

**ADMINISTRATIVE PANEL DECISION**  
**IN THE MATTER OF A DOMAIN NAME DISPUTE**

**BETWEEN**

**NAOS**

**... COMPLAINANT**

**AND**

**RELAX BEAUTY HOUSE**

**... RESPONDENT**

**CASE NO. KLRCA/DNDR-507-2017**

**A. Parties**

1. The Complainant, NAOS is a company limited by shares in France with an address at 355 rue Pierre-Simon Laplace, Aix-en-Provence, 13290, France ("**Complainant**"). The Complainant is represented by Tak & Associates, Taiwan.
  
2. The Respondent, RELAX BEAUTY HOUSE (Company Registration No. SA0088850-X) [Refer to **Appendix E**] is a company incorporated in Malaysia with an address at 1 Lorong Kirana 1, Taman Kirana, 88200 Kota Kinabalu, Sabah ("**Respondent**"). The Respondent's alternative address is at No.21, 1<sup>st</sup> Floor, Jalan Bacang 17, Jenjarom, Selangor [Refer to **Appendices C & D**]. The Respondent is unrepresented.

## B. Domain Name and Registrar

3. The disputed domain name is <esthederm.com.my> ("**Disputed Domain Name**"). The Registrar of the domain name is the Malaysian Network Information Centre ("**MYNIC**").

## C. Procedural History

4. The Complainant submitted its complaint to the Kuala Lumpur Regional Centre for Arbitration ("**Provider**") on 17.5.2017 ("**Complaint**") pursuant to MYNIC's (.my) Domain Name Dispute Resolution Policy ("**Policy**"), the Rules for MYNIC's (.my) Domain Name Dispute Resolution Policy ("**Rules**") and MYNIC's (.my) Supplemental Rules ("**Supplemental Rules**").
5. In accordance with the Policy and Rule 5.2 of the Rules, the Provider sent the complaint to the Respondent. However, there was no response filed by the Respondent. This was confirmed by the Provider in the email dated 11.9.2017 to me.
6. The Complainant opted to have the dispute decided by a single member panel. Accordingly, the Provider appointed me in accordance with Rule 11 of the Rules by way of the Notification of Appointment of Panel and Projected Decision Date dated 11.9.2017 ("**Notification**").
7. On 28.9.2017, I requested for an extension of time to render my decision under Rule 17 of the Rules. An extension of 5 working days from 2.10.2017 to 9.10.2017 was granted by the Director of KLRC.

## D. Parties' Contentions

### Complainant's Contention

#### *Company's Changes of Names*

8. SA LABORATOIRES ESTHEDERM, a company based in French, merged with SA LABORATOIRE ESTHEDERM INTERNATIONAL and formed SA LABORATOIRE ESTHEDERM INTERNATIONAL.
9. Over the course of time<sup>1</sup>, SA LABORATOIRE ESTHEDERM INTERNATIONAL changed its name to SA INSTITUT ESTHEDERM and subsequently, to INSTITUT ESTHEDERM [Refer to **Appendix F**].

#### *Registration of Trademarks*

10. On 26.10.1990, SA LABORATOIRES ESTHEDERM registered a trademark under the Trade Marks Act 1976 ("Act") (Trademark No. 90006988). The representations of the trademark contain the words "INSTITUT ESTHEDERM" ("**1990 Registered Trademark**").
11. On 3.8.2011, INSTITUT ESTHEDERM registered another trademark (Trademark No. 2011014004) under the Act. The representation of the trademark contains the words "INSTITUT ESTHEDERM PARIS" [Refer to **Appendix G**] ("**2011 Registered Trademark**").
12. On 1.4.2016, the Complainant acquired INSTITUT ESTHEDERM [Refer to **Appendix A**].

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<sup>1</sup> Specific timeline was not provided by the Complainant.

13. On 13.1.2017, the Complainant was recorded as the new proprietor for the 2011 Registered Trademark [Refer to **Appendix G**].

[The 1990 and 2011 Registered Trademarks will be considered together and collectively referred to as the “**Registered Trademark**”.]

### ***Registration and Ownership of Domain Name***

14. The Complainant adduced a search in **Appendix B** which confirms that the Disputed Domain Name <esthederm.com.my> was registered by the Respondent on 27.10.2010 (Registration No. D1A149547).
15. The Complainant then said that it had registered the “same domain name, with a different TLD”, i.e. <esthederm.my>, as early as 24.4.2008 through a local registrant (Registration No. D6A009685) (“**Domain Name 1**”). The search result in **Appendix H** shows that registration of Domain Name 1 was done by one IP Mirror (Malaysia) Sdn. Bhd. (Company Registration No. 551956-K).

### ***Disputed Domain Name Identical or Confusingly Similar to Registered Trademark***

16. The Complainant submitted that confusion exists between the Disputed Domain Name and its Registered Trademark because the Registered Trademark is “highly distinctive” and the Disputed Domain Name is “identical” to it.
17. To prove its exclusivity over the Disputed Domain Name, the Complainant attached a whois record containing available and registered domain names with the word “ESTHEDERM” in them. The Complainant contended that according to the whois record, it has filed for the registration of the domain

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name “ESTHEDERM” throughout the world with 50 or more records, including gTLDs or ccTLDs [Refer to **Appendix I**].

18. The Complainant further submitted that:

18.1. The fact that the Respondent only registered the name “ESTHEDERM” as the Disputed Domain Name, while the Registered Trademark have the words “INSTITUT ESTHEDERM”, does not alter the confusion created by the Respondent toward the general public. The word “INSTITUT” is a common term with no expression of distinctiveness or uniqueness alone;

18.2. The mere adjunction of common terms is not sufficient to avoid any risk of confusion with the trademark. The Complainant relied on the following authorities to support its submission on this point: *Compagnie Gervais Danone v Bruce Roarson* WIPO Case No. D2007-1719; *Institut Meriuex v Ho Nim* WIPO Case No.D2010-0866; *Mudah.my Sdn Bhd v Scalable Systems* Case No. KLRCA/DNDR-239-2014 [Refer to **Appendix J**]; and *Alliance Laundry Systems LLC vs Private Registrations Atkien Gesellschaft* WIPO Case No. D2012-1137 [Refer to **Appendix H**]; and

18.3. The addition of a gTLD (.com) and a ccTLD (.my) is immaterial when determining the identity of similarity between trademarks and domain names. To support this submission, the Complainant relied on the following authority: *Volkswagen Group Singapore Pte Ltd v Webmotion Design* Case No.KLRCA/DNDR/2003/01 (*int*) [Authority not found in the appendices].

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19. The Complainant then adduced two different pieces of evidence to show that the Disputed Domain Name is identical or confusingly similar to the Registered Trademark:

19.1. In **Appendix K**, the Complainant attached a print-out from a Facebook page belonging to the Respondent. In the print-out, the Respondent represented itself to be the distributor of the Complainant;

19.2. In **Appendix L**, the Complainant attached several print-outs from the website with the Disputed Domain Name ("**Respondent's website**"). According to the Complainant, the print-outs showed that the Respondent intended to confuse the general public through its conduct:

(a) The Respondent sells products on the website which are exclusively related to the Complainant;

(b) The Respondent displays the Complainant's logo on all pages of its website;

(c) The Respondent presents itself as the Complainant.

***Disputed Domain Name was Registered or Used in Bad Faith***

20. The Complainant contended that the Respondent has no right or legitimate interest in respect of the Disputed Domain Name as the Respondent was never authorised by the Complainant to register the Disputed Domain Name; nor was the Respondent commonly known as the Disputed Domain Name, or any part thereof.

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21. The Complainant alleged that by presenting itself as the official website of the Complainant, the Respondent's intention was clearly to attempt to attract internet users to gain illegal sponsorship, affiliation or endorsement from the Complainant.
  22. The Complainant further contended that the Respondent intends to make commercial gains, directly or indirectly, as the web pages are about "selling products of the Complainant to consumers".
  23. As an additional point, the Complainant alleged that the Respondent is using the Complainant's Chinese name on the Respondent's Facebook page, as a further display of bad faith [Refer to **Appendix M**]. The Complainant compared and highlighted the similarity between the Complainant's Chinese name on the Respondent's Facebook page and the Complainant's Chinese name as evidenced from print-outs from the Complainant's official Chinese website, Google, Weibo and Sephora.

***Respondent has No Right or Legitimate Interest in the Disputed Domain Name***

24. The Complainant contended that it has never been in a business relationship with the Respondent, nor did it authorise the Respondent to register a domain name identical or similar to the Complainant's name, trademark(s) or domain name(s), particularly the Registered Trademarks.
25. It alleged that by using the Disputed Domain Name, the Respondent has by default closed the Malaysian market to legitimate distributors the Complainant could deliver its products to. In other words, the Respondent's act of using the Disputed Domain Name has disrupted the "Complainant's business" in Malaysia. Unfair competition will result from this, with illegitimate

distributors such as the Respondent gaining advantage over distributorship rights.

26. The Complainant alleged that the Respondent has fraudulently presented itself as the Complainant by using the name "ESTHEDERM" on the website instead of "Relax Beauty House".
27. The Complainant also alleged that some of the products sold on the Respondent's website were not meant to be sold to the mass market and some have already been discontinued, thus creating "a risk for consumers to buy expired products" [Refer to **Appendix N**].

### **Respondent's Contentions**

28. The Respondent did not respond to or answer the Complainant's complaint despite being given the opportunity to do so by the Provider. I have not to date received any response from the Respondent.

### **E. Preliminary Issue**

29. The Complainant drew my attention to the fact that this dispute had been referred to and decided by another Panellist, Ms Karen Abraham, *vide* KLRC/DNDR-427-2016 [Refer to **Appendices T & U**] on 5.1.2017.
30. The learned Panellist in the previous proceedings between the parties in respect of the Dispute Domain Name found that:
  - 30.1. The Respondent had registered a domain name confusingly similar to the Registered Trademark;



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- 30.2. The Respondent had no rights or legitimate interests in the Disputed Domain Name; and
- 30.3. The Respondent had registered the domain name in bad faith.
31. However, the learned Panellist dismissed the claim on the basis that Complainant failed to provide sufficient evidence that it had full rights over the Registered Trademark. Essentially, the learned Panellist found that the transfer of the Registered Trademark from SA LABORATOIRES ESTHEDERM to the Complainant had not been supported by documentary evidence.
32. Given these earlier proceedings, I have considered the issue of *res judicata* and the impact of the earlier proceedings, if any, on the present complaint.
33. Paragraph 17.1 of the Rules state that the "...Panel will decide a Proceeding based on the documents and evidence submitted by the Parties, the Policy and Rules as well as any other rules and *principles of law* which are applied in Malaysia..."
34. *Res judicata*, put simply, is a "principle of law" ordinarily applicable in legal proceedings in Malaysia, which states that if a matter has already been decided by a competent court, parties may not relitigate the matter. In litigation proceedings between two parties, defendant may raise the defence of *res judicata* or issue estoppel or cause of action estoppel in response to an attempt by the plaintiff to relitigate a matter or cause of action.
35. Although *res judicata* is a defence that could have been raised by the Respondent, the Respondent did not do so. In fact as mentioned above, the Respondent has not participated at all in these proceedings.
36. Paragraph 17.1 of the Rules firstly states that I am bound by the documents and evidence submitted by the Parties. It is therefore not for me as the

panellist to advance a defence for the Respondent. For the avoidance of doubt, I do not make any finding or inference on the merits of the possible defence of *res judicata*.

37. Furthermore, paragraph 17.1 of the Rules also states that “for the avoidance of doubt, the decisions of other Panels in previous Proceedings or other domain name dispute cases are not binding precedent and should not be treated as such”. The phrase “decisions of other Panels in previous Proceedings” in this case can be interpreted to include the decision of Ms Karen Abraham, and accordingly, that decision is not binding on me in these present proceedings.
38. I have considered the facts of the matter independently and will now make my finding, together with reasons, and finally make my decision.

## **F. Findings and Reasons**

39. Clause 5 of the Policy states that the Complainant must establish both of the following elements:
- 39.1. The domain name is identical and confusingly similar to a trademark or service mark to which the Complainant has rights; and
- 39.2. The domain name is used in bad faith.

### **Rights and Legitimate Interests in the Domain Name**

40. Upon perusal of the documents provided by the Complainant to me, I am satisfied that the Complainant has established its rights and legitimate interests in the Disputed Domain Name. As evidenced by the documents in **Appendices F and G**, the Complainant has shown how the proprietorship of the Registered Trademark was transferred from SA LABORATOIRE ESTHEDERM

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INTERNATIONAL to SA INSTITUT ESTHEDERM, and subsequently to INSTITUT ESTHEDERM, and ultimately to the Complainant.

41. Significantly, the Respondent has chosen to remain silent and has not challenged the Complainant's rights and legitimate interests in the Domain Name.
42. My decision on this issue differs from that of Ms Karen Abraham, who did not have the benefit of the documents dated 25.1.2017 in **Appendix G**.

### **Identical and Confusingly Similar**

43. Throughout its complaint, the Complainant made references to its "registered trademark" several times. It is unclear which registered trademark was the subject of the Complainant's complaint. The logo for the 1990 Registered Trademark has the stylised words "INSTITUT ESTHEDERM", while the logo for the 2011 Registered Trademark has the stylised words "INSTITUT ESTHEDERM PARIS". Given that the complainant had furnished evidence of both, I assume that it considered both trademarks to have been infringed by the Respondent.
44. Upon closer inspection of the Respondent's website, which, contrary to the complaint, is still live and accessible by the public [refer to **Appendix R**], the stylised word "ESTHEDERM" is present throughout the website.
45. In the print-out from the Respondent's Facebook page, the words "RELAX BEAUTY HOUSE" as well as "INSTITUT ESTHEDERM product from PARIS" are visible. Other words in the printout are in Mandarin characters, which were not translated to either Malay or English in accordance with Rule 13 of the Rules.
46. The Complainant also adduced evidence of it registering a similar domain name in Malaysia, with a different TLD <esterderm.my> through a local

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- registrant, IP Mirror (Malaysia) Sdn. Bhd. as early as 2008. Other than the fact that there is a domain administrator based in France reflected on the search result, there are no other indications that registration of Domain Name 1 was made by the Complainant. Incidentally, I also note that the registration for Domain Name 1 expired on 24.4.2017. The Complainant did not produce any document to show that registration for Domain Name 1 has been renewed. In any event, the Respondent has not disputed that the Complainant as the owner of Domain Name 1.
47. On the issue of whether the Complainant has exclusivity over the Disputed Domain Name, the Complainant contended that it has filed for the registration of the domain name "ESTHEDERM" throughout the world with 50 or more records, including gTLDs or CCTLDs. Upon perusal of the whois record, I do not see any registration number attached to each domain name marked "registered"; nor do I see any indication that it was the Complainant who filed for the registration. If anything, the search is merely a record of available domain names containing the word "ESTHEDERM".
48. The Complainant submitted that although the word "INSTITUT" was omitted from the logo on the Respondent's website, the word "INSTITUT" is a common term with no expression of distinctiveness or uniqueness alone. It added that mere adjunction of common terms is not sufficient to avoid any risk of confusion with the trademark. Furthermore, the addition of a gTLD (".com") and a ccTLD (".my") is immaterial when determining the identity of similarity between trademarks and domain names.
49. I agree with the Complainant on this point. Despite the slight difference in style and words, I find that the word "ESTHEDERM" is unique to the Complainant. The public would naturally associate "ESTHEDERM", with or without the word "INSTITUT" prefixing it, to the Complainant. This is more so when the Respondent's website when compared with the Complainant's

website (<https://www.estheder.com/en/>) shares its likeness, aesthetics and more glaringly, sells the same products.

## **Bad Faith**

50. To prove bad faith, the Complainant contended that:

50.1. The Respondent was never authorised by the Complainant to register the Disputed Domain Name;

50.2. The Respondent is not known by the Disputed Domain Name;

50.3. The Respondent's intention was clearly and attempt to attract internet users to gain illegal sponsorship, affiliation or endorsement from the Complainant;

50.4. The Respondent intends to make commercial gains, directly or indirectly, as the web pages are about "selling products of the Complainant to consumers"; and

50.5. The Respondent is using the Complainant's Chinese name on its Facebook page, thus showing clear evidence of bad faith.

51. Without the benefit of the Respondent's response to the above, I am to take the Complainant's allegation at face value. I am also guided by Paragraph 6 .1 of the Policy which states that:

"6.1 For the purposes of paragraph 5.2(ii), evidence of your registration and/or use of the Domain Name being in bad faith may include, among others, the following circumstances:-

- (i) you registered and/or are using the Domain Name mainly to sell, rent or transfer the Domain Name for profit to the Complainant, its competitor or the owner of the trade mark or service mark; or

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- (ii) you registered and/or are using the Domain Name to prevent the owner of a trade mark or service mark from using the domain name which is identical with its trade mark or service mark; or
  - (iii) you registered and/or are using the Domain Name to disrupt the business of the Complainant; or
  - (iv) you registered and/or are using the Domain Name for the purposes of and with the intention to attract or divert, for commercial gain, Internet users to:-
    - (a) your web site;
    - (b) a web site of the Complainant's competitor; or
    - (c) any other web site and/or online location,  
  
by creating a possibility of confusion or deception that the web site and/or online location is operated or authorised by, or otherwise connected with the Complainant and/or its trade mark or service mark.”

52. From the facts before me, the Complainant has established that it has not authorised the Respondent to be its distributor in Malaysia; nor has it instructed the Respondent to register the Disputed Domain Name. The allegation by the Complainant that the Respondent's act of using the Disputed Domain Name has disrupted the "Complainant's business" in Malaysia was never disputed by the Respondent. It is clear that the Respondent intended to ride on the reputation the Complainant had built as a skin care company from France to gain commercially from the local market. The fact that the website sells similar (and even discontinued) products goes to show that the Respondent had indeed used the Disputed Domain Name in bad faith.
53. Given my findings above, the Complainant's reference and reliance on the Respondent's use of its Chinese name is unnecessary to establish bad faith on the part of the Respondent. In any event, I note that the Complainant's Chinese name is not the subject of any trademark.

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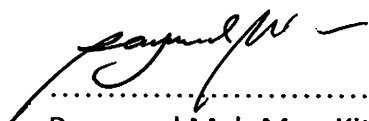
## Decision

54. Based on the facts and evidence before me, my decision is as follows:

54.1. The Disputed Domain Name <www.esthederm.com.my> is identical and confusingly similar to the Complainant's Registered Trademarks (i.e. Trademark Nos. 90006988 and 2011014004);

54.2. The Respondent has used the Disputed Domain Name <www.esthederm.com.my> in bad faith; and

54.3. Accordingly, I direct that the Respondent's ownership of <www.esthederm.com.my> be transferred to the Complainant, as prayed.



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Raymond Mah Mun Kitt  
Sole Panellist  
Date: 9 October 2017