ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Clarins v. babacan gunduz
Case No. D2024-2146

1. The Parties

The Complainant is Clarins, France, represented by Tmark Conseils, France.

The Respondent is babacan gunduz, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <clarinsextra.com> is registered with Dynadot Inc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 24, 2024. On May 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 29, 2024, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 31, 2024, 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 June 3, 2024.

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 June 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 4, 2024.

The Center appointed Michal Havlík as the sole panelist in this matter on July 9, 2024. 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 well-established French cosmetics company founded in 1954. The Complainant holds numerous trademark registrations worldwide including the following:

- French trademark registration CLARINS No. 1637194 with registration date June 14, 1991, and covering cosmetics in class 03 and beauty care services in class 44,

- French trademark registration CLARINS EXTRA-FIRMING No. 4337954 with registration date June 9, 2017 and covering cosmetics in class 03,

- European trademark registration CLARINS No. 5394283 with registration date October 5, 2010 and covering cosmetics in class 03 and cosmetic and beauty care services in class 44,

- United States of America trademark registration CLARINS No. 73746658 with registration date January 2, 1990, and covering cosmetics and make-up goods in class 3.

The Complainant's registered company name is CLARINS and the Complainant uses domain name <clarins.com> registered since March 16th, 1997 that is being used internationally including in the USA. The Complainant also uses the domain name <clarinsusa.com> registered since November 11, 1997.

The Disputed Domain Name was registered on April 12, 2024. There is no active website on the Disputed Domain Name. Traffic from the Disputed Domain Name is redirected to a webpage offering the Disputed Domain Name for sale at USD 2,850.00 excl. VAT. There was no change in the webpage after filing of the Complaint.

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.

The Complainant cites its French, European and United States of America trademark registrations for word mark CLARINS as well as its French registered company name CLARINS and use of the domain names <clarins.com> and <clarinsusa.com>.

The Complainant contends that the Disputed Domain Name contains the CLARINS mark in its entirety as its initial part. According to the Complainant, the additional element "extra" is a general laudatory term therefore, not sufficient to exclude confusion with the Disputed Domain Name. It submits that as a result, the Disputed Domain Name is confusingly similar with the Complainant's trademarks.

The Complainant contends that the Respondent has prima facie no rights or legitimate interests in respect of the Disputed Domain Name. Furthermore, it holds that the Complainant's earlier rights predate the Disputed Domain Name by a long period. The Complainant contends that it never licensed or granted any authorization to the Respondent to use CLARINS mark. Given the redirection of the Disputed Domain Name to a website offering the Disputed Domain Name for sale, the Respondent is not making fair use of it.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was undertaken in bad faith. The Complainant contends that given the long-term and broad use of the Complainant's trademarks, the Respondent must have known about their existence when registering the Disputed Domain Name. In addition, the Complainant alleges that the offer for sale of domain name incorporating a well-known trademark for the sole purpose of selling, renting or transferring it at a high price is evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

(i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(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 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 entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.7.

Although the addition of other terms "extra" may bear on assessment of the second and third elements, the Panel finds the addition of such term does 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.

The Complainant has sufficiently demonstrated existence of its trademark rights in Europe and in numerous other jurisdictions. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. See *Thaigem Global Marketing Limited v. Sanchai Aree*, WIPO Case No. D2002-0358. The Disputed Domain Name incorporates the entirety of the Complainant's trademark CLARINS and adds the general word "extra" and generic Top-Level-Domain (gTLD) ".com". The additional word element is a common English word of laudatory or qualitative nature that is not capable of preventing confusing similarity of the Disputed Domain Name and the Complainant's trademark. See *F. Hoffmann-la Roche AG v. Popo*, WIPO Case No. D2008-0423; and WIPO Overview 3.0, section 1.8. gTLD is an obligatory part of the domain name and is to be disregarded in assessment of confusing similarity, see *Autodesk v. MumbaiDomains*, WIPO Case No. D2012-0286.

Accordingly, this Panel finds that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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.

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.

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.

The Panel notes that the Complainant's trademarks and company name, CLARINS, predate the Disputed Domain Name by several decades and have been intensively used in numerous jurisdictions including the European Union and United States of America. As a result of the long-term use, the Complainant's trademarks are distinctive and well-known for cosmetics. Therefore, the Respondent knew or should have known about the Complainant's trademarks prior to registering the Disputed Domain Name, see *F. Hoffmann-la Roche AG v. Popo*, WIPO Case No. D2008-0423.

The Disputed Domain Name has not been put to any use in connection with an active website other than it simply redirects to third party page offering the Disputed Domain Name for sale. Such use of a domain name does not prevent the finding of bad faith. Inactive or passive holding of a domain name that incorporates a registered trademark, without a legitimate purpose, does not prevent a finding of bad faith under paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; and *Jupiters Limited v. Aaron Hall*, WIPO Case No. D2000-0574.

The WIPO Overview 3.0, at section 3.3, describes the circumstances under which the passive holding of a domain name will be considered to be in bad faith: "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".

The registration of a domain name primarily for the purpose of selling it at a substantial profit relative to the out-of pocket expenses in an attempt to capitalize upon the complainant's reputation, goodwill and trademark rights constitutes bad faith. See *Clarins v. DOMAIN ADMINISTRATOR,* WIPO Case No. D2022-4191.

When taking into account all relevant facts and circumstances, the Panel notes that the Disputed Domain Name is confusingly similar to the Complainant's highly distinctive and well-known trademark, the Respondent has no legitimate rights or interests in the Disputed Domain Name and has failed to prove any evidence of actual or contemplated good-faith use and such use is practically implausible. The Panel finds that the Respondent has registered and used the Disputed Domain Name in bad faith primarily for the

purpose of selling or otherwise transferring the Disputed Domain Name to the Complainant who is the owner of the trademark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the Disputed Domain name.

The Panel finds that the Complainant has established the third element 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 <clarinsextra.com> be transferred to the Complainant.

/Michal Havlík/
Michal Havlík
Sole Panelist
Date: July 23, 2024