

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. 2024-0011

Also in PDF 2024-0011

1. The Parties

The Complainant is La-Roche Posay Laboratoire Dermatologique, having its office at Avenue René Levayer, 86270, La-Roche Posay, France. The Complainant has initiated the Complaint vide their authorized representatives, Dreyfus & associés, with their address at 78, avenue Raymond Poincaré, 75116, Paris, France.

The Respondent's name is Huzaifa Shoukat with their address at Kotli Pain, Mansehra, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <larocheposay.pk>, hereinafter referred to as the Disputed Domain Name [the DDN"]. Vide email dated 05 September 2024, PKNIC has informed DNDRC that the DDN is registered by Huzaifa Shoukat with the contact's name Huzaifa Shoukat, with their address at Kotli Pain, Mansehra, Pakistan.

3. Procedural History

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainant on 24 July 2024 after which DNDRC completed its compliance review.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 07 September 2024 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. The Respondent submitted the response form to DNDRC via email on 09 September 2024.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*), DNDRC appointed Mr. Willayat Ali Shah as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

Factual Background

The domain name upon which the Complaint is based is <larocheposay.pk>.

PKNIC has confirmed via their email dated 05 September 2024 that the DDN was registered by the Respondent above-named and that the email address provided at the time of registration of the DDN is huzaifashoukat5@gmail.com.

4. Parties Contentions

1. Complainant

The Complainant's brief contentions are reproduced below:

Complainant is La Roche-Posay Laboratoire Pharmaceutique, the French company specialized in the field of cosmetics and beauty. Founded 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. With beginnings tracing back to the 1400s, the life-changing thermal spring water at the heart of its story has made a real clinical impact for well over six centuries and continues its treatment of skin conditions today (Annex 3).

Headquartered in Avenue René Levayer 86270 La Roche-Posay France, Complainant is present in 150 countries and has 86,000 employees (Annex 3).

The high-tech dermatological brand prides itself on safety, expertise, ethics and rigorous testing. The formulation charter for each La Roche-Posay product goes far beyond international cosmetics regulations. La Roche-Posay is strict because they care, and embark on each step of the development process with precision and efficacy. Always backed by the ever-developing advancements in dermatological research.

The fruit of the marriage of thermal water with prodigious virtues with the expertise of specialists in sensitive skin, the La Roche-Posay Dermatological Laboratory has today become a privileged partner of 25,000 dermatologists around the world. A true community resulting from 40 years of a relationship which goes well beyond a daily support in the care of sensitive skin. Collaboration in exclusive clinical studies, pooling of dermatological expertise, contribution to continuing education and solidarity actions (Annex 3).

La Roche-Posay is the number 1 dermo cosmetic brand worldwide, recommended by 90,000 dermatologists. Driven by values of courage, commitment and love, they partner with dermatologists and experts to design innovative skincare solutions for the most fragile skin and be useful to people (Annex 3).

La Roche-Posay has been pioneering dermatology since its creation in 1975, working in close partnership with dermatologists. The brand conducted more than 600 clinical studies on 90,000 patients, from newborns to 104-year-olds, of different ethnicities and varied skin pathologies (acne, allergic skin, eczema, under cancer treatment, wounds, post-esthetic treatment, etc.) (Annex 3).

Complainant's efforts to resolve this matter amicably

Complainant became aware of Respondent's registration of the domain name <larocheposay.pk>, which reproduces Complainant's trademark LA ROCHE POSAY in its entirety, and does not associate it with any generic term that could reduce the risk of confusion. On the contrary, the composition of the domain name and the mere addition of the extension ".pk" can mislead Internet users into believing the disputed domain name is endorsed by Complainant or that it will direct them to the official website promoting Complainant's products intended for the Pakistani market.

Since its detection, the domain name has been directing to a fake e-commerce website in English where Complainant's products are being sold without any authorization. This fraudulent website creates a false impression that it is officially associated with LA ROCHE POSAY, thereby misleading consumers (Annex 1).

Before starting the present proceeding, Complainant made some efforts to resolve this matter amicably.

Complainant sent a blocking request to the registrar, on June 19, 2024. In addition, Complainant also addressed a notification to the hosting company requesting a deactivation of the fraudulent website. However, the hosting never replied despite several reminder and the registry advised initiating a dispute (Annex 6).

Having exhausted all the resources available, and considering Respondent's details are not disclosed, Complainant has not been able to conclude the case in a satisfactory manner.

As no amicable settlement could be found, despite Complainant's best efforts, Complainant had no other choice but to initiate an DNDRC procedure against Respondent based on the infringing nature of the domain name in order to obtain the transfer of the disputed domain name.

Therefore, the Complainant seeks the following remedy:

The Complainant requests the Administrative Panel appointed in this administrative proceeding that the domain name <larocheposay.pk> be transferred to the Complainant.

2. Respondent

The Respondent has contended:

Respondent, Huzaira Shoukat, submits this Response to the Complaint filed by LA ROCHE-POSAY LABORATOIRE DERMATOLOGIQUE ("Complainant") concerning the domain name larocheposay.pk. Respondent respectfully requests that the Administrative Panel deny the Complaint in its entirety and find that the Respondent has not engaged in any cybersquatting or bad faith registration or use of the disputed domain name.

Therefore, the Respondent seeks the following remedy:

The Respondent respectfully requests that the Administrative Panel reject the Complaint in its entirety and find that the Respondent has not engaged in any cybersquatting or bad faith registration or use of the disputed domain name larocheposay to consider the following:

- *The Complainant has not demonstrated that their trademarks are well-known or recognized in Pakistan, the relevant market for the .pk domain.*
- *The addition of the .pk ccTLD significantly distinguishes the disputed domain name from the Complainant's trademarks, reducing the likelihood of confusion.*
- *The Respondent has a legitimate interest in using the domain name for informational and educational purposes related to skincare and dermatological health.*
- *The Respondent registered and is using the disputed domain name in good faith, without any intention of capitalizing on the Complainant's reputation or goodwill.*

5. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the Internet Domain Registration Policy version 4.4 (2019-08-19) and the Rules.

The Respondent applied for and was granted registration of the DDNs on the basis of these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

6. Discussion and Findings

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf), the Panel laid down the following four heads under which to analyze cases, under the Internet Domain Registration Policy version 4.4 (2019-08-19) and the UDRP:

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006 version 4.1 in addition to the criteria of the UDRP)*
2. *Identical or confusing similarity to a trademark or service mark in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

The decision of the dispute shall be addressed with respect to the following aspects:

- i. Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) criteria).
- ii. Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).
- iii. Legitimate interest in the domain name (a UDRP criteria).
- iv. Registration and use of the domain name in bad faith (a UDRP criteria).

I. Illegality, unlawfulness or otherwise invalidity of the Application & Registration

The PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) states that it creates an exception for, and thus excludes the registration of a domain name that:

- a. *infringes upon a registered tradename,*

- b. is not bona fide as recognized by international best practice,
- c. in the opinion of PKNIC, a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,
- d. has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or
- e. in the opinion of PKNIC is not appropriate for registration.

As per the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19),

If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name is not bona fide as recognized by international best practice, and is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, PKNIC reserves the right to cancel, or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Therefore, for the purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the Disputed Domain Names, the application and registration of the DDNs shall be assessed in consideration of the following criteria:

- i. Whether the DDNs infringes upon a registered trade name / trade mark?
- ii. Whether the application and/or registration of the DDNs is bona fide?
- iii. Whether the application and/or registration of the DDNs contravenes the Pakistan Penal Code, 1860 (the “Penal Code”) or any applicable criminal law?

The Complainant has not submitted any contention regarding illegality, unlawfulness or otherwise invalidity of the Application & Registration of the DDN.

The Respondent has subsequently not submitted a response regarding illegality, unlawfulness or otherwise invalidity of the Application & Registration of the DDN.

It is sufficient, for the purposes of satisfying this criterion, to prove that the DDN is infringing on the registered trademark of the Complainant. In this context, the Panel notes that the Complainant has claimed confusing similarity of the DDN with their registered trademark but has failed to present evidence that establishes the infringement of their trademark rights.

The lack of submission in this regard suggests that the information is insufficient for the purposes of satisfying this criterion. Therefore, the Panel finds it imperative to evaluate each of the three UDRP criteria to determine whether the Complaint can be accepted.

II. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights

The Complainant has contended the following:

Complainant and its trademark MICHELIN enjoy a worldwide reputation. Complainant owns numerous MICHELIN trademark registrations around the world.

*Complainant is in particular the owner of the following MICHELIN Trademark applications and registrations (**Annex 4**):*

- *Pakistani Trademark application “LA ROCHE POSAY” No. 647773, dated January 17, 2022 and covering goods in class 3;*
- *International Trademark application “LA ROCHE POSAY” No. 787605, dated July 12, 2002, duly renewed, covering goods in classes 3 and 5 and designating, inter alia, Australia, Montenegro, China, Singapore, Republic of Korea and Japan;*
- *International Trademark application “LA ROCHE POSAY” No. 1533143, dated April 24, 2020, covering goods in classes 3 and 5 and designating, inter alia, Brazil, Australia, China, Republic of Korea, Thailand and Vietnam;*
- *International Trademark application “ LA ROCHE-POSAY LABORATOIRE DERMATOLOGIQUE” No. 1281149, dated October 14, 2015, covering goods in class 3 and designating, inter alia, Australia, China, Japan, Singapore and Vietnam.*

*In addition, Complainant operates, among others, the following domain name reflecting its trademark in order to promote its services (**Annex 5**):*

- *<laroche-posay.com > registered on registered on October 21, 1996.*

The disputed domain name <larocheposay.pk> is virtually identical to Complainant's prior trademarks LA ROCHE POSAY.

Indeed, the disputed domain name reproduces in its entirety Complainant's trademark LA ROCHE POSAY. In many WIPO decisions, Panels considered that the incorporation of a well-known trademark in its entirety may be sufficient to establish that the domain name is identical or confusingly similar to a complainant's trademark (WIPO Case No. D2019-0553, Compagnie Générale des Etablissements Michelin v. World Industrial, LNQ, WIPO Case No. D2018-2331, Compagnie Générale des Etablissements Michelin v. Kanoksak Puangkhram, WIPO Case No. D2017-0234, Compagnie Générale des Etablissements Michelin v. WhoisGuard, Inc., WhoisGuard Protected / Saad Zaeem, Caramel Tech Studios, WIPO Case No. D2014-1240, Compagnie Générale des Etablissements Michelin v. Oncu, Ibrahim Gonullu, WIPO Case No. D2013-1418, Compagnie Générale des Etablissements Michelin (Michelin) v. Zhichao Yang, WIPO Case No. D2012-0634, Compagnie Générale des Etablissements Michelin v. Milan Kovac/Privacy--Protect.org, WIPO Case No. D2012-0384, Compagnie Générale des Etablissements Michelin v. Vyacheslav Nechaev and WIPO Case No. D2015-1671 Compagnie Générale des Etablissements Michelin v. Transure Enterprise Ltd, Host Master / Above.com Domain Privacy, Compagnie Générale des Etablissements Michelin v. Cameron David Jackson).

Additionally, in many WIPO decisions, it is well established that "Where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark" (WIPO Case No. D2011-1627, L'Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang, WIPO Case No. D2010-1059, Rapidshare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin and WIPO Case No. D2000-0113, The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc.). See section 1.7 of the WIPO Jurisprudential Overview 3.0.

Furthermore, the structure of the domain name <larocheposay.pk> enhances the false impression that this domain name is somehow officially related to Complainant, as it may be perceived as the official domain name differing only in the extension. Indeed, the disputed domain name is likely to confuse Internet users into believing that the domain name will direct them to the official website or to a page providing information on Complainant's products and services intended for the Pakistani market.

*Complainant has used the trademark MICHELIN in connection with specific products around the world (**Annexes 3 and 4**), including in Pakistan. Consequently, the public has learnt to perceive the goods offered under this trademark as being those of Complainant. Therefore, the public would reasonably assume that the disputed domain name would be owned by Complainant or at least assume that it is endorsed by or in other way related to Complainant.*

The ccTLD <.pk> is insufficient to distinguish the disputed domain name from Complainant's trademarks. Complainant's trademarks are the most prominent part of the disputed domain name and the <.pk> indication is not distinctive.

The extension “.pk” or any other gTLD or ccTLD is not to be taken into consideration when examining the identity or similarity between Complainant’s trademarks and the disputed domain name.

It is well established that the addition of the TLD suffix does not affect the likelihood of confusion merely because it is necessary for the registration of the domain name itself (WIPO Case No. DTV2011-0003, IndiaMART InterMESH Limited v. Personal, Manoj Nair/WhoisGuard and WIPO Case No. D2011-0775, L’Oréal v. Guowei Hai Gui).

Further, the disputed domain name incorporates Complainant’s trademark in its entirety, followed only by the country code top level domain (“ccTLD”) for Pakistan, “.pk”. This addition does not render the disputed domain name distinctive from the Complainant’s trademark. This is likely to increase the likelihood of confusion for Internet users who may wrongly believe the disputed domain name correspond to a website of Complainant. Prior cases have held that the incorporation of an ISO or ccTLD code is a non-distinctive element, which does not avoid confusing similarity (WIPO Case No. D2010-1965, LEGO Juris A/S v. pcmianiabg, Paisiy Aleksandrov). Many Panels have held that TLD suffix fails to distinguish the disputed domain name from Complainant’s mark (WIPO Case No. DCO2010-0033, Oceaneering International Inc. v. Sumer Kolcak).

Accordingly, by registering said domain name, Respondent has created a likelihood of confusion with Complainant’s trademark. It is likely that the domain name could mislead Internet users into thinking that it is, in some way, associated with Complainant.

For all of the above-mentioned reasons, the domain name in dispute is confusingly similar to the trademark LA ROCHE POSAY in which the Complainant has rights, and therefore the condition of Paragraph 4(a)(i) is fulfilled.

The Respondent has contended the following:

The Complainant’s argument rests heavily on the assertion that the disputed domain name is identical or confusingly similar to their trademarks. However, the Complainant has not provided sufficient evidence to demonstrate that their trademarks are well-known or recognized in Pakistan, the relevant market for the .pk domain.

Furthermore, the addition of the .pk country code top-level domain (ccTLD) to the disputed domain name significantly distinguishes it from the Complainant’s trademarks. The .pk ccTLD clearly indicates a connection to Pakistan, whereas the Complainant’s trademarks are associated with their international presence. This distinction reduces the likelihood of confusion among internet users.

The Panel has reviewed the submissions of the Complainant and the Respondent:

The Complainant has proven their rights in the registered trademark “LA ROCHE POSAY” by providing sufficient evidence of registrations in various jurisdictions around the world including an active application in Pakistan. The Panel must now assess whether the DDN <larocheposay.pk> is confusingly similar to the "LA ROCHE POSAY" trademark.

The Complainant contends that the inclusion of their trademark in its entirety in the DDN makes it sufficient to establish a confusing similarity with the trademark and cites various WIPO decisions for the purpose. The Panel agrees with the principle established by the Panels in the cited cases and affirms that the inclusion of the “LA ROCHE POSAY” trademark of the complainant in its entirety in the Respondent’s DDN <larocheposay.pk> makes it sufficient to establish the criterion of confusing similarity.

The Complainant further refers to the inclusion of the .pk ccTLD does not avoid the finding of confusing similarity between the trademark and the DDN and provides multiple WIPO references whereas the Respondent counters that the ccTLD indeed distinguishes the DDN from the Complainant’s trademark however fails to provide a legal basis for the assertion.

The Panel reviewed the precedent set in WIPO Case No. DTV2011-0003, *IndiaMART InterMESH Limited v. Personal, Manoj Nair/WhoisGuard* and WIPO Case No. D2011-0775, *L’Oréal v. Guowei Hai Gui*, as submitted by the Complainant and acknowledges the well-established principle laid down in these, as well as in earlier WIPO decisions that inclusion of a TLD suffix is not a ground to establish a distinction between a registered trademark and the DDN therefore a finding of confusing similarity cannot be negated (Also see *H. Lundbeck A/S v. Bkanggara Windarti, My Store* WIPO Case No. D2024-2000)

Based on the assessment above, the Panel concludes that the DDN is confusingly similar to a trademark in which the Complainant holds rights.

III. Legitimate interests in a domain name

As per paragraph 4(c), the UDRP requires the Respondent’s claim to be of legitimate interest and shall be:

“proved based on all evidence presented” that “shall demonstrate” the Respondent’s “rights or legitimate interests to the domain name for purposes of [Paragraph 4\(a\)\(ii\)](#). ”

Paragraph 4(a)(ii) states that:

“(i) before any notice to you of the dispute, your 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; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial 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:

*Respondent is neither affiliated with Complainant in any way nor has it been authorized by Complainant to use and register its trademark, or to seek registration of any domain name incorporating said trademark. Furthermore, Respondent cannot claim prior rights or legitimate interest in the domain name, as the LA ROCHE POSAY trademarks precede the registration of the disputed domain name for years (**Annexes 1 and 4**).*

*Respondent is not commonly known by the disputed domain name or the name “LA ROCHE POSAY”, in accordance with paragraph 4(c)(ii) of the Policy. There is simply no evidence that Respondent may be commonly known by the name LA ROCHE POSAY (**Annex 1**).*

The domain name <larocheposay.pk> is virtually identical to the Complainant’s trademark that Respondent cannot reasonably pretend it was intending to develop a legitimate activity through the disputed domain name. Panels have found that “domain names identical to a Complainant’s trademark carry a high risk of implied affiliation”. The adjunction of the extension “.pk” increases the risk of confusion since Internet users are likely to believe that the said domain name will direct them to the official website providing information on Complainant’s products intended for the Pakistani market (See section 2.5.1 of the WIPO Jurisprudential Overview 3.0).

Respondent cannot assert that, before any notice of this dispute, it was using, or had made 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, in accordance with paragraph 4I(i) of the Policy. As mentioned, the disputed domain name, which incorporates Complainant’s trademark in its entirety, directs to a fake website reproducing Complainant’s trademark, logo and visuals, and offering cosmetic products at low prices, under the name of La Roche Posay, creating in that way a false affiliation with Complainant. In addition, the fraudulent page is falsely presenting itself as La Roche Posay’s partner in Pakistan in the section “About us” without any authorization. Due to the presence Complainant’s logo on the website, Internet users were likely to wrongly believe this is an

official website (**Annex 1**). Indeed, this cannot be considered as a use of the domain name in connection with a bona fide offering of goods and services.

Such imitation of Complainant's websites cannot provide Respondent with rights or legitimate interests over the domain name (WIPO Case No. D2010-0746, Birkenstock Orthopädie GmbH & Co KG v. Chen Yanbing).

Consequently, Respondent fails to show any intention of non-commercial or fair use of the disputed domain names. It is most likely to be believed that Respondent has no legitimate interest or rights in the said domain name.

In previous decisions, Panels found that in the absence of any license or permission from the Complainant to use such widely-known trademarks, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed (WIPO Case No. D2010-0138, LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master).

Finally, given Complainant's goodwill and renown worldwide, and the nature of the disputed domain name, which is virtually identical to Complainant's trademark, it is not possible to conceive a plausible circumstance in which Respondent could legitimately use the disputed domain name, as it would invariably result in misleading diversion and taking unfair advantage of Complainant's rights.

For all of the above-cited reasons, it is undoubtedly established that Respondent has no rights or legitimate interests in respect to the domain name in dispute under Paragraph 4(a)(ii) of the Policy.

The Respondent has contended the following:

The Respondent registered the disputed domain name with the intention of creating a website dedicated to providing information and resources about skincare and dermatological health. The use of the term "larocheposay" in the domain name is purely descriptive and refers to the general topic of skincare, not specifically to the Complainant's products or brand. The Respondent has a legitimate interest in using the domain name for this purpose.

The Panel has reviewed the submissions of the Complainant and the Respondent:

The Panel initially notes that the Complainant has established a prima facie case of the Respondent lacking legitimate interest in the DDN where the burden of proof shifts on the Respondent to demonstrate otherwise. If the Respondent fails to do so, the complainant is deemed to have satisfied the second element (See *MicroBilt Corporation v. Greg J Michalko* Case No. D2024-2212).

The Panel further acknowledges that legitimate rights in the DDN can be proved if either one of the three criteria are met by the Respondent which includes the use of the DDN for bonafide offering of goods and services, Respondent being commonly known by the DDN or Respondent making a legitimate non-commercial use of the DDN according to Paragraph 4(a)(ii) of UDRP.

The Complainant contends that the Respondent lacks authorization to use their registered trademarks on the website therefore the Respondents lack legitimate interest in the DDN thereby establishing a prima facie case against the Respondent and shifting the burden of proof from themselves. The Respondent argues the presence of a legitimate interest in the DDN by terming it as purely descriptive in nature and is being used to provide information and resources about skincare.

The Panel has reviewed the WIPO Case No. D2010-0746, *Birkenstock Orthopädie GmbH & Co KG v. Chen Yanbing* and WIPO Case No. D2010-0138, *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, as cited by the Complainant and agrees with the decisions of the previous Panels. The failure of the Respondent to address the issue of authorization with relation to the use of trademarks upholds the contention of the Complainant that the trademarks are being used without right. Therefore, the Respondent's unauthorized use of the Complainant's trademark itself excludes the Respondent from claiming any bona fide offering of goods or legitimate interests in the DDN.

Moreover, the Panel finds no evidence that suggests the recognition of the Respondent with the DDN that they have registered and actively have control over. Alternatively, the evidence provided by the Complainant demonstrates that the Respondent is exploiting the Complainant's established trademark to mislead customers rather than being known by or legitimately associated with the DDN themselves.

Consequently, the Complainant has made a prima facie case that the Respondent has no rights or legitimate interests in the domain name and the Respondent failed to meet the burden shifted upon them.

The Panel therefore finds that the Respondent does not have any legitimate interest in the DDN.

IV. Registration and use in bad faith

The Complainant has made the following submission:

Paragraph 4(a) (iii) of the Policy requires Complainant to prove that Respondent registered and used the disputed domain name in bad faith.

1) Registration in bad faith

Bad faith can be found where Respondent “knew or should have known” of Complainant’s trademark rights and, nevertheless registered a domain name in which it had no rights or legitimate interest (WIPO Case No. D2009-0320, Research In Motion Limited v. Privacy Locked LLC/Nat Collicot; WIPO Case No. D2009-0113, The Gap, Inc. v. Deng Youqian).

It is implausible that Respondent was unaware of Complainant when it registered the disputed domain name.

*Firstly, Complainant is well-known throughout the world (**Annex 3**). In this regard, many panels have previously acknowledged Complainant’s reputation worldwide, making it unlikely that Respondent was not aware of Complainant’s rights in said trademark (WIPO Case No. D2019-0553, Compagnie Générale des Etablissements Michelin v. World Industrial, LNQ, WIPO Case No. D2018-2331, Compagnie Générale des Etablissements Michelin v. Kanoksak Puangkham, WIPO Case No. D2017-0234, Compagnie Générale des Etablissements Michelin v. WhoisGuard, Inc., WhoisGuard Protected / Saad Zaeem, Caramel Tech Studios, WIPO Case No. D2014-1240, Compagnie Générale des Etablissements Michelin v. Oncu, Ibrahim Gonullu).*

Secondly, the composition of the domain name <larocheposay.pk>, which entirely reproduces Complainant’s trademark LA ROCHE POSAY, which is a highly distinctive and widely recognized mark, confirms that the Respondent was aware of Complainant and its trademark and its official domain name <laroche-posay.com>. It clearly demonstrates that Respondent registered the disputed domain name based on the attractiveness of the Complainant’s trademark to divert internet traffic to its website. Prior panels have held that bad faith can be found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith (WIPO Case No. D2013-0091, LEGO Juris A/S v. store24hour; WIPO Case No. D2008-0226, Lancôme Parfums et Beauté & Cie, L’Oréal v. 10 Selling; WIPO Case No. D2006-0464, Caixa D’Estalvis I Pensions de Barcelona (“La Caixa”) v. Eric Adam). Given the reputation of the LA ROCHE POSAY trademark, registration in bad faith can be inferred.

*Thirdly, Complainant’s LA ROCHE POSAY trademark registrations significantly predate the registration date of the disputed domain name (**Annexes 1 and 4**). In this regard, previous Panels have established that knowledge of Complainant’s intellectual property rights, including trademarks, at the time of registration of the disputed domain name proves bad faith registration (WIPO Case No. D2008-0287, Alstom v. Domain Investments LLC, WIPO Case No. D2007-0077, NBC Universal Inc. v. Szk.com).*

Under Section 2 of the ICANN Policy, it is established that when someone registers a domain name, he represents and warrants to the registrar that, to his knowledge, the registration of the domain name will not infringe the rights of any third party. It means that it was Registrant's duty to verify that the registration of the disputed domain name would not infringe the rights of any third party before registering said domain name (WIPO Case No. D2009-0901, Compagnie Gervais Danone contre Gueorgui Dimitrov / NETART; WIPO Case No. D2002 0806, Carolina Herrera, Ltd. v. Alberto Rincon Garcia; WIPO Case No. D2000 1397, Nike, Inc. v. B.B. de Boer).

A quick "LA ROCHE POSAY" trademark search would have revealed to Respondent the existence of Complainant and its trademark. Respondent's failure to do so is a contributory factor to its bad faith (WIPO Case No. D2008-0226, Lancôme Parfums et Beauté & Cie, L'Oréal v. 10 Selling).

Even supposing that Respondent was not aware of the possibility of searching trademarks online before registering a domain name, a simple search via Google or any other search engine using the keyword "LA ROCHE POSAY" demonstrates that all first results relate to Complainant's products or news (Annex 7).

In this day and age of the Internet and advancement in information technology, the reputation of brands and trademarks transcends national borders. Taking into account the worldwide reputation of Complainant and its trademark, as well as the high level of notoriety of Complainant, it is hard to believe that Respondent was unaware of the existence of Complainant and its trademark at the time of registration of the disputed domain name. It is most likely to be believed that Respondent registered the domain name <larocheposay.pk> based on the notoriety and attractiveness of the Complainant's trademark to divert internet traffic to its fraudulent website.

Furthermore, Respondent registered domain name hiding their identity and contact details, thus, preventing Complainant from contacting them. Prior panels confirmed that a deliberate concealment of identity and contact information may in itself indicate registration in bad faith (WIPO Case No. D2012-0729, Schering Corporation v. Name Redacted and WIPO Case No. D2001-0725, TTT Moneycorp Limited. v. Diverse Communications).

Finally, Complainant submits that given Complainant's goodwill and renown, and the nature of the disputed domain name, Respondent could simply not have chosen the domain name <larocheposay.pk> for any reason other than to deliberately cause confusion amongst Internet users as to its source in order to take unfair advantage of Complainant's goodwill and reputation, which clearly constitutes bad faith.

Hence, in view of the above-mentioned circumstances, it is inconceivable that Respondent did not have Complainant's trademark in mind at the time of registration of the disputed domain name.

Consequently, it is established that Respondent registered the disputed domain name in bad faith.

2) Use in bad faith

Some elements may be put forward to support the finding that Respondent also uses the domain name in bad faith.

Previous Panels have considered that in the absence of any license or permission from Complainant to use such widely known trademark, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed (WIPO Case No. D2000-0055, Guerlain S.A. v. Peikang, WIPO Case N° D2008-0281, Alstom, Bouygues v. Webmaster).

It is submitted that Respondent is using the disputed domain name to intentionally attract Internet users to their website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of the services offered on the Respondent's website, in accordance with paragraph 4(b)(iv) of the Policy.

The disputed domain name <larocheposay.pk> is virtually identical or at least confusingly similar to Complainant's trademark LA ROCHE POSAY, 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 to Respondent's site" (WIPO Case No. D2012-1765, MasterCard International Incorporated ("MasterCard") v. Wavepass AS; WIPO Case No. D2006-1095, Edmunds.com, Inc. v. Triple E Holdings Limited).

As mentioned above, the disputed domain name resolves towards a website imitating Complainant's logo and visuals without any authorization and offering its products for sale. On the top of that, it seems therefore that the registrant is trying to impersonate Complainant and trick its consumers into believing this domain name is official, probably to retrieve confidential information such as bank details.

The fraudulent website, configured on this domain name, also displays a false information/presentation about "La Roche Posay" brand, misleading in that way Internet users into believing they are operated by Complainant or that the official partner in Pakistan, which presents a high security risk to its customers (**Annex 1**).

It is more likely than not, that Respondent's primary motive in registering and using the disputed domain name was to capitalize on or otherwise take advantage of Complainant's trademark rights, through the creation of initial interest of confusion.

Here, it should be noted that:

- Complainant and its trademark LA ROCHE POSAY have a strong reputation and are widely known throughout the world (**Annexes 3 and 4**);
- In view of the notoriety of Complainant, no possible use in good faith is conceivable;
- Respondent has not provided any evidence of actual or contemplated use in good faith of the disputed domain name.

Finally, given Complainant's goodwill and renown worldwide, and the nature of the disputed domain name, which is virtually identical to Complainant's trademark, it is not possible to conceive a plausible circumstance in which Respondent could legitimately use the disputed domain name, as it would invariably result in misleading diversion and taking unfair advantage of Complainant's rights.

All aforementioned circumstances confirm that the disputed domain name is used in bad faith.

Consequently, it is established that the Respondent both registered and used the disputed domain name in bad faith in accordance with Paragraph 4(a)(iii) of the Policy.

The Respondent has made the following submissions:

The Respondent categorically denies any bad faith in the registration and use of the disputed domain name. The Respondent was not aware of the Complainant's trademarks at the time of registration and had no intention of capitalizing on the Complainant's reputation or goodwill. The Respondent's intended use of the domain name is for informational and educational purposes, not for any commercial or deceptive activities.

The Panel has reviewed the submissions of the Complainant and the Respondent.

The Panel initially acknowledges the global recognition of the Complainant's "LA ROCHE POSAY" trademark particularly, in relation to its skincare products. At the outset, the recognition of the Complainant's mark makes it highly unlikely for the Respondent to be unaware of the existence of the mark at the time of the registration of the DDN. Therefore, the Complainant claims that the Respondent has deliberately registered the DDN despite being aware of the trademark to mislead customers to their website.

The Panel has reviewed WIPO Case No. D2019-0553, *Compagnie Générale des Etablissements Michelin v. World Industrial, LNQ*, WIPO Case No. D2018-2331, *Compagnie Générale des Etablissements Michelin v. Kanoksak Puangkham*, WIPO Case No. D2017-0234, *Compagnie Générale des Etablissements Michelin v. WhoisGuard, Inc., WhoisGuard Protected / Saad Zaeem, Caramel Tech Studios*, WIPO Case No. D2014-1240, *Compagnie Générale des Etablissements Michelin v. Oncu, Ibrahim Gonullu* cited by the Complainant and agrees the unlikelihood of the

Respondent not being aware of the Complainant's trademark at the time of registration. Moreover, the Respondent's claim of not being aware of the trademark without sufficient justification serves no legal purpose and proves an indication of registration in bad faith on part of the Respondent.

The Panel acknowledges the finding of bad faith where the Respondent has asserted the composition of the DDN <larocheposay.pk> to be purely descriptive but fails to provide any justification for the origination or the meaning of the said term therefore the very fact that the DDN is similar to the registered trademark of Complainant indicates the finding of bad faith.

The Panel further finds the presence of bad faith on the basis that the Respondent tried to create a likelihood of confusion of the Complainant's trademark with the DDN to capitalize on its reputation and the goodwill by misleading users for commercial benefit (See *Fenix International Limited v. Host Master, 1337 Services LLC* Case No. D2023-1050)

The Panel, therefore, finds that the DDN was registered and is being used in bad faith by the Respondent.

7. Decision

The Panel, upon the review of the information provided by the Complainant, recognizes that the "LA ROCHE POSAY" mark is registered to the Complainant and Respondent has no legitimate rights over it. The continuous use of the DDN purporting to the Complainant's registered trademark could seriously hinder the exercise of the rights of the Complainant in the trademark and could also jeopardize the reputation of the Complainant by amounting to confusion regarding the ownership of the DDN.

Taking all the discussion above into consideration, the Panel concludes and decides that:

1. The Respondent's registration of the DDNs does not violate the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19);
2. The DDN is confusingly similar to the registered trademark of the Complainant;
3. The Respondent does not have a legitimate interest in the DDN;
4. The DDN was registered and is being used in bad faith.

Pursuant to Section 4 of the Policy, the Panel, therefore, recommends that PKNIC transfer the registration of the domain name in dispute <larocheposay.pk> to the Complainant, as prayed, within 48 hours of receipt of this decision either by email or through the website where it will be

uploaded, www.dndrc.com/cases_resolved/, whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Willayat Ali Shah

Sole Panelist

Date: 26 October 2024