

ADMINISTRATIVE PANEL DECISION

OBAGI Holdings Company Limited v. NGUYEN KIM THOA
Case No. DPW2023-0002

1. The Parties

The Complainant is OBAGI Holdings Company Limited, Cayman Islands, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is NGUYEN KIM THOA, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <myphamobagichinhhang.pw> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 30, 2023. On July 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 4, 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 (Not disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 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 in English on July 11, 2023.

On July 8, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 11, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on July 14, 2023. In accordance with the

Rules, paragraph 5, the due date for Response was August 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 4, 2023.

The Center appointed Masato Dogauchi as the sole panelist in this matter on August 23, 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 Complainant is a global skincare products company with its registered office in Cayman Islands. The Complainant has since its foundation in 1988 developed and manufactured a portfolio of skin line products and has global media presence.

The Complainant has registered its OBAGI trademark in over 60 countries, including Vietnam, such as:

- International Registration for OBAGI No 1495947A, registered on July 31, 2019;
- International Registration for OBAGI MEDICAL No 1592492A, registered on March 29, 2021;
- Viet Nam Registration for OBAGI No 4-0106470-000, registered on August 4, 2008;
- Viet Nam Registration for OBAGI-C No 4-0039395-000, registered on December 25, 2001.

The disputed domain name <myphamobagichinhhang.pw> was registered on July 12, 2022 and resolves to an active website offering the OBAGI brand cosmetics in the Vietnamese language. On June 5, 2023, the Complainant sent a request for revealing of registrant's identity to the Registrar, which subsequently forwarded the Complainant's message to the Respondent. However, the Complainant has received no response from the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant's contentions are divided into three parts as follows:

First, the Complainant asserts that the disputed domain name is confusingly similar to its OBAGI trademark, since the disputed domain name incorporates the OBAGI trademark in its entirety. The other parts of the disputed domain name consist of the terms "my pham", "chinh hang" and ".pw". The term "obagi" is between the terms "my pham" and "chin hang". The term "my pham" should be understood to mean "cosmetic" or "beauty product" in Vietnamese and the term "chinh hang" should be understood to mean "authentic" or "genuine" in Vietnamese. These additional terms are closely related to the Complainant's business activity, and therefore they would not prevent finding the confusing similarity. And, the country code Top-Level Domain ("ccTLD") ".pw" should be disregarded under the identity test.

Second, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant confirms that the Respondent is not affiliated with the Complainant in any way and has not been authorized by the Complainant to use its OBAGI trademark or to seek registration of any domain name incorporating the trademark. To the best of the Complainant's knowledge, the Respondent has not been commonly known by the name "OBAGI" nor "MYPHAMOBAGICHINHANG". The fact that the disputed domain name resolves to an active website offering the Complainant's products shows that the Respondent is not doing a *bona fide* offering of goods or services by using the disputed domain name. Finally, the Complainant contends that the assertion of the Complainant should be admitted, since the Respondent has not submitted any evidence demonstrating rights or legitimate interests in the disputed domain name.

Third, the Complainant asserts that the disputed domain name has been registered and is being used in bad faith. The Complainant contends that the Complainant's trademark has been used globally for more than 35 years, it is implausible for the Respondent to have been unaware of the trademark. Therefore, the bad faith registration should be found in this case. With regard to the bad faith use, the Complainant contends that the fact that the disputed domain name resolves to an active website offering OBAGI brand cosmetics in the Vietnamese language at discounted prices should be deemed to show that the Respondent is trying to benefit from the fame of the Complainant's OBAGI trademark. It should be determined that the disputed domain name is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of Proceedings

In respect of the language to be used in the administrative proceeding, in accordance with the Rules, paragraph 11(a), the language of the administrative proceeding shall be, in principle, the language of the registration agreement. However, the same provision allows the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In the present case, the Registrar has confirmed that the language of the Registration Agreement is Japanese. However, the Panel determines that the language of this proceeding shall be English rather than Japanese on the following grounds:

- the Complainant requested to that effect;
- the Respondent surely has become aware of this case filed by the Complainant and did not reply to the notification in both English and Japanese by the Center that the Respondent was invited to indicate its objection, if any, to the Complainant's request for the language by the specified due date;
- the disputed domain name is not in Japanese script;
- the website resolving from the disputed domain name is written in Vietnamese language; and,
- the use of Japanese language would produce undue burden on the Complainant in consideration of the absence of a Response from the Respondent.

6.2. Substantive Matters

In accordance with the Rules, paragraph 15(a), a panel shall decide a case 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. Since the Respondent has not made any substantive arguments in this case, the following decision is rendered on the basis of the Complainant's contentions and other evidence submitted by the Complainant.

In accordance with the Policy, paragraph 4(a), in order to qualify for a remedy, the Complainant must prove each of the following:

- (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.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the OBAGI trademark.

The disputed domain name incorporates the OBAGI trademark in its entirety. The other parts of the disputed domain name consist of the terms “my pham”, “chinh hang” and “.pw”, and the term “obagi” is between the terms “my pham” and “chin hang”. Where the relevant trademark is recognizable within the disputed domain name, as in this case, 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). And incidentally, the ccTLD “.pw” is irrelevant in the determination of the confusing similarity between the disputed domain name and the OBAGI trademark.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights. The above requirement provided for in paragraph 4(a)(i) of the Policy is accordingly satisfied.

B. Rights or Legitimate Interests

The Panel finds that there is no evidence that shows the Respondent is commonly known by the name “obagi”, “myphamobagichinhhang” or any part of “myphamobagichinhhang”, and that the Respondent is not affiliated with the Complainant or authorized or licensed to use the Complainant’s OBAGI trademark. And it is determined that the use of the disputed domain name in this case, that is, offering the OBAGI brand cosmetics in the Vietnamese language at discounted prices without any consent of the Complainant constitutes neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use.

Since the Respondent did not reply to the Complainant’s contentions in this proceeding, the Panel finds on the available record that the Complainant has established an un rebutted *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

The above requirement provided for in paragraph 4(a)(ii) of the Policy is accordingly satisfied.

C. Registered and Used in Bad Faith

With regard to the requirement that the Respondent registered the disputed domain name in bad faith, since the Complainant is a globally known skincare products company, it is highly unlikely that the Respondent would not have known of the Complainant’s rights in the trademark at the time of registration of the disputed domain name. And, the way of use of the disputed domain name also points to the Respondent’s knowledge of the Complainant and its trademarks. Therefore, it is found that the Respondent registered the disputed domain name in bad faith.

On the other hand, with regard to the requirement that the Respondent is using the disputed domain name in bad faith, the fact that the disputed domain name resolves to a website offering the OBAGI brand cosmetics in the Vietnamese language at discounted prices without any consent of the Complainant is enough to show that the Respondent’s use of the disputed domain name is being done in bad faith.

Since the Respondent did not reply to the Complaint in this proceeding, the Panel finds that the disputed domain name has been registered in bad faith and is being used in bad faith. The above requirement provided for in paragraph 4(a)(iii) of the Policy is accordingly satisfied.

In conclusion, all three cumulative requirements as provided for in paragraph 4(a) of the Policy are determined to be satisfied.

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 <myphamobagichinhhang.pw> be transferred to the Complainant.

/Masato Dogauchi/

Masato Dogauchi

Sole Panelist

Date: September 6, 2023