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R 416555

BEFORE THE SOLE ARBITRATOR UNDER THE
.IN DISPUTE RESOLUTION POLICY

IN THE MATTER OF

L'OREAL

14, rue royale

75008 PARIS (FR)

France

(Complainant)

-v-

Corporate Domains

Rimi Sen

76 Ninth Avenue

10011 New York

US, +1.8003569377

domain@india.com

(Respondent)

THE PARTIES

The Complainant **L'OREAL** is a French corporation and is represented in this proceeding by **NAMESHIELD (Laurent Becker)** of France.

The Complainant's authorized representative in this administrative proceeding is:

NAMESHIELD, 27 rue des arenes 49100 Angers France, Telephone: +33 2 41 18 28 28 /
Fax:+33 2 41 18 28 29.

The Respondent in this proceeding is Corporate Domains (Rimi Sen) *for the domain name* <**SHUUEMURA.IN**> (According to the whois).

All information known to the Complainant regarding how to contact the Respondent is as follows:

Corporate Domains

Rimi Sen

76 Ninth Avenue

10011 New York

US, +1.8003569377

domain@india.com

THE DOMAIN NAME, REGISTRAR AND REGISTRANT

The disputed domain name is < **SHUUEMURA.IN**>.

The Registrar for the disputed domain name is **Directi Web Services Pvt. Ltd.**, Directiplex. Mogra Village Nagardas Road, Andheri (East) Mumbai Maharashtra 400069, India.

The Registrant is Corporate Domains (Rimi Sen), 76 Ninth Avenue, 10011 New York, US.

PROCEDURAL HISTORY:

I was appointed as the Arbitrator by .IN Registry, to adjudicate upon the complaint of the Complainant, regarding the dispute over the domain name **SHUUEMURA.IN**.

.In Registry has supplied the copy of the Complaint and Annexures to me.

On 30.08.2011, I sent an email to the parties informing them about my appointment as an Arbitrator.



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Thereafter on 30.08.2011, itself 1 sent an email to Complainant requesting them to supply the copy of the complaint with annexure to the Respondent and in case if they have already served it, then to provide me with the details of service record.

In accordance with INDRP read with INDRP Rules of Procedure, notice of arbitration was sent to the Respondent on 30.08.2011 with the instructions to file his say latest within 15 days.

On 30.08.2011, I received an email from the Counsels/Representative of the Complainant, sending the copy of the Complaint to me.

Thereafter, on 05.09.2011, it was directed to the Counsels/Representative of the Complainant to provide details of the service record of serving of Complaint upon the Respondent via an email and post as well by 06.09.2011.

On 05.09.2011, I received an email from the Counsels/Representative of the Complainant, informing about the details of the service of the copy of Complaint to the respondent. According to this mail copy of the complaint was duly sent to the email address of the Respondent.

On 07.09.2011, in the interest of justice the Counsels/Representative of the Complainant or the Complainant itself was directed to serve the copy of the complaint to the Respondent via post also and supply the proof for the same by 09.09.2011.

Thereafter in the interest of justice and fairness, on 11.03.2011, a reminder was sent to the Counsel of the Complainant to submit the proof of serving of copy of complaint to the Respondent via an email.

On 07.09.2011 and 09.09.2011, I received two emails respectively from the Counsels/Representative of the Complainant, informing about the details of the service of the copy of Complaint to the Complainant via post also which was duly sent to the postal address of the Respondent.

On 12.09.2011, the Respondent was directed by the Tribunal to respond or communicate any address within 15 days, latest by 24.09.2011, else the Tribunal shall pass an ex parte decision against the Respondent considering the present facts and circumstances of the matter.

The Respondent failed / neglected to file his say / reply to the Complaint of the Complainant within the stipulated time. Similarly he has not communicated anything on the Complaint till the date of this award and as such the proceedings were conducted.



I feel that enough opportunity has been given to the Respondent and genuine efforts have been made to make him a part of the proceedings. Since he has failed to join the proceedings, or to file any response the present ex parte award is passed.

That I have perused the record and Annexures / documents.

FACTUAL BACKGROUND:

The Complainant has raised, *inter-alia*, following important objections to registration of disputed domain name in the name of the Respondent and contended as follows in his Complaint: -

The Complainant in the proceedings is L'Oreal, which has a famous brand.

The brand SHUUEMURA is developing its international activity in three areas: makeup, skin care and accessories business.

The Complainant is a registered proprietor of various trademarks with the term "SHUUEMURA" in various countries including India since 1986, a list of which is provided by the Complainant.

The brand is best known in numerous countries in Asia.

Its flagship products: Shu Uemura Cleansing Oil, Makeup UV Underbase Mousse, Mascara Eye Lash Curler, facial lines Depsea Water, LIFO and Beta-Glucan Therapy.

L'Oreal owns and communicates on the Internet through various websites in the worldwide. The main one is "www.shuueamura.com" (registered on 22/03/2003), and L'Oreal has also registered numerous domain names similar to trademark "SHUUEMURA", a list of which is provided by the Complainant.

The Respondent's domain name "shuueamura.in" was registered on 12/03/2011 by Corporate Domains, which is identical to the said mark "SHUUEMURA" and domain name "SHUUEMURA.COM" in which the Complainant has rights on account of prior registrations and use all over the world.

Hence the present complaint is made.

PARTIES CONTENTIONS:

Complainant

The Complainant contends as follows:



The Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has the rights.

The Respondent has no rights and legitimate interest in respect of the domain name.

The Respondent has registered and is using his domain name in bad faith.

Respondent

The Respondent has not filed any response and submissions to the complaint despite being given an adequate notification and several opportunities by the Arbitrator.

DISCUSSIONS AND FINDINGS:

As earlier pointed out; the Respondent has failed to file any reply to the Complaint and has not rebutted the submissions put forth by the Complainant, and the evidence filed by him.

Rule 8 (b) of the INDRP Rules of Procedure provides that *"In all cases, the Arbitrator shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case"*.

As mentioned above fair opportunity has been given to the Respondent to file the reply but no response has been received from his side. Therefore, the Arbitration proceedings have been conducted ex parte.

Rule 12 (a) of the INDRP Rules of Procedure provided that *"An Arbitrator shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Arbitration and Conciliation Act, 1996, Dispute Resolution Policy, the Rules of Procedure and any bye-laws, rules and guidelines framed there under, and any law that the Arbitrator deems to be applicable"*

In the present circumstances, the decision of the Arbitrator is based upon the Complainant contentions and evidence and conclusion drawn from the Respondent's failure to reply.

Having perused and the submissions and documentary evidence placed on record, the Arbitrator is convinced that the Complainant has proved that he has statutory and common law rights in the mark "SHU UEMURA".

Further, the Arbitrator is of the view that the Complainant has satisfied all the three conditions outlined in the paragraph 4 of .IN Domain Name Dispute Resolution Policy, viz.



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

BASIS OF FINDINGS:

The Domain Name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights:

The Complainant contends in the complaint that the domain name of the respondent i.e. < SHUUEMURA.IN > is identical and confusingly similar to SHU UEMURA, its trademark and its domain names associated like < shuueamura.com>.

It is further stated that the complainant is the registered proprietor of the "SHU UEMURA" trademark in numerous countries in the world including INDIA and has gained significant reputation and its mark can be termed as a well known brand. The complainant is also the registrant and proprietor of various Domain name registration at International and domestic level.

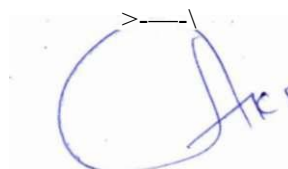
The Complainant contends the addition of a CTLD ".IN" is not sufficient to escape the finding that the domain is confusingly similar to the trademarks and does not change the overall impression of the designation as being connected to a trademark of L'OREAL.

The Complainant further contends that the term "SHU UEMURA" is known especially in relation to the L'OREAL and it has no meaning whatsoever in English or in any other language.

The Tribunal notes that the Respondent's domain name is created by mere addition of cCTLD ".in" in the end. Such is not sufficient to make the domain name distinct and hence the disputed domain name is confusingly similar to the Complainant's Trademark.

The Tribunal also gets support to the finding from the following cases:

1. Leso juris A/S v. Robin Martin, INDRP/118 (February 14, 2010), it was held that the addition of country code ("CTLD") in the domain name is not sufficient to distinguish from the mark and does not change the overall impression of the designation as being connected to a trademark of the Complainant.



Thus the conclusion is that the domain name of the Respondent is identical and confusingly similar to the Trademark of the Complainant as the above submissions of the Complainant have not been rebutted by Respondent, as such they are deemed to be admitted by him.

Even otherwise the above facts and annexures establish that the domain name of the Respondent is confusingly similar and identical to the mark of the Complainant.

The Registrant has no rights or legitimate interests in the respect of the domain name

It is clear that once a Complainant makes a prima facie case, then the burden shifts to the Respondent to provide evidences to establish rights or legitimate interests in the disputed domain name, which was held in the award of Croatia Airlines d.d. v. Modern Empire Internet Ltd WIPO case No. D2003-0455.

The Tribunal determines that the Complainant has made positive assertions and concrete evidences making a prima facie case showing that the Respondent does not possess rights or legitimate interests in the subject domain name. Hence, the burden shifts on the Respondent to prove that it has rights or legitimate interests in the subject domain name. Whereas the Respondent has not discharged the onus positively, which had shifted upon him as the Respondent has not responded to any of the allegations raised by the Complainant in its Complaint.

According to the paragraph 7 of the .IN Dispute Resolution Policy, the following circumstances show Registrants rights or legitimate interest in the domain for the purpose of paragraph 4(ii)

- i) *before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable 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;*
- ii) *the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or*
- iii) *the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.*



- a.' While considering paragraph 7 (i) of the .IN Dispute Resolution Policy, "*before any notice to the Registrant of the dispute, the Registrant's use of or demonstrable 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*", the Complainant has contended that Respondent has no intentions or purpose to use the disputed domain name for bona fide offering of goods and services in relation to it.

The Tribunal is of the view that the Respondent has neither responded nor has neither put forth or provided any evidence to show that the Respondent is engaged in or demonstrably prepared to engage in offering any bonfide goods or services in the name of the disputed domain name.

This proposition was also upheld in the following cases:

1. Pfizer Inc. Vs. Deep Soni and Ashok Soni. (Case No. D2000-0782). it was held that the respondent to prove his right or legitimate interest in domain name, must show that he is using the domain name for offering of goods and services or that he is making a demonstrable preparation to use the domain name for offering goods and services.
2. Madonna Ciccone v. Dan Parisi, ICANN Case No.D2000-0847.in which it was held that a use which intentionally trades on the fame of another cannot constitute a 'bona fide' offering of goods or services.

- b. While considering paragraph 7 (ii) of the .IN Dispute Resolution Policy, "*the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights*", the Complainant has stated that Respondent is neither commonly known by the disputed name, nor it is a personal name. The Complainant has further contended that Respondent is not engaged in any business or commerce under the domain name.

The Tribunal concludes that the Respondent has not shown or given any evidences to prove that it is commonly known by the disputed domain name and hence does not have any right or legitimate interest in the disputed domain name.

For this submission the Tribunal relies upon the award of Morgan Stanley v. Keep Guessing, INDRP/024 (June 27, 2007), where it was held that Respondent has failed

to show that he has a right or legitimate interest in the domain name, as he is neither known by the domain name, nor is it his personal name.

- c. While considering paragraph 7 (iii) of the .IN Dispute Resolution Policy, "*the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue*", the Complainant has contended that Respondent is not making a legitimate non commercial or fair use of the domain name.

According to Complainant, disputed domain name has been only adopted by the Respondent for commercial gain. The sole purpose of the Respondent is to divert Internet users to its web site.

The Tribunal concludes that the above submission of the Complainant has not been rebutted by Respondent, as such they are deemed to be admitted by him. Even otherwise the above facts and annexures establish that the Respondent has no right or legitimate interest in the disputed domain name under INDRP paragraph 4(ii).

The Registrant domain name has been registered or is being used in bad faith

The Complainant argues that the Respondent was aware of the Complainant's brand and tried to create a likelihood of confusion by registering domain name that is identical to the trademark in which the Complainant has rights.

The Complainant further alleges that the Respondent has registered the domain name only with the intention to create confusion in the mind of the internet users and to attract them to its impugned domain name. The Complainant has contended that the Respondent has the full knowledge and has intentionally attempted to divert the users from the domain name/website of the Complainant and also to deceive the consumers into believing that there is a connection or association between the Complainant and Respondents website.

The Complainant also alleges that the Respondent has registered the domain name only with the intention and purpose of sale. In support of this contention the Complainant has relied upon the award of *Ferrari S.P.A V. American Entertainment Group Inc., WIPO Case No. D2004- 0673*, where it was held that, registering a domain name for the primary purpose of offering to sale, rent, or otherwise transfer the domain name for an amount in excess of the registration cost is evidence that a domain name was registered in a bad faith.

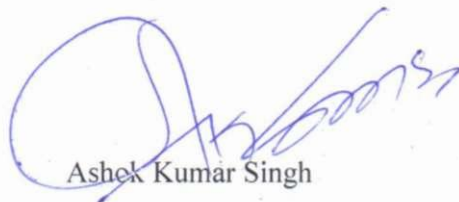


The Tribunal is of the view that the above submission of the Complainant has not been rebutted by Respondent, as such they are deemed to be admitted by him. Even otherwise the above facts and annexures establish that the Respondent has registered the disputed domain name in bad faith under INDRP paragraph 4(ii).

DECISION

In view of the above facts and circumstances, it is clear that the Complainant has succeeded in his complaint. In the facts and circumstances of the case it can be presumed that only purpose for the registration of the disputed domain name was to capitalize on the fame and reputation of Complainant and to make monetary benefit.

The Respondent has got registered and used the disputed domain name in bad faith .IN Registry of the NIXI is hereby directed to transfer the domain name of the Respondent i.e. <shuumura.in> to the Complainant. In the facts and circumstances of the case no cost or penalty is imposed upon the Respondent. The Award is accordingly passed on this 22nd day of October, 2011.



Ashok Kumar Singh

Sole Arbitrator

Date: 22nd October, 2011