

DISPUTE RESOLUTION SERVICE

D00012710

Decision of Independent Expert

L'Oréal SA

and

Sharon Meenagh

1. The Parties:

Complainant:

L'Oréal SA
14 Rue Royale
Paris
Ile de France
75008
France

Respondent:

Sharon Meenagh
3892 Murphy Rd.
Arlington
Virginia
22205
United States of America

2. The Domain Name:

mia2clarisonic.co.uk

3. Procedural History:

12 April 2013 11:55 Dispute received
12 April 2013 12:02 Complaint validated
12 April 2013 12:12 Notification of complaint sent to parties
02 May 2013 02:30 Response reminder sent
07 May 2013 11:00 No Response Received
07 May 2013 11:00 Notification of no response sent to parties
09 May 2013 10:59 Expert decision payment received

On 25 May 2013 the Expert made a statement to the Nominet Dispute Resolution Service in the following terms:

'I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.'

4. Factual Background

The Complainant, L'Oreal SA, is a well-known and established business operating in the cosmetic and beauty sector. In December 2011 it purchased Pacific Bioscience Laboratories, Inc. One of the products developed and marketed by Pacific Bioscience Laboratories, Inc. was the Clarisonic Mia 2, which is a sonic skin cleaning device. The Complainant markets the Clarisonic Mia 2 through various distribution channels, including on-line through its portfolio of domain names.

The Respondent, Sharon Meenagh, registered the Domain Name on 6 December 2012. There is very little information about the Respondent contained within the papers as she did not file a response.

The Complainant applied for a full decision, notwithstanding the absence of a response, presumably because it wanted a reasoned decision.

5. Parties' Contentions

The Complainant

First element - Rights

The Complainant, L'Oréal SA, is one of the world's largest companies in the field of cosmetic and beauty and the worldwide leader of this sector. The Complainant markets various beauty products (i.e. hair colour, skin care, sun protection, make-up, perfumes and hair care ones) and is also active in the dermatological and pharmaceutical fields.

The Complainant has a presence in over 130 countries with more than 25 global brands (including L'OREAL, GARNIER, MAYBELLINE and KERASTASE) which are used in connection with consumer, luxury and professional cosmetic and beauty products.

The Complainant's products are marketed through a wide variety of distribution channels, from hair salons and perfumeries to supermarkets, health/beauty outlets, pharmacies and direct mail.

The Complainant acquired Pacific Bioscience Laboratories Inc. and its trade mark CLARISONIC, the market leader in the areas of skin cleansing devices and technology, via a merger agreement on 15 December 2011 and such trade mark soon became one of the leading brands of the Complainant's luxury product division.

The Complainant directly, or through its subsidiary company Pacific Bioscience Laboratories Inc., is the owner of numerous national trade mark registrations for CLARISONIC, secured in the United Kingdom, in the European Union and in many national jurisdictions worldwide. Pacific Bioscience Laboratories Inc has issued a Power Of Attorney to L'Oréal SA, which demonstrates the Complainant's standing to act on their behalf.

The CLARISONIC products were created by a team of scientists and engineers in Seattle in 2004 and are patented with more than 40 registrations. They were launched in the USA by Pacific Bioscience Laboratories Inc. in 2004, initially in the professional market (mainly spa owners and physicians) and then in the consumer market. The consumer line of products includes the Clarisonic Sonic Skin Cleansing System, which is available in Classic, PLUS, Mia, Mia 2 and Aria models

The Complainant operates within an extensive sales network consisting of close to 69,000 employees in 130 countries and, to provide some figures indicative of the volumes of CLARISONIC products present in the market, the sales metrics were about \$200 million at the end of 2012.

CLARISONIC also enjoys a well-known reputation as demonstrated by the many awards that the products have received over the years, including the Best Beauty Gadget in the Cosmopolitan Beauty Awards 2011 and 2012, the Best New Appliance in the UK Beauty Awards 2011, the Best Cleansing Tool in 2011 and the Best Beauty Gadget in 2012 in the Harpers Bazaar Beauty Hot 100, the Best Gadget in Woman & Home, Best in Beauty 2011 and 2012 and the Best New Gadget in the InStyle Best Beauty Buys 2012.

The trade mark CLARISONIC is strongly supported by global advertising campaigns through television and other media such as international magazines with broad circulation, including Vanity Fair, Elle, Cosmopolitan, People and Marie Claire.

The CLARISONIC products have wide media coverage, as demonstrated by the various advertisements and articles that have appeared on different

magazines and newspapers reviewing the products, and they have enjoyed widespread appreciation also amongst famous personalities such as Oprah Winfrey, Lady Gaga, Madonna, Liv Tyler, Gwyneth Paltrow, Courteney Cox, Cameron Diaz, Mary J. Blige and Demi Moore.

Besides the traditional advertising channels, CLARISONIC has also been widely promoted via the Internet, in particular with a strong presence on-line through the most popular social media with channels and pages specifically dedicated to CLARISONIC, i.e. on Facebook, Twitter and YouTube.

The Complainant has long been involved in a series of various social commitments and, with regard to CLARISONIC products, since 2010 it has supported the American Cancer Society Look Good/Feel Better campaign, becoming the largest corporate financial donor in the Program's history, with the sponsorship of high profile events and promotions, organization of social media campaigns and donations of more than \$2 million, from sales of specially designated pink products, to fight breast cancer and to increase awareness and patient participation.

In light of the Complainant's significant investments in R&D, marketing, sales and distribution channels, as well as the existence of a truly impressive client base for these products, CLARISONIC is undisputedly a famous and well-known trade mark worldwide, including in the UK, in the field of sonic skin care.

In order to further protect its trade marks on the Internet, the Complainant has registered numerous domain names worldwide consisting of, or comprising, the word CLARISONIC (including variations thereof); the list of domain names registered by the Complainant and its subsidiaries under the different TLDs includes <clarisonic.com>, <clarisonic.co.uk>, <clarisonic.cn>, <clarisonic.fr>, <clarisonic.us> and <clarisonic.it>.

The Complainant's principal web site regarding the CLARISONIC brand, where products are advertised and offered for sale, is www.clarisonic.com.

Second element – Abusive Registration

The Domain Name is confusingly similar to the trade marks in which the Complainant has rights and is also identical to the name of the product CLARISONIC MIA 2 of skin care devices marketed by the Complainant.

The Domain Name incorporates the whole of the Complainant's trade mark with the addition of MIA 2 and, by combining CLARISONIC with the name of one of the Complainant's models of skin care devices, clearly enhances the likelihood that Internet users will expect that the Domain Name was registered or authorized by the Complainant and is related to the promotion of the Complainant's products, which amounts to 'initial interest confusion'.

It should be noted that CLARISONIC is a word with no meaning in foreign languages and, as such, is not one traders would legitimately choose unless seeking to create an impression of an association with the Complainant.

The Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (paragraph 3 (a)(ii) of the Policy) and primarily for the purpose of unfairly disrupting the business of the Complainant (paragraph 3 (a)(i)(C) of the Policy).

It is likely that Internet users could be misled as to the source, sponsorship or affiliation of the Respondent's activity through the use of the web site.

The Respondent registered <mia2clarisonic.co.uk > on 6 December 2012 without authorization of the Complainant and the Domain Name is redirected to the web site <http://www.miaclarisonicuk.co.uk/> displaying, in absence of any authorization, CLARISONIC trade marks and official images and offering for sale unauthorized discounted products bearing the trademark CLARISONIC.

The Respondent is not a licensee, an authorized agent of the Complainant or in any other way authorized to use the Complainant's trade mark CLARISONIC. The Respondent is not commonly known by the name or legitimately connected with the mark as an individual, business or other organization and CLARISONIC is not the family name of the Respondent.

There is no disclaimer of non affiliation with the Complainant and there is a clear attempt to blatantly impersonate the Complainant by copying the look and feel of the Complainant's official web sites (via the reproduction of the same colours, font and layout) and through the content and statements displayed thereon, including in the 'About Us' and 'Privacy Policy' sections, where the story about CLARISONIC's origins and formulating statements are made as if the web site is managed by the Complainant's subsidiary.

Furthermore, *prima facie* counterfeit products bearing CLARISONIC marks are offered for sale. The Complainant highlights that neither the name of the company nor any contact information is published on the web site and that the products are offered at very low prices, which suggests that they are likely to be counterfeit. The prices at which the products are offered for sale on the web site to which the Domain Name is redirected are, in fact, cheaper than the prices of the original products: for example, the same product named 'Clarisonic MIA 2 Sonic Skin Cleansing System', whose official price is £125.00, is offered for sale on the web site <http://www.miaclarisonicuk.co.uk> at £159.99 but discounted to £97.99.

The Complainant's authorized representative sent via e-mail a Cease and Desist letter to the attention of the Respondent requesting her to immediately deactivate the web site and to transfer the Domain Name. In the absence of any reply from the Respondent to the Cease & Desist letter, a subsequent reminder was sent to her on 7 February 2013. The Respondent did not reply.

Furthermore, the Complainant's authorized representative ascertained that the registered address indicated in the WHOIS by the Respondent, i.e. 3892 Murphy Rd. Arlington, Virginia 22205, United States, is false as *prima facie* no Murphy Rd exists in Arlington, Virginia. Under paragraph 3(a)(iv) of the Policy, the fact that the Respondent has given false contact details for the registration of a domain name may be evidence that the Domain Name is an Abusive Registration.

The Complainant seeks a transfer of the Domain Name.

The Respondent

The Respondent did not file a response.

6. Discussions and Findings

General

In order for the Complainant to succeed it must prove to the Expert, on the balance of probabilities, that:

'it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.'

Rights

The meaning of 'Rights' is defined in the Policy in the following terms:

'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.'

In the absence of a response, there is no challenge to the Complainant's case on Rights but the Expert still needs to be satisfied, on the balance of probabilities, that the Complainant has rights as defined in the Policy. For these purposes, it is permissible for the Expert to ignore the '.co.uk' top level domain identifier.

The Complainant's case is that it has the benefit of registered and unregistered rights in the mark CLARISONIC which is similar to the Domain Name. The Complainant also contends that the Domain Name is identical to the name of a skin care product that it markets under the name CLARISONIC MIA 2.

The evidence produced by the Complainant establishes the following:

- The Complainant, which trades as L'Oreal, is a well-known and established business operating in the cosmetic and beauty sector with an extensive portfolio of branded products, considerable geographical reach and substantial sales volumes.
- In 2004 Pacific Bioscience Laboratories, Inc. launched a line of skin cleaning products under the name CLARISONIC. The product range includes the Clarisonic Sonic Skin Cleaning System, which is available in various models including the MIA and MIA 2.
- Since 2004 Pacific Bioscience Laboratories, Inc. has applied for and obtained a number of trade mark registrations for the word mark CLARISONIC.
- On 15 December 2011 the Complainant acquired Pacific Bioscience Laboratories, Inc., its range of products and the trade mark registrations for the mark CLARISONIC. Pacific Bioscience Laboratories, Inc. now operates as a subsidiary of the Complainant.
- The Complainant markets the Clarisonic Mia 2 product through various distribution channels, including on-line.

Whilst the Complainant has not produced a copy of the agreement by which it acquired Pacific Bioscience Laboratories, Inc. it has produced a copy of a declaration dated 26 November 2012 from Pacific Bioscience Laboratories, Inc. authorising the Complainant to act on behalf of the trade mark owner in relation to the mark CLARISONIC.

The Expert is satisfied that the Complainant has registered rights in the word CLARISONIC which is a wholly distinctive word as it has no ordinary English meaning. The Expert is also satisfied that the Complainant has unregistered rights in the marks CLARISONIC and CLARISONIC MIA 2. For the purposes of establishing an enforceable right in an unregistered mark, the Complainant needs to show that it has used the mark and that the mark is relied upon to identify the origin of the goods. The Complainant has produced promotional material showing that the CLARISONIC MIA 2 product is marketed through various distribution channels, including on-line.

The Domain Name consists of the Complainant's distinctive registered trade mark preceded by the phrase MIA2. The addition of the phrase MIA2 does nothing to distinguish the Domain Name from the Complainant's registered trade mark; indeed, given that MIA 2 is associated in the public mind as the name of one of the Complainant's products, it re-enforces the association with the Complainant. The only difference between the Domain Name and the Complainant's unregistered mark CLARISONIC MIA 2 is the juxtaposition of the words within the word combination.

The Expert is satisfied that the Complainant has (i) registered and unregistered rights in the mark CLARISONIC which is similar to the Domain Name and (ii) unregistered rights in the product brand CLARISONIC MIA 2 which, save for the order of the words, is identical to the Domain Name. Accordingly, the Complainant has satisfied the Rights test set out in the Policy. The Complainant has clearly established that it has a *bona fide* basis for making the complaint.

Abusive Registration

An Abusive Registration is defined in the Policy as follows:

Abusive Registration means a Domain Name which either:

was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors, which may be evidence of an Abusive Registration, is set out in paragraph 3 of the Policy. A non-exhaustive list of factors, which may be evidence that the Domain Name is not an Abusive Registration, is set out at paragraph 4 of the Policy.

The Complainant makes specific reference to a number of factors set out in paragraph 3 of the Policy, including paragraph 3(a)(ii), which provides:

'Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant';

The Complainant does not put its case on the basis that actual confusion has taken place and there is no evidence to justify such a finding. The Complainant's case is that confusion is likely to occur and the Complainant has identified a number of features that it says supports that case, as follows:

- The Domain Name incorporates the Complainant's registered trade mark CLARISONIC, which is a word with no meaning in foreign languages.
- The Domain Name is identical to the name of the product CLARISONIC MIA2 which is marketed by the Complainant.
- There is nothing to suggest that the Respondent had a legitimate reason for registering the Domain Name. The Respondent's name is Sharon Meenagh and there is no evidence to suggest that the

Respondent is commonly known by, or legitimately connected to, the name CLARISONIC.

- The Respondent is not a licensee, an authorised agent or, in any other way, authorised to use the trade mark CLARISONIC.
- The Domain Name pointed to a web site that offered products for sale under the name CLARISONIC.
- There has been a clear attempt to 'blatantly impersonate' the Complainant by copying the look and feel of the Complainant's official web site by reproduction of the same colours, font and layout.

The meaning of paragraph 3(a)(ii) is considered in the Experts' Overview, which confirms that the 'confusion' referred to in this context is confusion as to the identity of the entity behind the domain name and it poses the following question:

'Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that "the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant"?'

The Domain Name

The adoption of a domain name incorporating a complainant's mark can, of itself, create the false impression that there is some form of commercial connection between the parties. This is the concept of 'initial interest confusion' and it has been established, in a number of DRS cases, that it is an admissible species of confusion. Clearly, it is most likely where the domain name is identical to the name or mark of the complainant and without any adornment.

On the facts of this case, the Domain Name is, save for the order of the words, identical to the Complainant's product CLARISONIC MIA 2. Given the highly distinctive nature of the words used it could not sensibly refer to anyone other than the Complainant. The Respondent has not put forward an explanation but it is difficult to conceive of an explanation other than the Respondent set out to exploit the risk of confusion in the hope that Internet users would be 'sucked in' by the Domain Name.

Accordingly, the answer to the question posed in the Experts' Overview above is plainly yes. The confusion is likely to arise, irrespective of the content of the web site, merely as a result of the adoption of the Complainant's trade mark and product descriptor in the Domain Name. On that basis, the Expert is satisfied that the Respondent has taken unfair advantage of the Complainant's rights.

Use of the Domain Name

Having drawn the visitor to the site, the visitor is faced with a commercial web site, which advertises products using the Complainant's name. The web site has a very similar look and feel to the Complainant's own web site in terms of the colours and fonts that have been used as well the layout of the web pages. The web site does not accurately disclose the Respondent's relationship with the Complainant and indeed it makes a number of representations to suggest that it is an official site.

The 'About Us' page on the web site contains the following text:

'Meet the company behind Clarisonic

At Pacific Bioscience Laboratories, we have a passion for bringing great new ideas to life. Our mission is to develop and market technically advanced and clinically proven products that make a clear difference in skin care.

With Clarisonic, we aim to revolutionize skin care in the same way sonic technology forever changed how millions care for their teeth and gums. Pacific Bioscience Laboratories was established by scientists, engineers, and the primary inventor of the Sonicare toothbrush, one of the best-selling sonic-based consumer products of all time.'

The words and punctuation that have been used are identical to those used on the 'About Clarisonic' page of the Complainant's own web site. Indeed, it appears to be a blatant case of copyright infringement. There are several other instances where the impression is given, through the language that has been used, that it is an official web site.

The appeal panel in the case of DRS 7991 <toshiba-laptop-battery.co.uk> summarised the principles that apply in cases where the respondent is acting as a re-seller of the complainant's goods, as follows:

'1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.

2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.

3. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.

4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the respondent's website.'

The use of a web site, which has been designed to impersonate the Complainant's official web site, to promote products under the name

CLARISONIC is unfair as it clearly designed to imply some form of official connection to the Complainant.

The Complainant invites the Expert to accept that the products offered on the web site are likely to be counterfeit. Clearly, if that can be established that the web site is being used to offer counterfeit goods that would be a further ground for a finding of Abusive Registration. It would damage the distinctiveness of the trade mark and therefore cause damage to the Complainant and it would be sufficient for a finding under paragraph 3(a)(i)C which provides:

‘Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant;’

As the DRS Procedure makes clear, it is for the Expert to determine the admissibility, relevance, materiality and weight of the evidence. There is no direct evidence that the goods being offered are counterfeit and the Complainant’s case is put on the basis that one can infer that is the case from a combination of other factors.

The Complainant relies upon the fact that the web site does not identify the company behind it, there are no contact details and the products are offered at very low prices. The Complainant has produced a screen shot from the web site which promotes CLARISONIC MIA 2 at a regular price of £159.99 which has been discounted to a special price of £97.99. The Complainant says the official price on its web site is £125.00. The Complainant has also produced a cease and desist letter to the Respondent dated 28 January 2013 and a further letter dated 7 February 2013 to which it says it received no response.

The evidence relied upon by the Complainant is admissible and relevant but the question is whether it is of sufficient weight to prove or render it probable to the required standard that the goods are counterfeit. The burden of proof is on the Complainant and the standard of proof is on the balance of probabilities, which has been described in civil cases as ‘more probable than not’.

The narrative of this case is that the Respondent, with no obvious connection to the Complainant, decided to register a domain name that adopted the name of the Complainant’s product. The Respondent changed the order of the words but in all other respects the Domain Name and product name are identical. The Respondent declined to identify herself, or accurately describe the true nature of her relationship with the Complainant, on the web site. Indeed, to the extent that there was any attempt to describe the nature of that relationship – whether that was through words used or the look and feel of the web site - it was entirely misleading as it was designed to imply there was an official connection to the Complainant. In at least one section, the Respondent has simply copied an entire passage of text from the Complainant’s own web site. The Respondent then used the web site to

promote products under the Complainant's name at substantial discounts compared to the 'official' price. The Respondent has had several opportunities to provide an explanation for her conduct but has failed to do so, most recently by failing to file a response in these proceedings.

Weighed up all of the above factors, the Expert is of the view that the evidence is of sufficient weight to render it more probable than not that the goods were counterfeit. This is another ground upon which the Expert finds that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Finally, the Complainant says that its authorised representative ascertained that the registered address given for the Respondent is false as *prima facie* there is no Murphy Road in Arlington, Virginia. The Complainant seeks to rely upon this to support a finding under paragraph 3(a)(iv) of the Policy, which provides:

'It is independently verified that the Respondent has given false contact details to us.'

The Expert is not satisfied that this aspect of the Complainant's case has been made out. There is no independent verification from the third party that the contact details are false.

7. Decision

The Expert finds, on the balance of probabilities, that the Complainant has rights in a mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert directs a transfer of the Domain Name to the Complainant.

Signed: Andrew Clinton

Dated: 04 June 2013