

ADMINISTRATIVE PANEL DECISION

Obagi Holdings Company Limited v. Vi Hua
Case No. D2024-5344

1. The Parties

The Complainant is Obagi Holdings Company Limited, United Kingdom (“UK”), represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is Vi Hua, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <obagiretinol.site> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 30, 2024. On December 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 30, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 2, 2025, 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 January 5, 2025.

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 January 14, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 3, 2025. The Respondent did not submit a formal response, however on January 7, 2025, the Respondent sent an email communication to the Center. The Center notified the Commencement of Panel Appointment Process on February 5, 2025.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on February 13, 2025. 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 skincare company founded in 1988. One of its skincare lines is sold under the OBAGI trademark.

The Complainant is the owner of numerous OBAGI trademark registrations, including:

- the International Trademark Registration for OBAGI (figurative) No. 1495947A, registered on July 31, 2019;
- the Vietnamese Trademark Registration for OBAGI No. 4-0106470-000, registered on August 4, 2008; and
- the European Union Trademark Registration for OBAGI (word) No. 000164509, registered on July 10, 1998.

The Complainant is also the owner of the domain name <obagi.com>, which incorporates its OBAGI trademark.

The Domain Name was registered on October 22, 2024.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has not resolved to any active website.

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 Domain Name.

First, the Complainant contends that the Domain Name is confusingly similar to the trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant submits that the Domain Name was registered and is being used in bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions, however sent an email to the Center on January 7, 2025, indicating that it agrees to delete the Domain Name and that it no longer uses the Domain Name.

6. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met. At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid OBAGI trademark registrations. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark. See *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#).

The addition of the term “retinol” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the OBAGI trademark. Panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#).

The generic Top-Level Domain (“gTLD”) “.site” in the Domain Name is viewed as a standard registration requirement and as such is typically disregarded under the first element test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant’s OBAGI trademark for purposes of the Policy. In sum, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Under the second element, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

A right or legitimate interest in the Domain Name may be established, in accordance with paragraph 4(c) of the Policy, if the Panel finds any of the following circumstances:

- (i) that the Respondent has used or made preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services prior to the dispute; or

(ii) that the Respondent is commonly known by the Domain Name, even if the Respondent has not acquired any trademark rights; or

(iii) that the Respondent is making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence on record that the Complainant's OBAGI trademark registrations predate the Respondent's registration of the Domain Name. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the OBAGI trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a bona fide offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name. On the contrary, at the time of submitting the Complaint and as of the date of this Decision, the Domain Name has not resolved to any active website. In fact, it does not result from the case evidence that the Domain Name has been used in any active way to date.

The Panel finds that the composition of the disputed domain name incorporating the Complainant's trademark with the term "retinol" which refers to the Complainant's best-selling product, carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Given the above, there are no circumstances in the evidence on record which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests of the Respondent in respect of the Domain Name. Thus, there is no evidence in the case record that refutes the Complainant's prima facie case. In sum, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1 of the [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes, without limitation:

(i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or

(iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the OBAGI trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration. This finding is supported by the composition of the Domain Name consisting of the OBAGI trademark and the term directly correlated with the Complainant's business. Moreover, it has been proven to the Panel's satisfaction that the Complainant's OBAGI trademark is well-known and unique to the Complainant. Thus, the Respondent could not reasonably ignore the reputation of goods under this trademark. In sum, the Respondent, more likely than not, registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's OBAGI trademark.

Moreover, as of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has not resolved to any active website. Considering the overall circumstances of this case, the Panel finds that the Respondent's passive holding of the Domain Name does not prevent a finding of bad faith. As numerous UDRP panels have held, passive holding, under the totality of circumstances of the case, would not prevent a finding of bad faith under the Policy. See section 3.3 of the [WIPO Overview 3.0](#). Here, given the well-known nature of the Complainant's trademark and the implausible good faith use to which the Domain Name may be intrinsically put, the Panel agrees with the above.

Furthermore, as evidenced by the Complainant, the Domain Name has been configured with mail exchange ("MX") records to enable sending and receiving emails from the Domain Name, which further supports a finding of bad faith.

Finally, the Respondent's use of privacy services that concealed registrant information constitutes additional evidence of bad faith.

For the reasons discussed above, 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 Domain Name <obagiretinol.site> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: February 27, 2025