



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1701053
Complainant 1:	GALDERMA S.A.
Complainant 2:	Nestlé Skin Health S.A.
Respondent 1:	wujianping (吴建平)
Respondent 2:	putianshi youlemidianzishangwuyouxiangongsi
Disputed Domain Name(s):	< CETAPHILCN.COM > & < CETAPHILSHOP.COM >

1. The Parties and Contested Domain Name

The First Complainant is GALADERMA S.A., of Zugerstrasse 8 CH-6330 CHAM, Switzerland.

The Second Complainant is Nestlé Skin Health S.A. of Avenue Gratta-Paille 2, 1018 Lausanne, Switzerland.

The First Respondent is wujianping (吴建平) of Cheng Xiang Qu Xue Yuan Zhong Lu 1156 Hao, Pu Tian Guang Xi, 351100, CN

The Second Respondent is putianshi youlemidianzishangwuyouxiangongsi of Hai Dian Qu, Beijing 100000, CN

The domain names at issue are < CETAPHILCN.COM > registered by Respondent 1 with OURDOMAINS LIMITED (“Registrar 1”) and < CETAPHILSHOP.COM > registered by Respondent 2 with IAPI GMBH (“Registrar 2”).

2. Procedural History

On 12 December 2017, the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC-HK”). On the same day, the ADNDRC-HK confirmed receipt of the Complaint and requested the Complainant to submit the case filing fee.

On 12 December 2017, the ADNDRC-HK notified Registrar 1 of the Disputed Domain Name of the proceedings by email. On the same day, Registrar 1 acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with OURDOMAINS LIMITED (“Registrar 1”), that wujianping (吴建平) is the holder of the Disputed Domain Name, that the Internet Corporation for Assigned Names and Numbers

Uniform Domain Name Dispute Resolution Policy (“the Policy”) is applicable to the Disputed Domain Name, the language of the Disputed Domain Name is Chinese as provided by the WHOIS information in relation to the Disputed Domain Name and confirmed that the Disputed Domain Name is under Registrar lock status.

On 12 December 2017, the ADNDRC-HK notified Registrar 2 of the Disputed Domain Name of the proceedings by email. On 14 December 2017, Registrar 2 acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with 1API GMBH (“Registrar 2”), that putianshi youlemidianzishangwuyouxiangongsi is the holder of the Disputed Domain Name, that the Internet Corporation for Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy (“the Policy”) is applicable to the Disputed Domain Name, the language of the Disputed Domain Name is English as provided by the WHOIS information in relation to the Disputed Domain Name and confirmed that the Disputed Domain Name is under Registrar lock status.

On 22 December 2017, the ADNDRC-HK sent a Written Notice of Complaint (“Notification”), together with the Complaint, to the email address of Respondent 1 and Respondent 2’s nominated registrant contacts for the Disputed Domain Name (as recorded in the WHOIS database). The Notification gave the respondents twenty (20) calendar days to file a Response (i.e. on or before 11 January 2018).

The Panel comprising of Dr. Shahla F. Ali as a single panelist was appointed by the ADNDRC-HK on 16 January 2018. The papers pertaining to the case were delivered to the Panel by email on the same day.

3. Factual background

The Complainants contend that the 1st Complainant was incorporated in 1981 and has nearly 36 years of history. The 1st Complainant was originally a joint venture established by Nestlé S.A. and L’Oréal S.A. However, since July 2014, the 1st Complainant has become wholly owned and managed by Nestlé Skin Health S.A. (i.e. the 2nd Complainant), the subsidiary of Nestlé S.A. Therefore, the 2nd Complainant has become the parent company of the 1st Complainant. The worldwide registered trademarks and/or domain names originally owned by the 1st Complainant have been and/or prepared to be transferred to the 2nd Complainant. In this regard, part of the registered “Cetaphil” marks are owned by the 1st Complainant and some are owned by the 2nd Complainant.

The Complainants further contend that the 1st Complainant mainly engages in the business of research and manufacturing of skin care products and has enjoyed a high level of reputation in the fields of cosmetics, skin care/pharmaceutical globally. The products of the 1st Complainant are distributed in more than 100 countries. Currently, the 1st Complainant has established 35 affiliates in major countries over the 5 continents in the world; has established 6 manufacturing sites in France, Canada, Sweden, Switzerland, Germany and Brazil; and has established 5 Research & Development centers in France, Canada, Sweden, Switzerland, Germany and Brazil. The 1st Complainant and its group company employ around 6,000 employees in the world. The annual turnover of the 1st Complainant exceeded US\$2.0 billion and US\$2.2 billion in the financial year of 2014 and 2015 respectively and US\$2.47 billion in 2016.

According to the Complaint, “CETAPHIL” is the trademark/ trade name of the 1st Complainant with respect to one of its skin care product series and the corresponding Simplified Chinese version of “CETAPHIL” is “丝塔芙”. The history of the 1st Complainant’s “CETAPHIL” trademark and products can be traced back to 1947 when a pharmacist discovered the formula for skin care during experiment. The mark “CETAPHIL” has been used in the U.S. since 15 February 1950. In 2014, 2015 and 2016 the worldwide annual sales of “Cetaphil” products were US\$433 million and US\$465 million and US\$487 million respectively. “CETAPHIL” products have also won countless prizes and beauty awards.

Furthermore, according to the Complaint, the 1st Complainant’s “CETAPHIL” (丝塔芙) products entered the China market (the location and principal place of business of the Respondent) in 2004. The 1st Complainant signed a distribution agreement with “Profex (Hong Kong) Limited” for the purpose of marketing and distributing “CETAPHIL” (丝塔芙) products in China through “Shanghai Bai Run Pharmaceutical Technology Company Limited” and “Profex Trading (Shanghai) Company Limited”. In February 2014, the 1st Complainant officially authorized its subsidiary Galderma Trading (Shanghai) Co. Ltd. as the exclusive distributor of “CETAPHIL” (丝塔芙) products in China and the sole authorized entity to use or license the use of “CETAPHIL” (丝塔芙) trademarks of the Complainants within China. On October 1, 2017, Galderma Trading (Shanghai) Co. Ltd., with the authorization of 1st Complainant, assigned the distribution of “CETAPHIL” (丝塔芙) products to Q-Med International Trading (Shanghai) Co. Ltd., another subsidiary.

The Complainants note that with the continuous efforts by the 1st Complainant, coupled with numerous sales channels through pharmaceutical-cosmetics chain stores, cosmetics shops, pharmacies and top retail e-commerce platforms in China (such as Tmall.com (天猫), Amazon, yihaodian.com, Vipshop), “CETAPHIL” (丝塔芙) products have received wide support from general consumers in China and “CETAPHIL” (丝塔芙) has become a well-known brand in the fields of skin care products in China. In 2014, 2015, and 2016 the annual sales of “Cetaphil” products in China were US\$23 million, US\$32 million and US\$26 million respectively.

The Respondents, wujianping (吴建平) and putianshi youlemidianzishangwuyouxiangongsi registered the disputed domain names on 23 May 2015 and 12 January 2016 respectively. The Respondents did not file a Reply with the ADNDRC-HK.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainants claims that it owns trademark rights in the “CETAPHIL” trademark in 100 countries and regions, including but not limited to the United States, China, Canada, Australia, Germany, France, Italy, Spain, Russia, Portugal, the United Kingdom, various member states of the European Union, Vietnam,

Japan, Taiwan, Singapore and Hong Kong. The registrations of the “CETAPHIL” marks cover the classification of goods and services, including but not limited to Classes 3 and 5.

The Complainants further submit that the registration of the Disputed Domain Names respectively took place on 23 May 2015 and 12 January 2016, a much later time than the registration dates of most of the “CETAPHIL” marks owned by the 1st Complainant and the 2nd Complainant.

Further, the Complainants note that in China, the location or principal place of business where the Respondent or his/her related organization are situated, the 1st Complainant obtained protection under its “CETAPHIL” mark in China in Class 3 as early as in 1990. Furthermore, the 1st Complainant registered the corresponding Simplified Chinese version of “CETAPHIL” —“丝塔芙” in 2012.

The Complainants claim that the identifiable portion of the Disputed Domain Names 1 and 2 is “cetaphil” which is identical or confusingly similar to the aforementioned goods or service marks owned by the Complainants.

In particular, for Disputed Domain Name 1: CETAPHILCN.COM, the Complainants contend that the portion of “.com” in the Disputed Domain Name 1 merely refers to the gTLD domain and should not be taken into account. The word “cetaphilcn” is not an ordinary word but a concatenation of two words “cetaphil” and “cn”. Since the word “cn” is the abbreviation of China, it is merely a descriptive general word indicating the location and principal place of business of the Respondent 1 and is not distinctive. Therefore the identifiable portion of the Disputed Domain Name 1 is “cetaphil”, which is identical or confusingly similar to the aforementioned goods or service marks owned by the Complainants.

For Disputed Domain Name 2: CETAPHILSHOP.COM, the Complainants contend that the portion of “.com” in the Disputed Domain Name 2 merely refers to the gTLD domain and should not be taken into account. The word “cetaphilshop” is not an ordinary word but a concatenation of two words “cetaphil” and “shop”. The word “shop” is merely a descriptive general word and not distinctive. Therefore, the identifiable portion of the Disputed Domain Name 2 is “cetaphil”, which is identical or confusingly similar to the aforementioned goods or service marks owned by the Complainants.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name:

The Complainants claim that the Disputed Domain Names were registered on 23 May 2015 and 12 January 2016, long after the registration dates of most of the “CETAPHIL” marks owned by the 1st Complainant and the 2nd Complainant (registered as early as 1991). It contends that its CETAPHIL trademarks have acquired significant online recognition worldwide including in Asia where the Respondents are located. Furthermore, the Complainants note that the Respondents are not subsidiaries of the Complainants and have no association with the Complainants. The Complainants have never authorized or otherwise permitted the Respondents to register or use the Disputed Domain Names and the Complainants’ trademarks. The Respondents are not related to the Disputed Domain Names. The Complainants’ proprietary trademark searches of the Respondents against the

official database of the PRC Trademark Office have not revealed any trademark applications/registrations which correspond or relate to the Disputed Domain Names in China.

iii. The disputed domain name has been registered and is being used in bad faith:

The Complainants claim that bad faith can be shown by the incorporation of the Complainant's well known trademark in its entirety in the Disputed Domain Names and the use of such Disputed Domains to offer for sale suspected Cetaphil products.

Specifically, the Complainants claim that the Respondents registered the Disputed Domain Names without having any rights or legitimate interests in the Disputed Domain Names. By using the Disputed Domain Names, the Respondents respectively created a “丝塔芙中国官网 (“Cetaphil Chinese official website” in Chinese) | 丝塔芙官网旗舰店 (“Cetaphil official online flagship shop” in Chinese)” website (the “Disputed Website 1”) and a “丝塔芙官网 (“Cetaphil official website” in Chinese) website (the “Disputed Website 2”) (collectively the “Disputed Websites”). The Respondents intentionally attempted to attract, for commercial gain, Internet users to visit the Disputed Websites thus creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of the Disputed Websites.

Further, the Complainants claim that printouts of the Disputed Website 1 and the Disputed Website 2 dated 8 October 2017 show that the Dispute Websites are online sales platforms, selling products suspected to be the products of Cetaphil. In addition, the Complainants claim that the website layout and content intentionally imitate the Complainants' Chinese official website of Cetaphil, including the use of the registered trademarks of the Complainants “丝塔芙” and “Cetaphil” in order to create confusion and mislead Internet users in believing that the Disputed Websites are in fact the official website of Cetaphil or have an official connection with Cetaphil and inducing Internet users to visit the Disputed Websites.

Finally, the Complainants claim that given that the Respondents appeared to be engaging in the business of selling products suspected to be Cetaphil products (which bear the Cetaphil trademark, trade name and logos of the Complainants) and the Complainants are the registrant of the “CETAPHIL” trademarks and domain names incorporating the mark “CETAPHIL”; it would be inconceivable for the Respondents to argue that the Respondents were unaware of the Complainants and the mark “CETAPHIL” at the time the Disputed Domain Names were registered. Accordingly, the Respondents ought to have known about the wide-spread reputation of the Complainants in the field of skin care products at the time of registering for the Disputed Domain Names.

B. Respondents

The Respondent's contentions may be summarized as follows:

The Respondents did not submit a reply.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

Preliminary Issues: Identity of Respondent and Language of Proceedings

Prior to the Panels consideration of the application of Paragraph 4(a) of ICANN's Uniform Domain Name Dispute Resolution Policy to the facts in this case, two preliminary issues must be addressed: 1) the identity of the respondents and 2) the language of the proceedings.

With respect to the first issue, the identity of the respondents, the Complainants request that the Panel proceed with a single Complaint issued to wujianping (吴建平) and putianshi youlemidianzishangwuyouxiangongsi as a single Respondent. According to the registration information provided by the concerned Registrar, the name of the registrant(s) of < CETAPHILCN.COM > and < CETAPHILSHOP.COM > are wujianping (吴建平) and putianshi youlemidianzishangwuyouxiangongsi respectively.

More specifically, in accordance with a WHOIS database search against the Disputed Domain Name 1, i.e. CETAPHILCN.COM, as of 8 October 2017, the registrant of the Disputed Domain Name 1 is "wujianping (吴建平)" ("Respondent 1") and the registrant organization of the Disputed Domain Name 1 is "putianshiyoulemidianzishangwuyouxiangongsi". Furthermore, in accordance with the WHOIS database search against the Disputed Domain Name 2, i.e. CETAPHILSHOP.COM, as of 8 October 2017, the registrant and registrant organization of the Disputed Domain Name 2 is "putianshi youlemidianzishangwuyouxiangongsi" ("Respondent 2"). Based on these WHOIS database searches, the registrant organization of the Disputed Domain Name 1, and the registrant and registrant organization of the Disputed Domain Name 2 are the same entity. In addition, according to the Complainant a further company search of National Enterprise Credit Information Publicity System against the Respondent 2 as of 9 October 2017 revealed that the legal representative and shareholder of Respondent 2 is "吴建平", i.e. Respondent 1.

Based on review of the relevant evidence, the Panel is of the view that Respondent 1 and Respondent 2 (collectively "Respondents") are the same or related entities. Therefore, the Panel will proceed on the basis of a single Complaint issued to wujianping (吴建平) and putianshi youlemidianzishangwuyouxiangongsi as a single Respondent.

With regard to the second issue, the language of the proceedings, according to Article 11(a) of the UDRP Rules, "Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

While the Panel observes that the language of the registration agreements of Respondent 1 and 2 are Chinese and English respectively, in accordance with the Rules of UDRP, the Panel has the authority to determine the language of the proceedings, having regard to the circumstances. Having reviewed the Complainants submission, and given the above determination that wujianping (吴建平) and putianshi youlemidianzishangwu youxiangongsi are to be regarded as a single Respondent, for reasons of efficiency the Panel thus determines that the language of the proceedings is English.

A) Identical / Confusingly Similar

The Complainants have established its right to the “CETAPHIL” trademarks by submitting trademark registration certificates and records in a number of jurisdictions including in the United States, Europe and Mainland China. The disputed domain names <CETAPHILCN.COM> and <CETAPHILSHOP.COM> contain three elements: "CETAPHIL" and “CN” and “SHOP” and finally top-level domain "com". Numerous UDRP precedents have established that the top-level domain does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. Similarly, “CN” and “SHOP” are not a distinctive words and are merely descriptive. The addition of these terms do nothing to minimise the risk of confusion. There is a long line of authorities on the UDRP which make it clear that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

The only distinctive part of the disputed domain should be "CETAPHIL", which is identical to the Complainant's "CETAPHIL" trademark and trade name. This striking resemblance will no doubt mislead consumers into believing that the website is operated by or associated with the Complainant. There is no doubt that the Disputed Domain Names <CETAPHILCN.COM> and <CETAPHILSHOP.COM> completely incorporate the Complainant's “CETAPHIL” trademark which is the distinctive part of the Disputed Domain Names, and such incorporation makes the Disputed Domain Names confusingly similar with the Complainant's trademark.

In conclusion, the Panel finds that the Complainants have satisfied the Paragraph 4(a)(i).

B) Rights and Legitimate Interests

As the owner of the “CETAPHIL” trademarks, the Complainants have confirmed that they have no prior connection with the Respondents in any way, nor have they authorized the Respondents to use its trademarks in the Disputed Domain Names.

In determining whether the Respondents have any legal right and interest in the Disputed Domain Names, the mere registration of the Disputed Domain Name by the Respondent itself is not sufficient to prove that it owns legal rights and interests thereof; otherwise, “all registrants would have such rights or interests, and no complainant could succeed on a claim of abusive registration” - See: Adobe Systems Incorporated v. Domain OZ, WIPO Case No.: D2000-0057.

In the present case, the Respondents failed to provide evidence indicating that they have been commonly known by the Disputed Domain Name, nor any evidence that they have been making a legitimate noncommercial or fair use thereof.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(ii).

C) Bad Faith

In determining whether the Respondents have registered or used the Disputed Domain Names in bad faith, paragraph 4(b) of the Policy sets down four (4) factors which the Panel will need to examine. The four (4) factors are as follows:

“Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

Given the extensive reputation of CETAPHIL in Asia and worldwide, the Respondents must have been aware of the Complainants' prior rights and interest in the Disputed Domain Names given the Complainants' reputation in the mark “CETAPHIL” as of the date that the Respondents registered the Disputed Domain Names.

According to the evidence provided by the Complainants, the Respondents respectively created a “丝塔芙中国官网 (“Cetaphil Chinese official website” in Chinese) | 丝塔芙官网旗舰店 (“Cetaphil official online flagship shop” in Chinese)” website (the “Disputed Website 1”) and a “丝塔芙官网 (“Cetaphil official website” in Chinese) website (the “Disputed Website 2”). The Respondents intentionally attempted to attract, for commercial gain, Internet users to visit the Disputed Websites thus creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of the Disputed Websites.

Further, the Complainants show through that printouts of the Disputed Website 1 and the Disputed Website 2 dated 8 October 2017 that the Disputed Websites are online sales platforms, selling products suspected to be the products of Cetaphil. In addition, the Complainants demonstrate that the website layout and content intentionally imitates the Complainants' Chinese official website of Cetaphil, including the use of the registered trademarks of the Complainants “丝塔芙” and “Cetaphil” in order to create confusion and mislead Internet users in believing that the Disputed Websites are in fact the official website of Cetaphil or have an official connection with Cetaphil and inducing Internet users to visit the Disputed Websites.

No evidence has been provided showing that the Respondents sought the permission of the Complainants to use its mark, nor any evidence showing that the Complainants gave such permission to the Respondents.

Given the above findings, the Panel is of the view that the Respondent registered and used the contested domain name in bad faith.

6. Decision

Pursuant to Paragraph 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain names <CETAPHILCN.COM> and <CETAPHILSHOP.COM> be transferred to the Second Complainant.

/s/ Shahla F. Ali

Dr. Shahla F. Ali
Panelist

Dated: 29 January 2018