

தமிழ்நாடு தமில்நாடு TAMILNADU

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10 MAY 2013

D. SARAVANAN

Advocate, Arbitrator & Mediator
"Orient Chambers" No. 90 (Old No. 73),
4th & 5th Floor, Armenian Street,
Chennai - 600 001.

AL 538642

AS. SUNDARARAJAN
STAMP VENDOR,
L No. BA / 109 / 80
HIGH COURT CAMPUS,
CHENNAI-600 104 (TAMIL NADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN
.IN REGISTRY
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: <kerastase.co.in>

L'OREAL
14 Rue Royale
75008 Paris
FRANCE
contact@dreyfus.fr

Complainant

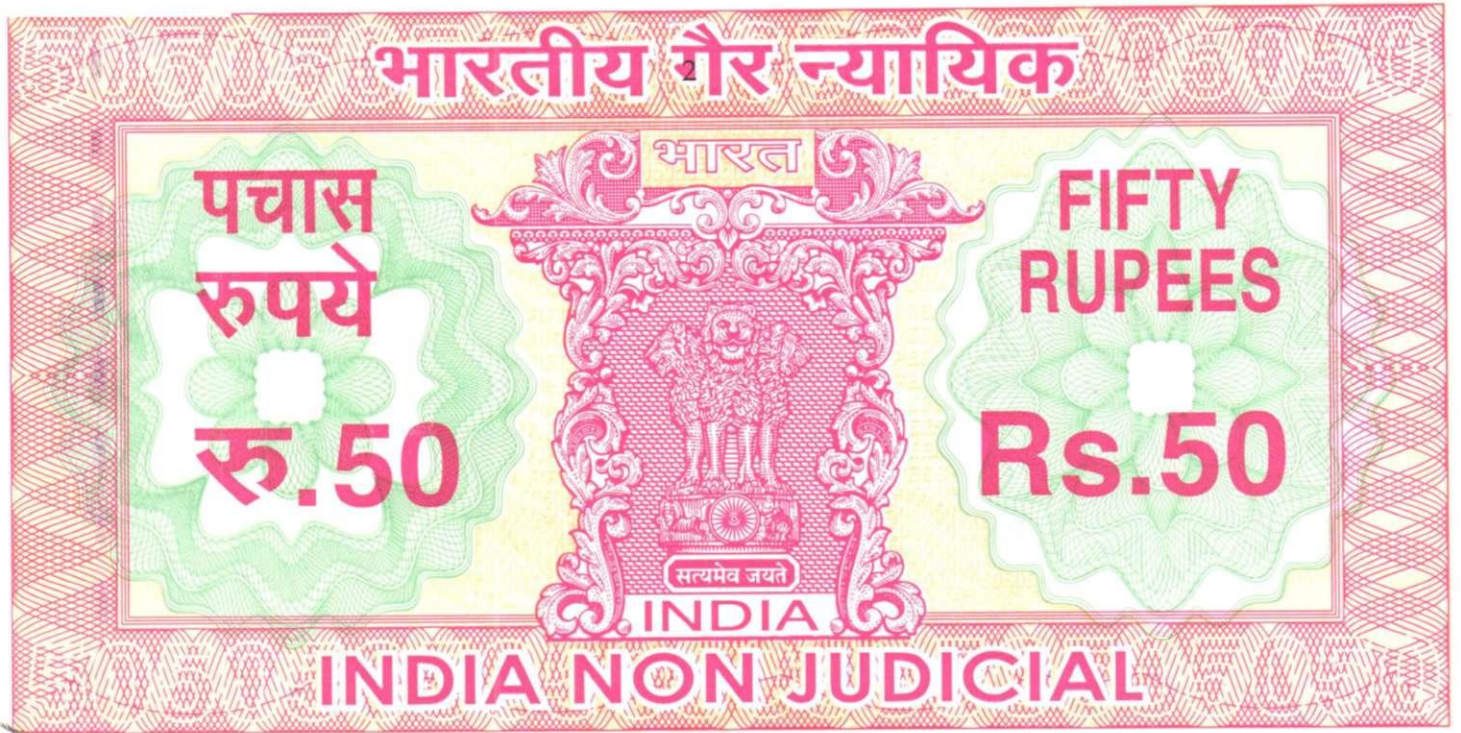
Vs.

YERECT INTERNATIONAL LIMITED
GaoGou
Suite 1100 South Tower
175 Bloor Street, East
M4W 3R8, Toronto
CANADA.
chromebooks@hotmail.com

Respondent

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தமிழ்நாடு தமில்நாடு TAMILNADU

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- 3 MAY 2013

D. SARAVANAN
Advocate, Arbitrator & Mediator
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4th & 5th Floor, Armenian Street,
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AD 538090
PS. SIVAKUMAR KINADAM,
STAMP VENDOR,
L No. 04 / 100 / 08
HIGH COURT CAMPUS,
CHENNAI-600 101 (TAMIL NADU)

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1. The Parties:

The complainant is L'Oreal, a French Company incorporated under French law as "societe anonyme a conseil d'administration", whose registered office is located at 14, Rue Royale, 75008, Paris, France.

The Respondent is YERECT INTERNATIONAL LIMITED, Suite 1100, South Tower, 175, Bloor Street, East, M4W 3R8, Toronto, Canada. The Respondent is not represented by any one.

2. The Domain Name and Registrar:

The disputed domain name is <kerastase.co.in>. The domain name has been registered with .IN REGISTRY

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3. Procedural History:

- April 04, 2013 : The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- April 04, 2013 : The Arbitrator has consented and submitted Statement of Acceptance and Declaration of Impartiality And Independence, to the .IN REGISTRY.
- April 19, 2013: The .IN REGISTRY has forwarded the hard copy of the complaint and annexures to Mr.D.Saravanan, Sole Arbitrator.
- May 03, 2013: Arbitral proceedings were commenced by sending notice to Respondent through e-mail as per Paragraph 4(c) of INDRP Rules of Procedure, marking a copy of the same to Complainant, Complainant's authorised representative and .IN REGISTRY.
- May 09, 2013: NIXI forwarded a soft copy of the complaint along with Annexures to the Respondent, marking a copy of the same to the Arbitrator, as the shipment sent to the Respondent was returned undelivered.
- May 19, 2013 : Due date for filing Response by Respondent.
- June 04, 2013 : Arbitrator sent an e-mail to Respondent notifying its default, a copy of which was marked to Complainant, Complainant's authorised representative and the .IN REGISTRY.
- : The language of the proceedings in English.

4. Factual Background:

4.1 The Complainant:

The complainant is L'Oreal, a French Company, whose registered office is located at 14, Rue Royale, 75008, Paris, France, represented by its Authorised Representative M/s Dreyfus et associe's through Nathalic DREYFUS.



4.2 Complainant's Activities:

The Complainant states *inter-alia* that L'Oreal is a French industrial group specialized in the field of cosmetics and beauty, created in 1909 by a French chemist, L'Oreal who has recently celebrated its centenary; L'Oreal is today the International leader and one of the world's largest groups in cosmetics business; the Company is present in over 130 countries with over 68,900 employees and successful in every continent; among its numerous subsidiaries and affiliates over the world, L'Oreal particularly has an affiliate in Canada, L'Oreal Canada located in Montreal, where Respondent is located according to the Whois database; L'Oreal is also present *inter alia* in China and in India. L'Oreal markets very numerous products and brands, including KERASTASE, in all sectors of the beauty business: hair colour, permanents, styling aids, body and science skincare, cleansers and fragrance; KERASTASE is a brand intended for hair professionals sold in prestigious hair salons on a global basis; since its creation, Kerastase has developed new haircare products and services; L'Oreal Advance Research has produced, with the most advanced technology in the industry, the innovative Kerastase products dedicated to enhancing the natural beauty of the hair; KERASTASE belongs to the Professional Products division and represents L'OREAL premium, luxury hair care product since 1964; sold only in the most prestigious salons, KERASTASE encompasses six product lines designed for all different types of hair, that is to say: Nutritive, Reflection, Dermo-Calm, Resistance, Specifique and Soleil; KERASTASE is very well known and well implanted around the world, including Canada; Complainant and its affiliates communicates have developed and maintains specific websites such as www.kerastase.fr and www.kerastase.ca for its brand KERASTASE; KERASTASE products are widely known and are indeed constantly cited by the most prestigious magazines, such as Vanity Fair, Allure, Lifestyle, Self, Glamour, Luxury etc; KERASTASE products are continuously nominated and awarded the most prestigious honors in the industry; In 2011, four KERASTASE products have been awarded the Best Beauty Buys by the American magazine INSTYLE.



4.3 Complainant's Trading Name:

Complainant states that they own numerous KERASTASE trademarks, which are very well-known in particular in relation to the beauty business; Complainant is notably the owner of the following KERASTASE trademark registrations; Indian trademark KERASTASE, No. 595824 registered on April 29, 1993, duly renewed and covering goods in class 3, Indian trademark KERASTASE, No.1352702 registered on April 25, 2005 and covering goods in class 42, Canadian trademark KERASTASE, No. TMA139827 registered on April 9, 1965 and duly renewed, Chinese trademark KERASTASE No.148658 registered on July 30, 1981, duly renewed and covering goods in classes 3, Hong Kong trademark KERASTASE No. 19903439 registered on November 13, 1990 and covering goods in class 3; Complainant and its affiliates operate, among others, domain names reflecting their trademarks in order to promote their products and services viz. <kerastase.com> registered on October 21, 1996; <kerastase.fr> registered on April 1, 2003; <kerastase.ca> registered on August 28, 2003.

4.4 Respondent's Identity and activities:

The Respondent is YERECT INTERNATIONAL LIMITED, Suite 1100, South Tower, 175, Bloor Street, East, M4W 3R8, Toronto, Canada. Complainant has become aware of Respondent's registration of the domain name <kerastase.co.in> which entirely reproduces entirely its trademark KERASTASE. Said domain name resolves to a parking page which displays commercial links. On the top left lies a link which mentions that the domain name is for sale. This link allows internet users to inquire about said domain name. Besides, Complainant and its affiliates have already been confronted to Respondent. Indeed respondent was the initial registrant of a domain name in the INDRP dispute for domain name <laroche-posay.co.in> which resulted in transfer of the domain name to Complainant's affiliate as per Case No. INDRP/375, July 28, 2012. Respondent has been involved in, at least, five INDRP cases, where transfer of the disputed domain names has been ordered vide Case No. INDRP/359, Case No. INDRP/362, Case No. INDRP/404, Case No. INDRP/420



and Case No. INDRP/434. It thus seems that Respondent has engaged in a pattern of conduct of registering domain names reproducing trademarks of third parties. In these decisions, it appears that Respondent's address is one time in Hong Kong and the other time in Canada. Respondent also appears to be using several identities. An offer to sale the disputed domain name was sent to Complainant. The sender, Hua an Holdings (H.K.) Limited is the Respondent in another INDRP case filed by Complainant in respect to domain name <kiehls.co.in>. This Complaint is currently pending before the NIXI. Furthermore, this latter has already been involved in a NIXI case, where the Panel ordered the transfer of the disputed domain name vide Case No. INDRP/416.

5. Parties contentions:

A. Complainant:

- (a) The Domain Name is identical or confusingly similar to a Trademark or service mark in which the Complainant has rights:**

The disputed domain name differs from KERASTASE trademark by the addition of the ccTLD ".co.in". However this is only a minor difference that is insufficient to avoid any likelihood of confusion between Complainant's trademark and the disputed domain name. Indeed, 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 vide Case No. INDRP/014, Case No. INDRP/061 and Case No. INDRP/063. The disputed domain name incorporates Complainant's trademark KERASTASE 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 vide Case No. INDRP/130 and Case No. INDRP/065. The mark KERASTASE is extensively used by Complainant and Internet users may wrongly believe the domain name <kerastase.co.in> belongs to Complainant. As held by the Panel in respect to a domain name kerastaseonline.com, *"Any person who came across the Respondent's disputed domain name would immediately assume that it was a domain name owned and operated by the Complainant, contrary to the*



fact" (WIPO Case No.D2012-0144, *L'Oreal v. Vogue*) Accordingly, by registering said domain name, Respondent created a likelihood of confusion with Complainant's trademark. It is likely that this domain name could mislead Internet users into thinking that this is, in some way, associated with Complainant.

(b) Respondent has no rights or legitimate interests in the domain name:

Respondent does not have prior rights or legitimate interests in the KERASTASE 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 vide Case No.INDRP/096. Respondent is in no way affiliated with Complainant. Complainant has not authorized or licensed Respondent to use and register the KERASTASE trademark, nor to seek registration of any domain name incorporating this trademark. Although Respondent is the current owner of the disputed domain name, the simple use of Complainant's trademark in the disputed domain name does not confer rights or legitimate interests to Respondent vide Case No.INDRP/050. Further more, Respondent is not known or recognized by the domain name, Respondent has thus no rights or legitimate interests in the domain name vide Case No.INDRP/256, Case No.INDRP/127, Case No. INDRP/118 and Case No.INDRP/415. Additionally, Complainant had registered and used various domain names consisting in its mark KERASTASE long before Respondent registered the disputed domain name. Consequently, there can be no right or legitimate interest on Respondent's side vide Case No.INDRP/099. 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 sponsored links. Such links cannot constitute a bona fide use offering of goods and services vide Case No. INDRP/100 and Case No.INDRP/342. Additionally the page includes a link directing Internet users to a page where they can make an offer for the domain name. Complainant was contacted by a person that appears to be also Respondent or a closely related to purchase the domain name. It is thus appear obvious that Respondent has never intended to use the disputed domain name for a bona fide offering of goods and



services vide Case No. INDRP/343. Lastly, it seems that Respondent tried to sell the domain name to Complainant for a sum largely exceeding the registration costs. Thus, it appears obvious that the sole reason for Respondent's registration of the Disputed Domain Name was sale of said domain name. Such a conduct demonstrates everything but a legitimate interest in the domain name vide Case No. INDRP/096. Respondent also seems to have engaged in a practice of registering domain name reproducing well known marks which further deprive Respondent from having any right or legitimate interest in the disputed domain name vide Case No. INDRP/342.

(c) Respondent has registered and is using the domain name in bad faith:

The Complainant is present on a worldwide basis and its trademark KERSTASE is well known throughout the world, including in Canada, Hong Kong or China, where Respondent seems to be located. Further, the well known character of Complainant's mark KERASTASE has been underlined by WIPO Case No.D2011-1608, Case No.D2012-20144, and WIPO Case No.D2012-2255. It is thus very unlikely that Respondent was unaware of Complainant's existence or trademark rights before registering the disputed domain name. It has been held that the registration of a domain name containing a well-known mark is strong evidence of bad faith vide Case No. INDRP/018 and Case No. INDRP/051. The disputed domain name has been and is used for a page displaying commercial and is currently for sale. Because of the distinctiveness of Complainant's KERASTASE trademark, it is reasonable to infer that Respondent registered the disputed domain name 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 vide Case No. INDRP/125. The reservation of the disputed name prevents Complainant to communicate in India and to Indian consumers via Internet using domain name with a ccTLD extension and a specific website dedicated to the complainant's presence and offering of goods in India. This evidences Respondent's bad faith in the registration of disputed domain name vide Case No. INDRP/343. 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 keyword "KERASTASE" 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 vide Case No. INDRP/343. Moreover, Respondent offers the domain name for sale and has directly or via a related entity proposed to sell the disputed domain name to complainant. There is no doubt that Respondent tried and is trying to sell the latter to the highest bid, far more expensive than the registering fees of the domain name. 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 bad faith registration and use of the domain name. In the present case the disputed domain name has been offered for sale to Complainant by Respondent. Additionally, it seems that Respondent has engaged in a pattern of conduct of registering domain names. Indeed, Respondent was involved in, at least, five NIXI cases, where the transfers of the disputed domain names were ordered vide Case No. INDRP/359, Case No. INDRP/362, Case No. INDRP/404, Case No. INDRP/420 and Case No. INDRP/434. Respondent also seems to be using several identities. Indeed, Complainant was offered to purchase the disputed domain name by an entity, Song, also involved in cybersquatting cases and inter alia in a dispute brought to the Indian Arbitration Centre. Complainant and its affiliates have already been confronted to both identities. This further suggests Respondent's bad faith. Consequently, it can be assumed 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. The domain name <kerastase.co.in> resolves to a parking website displaying pay-per-click links. The 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. 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 vide Case No. INDRP/125. Moreover, there is little doubt that many Internet users attempting to visit Complainant's website have ended up on the



web page set up by Respondent. Indeed, the disputed domain name is identical to Complainant's trademark. Respondent has engaged in a pattern of conduct of abusive domain name registration and has already been involved in several cases of cybersquatting. Besides, it seems that Respondent gives incorrect contact information when registering domain names, being sometimes located in China and sometimes in Canada. Respondent is also offering to sell the domain name to Complainant. There is no doubt that Respondent tried and is trying to sell the latter to the highest bid, for a sum undoubtedly exceeding the registering fees of the domain name. It appears that the sole objective of Respondent was to sell the domain name for considerable compensation which is the same of bad faith.

B. Respondent:

The Respondent did not submit any response.

6. Discussion and Findings:

It has to be asserted as to Whether the Constitution of Arbitral Tribunal was proper? and Whether the Respondent has received the notice of this Arbitral Tribunal?

Having gone through the procedural history, this Tribunal comes to the irresistible conclusion that the Arbitral Tribunal was properly constituted and Respondent has been notified of the complaint of the Complainant. However, the Respondent did not choose to submit any response and that non-submission of the Response by the Respondent had also been notified to the Respondent on June 04, 2013.

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:



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

(a) Identical or confusing similarity:

i) The Arbitral Tribunal finds that the Complainant has provided evidences that it possesses registered trademark KERASTASE and domain names in various countries including in India. The Respondent's domain name, <kerastase.co.in>, consists of entirely Complainant's trademark except cc TLD ".co.in". Thus, this Arbitral Tribunal comes to the irresistible conclusion that the disputed domain name <kerastase.co.in> is confusingly similar or identical to the Complainant's marks.

ii) The Arbitral Tribunal concludes that the Complainant has established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

(b) Respondent's Rights or Legitimate Interests:

i) The Complainant contends that the Respondent has no legitimate interest in the disputed domain name. Paragraph 7 of the IN Dispute Resolution Policy sets out three elements, any of which shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(ii) of the Policy. The Respondent had been given the opportunity to respond and to present evidence in support of the elements in paragraph 7 of the INDRP. The Respondent has not chosen to do so and has not filed any response in these proceedings to establish any circumstances that could assist it in demonstrating, any rights or legitimate interests in the disputed domain name.



Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Arbitral Tribunal can however and does draw evidentiary inferences from the failure of the Respondent to respond. The Complainant has established a prima facie case of lack of rights and legitimate interest and the Respondent has failed to rebut the presumption of absence of rights or legitimate interests.

ii) Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain name as the Respondent's current use is neither an example of a bona fide offering of goods or services as required under paragraph 7(i) of the Policy nor is there any legitimate non-commercial or fair use of the disputed domain name and as such there is no evidence that paragraphs 7(ii) or 7(iii) of the Policy apply. The Complainant asserts that they have not licensed or otherwise authorized the Respondent to use their trademark.

iii) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interests in respect of the disputed domain name and, accordingly paragraph 4(ii) of the Policy is satisfied.

(c) Registration and Use in Bad faith:

i) Paragraph 6 of the Policy provides the circumstances evidencing registration and use of a domain name in bad faith are that, by using the same, the Respondent has engaged in a pattern of such conduct and the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's web site or other online locations, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's web site or location.

ii) The Respondent has registered the domain name which appears to have been selected precisely for the reason that it is identical or confusingly similar to registered trademarks and trade names of the Complainant. The



Respondent has no affiliation with the Complainant. Registration of a domain name that is confusingly similar or identical to a famous trademark by any entity, which has no relationship to that mark, is itself sufficient evidence of bad faith registration and use.

iii) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the legal inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was a malafide intent for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

7. Decision:

For all the foregoing reasons, in accordance with paragraph 10 of the Policy, the Arbitral Tribunal orders that the disputed domain name <kerastase.co.in> be transferred to the Complainant.

Dated at Chennai (India) on this 6th June, 2013.


(D.SARAVANAN)
Sole Arbitrator