

ADMINISTRATIVE PANEL DECISION

Deciem Beauty Group Inc. v. Lisa Ann
Case No. D2024-4632

1. The Parties

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

The Respondent is Lisa Ann, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <theordinaryserum.shop> 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 11, 2024. On November 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 13, 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 November 14, 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 amendment to the Complaint on November 14, 2024.

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 November 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 10, 2024. The Respondent sent an email communication to the Center on November 27, 2024.

Pursuant to paragraph 6 of the Rules, on December 17, 2024, the Center informed the Parties that it would proceed with the panel appointment process

The Center appointed John Swinson as the sole panelist in this matter on December 20, 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 global skin care and beauty company based in Canada. The Complainant launched its business in 2013 and now sells more than 50 products in many countries around the world and has generated significant sales.

The Complainant sells products under several brands including THE ORDINARY. The Complainant sells THE ORDINARY products in a long list of countries, including the United Arab Emirates ("UAE"), Australia and Pakistan.

The Complainant owns more than 400 trademark registrations worldwide for or that contain THE ORDINARY. These include Australian trademark registration number 1794388 for THE ORDINARY in class 3, that was filed on September 5, 2016 and entered on the register on April 10, 2017; and UAE Registration Number 260223 for THE ORDINARY in class 3, registered on June 29, 2021.

The Complainant operates a website located at <theordinary.com>.

The disputed domain name was registered on September 26, 2024.

The Respondent did not file a formal Response, so little information is known about the Respondent. According to the Registrar's records, the Respondent has an address in "Nobby Beach, QLD" albeit in Pakistan. The website at the disputed domain name additionally gives an address at Sharjah Publishing City Free Zone (*SPC Free Zone*) in the UAE.

The website at the disputed domain name is titled "The Ordinary". The metatags for this website have the following title and description: "The Ordinary UAE: 50% Off Original Products & Best Low Prices in UAE!" and "Shop The Ordinary UAE store guaranteed original products at 50% off! Enjoy fast shipping, cash on delivery, easy free returns, and next-day delivery in Dubai. Discover radiant skin at the best low prices!"

This website lists many of what appear to be the Complainant's products for sale, with photographs of each product. The website appears to only enable shipping to an address within the UAE. At the bottom of the website is a copyright notice that currently states "© 2024 - The Ordinary Serum Powered by Shopify". In the checkout process, a message is displayed "Thank you for choosing The Ordinary Serum". The checkout process includes information that the trade name of the vendor is "The Ordinary UAE".

Prior to filing the Complaint, on October 22, 2024, the website at the disputed domain name included the following:

"We're not just launching another brand— we're driving a movement for transparency, affordability, and real results. Our journey started from frustration with overpriced skincare that over-promised and under-delivered. We wanted to change the game, making skincare a right, not a luxury. That's why we partnered with The Ordinary, a brand that values simplicity, transparency, and effectiveness. With proven, affordable formulas, we bring you skincare that actually works, without the hype."

Subsequently, on November 11, 2024, the website was changed to include the text “Launching Soon”.

At the present time, the above notices have been removed, and the website at the disputed domain name includes the following notices:

“We guarantee 100% original products sourced directly from authorized retailers. Every item is imported, verified, and checked for authenticity to ensure your safety and satisfaction. Trust us for genuine skincare and beauty products with sealed, quality-assured packaging.”

and

“Sourced from Authorized Retailers

We collaborate only with certified and trusted retailers. This ensures that every product is genuine and meets international quality standards.”

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.

Notably, the Complainant contends that the disputed domain name has been made to resolve to a website engaged in the wholesale and flagrant misappropriation of THE ORDINARY trademarks and copyrighted images such that consumers are destined to be confused or misled into believing that the website is operated by the Complainant, or is otherwise connected to it. The Respondent refers to itself as “The Ordinary UAE”, which it is not.

The Respondent’s website includes The Ordinary stylized trademark in the banner as well as various copyrighted images owned by the Complainant. As well, the Respondent refers to itself as a partner of the Complainant in the UAE, which is not the case.

The Complainant relies upon several prior decisions under the Policy, including *Deciem Beauty Group Inc. v. WhoisGuard Protected, WhoisGuard, Inc. / Malik Ali*, WIPO Case No. [D2020-1271](#).

B. Respondent

The Respondent did not file a formal reply to the Complainant’s contentions. Rather, the Respondent sent an email to the Center stating:

“We have carefully reviewed the concerns raised and taken immediate steps to address the issues outlined. Our team has ensured that all necessary corrections and adjustments have been made. We kindly request you to review the updates and inform us if everything has been resolved to your satisfaction.

To clarify, The Ordinary products we sell on our platform are sourced exclusively from trusted suppliers in Dubai, who import these products directly from authorized dealers. We are committed to maintaining the highest standards of authenticity and transparency in all our operations.”

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that:

“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the 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 a 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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances or acts which would, for the purposes of paragraph 4(a)(iii) above, be evidence of the registration and use of a domain name in bad faith. These are non-exclusive.

Similarly, paragraph 4(c) of the Policy sets out three illustrative circumstances which would demonstrate the Respondent's rights or legitimate interests in a domain name for the purpose of paragraph 4(a)(ii) of the Policy.

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.

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 in full within the disputed domain name with an additional term. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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. An assertion without evidence is not sufficient to *demonstrate* rights or legitimate interests.

At one time, the website at the disputed domain name included the statement that the Respondent had "partnered with The Ordinary" which is a false statement.

The Respondent does not satisfy the Oki Data test (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) because the Respondent did not accurately disclose the Respondent's relationship with the Complainant or include any disclaimers, as required by that test. On top of that, the composition of the disputed domain name gives the false impression that it is authorized or endorsed by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

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 Respondent is using the disputed domain name to sell and advertise products that appear to be the Complainant's products, although their authenticity is not clear. This strongly suggests that the Respondent was aware of the Complainant and the Complainant's trademark when the Respondent registered the disputed domain name.

The use being made of the disputed domain name cannot be characterized as a good faith use of the disputed domain name. The website at the disputed domain name prominently featured the Complainant's branding and products, and copyrighted images, with no disclaimer as to the Respondent's lack of relationship or affiliation with the Complainant. The website gives the impression of being a website that is operated by the Complainant.

The address provided by the Respondent when registering the disputed domain name, as evidenced by the Registrar's records, appears to be a false address. This address states that the city is "Nobby Beach, QLD" in the country of Pakistan. This is curious, because Nobby Beach is a well-known beach resort on the Gold Coast in Queensland, Australia; it is not in Pakistan. The Panel can draw the inference that the Respondent gave a false address because of its conduct in respect of the website at the disputed domain name.

The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark.

Based on the facts set out in the Complaint, which the Respondent does not rebut, the Panel finds that paragraph 4(b)(iv) of the Policy applies in the present case.

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 <theordinaryserum.shop> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: January 3, 2025