



THE BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

CEPANI

THE BELGIAN CENTER FOR ARBITRATION AND MEDIATION

ARBITRATION N°444110 – CLARINS-ONLINE.BE

CLARINS, S.A.S.

VS.

MR. LEHCIM REVALK

DECISION OF THE THIRD-PARTY DECIDER

30 DECEMBER 2020

1. The parties

1.1 Complainant :

CLARINS, SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE,

with registered offices at 9 Rue du Commandant Pilot, 92200 Neuilly-sur-Seine, France

hereinafter referred to as "*the Complainant*"

Represented by

FRANÇOIS MOL, trademark attorney at Merkenbureau Knijff & Partners B.V.)

with registered offices at Leeuvenveldsweg 12, 1382 LX Weesp, The Netherlands

1.2 Domain name holder, Respondent :

Mr. LEIHCIM REVALK

Claude Debussylaan 34, 1082 MD Amsterdam, The Netherlands

hereinafter referred to as "*the Domain name holder*"

2. Domain name

Domain name: **CLARINS-ONLINE.BE**

Registered on: 31 January 2013

hereinafter referred to as "*the Contested domain name*".

3. Background of the case

The Complainant filed a complaint with CEPANI on November 23, 2020 in view of a decision of a Third-Party Decider, according to the CEPANI Rules for domain name dispute resolution ("the Rules") and the dispute resolution policy of DNS.be, incorporated in their general conditions ("the Policy").

The Complainant request that the Contested domain name be transferred in their favour.



The complaint was notified by CEPANI to the Domain name holder who was invited to submit a response. The domain name holder did not submit a response to the CEPANI.

Mr. Fernand de Visscher was appointed on December 15, 2020 by the CEPANI as the Third-Party Decider to settle the dispute pursuant to Article 7.2. of the CEPANI Rules for domain name dispute resolution.

The CEPANI also informed the Third-Party Decider that the deliberation would be closed by December 22, 2020 and that his decision has to be filed by January 5, 2021. Both the Complainant and the Domain name holder were informed of the aforementioned appointment and deadlines.

On December 22, 2020 pursuant to Article 13 of the CEPANI Rules for domain name dispute resolution, the deliberations were closed.

The Third-Party Decider's decision is issued in consideration of:

- the complaint dated November 23, 2020 and the annexed documents;
- the Rules of the Belgian Centre for Arbitration and Mediation for domain name dispute resolution (hereinafter "CEPANI Rules");
- the "Terms and conditions of domain name registrations under the ".be" domain operated by DNS", entitled "Dispute Resolution Policy" (hereinafter "the Policy").

4. Factual information : summary

4.1. The Complainant set out being one of the major actors in the field of cosmetics and make-up goods. The Complainant have been active in this field for more than 50 years and are well-known in this field. The Complainant are well-established worldwide.

4.2. The Domain name holder did not submit any response.

5. Position of the parties

5.1. Position of the Complainant

The Complainant argue in their complaint that the conditions of Art. 10.b.1 of the Policy are met since:

- the Contested domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company name, a geographical designation,

a name of origin, a designation of source, a personal name or geographical entity in which the Complainant has rights;

- the Domain name holder has no rights or legitimate interests in the Contested domain name; and
- the Contested domain name was registered or is being used in bad faith.

As a result, the Complainant request that the Contested domain name CLARINS-ONLINE.be be transferred to the Complainant.

5.2. Position of the Domain name holder

The domain name holder did not submit any response in the course of the proceedings.

6. Discussion and findings

6.1 Pursuant to Art. 10.b.1. of the Policy, the complainant has to assert and to prove that:

i) *“the registrant's domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the Complainant has rights; and*

ii) *the registrant has no rights or legitimate interests in the domain name; and*

iii) *the registrant's domain name has been registered or is being used in bad faith.”*

(i) “Is identical or confusingly similar to ...”

6.2.1. With reference to Article 10.b.1., i) of the Policy, the Complainant allege to be the owner of a portfolio of very similar or identical “CLARINS” trademarks to the Contested domain name CLARINS-ONLINE.be.

6.2.2. The Complainant are the owner of the European Union trademark registration No. 005394283 of the word mark **CLARINS** (filed on October 17, 2006 and registered on October 5, 2010 – annex 4 of the complaint). That trademark is registered to designate goods and services in classes 3, 5, 10, 16, 21 and 44.

The rights granted by a registered trademark date back to the date of application, that is, October 17, 2006. It is therefore a prior right to the Contested domain name which was registered on January 31, 2013., as well as to the transfer to the Domain name holder in 2018.

The Complainant also submit a French trademark registration for the word mark **CLARINS** (registration No. 1637194, filed on January 7, 1991– annex 4 of the complaint) and designating, amongst others, cosmetics in class 3 and beauty care services in class 44.

The rights granted by a registered trademark date back to the date of application, that is, January 7, 1991. It is therefore also a prior right to the registration and the transfer of the Contested domain name.

The Complainant also submits other trademark registrations resulting in exclusive rights prior to the registration of the Contested domain name.

6.2.3. The Complainant also allege to use the name **CLARINS** as registered company name (annex 5 of the complaint).

6.2.4. The country-code top-level domain “.be” has to be disregarded in verifying the identity or similarity between the earlier rights of the Complainant and the Contested domain name (see *inter alia* : CEPANI, 44292, “moneygram.be”).

The “CLARINS” trademark is wholly reproduced in the Contested domain name. It is the first element of the Contested domain name. This term has no semantic meaning and is not a generic term.

Various WIPO rulings support the view that when a trademark is included in its entirety in a domain name, it is sufficient to assume similarity. In fact, a domain name is to be considered as identical or confusingly similar to a trademark when the domain name includes the trademark, or a confusingly similar approximation thereof, regardless of other terms in the domain name (see *inter alia* : WIPO, D2020-2923, “loreal-europe.com”; WIPO, D2000-0662, “wal-martsucks.com”).

The element “-ONLINE”, added to the element “CLARINS” does not offset the similarity between the earlier rights “CLARINS” and the Contested domain name “CLARINS-ONLINE.be”. It does not provide additional specification or sufficient distinction from the trademarks or the company name ‘CLARINS’ but it is instead purely descriptive of the offering of goods and services on the internet (see *inter alia* WIPO, D2000-0404, “straumann-clone.com”; WIPO, D2004-0511, “dellcomputersclone.com”; WIPO, D2011-0203, “buyvogue.com”).

6.2.5. The Contested domain name is therefore similar to the above-mentioned Complainant’s relevant earlier rights.

The first requirement is therefore met.

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(ii) Rights and legitimate interests of the Domain name holder

6.3.1. According to Article 10.b.1., ii) of the Policy, the complainant has to prove that the domain name holder has no rights or legitimate interests in the contested domain name.

6.3.2. The Complainant submit that it is sufficient for them to show *prima facie* that the Domain name holder lacks rights or legitimate interests in the Contested domain name to shift the burden of proof to the Domain name holder.

The Complainant then state that the Domain name holder lacks rights and legitimates interests in the Contested domain name due to the existence of prior rights belonging to the Complainant, to the fact that the Domain name holder has no right or activity under the name "CLARINS", and to the fact that the Respondent had no authorization from the Complainant to use the protected name "CLARINS".

6.3.3. The Domain name holder did not submit any answers and thereby did not allege having any rights or legitimate interests in the Contested domain name.

6.3.4. Considering the difficulty of proving a negative fact ("*negativa non sunt probanda*"), the burden of proof that the domain name holder has no rights or legitimate interests to the litigious domain name is considered to be satisfied when, taking into account all the facts of the case, the complainant can credibly state that he is unaware of any reason or circumstance which could be indicative of such a right or legitimate interest (see *inter alia*: WIPO, D2001-1020, "pokemonplanet.com"; CEPANI, 44071, "hrs.be"; 44059, "brabant-wallon.be"; 44013, "smirnoff.be"; see also CEPANI, 4038, 4064, 4030, 4013, 44334, 44387 and 44419).

In that regard, the Complainant underline that they have been using the trademarks "CLARINS", the company name "CLARINS" as well as the domain name "CLARINS.com" for a long time and in numerous countries. The Complainant underline also that the term "CLARINS" enjoys a worldwide reputation in the cosmetic field and that they are active in all continents. Such use of the term "CLARINS" precedes the registration (and the transfer) of the Contested domain name.

Moreover the Complainant underline that the Domain name holder has no right or activity under the name "CLARINS", as opposed to the Complainant. Therefore, there appears to be no reason to incorporate such well-known mark, company name and domain name belonging to the Complainant in the Contested domain name.

Furthermore, the Complainant add that the Domain name holder has no authorization, under a license or otherwise, from the Complainant to use the protected name "CLARINS" as a domain name or as an element of a domain name or for any other kind of purpose, nor has the Domain name holder any kind of relationship with the Complainant.

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6.3.5. Taking into account the above, it is reasonable to determine that there are no reasons or circumstances that are indicative of any rights or legitimate interest in the Contested domain name by the Domain name holder.

Therefore, the burden to prove that there is a right or legitimate interest in the Contested domain name shifts to the Domain name holder. The Domain name holder has failed to demonstrate such right or legitimate interest. Therefore, the statements of the Complainant is deemed to be sufficient to determine the lack of rights and legitimate interests (see *inter alia*: CEPANI, 44068, “vueling.be”; 44056, “idealstandard.be”; WIPO, D2000-0270, “htmllease”; D2002-0503, “arroyocraftsman.com”).

6.3.6. It results from the above that the Domain name holder had no rights or legitimate interests in the Contested domain name.

The second requirement is therefore met.

(iii) Registered or used in bad faith

6.4.1. According to Article 10.b.1., iii) of the Policy, the complainant has to prove that the contested domain name has been registered or is being used in bad faith.

Article 10.b.2. of the Policy enunciates some circumstances allowing to demonstrate bad faith registration or use of a domain name.

6.4.2. The Complainant allege that the Contested domain name was registered but is also being used in bad faith.

The Complainant allege that the Domain name holder was aware of their prior rights and use. The Complainant indicate in particular that the trademark “CLARINS” was already used extensively and worldwide well before the date of registration of the domain name on January 31, 2013, and well before the date of the transfer of it to the Domain name holder on March 18, 2018. Moreover, the “CLARINS” trademarks are well-known worldwide and the domain name “clarins.com” is being used worldwide. The Complainant thus allege that the registration of the Contested domain name shows bad faith by taking advantage of the voluntary confusion created by the fraudulent registration.

The Complainant also allege that the Contested domain name is not converted to a website and is therefore not used but held passively, which constitutes bad faith.

6.4.3. The Domain name holder did not submit any response.

6.4.4. It should first be noted that the notion of bad faith is a broad notion and that in CEPANI case law, it is sufficient that the domain name has been registered in bad faith *or* is

being used in bad faith, these two criteria being non-cumulative (CEPANI, 44046, “zodiac.be”).

When there has been a transfer of the domain name, the moment to consider for assessing bad faith at the time of “registration” is the moment of the transfer of the domain name (CEPANI, 44046, “zodiac.be”), in this matter: March 18, 2018.

6.4.5. Case law also reiterated the principle that one may not deduce bad faith from the mere fact that a domain name holder does not file a response (CEPANI 4045, 4053, 44309, 44387 and 44419). However, although not being in itself a sufficient evidence for bad faith, the absence of a response, in combination with other elements, may nevertheless serve as a circumstantial evidence for establishing a domain name holder’s bad faith.

6.4.6. Bad faith can be proven by any reasonable means, including presumptions and circumstances that indicate, with a reasonable degree of certainty, that the domain name holder knew, or ought to know, the Complainant’s prior rights and nevertheless registered the domain name (see *inter alia* : CEPANI, 44068, “vueling.be”; CEPANI, 44067, “rembostyling.be”).

The list of circumstances demonstrating bad faith registration or use of a domain name under Art. 10.b.2., of the Policy is merely illustrative and should therefore not be regarded as closed (see *inter alia* : CEPANI, 44010, “redbulls.be”).

6.4.7. Bad faith is to be construed as the knowledge (proven as having been actual or having taken place with a reasonable certainty of evidence in the circumstances) by the Domain name holder that a third party (the Complainant) enjoyed a factual or legal situation previous to, and conflicting with, the litigious registration or use (CEPANI, 44436, “bollore-logistics.be”).

The Domain name holder could not reasonably ignore, on March 18, 2018, that the Complainant were at least using the term “CLARINS” as a company name and as a trademark. In fact, a simple research of the term on popular search engines directly refers to the website of the Complainant.

Moreover, the passive holding of a domain name may be regarded as use in bad faith of such domain name (see *inter alia* : WIPO, D2000-0003, “Telstra.org”; WIPO, D2005-0615, “chinavogue.com”). The Contested domain name is held passively by the Domain name holder.

In addition, as stated above, the Domain name holder has no activity under the name “CLARINS”.

6.4.8. Considering the above, there is no reasonable doubt that the Contested domain name was registered in bad faith and that the Domain name holder acquired (and is now using) the Contested domain name in bad faith, that is, with the knowledge of the prior use of the term “CLARINS” by the Complainant in the field of cosmetics.

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The third requirement is therefore met.

7. Decision

Consequently, the Third-Party Decider hereby:

- rules that the complaint is founded;
- orders the domain name "CLARINS-ONLINE.be" to be transferred from the Contested domain name holder to the Complainant pursuant to Art. 10.e of the Policy.

Brussels, 30 December 2020.



Fernand DE VISSCHER
Third-Party Decider

