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தமிழ்நாடு TAMILNADU

2130

Sridharan

8.5.2012

Y 140591

S. Mangalam

**S. MANGALAM**

STAMP VENDOR.

66 MURTHY STREET.

CHENNAI 600 033

LICENCE NO : 9942/89

PHONE No: 2371 0754

BEFORE THE INTERNET EXCHANGE OF INDIA  
ARBITRATION AWARD

ARBITRATOR: S SRIDHARAN

DATED 17th May 2012

Loreal

--- Complainant

-VS-

--- Respondent

Talk Shop

Sridharan



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<b>L'OREAL</b>	...	<b>Complainant</b>
	<b>Versus</b>	
<b>Jack Sun</b>	...	<b>Respondent</b>

**1. The Parties**

1.1 The complainant L'Oreal, is a French Company incorporated under French law as "société anonyme à conseil d'administration", having its registered at 14, Rue Royale, 75008, Paris, France represented by Nathalie DREYFUS of Dreyfus & Associates at 78 Avenue Raymond Poincaré, 75116 Paris, France.

1.2 Respondent is Mr. Jack Sun of Domainjet Inc at 1800 Amphitheatre Parkway, Mountain View, California-94043, United States of America.

**The Domain Name and Registrar**

1.3 The disputed domain name <lorealprofessionnel.in> is registered with Transecute Solutions Pvt Ltd (R120-AFIN).

**2. Procedural History**

2.1 On 22<sup>nd</sup> March 2012, NIXI asked me about my availability and consent to take up the Complaint for arbitration. On 23<sup>rd</sup> March 2012, I informed my

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availability and consent. I also informed NIXI that I had no conflict of interest with either of the parties and could act independently and impartially.

- 2.2 On 28<sup>th</sup> April 2012, I received hardcopy of the Complaint.
- 2.3 On 29<sup>th</sup> April, I issued by email a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. I also sent an email about my appointment to arbitrate the complaint to the Complainant and asked the Complainant to send a soft copy of the complaint to me.
- 2.4 On 30<sup>th</sup> April 2012, I received a soft copy of the Complaint.
- 2.5 Respondent has not filed any response to the Complaint.
- 2.6 Email is the medium of communication of this arbitration and each email is copied to all, Complainant, Respondent and NIXI.

### 3. Factual Background

#### A Complainant

- 3.1 The Complainant, L'Oréal is a French industrial group specialized in the field of cosmetics and beauty. Created in 1909 by a French chemist of the same name, the Complainant recently celebrated its centenary.
- 3.2 Complainant is one of the world's largest groups in the cosmetics business. Present in over 130 countries, Complainant creates and distributes products in all sectors of the beauty industry, such as hair color, styling aids, cosmetics, cleansers, and fragrances. Complainant markets professional products, consumer products, luxury products and active cosmetics.

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Complainant owns 23 international brands among which GARNIER, KERASTASE, MAYBELLINE, LANCOME and SHU UEMURA.

3.3 Complainant conducts its operations on a worldwide basis. North America is a particularly important market for Complainant. It is present in United-States since 1953. In 2010 North America accounted for 23.6% of group cosmetic sales which amounted to €4,291M in 2010.

3.4 Complainant also owns the brand L'OREAL PROFESSIONNEL which offers a complete line of premium in-salon products and services to hairstylists and their clients. In this connection, Complainant operates the website [www.lorealparis.com](http://www.lorealparis.com) which is entirely dedicated to the brand L'OREAL PROFESSIONNEL present throughout the world

3.5 Complainant owns numerous trademark registrations for L'OREAL throughout the world and inter alia in India and China.

(a) Indian Trademark Registration L'OREAL n° 165778, dated of September 14, 1954, duly renewed and covering goods in class 3;

(b) Indian Trademark Registration L'OREAL n°1832961, dated of July 25, 2009 and covering goods in class 18.

3.6 Complainant owns the following Indian Trademarks containing the terms "L'oreal professionnel":

(a) Indian Trademark Registration L'OREAL PROFESSIONNEL n°737030, dated of December 5, 1996 and covering goods in class 3;

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(b) Indian Trademark Registration L'OREAL PROFESSIONNEL n°737034, dated of December 5, 1996 and covering goods in class 21.

3.7 Complainant is also the owner of numerous trademarks in China and notably:

(a) Chinese Trademark Registration L'OREAL n°1487385, dated of November 8, 1999, duly renewed and covering services in class 42.

3.8 In addition, Complainants owns many domain names including the trademarks L'ORÉAL such as:

(a) <loreal.com>, registered on October 24, 1997

(b) <lorealjobs.com>, registered on January 18, 2008

(c) <lorealprofessionnel.com>, registered on January 9, 2001

(d) <lorealusa.com>, registered on February 6, 1999

(e) <loreal-finance.com>, registered on September 15, 1997

3.9 Complainant noticed the registration of the disputed domain name **<lorealprofessionnel.in>** since June 2010. Accordingly to the Whois History, the initial registrant of the disputed domain names was Bharat Domains Services Limited. Afterwards, this domain name has been transferred to Jack Sun of the company DomainJet, Inc, which is the actual Respondent.

3.10 The disputed domain name **<lorealprofessionnel.in>** resolves to a parking website displaying pay-per-click links related to products for hairs, creams and other cosmetic products. Many of these commercial links and tags

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contain the term "Loreal" and resolve to the websites of Complainant's competitors.

3.11 In recent INDRP decisions, Respondent was involved in similar proceedings under similar circumstances and the Arbitrators ruled in favor of the Complainants. (INDRP Dispute decision 165, <Lazard.co.in>, INDRP Dispute decision 167, <Lazard.in> and INDRP Dispute decision 181, <Manulife.in>).

3.12 Besides, Respondent was involved in 3 WIPO cases and a NAF case by which Respondent was obliged to transfer the disputed domain names to complainants.

3.13 These decisions of the most important of arbitral organizations clearly show Respondent's bad faith habit of infringing trademarks. Therefore, Complainant is forced to start the present procedure in order to obtain the transfer of the disputed domain name <lorealprofessionnel.in>.

#### **B Respondent**

3.14 The Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

#### **4. Parties Contentions**

##### **A Complainant**

4.1 The disputed domain name <lorealprofessionnel.in> is confusingly similar to the Complainant's trademarks.

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- 4.2 The predominant part of the disputed domain name is "lorealprofessionnel", which reproduces in entirety or in part the registered trademarks of Complainant. The presence of the suffix <.in> is not to be taken into account. It is well established in domain name cases that the suffix to indicate the top level of the domain name has to be disregarded for the purpose of determining whether the domain name is identical or confusingly similar to Complainant's trademark.
- 4.3 The disputed domain name <lorealprofessionnel.in> incorporate Complainants' trademark L'ORÉAL in its entirety. Previous Panels have found that when a domain name contains a trademark in its entirety, the domain name is identical or at least confusingly similar to the trademark. Previous UDRP decisions have recognized that Complainant's L'OREAL trademark is a famous mark
- 4.4 Besides, the name L'OREAL is also the corporate and trade name of Complainant. Finally, the disputed domain name is confusingly similar to Indian trademarks which include the term "L'Oreal Professionnel" and reproduces entirely Complainant's brand L'OREAL PROFESSIONNEL which has a worldwide presence.
- 4.5 For all the reasons above, it has been established that Complainant has rights to the L'OREAL trademark and that the disputed domain name is highly and confusingly similar to this trademark. The condition of paragraph 4(i) of the IN. Policy has therefore been fulfilled.

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- 4.6 Respondent does not have prior rights or legitimate interests in the L'OREAL trademark. Where Complainant's rights in a trademark predate Respondent's registration of the disputed domain name incorporating that trademark, Respondent does not have rights or legitimate interests in the disputed domain name.
- 4.7 Respondent is in no way affiliated with Complainant. Complainant has not authorized or licensed Respondent to use and register the L'OREAL trademark, nor sought registration of any domain name incorporating its trademark.
- 4.8 Although Respondent is the current owner of the disputed domain name <lorealprofessionnel.in>, the simple use of the L'OREAL trademark in the disputed domain name does not confer rights or legitimate interests to Respondent.
- 4.9 Furthermore, Respondent has never provided evidence of being known or recognized by the disputed domain name <lorealprofessionnel.in>. Previous Panels have concluded that where Respondent has not provided evidence that it is known or recognized by the domain name, Respondent has no rights or legitimate interests in the domain name.
- 4.10 Additionally, Complainant has registered and used various domain names consisting in its mark and trade name L'OREAL before Respondent registered the disputed domain name. Consequently, there can be no right or legitimate interest on Respondent's side.

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4.11 The disputed domain name **<lorealprofessionnel.in>** currently resolves to a parking page displaying pay-per-click links which is not use or demonstrable preparations to use the disputed domain name **<lorealprofessionnel.in>** in connection with a bona fide offering of goods and services.

4.12 For the aforementioned reasons, Respondent has no rights or legitimate interests in respect of the disputed domain name **<lorealprofessionnel.in>** under paragraph 4(ii) of the Policy. Since Complainant has established a prima facie case of Respondent's lack of rights or legitimate interests in the domain name, Respondent has now the burden to prove his rights or legitimate interests in the disputed domain name **<lorealprofessionnel.in>**.

4.13 As indicated earlier, Complainant is present on a global scale. Its activities are particularly important in India and in China where Respondent is located. Further, the well-known character of Complainant's mark L'OREAL has been underlined by several WIPO Panels. It is unlikely that Respondent was unaware of Complainant's existence of trademark rights before registering the disputed domain name **<lorealprofessionnel.in>**.

4.14 It has been held that the registration of a domain name containing a well-known mark is strong evidence of bad faith.

4.15 Because of the distinctiveness of Complainant's trademark, it is reasonable to infer that Respondent registered the disputed domain name **<lorealprofessionnel.in>** with full knowledge of Complainant's trademark. Where a domain name is found to be registered with an intention to attract

Internet users by exploiting the fame of a well-known trademark, it constitutes bad faith registration.

4.16 Even if Respondent was unaware of Complainant, which is unlikely in the present case, a quick trademark search or online search on Google using the keywords "loreal professionnel" would have shown the existence of Complainant and its trademark rights. According to the Policy paragraph 3, it was Respondent's responsibility to conduct a trademark search before registering the disputed domain name <lorealprofessionnel.in>. Respondent's failure to conduct this search is evidence of registration in bad faith.

4.17 Additionally, it seems that Respondent has engaged in a pattern of conduct of registering domain names under false postal address. As claimed by Complainant in *Lazard Strategic Coordination Company LLC & Lazard India Private Limited v. Jack Sun*, Case No. INDRP/167, November 30, 2010, the postal address of DomainJet corresponds to Google's postal address while there appears to be no connection between these two entities. According to information provided by Google, Respondent's address was indeed the same as Google. Since this decision, Respondent has just slightly changed the street number from 1600 to 1800.

4.18 Further, Respondent has engaged in a pattern of conduct of registering domain names consisting in trademarks belonging to third parties and thus preventing them to reflecting their trademark in corresponding domain

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names which is an evidence of bad faith pursuant to article 6 (ii) of the Policy.

4.19 Respondent has been involved in several INDRP proceedings, as well as in UDRP proceedings. According to these decisions, it appears that Respondent also pretends to be localized in China.

4.20 Respondent has registered this domain name to capitalize on Complainant's long history, reputation and goodwill. It is thus established that Respondent registered the domain name in bad faith.

4.21 Several elements can be put forward to support the finding that Respondent also uses the disputed domain name **<lorealprofessionnel.in>** in bad faith. The disputed domain name **<lorealprofessionnel.in>** resolves to a parking webpages displaying pay-per-click links related to Complainant's competitors and notably named "Loreal Haircolor", "Loreal Tints" etc. Respondent is taking undue advantage of Complainant's trademark to generate profits. The use of a famous trademark to attract Internet users to a website for commercial gains constitutes use in bad faith pursuant to the Policy, paragraph 6.

4.22 Respondent has engaged in a pattern of conduct of abusive domain name registration and is involved in several cases of cybersquatting. In view of the above it is established that the disputed domain name **<lorealprofessionnel.in>** is also being used in bad faith. Consequently, it is established that Respondent both, registered and used the disputed

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domain name <lorealprofessionnel.in> in bad faith in accordance with Paragraph 4 (iii) and Paragraph 6 of the Policy.

**B. Respondent**

4.23 Respondent has not filed any reply to the Complainant's Complaint in this arbitration.

**5. Discussion and Findings**

5.1 Respondent has not filed his response. I have not received any communication from him until the date of this award. Therefore, I am proceeding to determine this Complaint on the basis of the materials available on record.

5.2 The Complainant in order to succeed in the Complaint must establish under Paragraph 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

- (I) Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (II) Respondent has no rights or legitimate interests in respect of the domain name; and
- (III) Respondent's domain name has been registered or is being used in bad faith.

5.3 Each of the aforesaid three elements must be proved by a Complainant to warrant relief.

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***Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.***

5.4 The Complainant is the proprietor of the mark L'Oreal. Complainant has been using L'Oreal mark internationally continuously since 1953. The Complainant's L'Oreal products are available in India. Complainant owns numerous trademark registrations for L'OREAL throughout the world. The first registration in India under No.165778 dates back to 14.09.1954. The Complainant also owns the trade mark L'Oreal Professionnel and the first Indian registration under No.737030 dates back to 5.12.1996. The Complainant registered [www.loreal.com](http://www.loreal.com) on 24.10.1997 and [www.lorealprofessionnel.com](http://www.lorealprofessionnel.com) on 9.1.2001. The disputed domain name **<[lorealprofessionnel.in](http://lorealprofessionnel.in)>** was registered on 13.06.2010. Obviously, the Complainant is the prior adopter and registrant of Loreal marks. The above facts have established that the Complainant has both common law and statutory rights in respect of its Loreal marks.

5.5 The predominant and distinctive part of the disputed domain name **<[lorealprofessionnel.in](http://lorealprofessionnel.in)>** is L'Oreal. The Complainant's Loreal marks are famous and well known throughout the world including India. It is clearly seen that the disputed domain name **<[lorealprofessionnel.in](http://lorealprofessionnel.in)>** wholly incorporates the prior registered Loreal marks, i.e. L'Oreal and Lorealprofessionnel of the Complainant. The disputed domain name **<[lorealprofessionnel.in](http://lorealprofessionnel.in)>** is similar to the Complainant's domain names [www.loreal.com](http://www.loreal.com) and [www.lorealprofessionnel.com](http://www.lorealprofessionnel.com).

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5.6 I, therefore, find that:

- (a) The Complaint has both common law and statutory rights in respect of its Loreal marks.
- (b) The disputed domain name <lorealprofessionnel.in> is:
  - (i) Identical to the Complainant's prior registered trademarks Lorealprofessionnel and similar to L'Oreal, and
  - (ii) Similar to the Complainant's domain names www.loreal.com and www.lorealprofessionnel.com

***Respondent has no rights or legitimate interests in respect of the disputed domain name***

5.7 It is already seen that:

- (a) The Complainant is the prior adopter and user of the Loreal marks. The Complainant's Loreal marks are well known in many countries across the globe including India.
- (b) The Complainant's Loreal mark was adopted in the year 1953. It was registered in India in 1954. Lorealprofessional was registered in India in 1996. The disputed domain name <lorealprofessionnel.in> was registered by the Respondent only on 13.06.2010.

5.8 Respondent did not register the disputed domain name <lorealprofessionnel.in> until 2010. Complainant has registered and used various domain names consisting in its mark and trade name L'OREAL before Respondent registered the disputed domain name. It is

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unlikely that the Respondent was unaware of Complainant's existence of trademark rights before registering the disputed domain name <lorealprofessionnel.in>.

5.9 I visited the web site of the Respondent under the disputed domain name <lorealprofessionnel.in>. The disputed domain name <lorealprofessionnel.in> resolved to a web page providing links to web sites of the competitors of the Complainant. At the top left, there is tab "Inquire about this domain name". A click on the tab led to a link to make offer. The visitor was asked to enter the sum offered by him to purchase the disputed domain name <lorealprofessionnel.in>. It is obvious that the Respondent never intended to use the disputed domain name <lorealprofessionnel.in> in connection with a bona fide offering of goods or services.

5.10 In the absence of response from the Respondent, I accept the argument of the Complainant that:

- (a) Respondent is in no way affiliated with Complainant. Complainant has not authorized or licensed Respondent to use and register the L'OREAL trademark, nor sought registration of any domain name incorporating its trademark.
- (b) Although Respondent is the current owner of the disputed domain name <lorealprofessionnel.in>, the simple use of the L'OREAL trademark in the disputed domain name does not confer rights or legitimate interests to Respondent.





(c) Respondent has never provided evidence of being known or recognized by the disputed domain name <lorealprofessionnel.in>. Where Respondent has not provided evidence that it is known or recognized by the domain name, Respondent has no rights or legitimate interests in the domain name.

5.11 Therefore, I have no hesitation to hold, for the above reasons that the Respondent has no right or legitimate interest in respect of the disputed domain name <lorealprofessionnel.in>.

***Respondent's domain name has been registered or is being used in bad faith.***

5.12 The Complainant is the proprietor of the mark L'Oreal. Complainant has been using L'Oreal mark internationally continuously since 1953. The Complainant's L'Oreal products are available in India. Complainant owns numerous trademark registrations for L'OREAL throughout the world. The first registration in India under No.165778 dates back to 14.09.1954. The Complainant also owns the trade mark L'Oreal Professionnel and the first Indian registration under No.737030 dates back to 5.12.1996. The Complainant registered www.loreal.com on 24.10.1997 and www.lorealprofessionnel.com on 9.1.2001. The disputed domain name <lorealprofessionnel.in> was registered on 13.06.2010. Obviously, Complainant's rights in the Loreal marks pre-date Respondent's registration of the disputed domain name <lorealprofessionnel.in>. The Respondent could not have ignored, rather actually influenced by, the

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well-known Loreal marks of the Complainant at the time he acquired the disputed domain name <lorealprofessionnel.in>.

- 5.13 As seen above, Respondent is currently holding the disputed domain name <lorealprofessionnel.in> primarily for sale and gives links to other web sites offered by third parties and not for any other purpose. The Respondent is no way connected with the Complainant. Respondent's adoption of the disputed domain name <lorealprofessionnel.in> is nothing but an unjust exploitation of the well-known reputation of the Complainant's prior registered Loreal marks.
- 5.14 Respondent's lack of response to the Complaint indicates that the Respondent has no reason and/or justification for the adoption of the Complainant's Loreal marks.
- 5.15 Respondent registered the disputed domain name <lorealprofessionnel.in> with full knowledge of Complainant's trademark. Where a domain name is found to be registered with an intention to attract Internet users by exploiting the fame of a well-known trademark, it constitutes bad faith registration.
- 5.16 Even if Respondent was unaware of Complainant, which is unlikely in the present case, a quick trademark search or online search on Google using the keywords "loreal professionnel" would have shown the existence of Complainant and its trademark rights. Respondent's failure to conduct this search is evidence of registration in bad faith.

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- 5.17 Respondent has engaged in a pattern of conduct of registering domain names under false postal address. As claimed by Complainant in *Lazard Strategic Coordination Company LLC & Lazard India Private Limited v. Jack Sun*, Case No. INDRP/167, November 30, 2010, the postal address of DomainJet corresponds to Google's postal address while there appears to be no connection between these two entities. According to information provided by Google, Respondent's address was indeed the same as Google. Since this decision, Respondent has just slightly changed the street number from 1600 to 1800.
- 5.18 Respondent has been involved in several INDRP proceedings, as well as in UDRP proceedings.
- 5.19 Respondent has registered the disputed domain name **<lorealprofessionnel.in>** to capitalize on Complainant's long history, reputation and goodwill.
- 5.20 The reservation of the disputed domain name **<lorealprofessionnel.in>** is prejudicial to Complainant by creating a likelihood of confusion with Complainant's trademark and trade name. Besides, the reservation of the disputed domain name **<lorealprofessionnel.in>** prevents Complainant to communicate in India and to Indian customers via Internet using an extension corresponding to their country of origin and using domain name with a cctld extension and a specific website dedicated to the Complainant's presence and offering of goods in India.

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5.21 Thus it is clearly established that Respondent registered the disputed the disputed domain name <lorealprofessionnel.in> in bad faith.

5.22 The actions of the Respondent should not be encouraged and should not be allowed to continue. Respondent never intended to put the disputed domain name <lorealprofessionnel.in> into any fair/useful purpose. Respondent not even considered it worth responding the complaint of the Complainant. Respondent did not file any response. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

**6. Decision**

6.1 For all the foregoing reasons, the Complaint is allowed as prayed for in the Complaint.

6.2 It is hereby ordered that the disputed domain name <lorealprofessionnel.in> be transferred to the Complainant.

6.3 Respondent is ordered to pay the Complainant a sum of Rs.3,00,000/- (Rupees three lakhs only) towards costs of the proceedings.



**S.Sridharan**  
Arbitrator