

## ADMINISTRATIVE PANEL DECISION

L'Oréal v. Li Ning  
Case No. D2024-4651

### 1. The Parties

1.1 The Complainant is L'Oréal, France, represented by Dreyfus & Associés, France.

1.2 The Respondent is Li Ning, United States of America ("United States") (although see the Panel's comments in this respect in the Procedural History section of this decision).

### 2. The Domain Name and Registrar

2.1 The disputed domain name <kiehlsessentials.shop> (the "Domain Name") is registered with Sav.com, LLC (the "Registrar").

### 3. Procedural History

3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 12, 2024. At that time, publicly available Whois details did not identify the registrant of the Domain Name.

3.2 On November 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 13, 2024, the Registrar transmitted by email to the Center its verification response. That response provided some contact details for the registrant, but so far as the registrant's name was concerned, it asserted "[t]he user did not fill in their name on the domain WHOIS contact." On November 15, 2024, the Registrar transmitted by email to the Center a further verification response in which it further stated in respect of the registrant's name:

"The owner or registrant did not respond to our email after 48 hours. However, their name when they first created their Sav account was Li Ning."

3.3 The Center sent an email to the Complainant on November 18, 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 November 19, 2024.

3.4 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”).

3.5 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 23, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 25, 2024.

3.6 The Center appointed Matthew S. Harris as the sole panelist in this matter on December 30, 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.

3.7 The Panel issued a procedural order in these proceedings on January 10, 2025 (“Procedural Order No. 1”) requiring the Complainant to submit a further submission in these proceedings, inter alia, (a) identifying the basis for the Complainant’s contention as to the reputation of the KIEHL’S trade mark, and (b) clarifying what was meant by contentions that the website operating from the Domain Name was “fake”; and (c) setting out the basis for the Complainant’s contentions that counterfeit goods were being sold on that website. The Complainant filed a further submission in this respect on January 16, 2025. Procedural Order No. 1 also permitted the Respondent to file a further submission in this respect, but no such submission was provided.

#### **4. Factual Background**

4.1 The Complainant, is a French industrial group specialised in the field of cosmetics and beauty. Created in 1909 by a French chemist by the same name, L’Oréal is today one of the world’s largest cosmetic groups. It has a portfolio of 36 brands, employs 86,000 employees, and is present in 150 countries.

4.2 One of the Complainant brands is “Kiehl’s”. The Kiehl’s business began in a New York pharmacy in 1851 and involves “highly-concentrated skin care” products made “from natural ingredients”. The business was purchased by the Complainant in 2000 and has 65 stores in the United States and 400 stores worldwide as of 2015, with over 1,000 points of sale supplemented by sales in department stores, select airport locations, as well as independent stockists.

4.3 The “Kiehl’s” brand also has a considerable social media presence with 3.8 million followers on Facebook France, 956,000 followers on Instagram, 193,300 followers on TikTok and 21,700 on YouTube. It has been featured on numerous occasions in various magazines and was ranked third by Vogue in October 2023 in the Vogue Business Beauty Index, where it was described “as one of the more established brands within the index”.

4.3 The Complainant is the owner of a number of trade marks around the world that comprise or incorporate the term “KIEHL’S”. They include:

(i) European Union registered trade mark no 1505767, with a filing date of February 14, 2000 and a registration date of March 23, 2001 for “KIEHL’S” as a word mark in classes 3, 41 and 42 and registered in the name of the Complainant; and

(ii) International trade mark no 752476 with a registration date of January 18, 2001, and which has proceeded to registration in at least 6 territories in class 3, and where the owner of this mark being the Complainant. This mark takes the following form:

The logo for Kiehl's, featuring the brand name in a stylized, cursive script font. The 'i' in 'Kiehl's' has a distinctive dot, and the 's' at the end is a simple, elegant flourish.

4.4 The Complainant's United States subsidiary has operated a website from the domain name <kiehls.com> to promote the activities of the Complainant's group of companies under the "Kiehl's" name. L'Oréal USA S/D, INC., which is a wholly-owned subsidiary of the Complainant, is also the owner of United States registered trade mark serial no 73832326 and registration no 1618321, for KIEHL'S as a standard character mark in class 3, with an application filing date of October 19, 1989 and a registration date of October 23, 1990.

4.5 The Domain Name was registered on July 17, 2024. Since that date the Domain Name has been used for a website that purports to sell "Kiehl's" branded products but at prices that are less than that at which the Complainant sells those products. Further, at least one of the products offered for sale under that brand is not one sold by the Complainant. The website also contains the notice "© Kiehl's Beauty Essentials".

4.6 Further, the contact email address provided by the Registrar in respect of the Domain Name, uses the domain name <nyxbeautyhub.shop>. That domain name was one of the domain names the subject of *La Roche-Posay Laboratoire Pharmaceutique and L'Oréal v. Details Not Provided by Registrant and mike simon*, WIPO Case No. [D2024-3406](#), in which the Complainant was one of the complainants. The same contact email address was also used as the contact email address in respect of the domain name <larocheposaybeautystore.shop>, that was another domain name the subject matter of the *La Roche-Posay Laboratoire Pharmaceutique* case *supra*. Both domain names were ordered in that case to be transferred.

4.7 On October 18, 2024 the Complainant requested the hosting company for the website operating from the website to deactivate the website and the Registrar to deactivate the Domain Name. Neither the hosting company nor the Registrar complied with these requests.

## 5. Parties' Contentions

### A. Complainant

5.1 The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

5.2 In this respect it contends that the Domain Name is virtually identical or at least confusingly similar to its trade marks.

5.3 The Complainant also contends that the Respondent must have known about the Complainant's mark when registering the Domain Name and that the website operating from the Domain Name has been used to offer for sale counterfeit products, relying in this respect upon the fact that the products are sold at a price below those offered by the Complainant and the sale of a product not offered for sale by the Complainant. The Complainant further contends that Internet users will believe that this is an official website of the Complainant when it is not. In any event, it claims that the website does not accurately disclose the relationship with the Complainant's trade mark contrary to the requirements set out in *Oki Data Americas, Inc. v. ASD, Inc* WIPO Case No. [D2001-0903](#).

5.4 On the issue of bad faith it, inter alia, also (a) relies upon the representation and warranty of non-infringement to be found in paragraph 2 of the Policy, which is said to impose a duty on the Respondent not to infringe the Complainant's rights, and (b) contends that the use made of the Domain Name falls within the scope of paragraph 4(b)(iv) of the Policy. Further, the Complainant relies upon the use of a privacy shield in relation to the Domain Name and the fact that the Respondent did not "fill in" its or his or her name when providing WHOIS contact details for the Domain Name.

### B. Respondent

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

6.1 It is generally 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 trade mark and the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

6.2 The Panel finds the Complainant has clearly shown rights in registered trade mark for the term KIEHL'S. [WIPO Overview 3.0](#), section 1.2.1.

6.3 The Panel also accepts that the Domain Name can only be sensibly understood as the term KIEHLS in combination with the word "essentials" and the ".shop" Top-Level Domain ("TLD"). Further, "Kiehls" closely corresponds to the Complainant's trade mark since apostrophes cannot be represented in domain names.

6.4 Accordingly, the entirety of the Complainant's mark is effectively reproduced in its entirety and is recognisable within the Domain Name and the Panel accepts that the Domain Name is confusingly similar to the Complainant's mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.9.

6.5 Although the addition of other terms (in this case "essentials") 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 Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

6.6 The Panel, therefore, finds the first element of the Policy has been established.

### B. Rights or Legitimate Interests

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

6.8 In the present case the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the 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 Domain Name.

6.9 However, dealing with the issue more directly, and for reasons that are set out in the context of its assessment of bad faith, the Panel is satisfied that the Domain Name was registered and held with knowledge of the Complainant's marks and business and with the intention that it would be used for a website that understood by Internet users as controlled or authorised by the Complainant, when it is not.

6.10 Further, again for the reasons set out in its assessment of bad faith, the Panel is satisfied on the balance of probabilities, that the website operating from the Domain Name has sold goods that are counterfeit in nature.

6.11 There is no right or legitimate interest in holding a domain name for such a purpose (see, for example, [WIPO Overview 3.0](#), section 2.5.1) or that is being used to deal in counterfeit products (see, for example, [WIPO Overview 3.0](#), section 2.13.1) and the Panel is of the view that such activity provides positive evidence that no rights or legitimate interests exists.

6.12 Further, and in any event, the Panel agrees with the Complainant's contention that in order to have a right or legitimate interest in the Domain Name that is being used to sell genuine products of the Complainant, the Respondent would need at least to satisfy the conditions commonly referred to as the "Oki

Data” requirements (as set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), and section 2.8.2 of the [WIPO Overview 3.0](#)) and that one of these requirements is that the domain name holder “must accurately and prominently disclose the registrant’s relationship with the trade mark holder”. The Panel is of the view that the degree of disclosure required includes full disclosure of the individual or commercial entity that is operating the relevant website. This the Respondent has failed to do.

6.13 In the circumstances, the Panel finds the second element of the Policy has been established.

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

6.14 The Panel is satisfied given the extent of the Complainant’s business and the way in which the Domain Name has been used, that the Domain Name was registered with the actual knowledge of the Complainant’s business and marks and with the intention of using the Domain Name for a website that was likely to be understood by Internet users as controlled or authorised by the Complainant, when it is not. There is no obvious indication on the website operating from the Domain Name that it is not authorised by the Complainant, and the addition of the word “essentials” used both in the Domain Name and on the website does not provide any such indication. The website also prominently displays the Kiehl’s mark at the top of the page (albeit in the form of device the design of which does not correspond to any mark relied upon in these proceedings). Accordingly, the use made of the Domain Name falls within the scope of the example of circumstances that constitutes evidence of bad faith set out in paragraph 4(b)(iv) of the Policy.

6.15 The Complainant also claims that the website operating from the Domain Name has been used to sell counterfeit goods under the Complainant’s trade mark. The registration and use of a domain name that incorporates such a trade mark for such a purpose clearly involves registration and use in bad faith (see section 2.13.2 of the [WIPO Overview 3.0](#)). However, a mere assertion in this respect is insufficient and it is incumbent upon a complainant advancing such a contention to at least explain why it is that the goods offered for sale are counterfeit (see sections 2.13.2 of the [WIPO Overview 3.0](#)). In the present case the Complainant contends that products have been sold on the relevant website at a price is less than that sold by the Complainant. The price differential alleged is relatively slight and there is no explanation of why that differential indicates that the goods themselves are not genuine. However, the Complainant also contends that one of the products sold by the Respondent is not actually offered for sale by the Complainant. Given this, the Panel is prepared to accept on the balance of probabilities absent argument or evidence to the contrary, that the Complainant’s contentions in this respect are correct.

6.16 The Panel is less convinced by the Complainant’s contentions that there has been use of a privacy shield and that this is another indicator of bad faith in this case. There is nothing before the Panel that suggests that the reason why the Respondent’s contact details were not initially publicly available, was anything other than as a consequence of the Registrar’s implementation of ICANN’s Temporary Specification for gTLD Registration Data and/or ICANN’s Registration Data Policy. However, the Panel does accept that the fact that when providing underlying registration details for the Domain Name to the Registrar, that the failure to give name registration details, is of a different character. This does suggest that the Registrant is trying to disguise its, his or her identity, and this does support a finding of bad faith registration and use.

6.17 Finally, the Panel accepts that the Complainant has provided evidence, in the form of use of a common email address, that the Respondent has previously been involved in at least one previous case under the UDRP, where the Respondent was found to have taken unfair advantage of rights in which the Complainant had an interest. This is yet another factor that supports a finding of bad faith registration and use in the present case.

6.18 In the circumstances, the Panel finds the third element of the Policy has been established.

6.19 In coming to this conclusion the Panel has not relied upon the Complainant’s argument based upon the text of paragraph 2 of the UDRP. The Panel is conscious that some panels have found such arguments to be persuasive, but paragraph 2 involves a registrant giving a warranty to a registrar, that is designed to provide the registrar with a degree of protection in respect of unlawful activity of any sort. To import this into

consideration of how elements of the Policy are to be understood, carries with it the risk of turning the Policy into a mechanism that would deal with general wrongdoing on the Internet that it was not designed to perform and it is ill-equipped to address. However, given the Panel's findings above, there is no need in this case to consider this issue further.

## **7. Decision**

7.1 For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <kiehlsessentials.shop> be transferred to the Complainant.

*/Matthew S. Harris/*

**Matthew S. Harris**

Sole Panelist

Date: January 23, 2025