

Case Number: JP2021-0001

PANEL DECISION

1. The Parties

Complainant:

Name: L'occitane International SA, Luxembourg, succursale de Plan-les-Ouates

Domicile: chemin du Pré-Fleuri 5, 1228 Plan-les-Ouates, Switzerland

Registrant:

Name: Ye Li

Domicile: Nanjingxi Rd. 2100, 200000, Shanghai, China

2. The Disputed Domain Name and Remedy Sought

The disputed Domain Name is <erborian.jp>.

The Complainant requests transfer of the disputed Domain Name.

3. Procedural History

As indicated in the Annex attached.

4. Language of the Proceedings

A. Request by the Complainant

The Complaint was filed with the Japan Intellectual Property Arbitration Center (the "Center") on February 16, 2021 as indicated in the Annex. The Complainant asked that the language of the proceedings would be English. The request to change the language of the proceedings was

submitted to the Center by the Complainant on February 16, 2021 (See, Document named “Language of proceedings”). In the request, 6 reasons were pointed out. The 1st, 2nd, and 4th reasons were based upon the grounds that the script of the disputed Domain Name, the country code Top-Level-Domain (“ccTLD”) “.jp” and almost a hundred domain names under the “.jp” ccTLD registered by the Registrant are constituted of Latin words. The 5th reason is that the Registrant has been involved in at least 16 cases before WIPO concerning marks or names pertaining to markets where, to the exception of China, languages making use of the Latin alphabet are used. And the 3rd reason is that the email communications between the Complainant and the Registrant prior to filing this Complaint were written in English and price of Domain Name was discussed in US dollars (See, Complainant’s Evidence 2). It means the Registrant understands English. The 6th reason is that both the Complainant and the Registrant are not Japanese nationals: the Complainant is a French company whereas the Registrant is a Chinese national.

B. Panel’s View of the Principle of the Language

Since the Complainant requested on the language, the Panel should determine whether to accept the request initially, before examining substantive discussion on the Complaint.

Article 11(a) of the Rules clearly defined “The language of the Proceedings is Japanese”, however Article 11(a) of the Rules gives the panel the authority to decide another language as the language of the proceedings based on the circumstances of the proceeding¹. And the “circumstances” to be considered may include the following examples:

- (1) If both parties agree a specific language other than Japanese as the language of the proceedings, basically the agreed language should be accepted when the Center and the Panel could verify accuracy of the documents concerned in the agreed language directly² without any translation. This principle follows Article 30, paragraph 1 of the Arbitration Act. However, if such an agreement designates multiple languages as the language of the proceedings, the Panel should determine a selected single language be the language of the proceedings (one single language for one proceeding) or simply ignore the request, in the Panel’s view.

These agreements should be notified to the Center before the appointment of the Panel, and the Panel should determine the language before starting the examination of substantive discussion, however, whether the Panel should notify the parties of the determination on the language before publication of the decision depends upon the case circumstances. Especially for the Registrant's default case, the Panel may mention about determination on the language of the proceedings only in the decision.

(2) In case of no agreement on language, the Panel should consider:

(a) When one of the parties (usually the Complainant) requests a language other than Japanese, and the other party clearly denied the proposal, the Panel should determine Japanese as the language of the proceedings if the Panel finds no irregular special situations.

(b) When one of the parties (usually the Complainant) requests a language other than Japanese, and the other party has never replied, the Panel considers both parties' situation carefully and determines the language of the proceedings, with taking into consideration of the description of the submitted request. In such a case, the Panel determines, in principle, Japanese as the language of the proceedings unless the Panel finds exceptional circumstances. Since the proceedings are governed by Japanese Law (See, Article 10 of the Policy), then it is natural that the language of the proceedings is also Japanese. In this sense, the case when the language other than Japanese is adopted as the language of the proceedings should be quite exceptional situation only, under the Panel's view. And if the Panel determines the language other than Japanese as the language of the proceedings, it should be fair for both parties, since Article 7 of the Rules stipulates, "A Panelist shall be impartial and independent ...". In particular, if the Registrant does not understand the language designated in the request, adopting such a request should be unfair. In other words, it is desirable for a party who is not the party filing the language change request to have minimum disadvantages such as additional burden with time and/or cost associated with the adoption of a language other than Japanese.

When the Panel considers more about the parties' circumstances, the facts to be considered may include, for example³, (i) language communicated between parties (irrespective of within or outside of the proceeding), (ii) language of previous DRP proceedings (including UDRP or other DRP) which a party other than the party who filed the language change request has experienced, (iii) language for which the parties used in their websites, SNS and other media, (iv) the both parties' permanent address or domicile (in particular, whether a party other than the requesting party is operating (or operated) its business with an active base in Japan), and (v) reasons for the request and reasons for negative response to the request, and other facts. The fact that the parties are not Japanese nationals may not be considered as an important factor in principle, since Japanese nationality is not always linked to whether the parties do not understand Japanese language. The fact that the party is not a Japanese national simply means that it is highly likely that the party has only limited ability to have communication with Japanese language, however, the fact does not directly mean that the designated language is easier for the party to understand. In the language change request, the requesting party should explain both the facts that the other party has limited Japanese communication ability and that the other party has enough ability to have communication with a designated language.

In all cases above, the language change into the language other than Japanese is only allowed in the case which the Center and the Panel can fully verify the accuracy of the decision directly by the adopted language without translation. In addition, the Panel notes that if the request to change the language of the proceedings does not state and explain that the other party can fully understand the language specified in the request, the Panel may simply ignore the request. Also, the Panel may ignore the request to change the language of the proceedings, if it did not designate a single language in its request.

C. Circumstances of this Proceeding

In this case, there is no agreement between parties on the language of the proceedings, and the Complainant requested English as the language of the proceedings, but the Registrant has never

replied. Then this case falls into the case of (2)(b) above. In the case of (2)(b), the Panel should consider the detail situation of both sides.

The Panel finds; (I) before the commencement of this proceedings, both parties have communicated via email in English, (See, Complainant's Evidence 2), (II) the Registrant offers the disputed Domain Name on the domain name selling platform sites (Afternic.com and DAN.COM), which were written in English (See, Complainant's Evidence 9), (III) the Registrant has several experiences of the DRP procedure as a Respondent, including Solvay SA v. Ye Li, DCO2014-0020<solvay.co> at WIPO, and L'Oréal and others v. Ye Li and others, D2011-1608 <lorealjapan.com and others> at WIPO, and so on. In these proceedings, Ye Li, the Registrant at this proceeding, got several DRP decisions in English but he/she never denied English as the language of the proceedings. Actually, in the latter case, the Panel decided English as the language of the proceedings despite that the language of the registration agreement was Chinese.

So, the Registrant seems to have no difficulties to communicate in English, and the Panel did not find any circumstantial facts which might be unfair to the Registrant if the Panel determines English as the language of this proceeding.

By the way, the Panel notes that nationality of the Registrant is not taken into consideration when the Panel reviews the request in this case. It is true the name of the Registrant "Ye Li" is not a typical name of Japanese nationals, but the Complainant did not submit any evidences showing that his/her nationality is Chinese. However, other supported evidences seem enough to show that the Registrant is able to understand documents written in English.

In summary, while the Complainant requested that the proceeding shall be conducted in English; the Registrant did not submit the opinion regarding the language of the proceedings; and, per the Center's Commencement Notice to the Registrant dated March 11, 2021 (this notice was sent both in Japanese and in English), the Registrant is deemed to have no objection to proceeding in English, given the failure to respond to the Complainant's request. Considering all the circumstances, the Panel determines English to be the language of this proceeding.

5. Factual Background

The Complainant is a corporation based in Switzerland (in the description of the Complaint, although the Complainant is described as “a French company” at page 4 of the document titled “Language of proceedings”), and part of the L’Occitane Group. The L’Occitane Group is a global manufacturer for cosmetic products and their retailer. The Complainant registered and holds several trademarks in the term ERBORIAN including International trademark ERBORIAN No. 1125364 dated June 29, 2012 designating Japan and other countries (effective on April 25, 2014 in Japan) for goods in international classes 3 and 5, and International trademark ERBORIAN (logo) No. 1295774 dated January 19, 2016 designating notably Korea, China, etc. for goods and services in international classes 18, 21, 24 and 35, and other trademark registrations.

The Registrant registered the disputed Domain Name <erborian.jp> on October 1, 2015. The domain name will expire on October 31, 2021.

6. Parties' Contentions

A. Complainant

In the Complaint, the Complainant requests that the disputed Domain Name should be transferred to the Complainant, and states its reasons: (i) the disputed Domain Name is identical or confusingly similar to the trademark and other indication in which the Complainant has rights or legitimate interests; (ii) the Registrant has no rights or legitimate interests in respect of the disputed Domain Name; and (iii) the disputed Domain Name has been registered or is being used in bad faith (unfair purpose).

(i) The disputed Domain Name is identical or confusingly similar to the trademark and other indication in which the Complainant has rights or legitimate interests: The reason is that “The contested domain name fully incorporates the Complainant’s prior trademarks ERBORIAN. Therefore, the Complainant contends that the contested domain name is identical or highly similar to the Complainant’s earlier trademarks ERBORIAN.”

(ii) The Registrant has no rights or legitimate interests in respect of the disputed Domain Name: The Registrant states that, “There exist no signs whatsoever that the Registrant acquired the disputed domain name in connection with a bona fide offering of goods or services; in fact, to the contrary, it is for sale on at least two platforms for a price well in excess of the Registrant’s out-of-pocket expenses: it is listed for sale on DAN, and on AFTERNIC for USD 9,999.” (Complainant’s Evidence 9). “This is clear evidence that the sole goal of the Registrant is to sell the disputed domain name to the Complainant for a high price, or in other words, that the Registrant’s sole intent is cybersquatting”, and so on. “Furthermore, the disputed domain currently does not resolve to any active website which is yet more indicia that there exist no bona fide offering of goods or services in connection with this domain.” (Complainant’s Evidence 10).

(iii) the domain name of the Registrant has been registered or is being used in bad faith (unfair purpose): The Complainant pointed out several reasons. (1) “the Complainant states that the ERBORIAN trademark is so widely well-known that it is inconceivable that the Registrant ignored the Complainant’s earlier rights on the term ERBORIAN.” “The Registrant’s choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant’s trademark.” (2) “The sole detention of the contested domain name by the Registrant, to prevent the Complainant from reflecting its trademark and company name in a domain name, is strong evidence of bad faith.” “Furthermore, any actual use of the disputed domain name by the Registrant would de facto amount to bad faith active use.” “[I]t is for sale on at least two platforms for a price well in excess of the Registrant’s out-of-pocket expenses: it is listed for sale on DAN, and on AFTERNIC for USD 9,999.” (3) “the Complainant submits that it is highly likely that the Registrant chose the domain name because of its identity with or similarity to a trademark in which the Complainant has rights and legitimate interest.” (4) “the Registrant has also registered 97 other domain names under the “.jp” ccTLD, the vast majority of which are similar or identical to preexisting names or marks in which other persons have legitimate rights and interests” (Complainant’s Evidence 3). “The Complainant submits that among the 98 domains that are registered in the name of Ye Li under the “.jp” ccTLD” (Complainant’s Evidence 4), “at least 65 can be connected to preexisting names or marks; more importantly, approximately 20 domains are simply identical to French trademarks”. “Overall, at least 51 domains are directed at European

markets, 12 at the United States, and 2 are of international reach” (Complainant’s Evidence 4).
“The Registrant is unquestionably engaging in a pattern of abusive registrations the sole purpose of which is to prevent the Complainant and other holders of well-known marks from reflecting their marks in a corresponding domain name under the “.jp” ccTLD.” “[A]ll the domains involved in these cases are identical or quasi-identical to pre-existing trademarks or well-known names pertaining mostly to Western markets”.

B. Registrant

The Registrant did not reply to the Complainant's contentions.

Under Articles 5(f) and 14(a) of the Rules, the Panel may decide the dispute based on the Complaint. The Panel may also draw appropriate inferences from such default, according to Article 14(b) of the Rules.

7. Discussion and Findings

Article 15(a) of the Rules directs the Panel to use the principles in resolving disputes: “The Panel shall decide a complaint that it deems applicable on the basis of the statements and documents submitted and the results of hearings, and in accordance with the Policy, these Rules and provisions or principles of related law, and reasons.” In Article 4(a) of the Policy, it clearly dictates that the Complainant must prove each of the following 3 elements.

- (i) The domain name of the Registrant is identical or confusingly similar to any mark such as trademark or service mark in which the Complainant has rights or legitimate interests; and
- (ii) The Registrant has no relevant rights or legitimate interests in respect of the domain name; and
- (iii) The domain name of the Registrant has been registered or is being used in bad faith (unfair purpose).

A. Identical or Confusingly Similar

The disputed Domain Name “ERBORIAN.JP” owned by the Registrant consists of 2 parts, namely “ERBORIAN” and “.JP”. In the disputed Domain Name, “.JP” is a string for top-level domain, which merely indicates the ccTLD of Japan, however, since it is a part that does not affect the judgment of similarity, only the part “ERBORIAN” should be compared with the mark owned by the Complainant. In other words, the disputed Domain Name differs from the Complainant's mark only by the addition of the “.jp”, which is a string of the top-level domain of JP domain. The Complainant’s trademark and the part of the disputed Domain Name to be compared are the same. The Panel concludes that the disputed Domain Name is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has demonstrated the first element.

B. Rights or Legitimate Interests

Currently, the disputed Domain Name does not resolve to any active web page (See, Complainant’s Evidence 10). In the Panelist’s independent search on the page shows the same on May 09, 2021. Also, the Panelist’s search shows that the Registrant has no trademark registrations on the word “erborian” in Japan. In such situation, the Registrant should show the evidences that he/she has a registration on “erborian”, however, the Registrant failed to show such evidences, since the Registrant did not respond to the Complaint. The Panel is unable to ascertain any evidence that would demonstrate the Registrant's rights or legitimate interests in the disputed Domain Name, as described Article 4(c) of the Policy or otherwise.

The second element is established.

C. Registered or Used in Bad Faith

In Article 4(b)(i) of the Policy, one of the bad faith typical examples is defined as “circumstances indicating that the Registrant has registered or has acquired the domain name primarily for the purpose of selling ... the domain name to the Complainant or to a competitor of that Complainant,

for valuable consideration in excess of the out-of-pocket costs...”. It may not be expected that this provision covers the case that Registrant’s activity is only listing on the auction sites, or domain name selling offer sites, however, normally posting information on the domain name selling site will lead to negotiation about prices. In such a case, it is possible to identify bad faith intent by integrating the act of listing on the auction site and following price negotiation.

In this case, the evidence submitted by the Complainant shows that the disputed Domain Name is on the listing of domain name selling site named Afternic.com and DAN.COM. In the Afternic.com site, the price was set 9,999 US dollars and minimum counter-offer was 1,000 US dollars. Also, in the DAN.COM site, the price is not specified by the Registrant, but the person who would like to buy it should offer actual price and the system set minimum price is 100 US dollars (See, Complainant’s Evidence 9). Considering the disputed Domain Name currently does not resolve to any website, the aim of the Registrant seems to get out-of-pocket expenses in the Panel’s view. And the listing on the selling sites and its following price negotiation activities might be recognized at least as bad faith “use” of the disputed Domain Name.

It may be issues in the following 2 points. First, it might be assumed that the Registrant himself/herself has not specified the selling price. And second, Article 4(b)(i) of the Policy may not be applied to this case, since the provision defined the person buying the domain name as “the complainant or its competitor”.

In the Panel’s view, these issues are explained by the e-mail communication (See, Complainant’s Evidence 2). This e-mail shows that (i) during e-mail communication between Registrant and the person concerned with the Complainant, the Registrant clearly specified the final price of disputed Domain Name as 2,500 US dollars. (ii) It is not clear that the Registrant actually knew who would like to buy the disputed Domain Name and started negotiating the price, but it could be assumed that a person buying (or showing interests in buying) one domain name for thousands of US dollars might at least be a commercial entity. In this sense, it could be understood that the Registrant’s targeted sales destination is at least a commercial entity that is interested in the domain name “erborian.jp”. In such situations, Article 4(b)(i) could be applied to this case in the Panel’s view.

The Complainant discussed pattern of conduct provided at Article 4(b)(ii), however, the Panel can

find bad faith intent based upon Article 4(b)(i), without a discussion on Article 4(b)(ii).

The third element of bad faith use is established.

8. Decision

For all the foregoing reasons, in accordance with Article 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the Domain Name <erborian.jp> be transferred to the Complainant.

Decided on May 11, 2021

SATO, Keita

Sole Panelist

Japan Intellectual Property Arbitration Center

¹ The actual wording of Article 11 in the Japanese version of the Rules is “implementation circumstances of the proceedings”, however, under the Panel’s interpretation, this wording suggests that the Panel should consider not only the parties’ actions such as submission of documents and evidences but also all circumstantial facts of which we could have knowledge through the Internet and other media.

² At present in the Panel’s view, English is the only language which satisfies this condition.

³ These facts indicated by the Panel are just examples and not exhaustive.

Annex: Procedural History

(1) Submission of the Complaint

The Japan Intellectual Property Arbitration Center (the “Center”) received the complaint (including related documents attached herewith) and the request to change the language of the proceedings from Japanese to English from the Complainant by Electronic Transmission on February 16, 2021.

(2) Fee Payment

The Center received the entire fee from the Complainant on February 26, 2021.

(3) Confirmation of the Domain Name and the Registrant

The Center made an inquiry of the registration data to the JPRS on February 26, 2021 and received from the JPRS the verification response confirming the Registrant named in the Complaint is listed as the registrant of the disputed domain name and the e-mail addresses, postal addresses, etc. of the registrant registered by the JPRS on February 26, 2021.

(4) Verification of the Formal Requirements

The Center determined that an amendment (correction of the information in the complaint, etc.) was necessary on March 1, 2021 and notified the Complainant to that effect. The Center received the amended documents on March 4, 2021 and verified on March 8, 2021 that the Complaint satisfied the formal requirements of the Policy and Rules.

(5) Commencement of the Proceeding

The Center notified the Complainant, JPRS and JPNIC of the commencement of the Proceeding by Electronic Transmission on March 11, 2021. The Center sent the Registrant the Commencement Notice by postal service and Electronic Transmission on March 11, 2021. The Commencement Notice informed the Registrant of the commencement date of the Proceeding (March 11, 2021), the deadline for the submission of the Answer (April 8, 2021) and the means for the receipt and submission of documents and asked the Registrant to submit the opinion regarding the language of the proceedings. However, some of the e-mails sent to the Registrant were not able to be sent. In addition, the Commencement Notice sent to the address of the Registrant identified in the Complaint was not delivered by the post office in China at the time of decision and has been put on hold.

(6) Submission of the Answer

Since the Center did not receive the Answer by the deadline for submission, the Center sent a notice on non-submission of the Answer to the Complainant and the Registrant by Electronic Transmission on April 9, 2021, stating that "the Answer shall be deemed not to have been submitted." The Center did not receive the opinion regarding the language of the proceedings from the Registrant.

(7) Notice on the Appointment of the Panel and Scheduled Date of Decision

The Complainant elected to have the dispute decided by a single-member panel, and the Center appointed Professor Keita Sato, Chuo University, as the sole panelist and forwarded the case file to the Panel by Electronic Transmission on April 15, 2021. The Center notified the Complainant, the Registrant, JPNIC and JPRS of the appointed panelist and scheduled date of decision (May 11, 2021) by Electronic Transmission on April 15, 2021. The Panel submitted the declaration of impartiality and independence to the Center on May 11, 2021.

(8) Request for Further Statements

The Panel requested the Complainant to submit an evidence without black out parts and a statement of clarification on the evidence on May 6, 2021. The Complainant submitted the evidence and the statement on May 6, 2021.

(9) Decision by the Panel

The Panel determined that the language of the proceedings shall be English, having regard to the circumstances of the proceedings, and then completed the review and rendered the decision on May 11, 2021.