Parties**

The Complainant is Estée Lauder Inc., United States of America (“Unites States”) and Estée Lauder Cosmetics Ltd., Canada, represented by Fross Zelnick Lehrman & Zissu, PC, United States.

The Respondent is Dang Xuan Hoa, Viet Nam.

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

The disputed domain name <esteelauderoofficial.com> is registered with Mat Bao Corporation (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2023. On August 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 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 (PRIVACY PROTECT, LLC,) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 8, 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 August 9, 2023.

The Center verified that the Complaint 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 August 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 31, 2023.

The Center appointed Fabrice Bircker as the sole panelist in this matter on September 8, 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 companies having initiated this procedure, Estée Lauder Inc. and Estée Lauder Cosmetics Ltd (hereinafter referred indistinctively as the “Complainant”), are part of the same group of companies, namely The Estée Lauder Companies Inc. The Complainant, Estée Lauder Inc. and Estée Lauder Cosmetics Ltd., is active in the field of the cosmetics industry. Its flagship brand is ESTEE LAUDER.

According to undisputed elements provided by the Complainant, the ESTEE LAUDER brand has been founded in 1946 and is since then continuously used to designate cosmetics, skin care, and fragrance products. These products are available for sale in over 135 countries, at over 22,000 retail locations around the world and in numerous merchant websites. During its most recent fiscal year, the Complainant and its parent company’s sales totaled more than USD 17.7 billion worldwide.

The Complainant’s activities are protected through trademarks registrations for ESTEE LAUDER (cf. section 6 below).

The Complainant’s on-line activities are notably conducted through the <esteelauder.com> domain name, which was registered on August 14, 1997. It resolves to a website presenting the Complainant’s activities and also offering its products for sale.

Very little is known about the Respondent, except that it is apparently located in Viet Nam, based on the information disclosed by the Registrar.

The disputed domain name was registered on May 31, 2023.

At the time of filing of the Complaint and drafting this decision, it does not resolve to any active website.

However, it results from the evidence submitted by the Complainant that the disputed domain name was previously used in connection with a website mimicking the Complainant’s one.

In particular, this website:

- was titled “ESTEE LAUDER”,
- purported to offer for sale beauty products under the ESTEE LAUDER trademark,
- displayed the postal address of the Complainant’s United States headquarters.

#### **5. Parties’ Contentions**

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

In substance, its main arguments can be summarized as follows.

First, the Complainant contends that it has strong rights in the ESTEE LAUDER trademark, which is globally very well known. Then it claims that the disputed domain name is confusingly similar to its ESTEE LAUDER

trademark, because it reproduces the latter, and the added elements do not prevent it from being recognizable.

Then, the Complainant argues that the Respondent has no rights or legitimate interests in respect with the disputed domain name notably because:

- the Complainant's rights on the ESTEE LAUDER trademark predate the registration of the disputed domain name,
- there exists no relationship between the Complainant and the Respondent that would give rise to any license, permission, or authorization by which the Respondent could own or use the disputed domain name,
- the disputed domain name itself reveals the lack of any rights or legitimacy as it identifies itself as being "official" whereas it is not used in connection with the official website of the Complainant or anyone authorized by the latter,
- there is no evidence to suggest that the Respondent has been or is commonly known by the disputed domain name,
- the Respondent's use of the disputed domain name in connection with a copycat website that falsely claimed to sell the Complainant's ESTEE LAUDER products fails to demonstrate a legitimate interest in said disputed domain name.

At last, the Complainant contends that the disputed domain name has been registered and is being used in bad faith notably because:

- the Respondent's bad faith can be found on the ground of the passive holding doctrine,
- the website that was previously available through the disputed domain name was copying the Complainant's copyrighted websites,
- any website that might appear at the disputed domain name or any emails sent from addresses associated with the latter will be assumed to be official communications from the Complainant, whereas this would not be the case,
- as the Complainant's ESTEE LAUDER trademark enjoys wide recognition, it is inconceivable that the Respondent was unaware of it when it registered the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, for obtaining the transfer of the disputed domain name, the Complainant must establish each of the following three elements:

- 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.

Besides, paragraph 15(a) of the Rules provides that "[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".

Paragraphs 10(b) and 10(d) of the Rules also provide that "[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case" and that "[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

Besides, the Respondent's failure to reply to the Complainant's contentions does not automatically result in a decision in favor of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.3).

Taking the foregoing provisions into consideration the Panel finds as follows.

#### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Complainant has provided a substantial extract of its trademarks portfolio, but without communicating certificates of registration or relevant extracts of official trademarks databases.

However, it is well established that the general powers of a panel as articulated *inter alia* in paragraphs 10 and 12 of the Rules include, among others, the possibility to undertake limited factual researches into matters of public record if the panel considers such information useful to assessing the case merits and reaching a decision. These limited factual researches notably include accessing trademark registration databases (see for instance, [WIPO Overview 3.0](#), section 4.8).

The Panel therefore performed such searches. It resulted from them that the Complainant is well the owner of the following trademarks registrations, among many others:

- ESTEE LAUDER, United States trademark registration No. 3217192, filed on October 6, 2005, registered on March 13, 2007, and designating products and services of classes 3 (with first use on November 2, 1946), 21 (with first use on January 1, 1965), and 35 (with first use on December 31, 1948),

- ESTEE LAUDER, European Union Trade mark registration No. 91090, filed on April 1, 1996, registered on December 1, 1998, and designating products and services of classes 3, 14, and 42,

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms [here, "official"] may bear on assessment of the second and third elements, the Panel finds the addition of such term do not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

#### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Indeed, the Complainant contends that it has not given its consent for the Respondent to use its ESTEE LAUDER trademark in a domain name registration or in any other manner.

In addition, there is nothing in the record of the case likely to indicate that the Respondent may be commonly known by the disputed domain name.

Besides, the disputed domain name is currently not used.

At last, before being deactivated, it resolved to a website mimicking the Complainant’s website. In particular, it purported offering for sale beauty products under the ESTEE LAUDER brand and was deceitfully presented as being operated by the Complainant in as far as the postal address of its United States headquarters was displayed.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent used the disputed domain name to resolve to an e-commerce website reproducing the prior and globally well-known ESTEE LAUDER trademark, mimicking the Complainant’s website, and deceitfully mentioning that it was run by the latter (which address of its United States headquarters was reproduced). Furthermore, the composition of the disputed domain name, in as far as it associates the Complainant’s brand with the term “official”, contributes to impersonate the Complainant or to suggests sponsorship or endorsement by the latter.

As a consequence, the Panel finds that the present case falls within the scope of paragraph 4(b)(iv) of the Policy, namely: “by using the disputed domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent’s] 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 [the Respondent’s] website or location or of a product or service on [the Respondent’s] website or location.”

In addition, the fact that the disputed domain name is currently inactive does not prevent a bad faith finding.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the record, the Panel notes, among others, i) the distinctiveness and the reputation of the Complainant's prior trademark, ii) the composition of the disputed domain name in as far as it associate the Complainant's trademark with the term "official", iii) its previous use in relation with a website mimicking the Complainant's one, and iv) the fact that emails server records are configured with the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name do not prevent a finding of bad faith under the Policy.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

## 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, <esteelauderofficial.com>, be transferred to the Complainant, namely, as requested by the Complainant, to Estée Lauder Inc.

*/Fabrice Bircker/*

**Fabrice Bircker**

Sole Panelist

Date: September 17, 2023