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BEFORE SHRI SANJAY KUMAR SINGH ARBITRATOR
IN DOMAIN NAME DISPUTE RESOLUTION POLICY (INDRP)

IN RE:

LA ROCHE-POSAY LABORATOIRE PHARMACEUTIQUE,
Rue Rene Levayer, 86270,

La Roche-Posay, FRANCE

E-mail: contact@dreyfus.fr

Through authorized representative

Nathalie DREYFUS, DREYFUS & ASSOCIES,

78 Avenue Raymond Poincare, 75116 Paris, FRANCE,

E-mail: contact@dreyfus.fr

COMPLAINANT

VERSUS

ZENG WEI

Shanghai Weihai road 1888

Shanghai 200001, CHINA

E-mail: domain.broker@haodomains.com

RESPONDENT

Disputed Domain Name: "larocheposay.co.in"

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Sanjay Kumar Singh

1. Factual background:

The complainant has submitted that La Roche-Posay is French Company specialized in the field of cosmetics and beauty. Founded in 1928 for post treatment dermatological products formulated with La Roche-Posay thermal spring water, this brand has been ever since dedicated to create new generations of dermatological skincare products.

The complainant has submitted that the high-tech dermatological brand prides itself on safety, expertise, ethics and rigorous testing. The complainant has submitted that La Roche-Posay aims to improve quality of life for patients and consumers by offering a range of products and services designed specifically to meet the needs and requirements of dermatologists and suitable for even the most sensitive skins.

The complainant has submitted that with over 30 years' experience in research into sensitive skins and 25 patents to their name, La Roche-Posay laboratories have become a true benchmark in the development of the simplest possible formula for sensitive skin. The formulation is governed by strict rules, rigorous selection of active ingredients at their optimum concentration, elimination of any potential irritants, paraben-free formulation, and hypoallergenic fragrance. It is now present in 50 countries and recommended by 25,000 dermatologists worldwide. The complainant has annexed documents in its support as annexure-3.

The complainant has submitted that the brand LA ROCHE-POSAY is also present in China notably via dedicated website www.laroche-posay.com.cn launched for marketing and commercial purposes. The complainant has annexed documents in its support as annexure-4. La Roche-Posay is the subsidiary of the industrial group L'Oreal. The complainant has annexed documents in its support as annexure-5.

The complainant has submitted that Created in 1909 by a FRENCH Chemist of the same name, L'Oreal recently celebrated its centenary.

The complainant has submitted that it is one of the world's largest groups in the cosmetics business. Present in over 130 countries, L'Oreal creates and distributes products in all sectors of the beauty industry, professional products, consumer products, luxury products and active cosmetics. L'Oreal owns 23 international

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brands among which GARNIER, KERASTASE, MAYBELLINE, LANCOME and SHU UEMURA. The complainant has annexed documents in its support as annexure-6.

The complainant has submitted that L'Oreal markets over than 500 brands, and more than 2,000 products in all sectors of the beauty business. It develops and markets inter-alia cosmetics active products with brands such as La Roche-Posay.

Complainant's Group L'Oreal is present in China where it has recorded very significant growth in terms of sales; L'Oreal has a local subsidiary in China since 1997. L'Oreal has opened in particular a research center as Pudong where it has conducted studies to create a range of shampoos and hair-care products ideally suited to local hair types and cultural tradition, Chinese market is a particularly fast growing market for L'Oreal. In this country the sales have doubled from 2005 to 2009. L'Oreal has become one for skincare in China thanks in particular to the brand Men Expert. In respect of professional products, L'Oreal is strengthening its position and has recorded a growth by 10% of its sales in 2009. To sustain its development, L'Oreal has used local icon liked the actor David Wu to promote its products and has sponsored events like the World Expo in Shanghai. The complainant has annexed documents in its support as annexure-7.

Complainant's efforts to resolve this matter amicably.

It has been submitted by Complainant that it noticed in October 2011 that the disputed domain name has been registered. A Whois database search revealed that said domain name has been registered by Zeng Wei located in Shanghai having an email related to Hao Domains Services. The complainant has annexed documents in its support as annexure-8-9.

The complainant has submitted that the said domain name resolves to a parking webpages displaying various pay-per-click links as well as a mention. This domain may be for sale by its owner". The complainant has annexed documents in its support as annexure-10. The complainant has contended that the disputed domain name has been put up for sale by the owner on Sedo's Domain Marketplace for 7,600 The complainant has annexed documents in its support as annexure-11

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The complainant has relied on recent WIPO decisions where, Zeng Wei was involved in similar proceedings under similar circumstances and the Arbitrators ruled in favour of the complainants (WIPO case no.D2011-1608, L'Oreal Laboratoire Garnier et Compagnie Lancome Parfums et Beaute et Compagnie V Zbhao Ke, Zeng We,. Zbu Tao, Yang Yong Ma Yun, Ye Genrong Ye Li, ChinaDNS Inc. Domainjjet, Inc., Hao Domains Services and WIPO Case No.D2010-1567, Revlon Consumer Products Corporation V. Zeng Wei-. The complainant has annexed copies of the same in its support as annexure-12.

These decisions clearly show Respondent's bad faith habit of infringing trademarks. Besides Zhao Ke, Hao Domains Services which operates the same email as Respondent and is presumably the legal entity, was involved in 4 other WIPO cases and a NAF case by D2011-1943, Dr. Martens International Trading GmbH, Dr. Maertens, Marketing GmbH vs Zhao Ke/Hao Domains Services, WIPO case No.D2011-1913, Dr.Ing. h.e. F. Porsche AG v. Zhao Ke, WIPO case NO.D2011-1503, Societe' Nationale des Chemins de Fer Rancais SNCF, SNCF International V.s Zhao Ke, WIPO case No.D2011-1768, Missoni S.p.a. v. Zhao Ke an NAF Claim No.FA1106001392705, Victoria's Secret Stores Brand Management, Inc. V. Zhao Ke. The complainant has annexed documents in its support as annexure-13.

Therefore, complainant is forced to start the present procedure in order to obtain the transfer of the disputed domain name <larocheposay.co.in>

2. contentions of complainant :

A. The domain name registered by respondent is identical to the trademark of complainant. (Policy, Para 4 (i); Rules, Para. 3 (b)(vi) (1).

Complainants own numerous trademark registrations for LA ROCHE-POSAY throughout the world.

Complainant is inter alia the owner of:

The complainant has annexed documents in its support as annexure-Annex-14.

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- International trademark LA ROCHE-POSAY, No. 787605 registered on July 12, 2002 protected in Chain and covering goods in classes 3 and 5;
- Indian trademark LA ROCHE-POSAY, No.2123344 dated of March 13, 2011 and covering goods in class 3.

The complainant has submitted that additionally, complainant's Group L'Oreal operates an international website www.laroche-posay.com which is entirely dedicated to his brand LA ROCHE-POSAY and has its branch national website in over 40 countries where the products of said brand are marketed. Thus, complainant owns numerous ccTLD names corresponding to these websites, a for example. The complainant has annexed documents in its support as annexure-15.

larocheposay.com.cn created on September 8, 2000;

laroche-posay.hk created on October 29, 2008;

- laroche-posay.jp created on December 17, 2003;
- laroche-posay.us created on April 26, 2002 etc.

The complainant has submitted that the disputed domain name is identical or at least confusingly similar with complainant's trademarks LA ROCHE-POSAY.

The complainant has submitted that the disputed domain name differs from LA ROCHE-POSAY trademark by the addition the ccTLD "co.in". However it is only minor difference that are insufficient to avoid likelihood of confusion between complainant's trademarks and the disputed domain name. The complainant has also submitted that, 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 (PepsiCo, Inc. V. Bijon Chatterji, case No.INDRP/014, June 24, 2006; Motbercare UK Limited, United Kingdom V. Mr. Rajkumar Jalan, New Delhi, case no.INDRP/061, April 27, 2008; Bombay Stock Exchange Limited Vs. Vikamsey, case No.INDRP/063 August 17, 2008. The complainant has annexed documents in its support as annexure-16.

It has been submitted by the complainant that disputed domain name incorporates complainant's trademark LA ROCHE-POSAY in its entirety. The complainant has contended that 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 (Tenneco Inc. V. Toni Li Case No. INDRP/130 March 5, 2010. ITC Limited V. Travel India, Case No.INDRRP/065, April, 15, 2008- The complainant has annexed the copy of the same as annexure-17.

The complainant has submitted that besides, the name of LA ROCHE-POSAY is also the corporate and trade name of complainant. For all the reasons above, it has been established that complainant has rights to the L.A. ROCHE-POSAY trademarks and that the disputed domain name is highly and confusingly similar to these trademarks. The condition of paragraph 4(i) of the IN. Policy has therefore, been fulfilled.

B. Respondent has no rights or legitimate interests in respect of the domain name: (Policy, paras 4(ii) and 7; Rules, Para 3(b)(vi) (2).

The complainant has submitted that respondent does not have prior rights or legitimate interests in the LA ROCHE-POSAY 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 interest in the disputed domain name. The complainant has relied on (case no. INDRP/096, June 27, 2009, Compagnie Gervais Damone V. Digitech Software Solutions. The complainant has annexed the copy of the same as annexure-18.

The complainant has submitted that respondent is in no way affiliated with complainant and further the complainant has not authorized or licensed respondent to use and register the LA ROCHE-POSAY trademark, nor seeked registration of any domain name incorporating these trademarks.

The complainant has submitted that although respondent is the current owner of the disputed domain name, the simple use of complainant's trademarks in the disputed domain name does not confer rights or legitimate interests to respondent. The complainant has relied on (case No. INDRP/050, November 30, 2007 ITC Limited V. Vishal and has placed the copy of same as Annexure-19.

Furthermore, respondent has never provided evidence of being known or recognized by the disputed domain name. Previous panels have concluded that

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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. The complainant has relied on (case no.INDRP/256, November 4, 2011, Citroen V Hyderabad, case No.INDRP/127, February 24, 2010, Accor V. Tang Wei, Case No.INDRP/118, November 26, 2009, Starbucks Corporation V Mobanraj and placed the copies of same as Annexure-20.

The complainant has also submitted that additionally, complainant had registered and used various domain names consisting in its marks and trade names LA ROCHE- POSAY before respondent registered the disputed domain name. Consequently, there can be no right or legitimate interest on respondent's side. The complainant has relied on (Annexes 1 and 15 and case No. INDRP/099, June 12, 2009, Societe' Anonyme des Eaux Minerales d'Evian (SAME), vs. Rajesh Aggarwal. The complainant has also placed copies of the same as Annexure-21.

The complainant has contended that respondent is not making a fair or legitimate non commercial use of the domain name. On the contrary it is making a commercial use of the domain name. Respondent uses the domain name to direct Internet users to a page of various sponsored links. The complainant has annexed documents in its support as annexure -10.

The complainant has contended that links which cannot constitute a bonafide use offering of goods and services (Sti des Produits Nestle' V. Nesafe Limited INDRP/100 May 4, 2009. The complainant has annexed documents in its support as annexure -22.

The complainant has further contended that respondent appears to have engaged in a pattern of conduct of registering domain names reproducing well known trademarks (Annex- 12 and 13). This further deprives respondent from having any right or legitimate interest in the disputed domain name. As per contentions of complainant and for the aforementioned reason, respondent has no rights or legitimate interests in respect of the disputed domain name under paragraph 4(ii) of the Policy.

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The complainant has further contended that 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 (Rbodja V. Sbi Jing, Case No.INDRP/178, December 19, 2010. The complainant has annexed documents in its support as annexure-23.

C. The Domain name has been registered or is being used in bad faith.

(Policy, para 4 (iii) and 6; rule Para 3(b)(vi)((3).

Registration in bad faith.

The complainant has submitted that complainant is present on a worldwide basis and its trademark LA ROCHE-POSAY is well known throughout the world and China where respondent is located. China is a particular fast growing market for complainant's group L'Oreal. The complainant has annexed documents in its support as annexure- 3, 4, 5 and 7 and placed reliance on same.

The complainant has submitted that because of the distinctiveness of complainant's LA ROCHE-POSAY trademark, it is reasonable to infer that respondent registered the disputed domain name with full knowledge of complainant's trademark.

The complainant has submitted that even if respondent was unaware of complainant, which is unlikely in the present case, a quick trademark search or online search on Baidu using the keywords, "LA ROCHE-POSAY, would have shown the existence of complainant and its trademark rights. The complainant has annexed documents in its support as annexure- 24 and placed reliance on same. Accordingly to the policy paragraph 3, it was respondent's responsibility to conduct a trademark search before registering the disputed domain name. Respondent's failure to conduct this search is evidence of registration in bad faith. The complainant has placed reliance on case no.INDRP/192, February 10, 2011, Altacor Inc. V. Aryanent; case no.INDRP/002 May 20, 2006, Monster.com (India) Private Limited V. Domain Leasing Company. The complainant has annexed the copies as Annexure-25.

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The complainant has submitted that respondent has engaged in a pattern of conduct of registering domain names consisting in famous trademarks belonging to third parties and thus preventing them to reflecting their mark in corresponding domain names which is an evidence of bad faith pursuant to article 6(ii) of the Policy. The complainant has placed reliance on Annexure-12 and 13.

The complainant has further submitted that respondent registered the domain name to prevent complainant from reflecting its trademarks in the disputed domain name This type of conduct constitutes evidence of respondent's bad faith. The complainant has placed reliance on WIPO case No.D2009-0242, L'Oreal V. Chenxiansheng. The copy of same has been annexed by complainant as Annexure-26.

The complainant has submitted that Policy, under paragraph 6(i), states that if there are circumstances which indicate that the registrant has registered or acquired the domain name for the purpose of selling renting or otherwise transferring the domain name to complainant or to a competitor, such registration can be considered as had faith registration and use of the domain name. In the present case, the disputed domain name was offered for sale at sedo.com for 7,600.00 (Annex-11), a price far beyond the registration costs for the disputed domain name. It demonstrates that respondent was aware of the disputed domain name's value and that it planned to make a profit via the offer for sale on Sedo, which is certainly not evidence of good faith registration and use (INDRP Dispute decision L-2/5/R1 <bacarrat.in> decided on October 06, 2006- Annex-7) since the value of the domain name is only provided by the fame of the trademark it contains.

The complainant has contended that, 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.

USE IN BAD FAITH:

The complainant has contended that several elements can be put forward to support the finding that respondent also uses the domain name in bad faith. As

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previously indicated the domain name <larocheposay.co.in> resolves to a parking website displaying various pay-per-click links. The complainant has placed reliance on Annexure-10. As per complainant use of the disputed domain name to divert internet users and directing them to a website providing click through revenues to respondent evidences bad faith. Respondent is taking undue advantage of complainant's trademark to generate profits. This does not constitute good faith use of the domain name (INDRP Dispute decision on L-2/5/RI <bacarrat.in> decided on October 06, 2006- Annexure-27.

The complainant has submitted that there is little doubt that many internet's users attempting to visit complainant's website have ended up on the web page set up by respondent. As per complainant the disputed domain name is confusingly similar to complainant's trademark and previous panels have ruled that 'a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of internet traffic from complainant's site of respondent's site. The complainant has placed reliance on WIPO Case No.D2010-1318, L'Oreal SA V. LinChaojie, Guangxi NaniNig IDEA Business Planning Co. Ltd. (Annex-28).

The complainant has submitted that respondent has been engaged in a pattern of conduct of abusive domain name registration and is involved in several cases of cyber squatting. The complainant has placed reliance on Annexure 12 and 13. The complainant has contended that the disputed domain name is also being used in bad faith.

3. A copy of complaint has been sent to the respondent by the .In Registry through e-mail. The undersigned was appointed as arbitrator and upon receipt of the complaint, the Arbitrator sent a notice dated 29-04-2012 to respondent whereby the respondent was directed to submit counter affidavit/reply to the complaint of the complainant with supportive documents/evidence to the undersigned within **Seven** days positively from the receipt of notice.
4. Despite the above notice the respondent neither filed counter affidavit/reply to the complaint of the complainant nor any supportive documents/evidence in his support.

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5. On 08-05-2012, the Arbitrator further directed the respondent to send his defence / counter to the complaint along with supportive documents / evidence at the e-mail address within further **Five** days positively from the receipt of the notice. But the respondent has not filed/submitted his defence / counter to the complaint till date despite notice that complaint would be decided ex parte on the merits of the complaint.
6. The respondent despite of earlier notices and reminders failed to send his defence / counter to the complaint though the notices were duly served on E-mail ID of the respondent.
7. Therefore, this matter is being decided ex-parte and on the merits of the complaint and as per law of the land.

8. OPINION/FINDING:

The Para no.4 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

TYPES OF DISPUTES

Any person who considers that a domain name conflicts with his legitimate rights or interest may file complaint to .IN Registry on following premises:

- 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."

The Para no.6 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:

9. EVIDENCE OF REGISTRATION AND USE OF DOMAIN NAME IN BAD FAITH :

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The following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

- "i) Circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or
- ii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location."

The Para no.7 of the IN Domain Dispute Resolution Policy (INDRP) is as follows:-

10. REGISTRANT'S RIGHTS TO AND LEGITIMATE INTERESTS IN THE DOMAIN NAME:

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purpose of paragraph 4 (ii):

- "i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstratable preparations to use, the domain name

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or a name corresponding to the domain name in connection with a bonafide offering of goods or services;

- ii) the Registrants (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."

11. OPINION AND FINDINGS ON MERITS:

A) Whether the domain name is identical or confusingly similar to a trademark in which complainant has right.

It has been held in Indian decision **M/s Satyam Infoway Ltd. Vs. M/s Sifynet Solution (P) Ltd. JT. 2004 (5) SC 541**, that Domain name has all characteristics of trademark. As such principles applicable to trademark are applicable to domain names also. In the said case the words, "Sify' & 'Siffy' were held to be phonetically similar and addition of work 'net' in one of them would not make them dissimilar.

It is held in Indian case **JT.2004 (5) SC 541**, that in modern times domain name is accessible by all internet users and thus there is need to maintain it as an exclusive symbol. It is also held that it can lead to confusion of source or it may lead a user to a service, which he is not searching.

The other fact, which is to be dealt with, is, as to whether, the cases decided by WIPO- Administrative Panel could be considered, while deciding the present controversy. Moreover these cases throw light upon various important aspects of controversy. As such they would be considered, while deciding the present controversy, in so far as they do not conflict with INDRP.

Thus conclusion is that domain name and trademark, which may be used in different manner and different business or field, or sphere, can still be confusingly similar or identical.

Thus the conclusion is that the domain name of respondent is identical and confusingly similar to the trademark of complainant.

Now the other important aspect that needs consideration is, as to whether the complainant has right in the trademark. It is important to mention here that as per the claim of the complainant the respondent has no trademark right on the said domain name.

This principle is settled in many Indian cases referred herein above. The complainant has made submission that he has legitimate trademark.

Thus the conclusion is that the domain name "larocheposay.co.in" is identical and confusingly similar to the trademark of the complainant "LA ROCHE POSAY" and the complainant has established that the complainant has right in the trademark.

B) Whether the respondent has no right or legitimate interest in the domain name got registered by him

It is pertinent to mention here that paragraph 4 (ii) of INDRP is to be read with paragraph no.7.

As already stated that paragraph 4 (ii) and 7 of INDRP are to be read together. Their combined effect is that, onus to prove the ingredients of these paras are prima facie on complainant. The onus is not very weak and prima facie, but it heavily shifts on respondent. Respondent can discharge the onus by direct cogent and positive evidence which are in his special knowledge and power. The complainant has made positive assertions that respondent has no legitimate right in domain name and the respondent has no trademark on the domain name. The complainant has made positive assertions regarding the fact that respondent has got registered the disputed domain name in the .IN Registry for which the respondent has no right or trademark. As such in above circumstance it is clear that the complainant has prima facie discharged the initial onus cast upon him by virtue of paragraph 4(ii) and 7 of INDRP.

The respondent has not filed any reply / counter or to provide any positive, cogent and specific evidence in spite of repeated notices.

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The respondent has failed to show that it is known or recognized by the impugned domain name in the present complaint. The respondent has neither put forth the reply/counter to the complaint nor has provided any evidence in its support.

Thus the conclusion is that respondent has no right or legitimate interest in the domain name.

C. Whether the respondent's domain name has been registered or is being used in bad faith:

It is to be seen as to whether the domain name has been got registered in bad faith. The paragraph no.4 (iii) and 6 are relevant and as already stated; the onus is primarily upon complainant.

Keeping in view the above facts and circumstances and Indian cases referred herein above it is thus clear that the respondent has registered the disputed domain name and in spite of repeated notices, he has neither come forward and nor provided any substantial evidence in his support.

Thus, the conclusion is that the respondent has got registered his domain name "larocheposay.co.in" in bad faith.

RELIEF

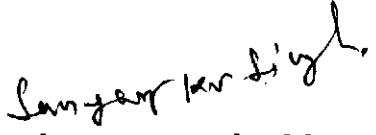
In view of the above facts and circumstances, it is clear that the respondent has no right and legitimate interest in the domain name "larocheposay.co.in" and that the respondent has illegally and wrongfully adopted the trademark / word "LA ROCHE POSAY" of the complainant with the sole intention to create an impression of an association with the complainant. The domain name of the respondent is identical and confusingly similar to trademark of complainant. The respondent also does not have right or legitimate interest in the domain name. He has got it registered in bad faith; as such he is not entitled to retain the domain name. The complainant is entitled for transfer of domain name "larocheposay.co.in" to him, as he has established his bonafide rights in trademark in view of facts of the case and as per law discussed above. Hence I direct that the Domain name be

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transferred to the complainant by registry on payment of requisite fee to the registry.

No order as to costs.


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Date: 11.06.2012

Arbitrator