Decision for dispute CAC-UDRP-101621

Case number	CAC-UDRP-101621
Time of filing	2017-07-28 11:09:50
Domain names	honeylovetoys.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Lovehoney Group Limited

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	Jordan

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of the EU trademark “LOVEHONEY” No. 003400298 (word mark; registration date: 17 January 2005; application date: 10 October 2003; classes 3, 5, 10, 25, 28, 35). The Complainant is also the registered owner of the international trademark “LOVEHONEY” No. 1091529 (word mark; registration date: 27 June 2011; application date: 27 June 2011; classes 3, 5, 10, 25, 28, 35) (Designations under Madrid Protocol: AU-CH-CN-IS-NO-NZ). These trademarks are hereafter referred to as the "LOVEHONEY trademarks".

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

i) ABOUT COMPLAINANT AND THE BRAND LOVEHONEY

The Complainant ("Lovehoney") is the owner of the LOVEHONEY trademarks. These trademark registrations predate the registration of the disputed domain name.

Founded in 2002, Lovehoney is now the largest online sex toy retailer in the UK and is growing rapidly internationally as a

retailer, manufacturer and distributor. Lovehoney’s website and sex toy brands are known and loved around the world.

Due to being an online business with extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, particularly in the adult products industry, including in China where the Respondent is located.

The Complainant has registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term “LOVEHONEY”, for example, <lovehoney.com> (created on December 1, 1998), <lovehoney.net> (created on December 5, 2001) and lovehoney.us (created on April 30, 2006). Complainant uses these domain names to connect to websites through which it informs potential customers about its LOVEHONEY mark and its products and services.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

I. The disputed domain name is confusingly similar to Complainant's registered LOVEHONEY trademarks.

The manner in which the disputed domain name is confusingly similar to the protected mark:
Misspelling/Typosquatting
Conceptual/intellectual similarity
Mark combined with generic term
Having regard to the website or other extraneous material to determine if the domain name is identical or confusingly similar to the mark

II. The Respondent does not have any rights or legitimate interest in the disputed domain name:

The Complainant refers to the following category of issues involved:

Diversion of consumers/trademark tarnishment

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

The Complainant refers to the following categories of issues involved:

No response to cease and desist letter
Other commercial gain
Attracting internet users for commercial gain by creating a likelihood of confusion with the Complainant
Substantial similarity between website associated with the disputed domain name and website associated with right holder’s domain names.

The Complainant in particular emphasises that the Complainant's registered LOVEHONEY trademarks predate the registration of the disputed domain name. The Complainant also emphasises that the disputed domain name incorporates a reversed version of the Complainant’s wellknown LOVEHONEY trademarks, i.e. “honeylove” along with the word “toys”, which is closely and intrinsically linked to Complainant’s business.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. Language of the proceedings

The domain name Registration Agreement being in Chinese, pursuant to paragraph 11 of the UDRP Rules, the language of the proceedings should be Chinese, unless otherwise agreed upon by the Parties or otherwise specified in the Registration Agreement.

The Panel notes that the Complainant filed a request that the language of the proceeding should be changed to English, based on the following arguments:

a) the disputed domain name includes a reversed word order variant of the Complainant's mark LOVEHONEY, along with the English word "Toys". The Complainant is a United Kingdom company whose business language is English;
b) considering that the Respondent has registered other domains with words in English, it is unlikely that the Respondent is not at least familiar with the English language.
c) the e-mail chain between the Complainant's legal representatives and the Respondent was in English and the Respondent did not reply to say that it did not understand the communications;
d) the disputed domain name is in Latin script rather than Chinese script; and
e) the content on the website associated with the disputed domain name is in English.
In addition, the Complainant refers to the fact that the Respondent has registered the disputed domain name under the Top Level domain name ".com" which is the commercial TLD, and is applicable to a broader audience than merely China.

The Panel accepts the language of proceeding request based on a combination of the following factors:

a) The disputed domain name consists of English words only (namely the words "honey", "love", and "toys");
b) The disputed domain name resolves to a website with content in the English language only (no content in Chinese or other languages). This website clearly targets an English language audience (e.g.: English language only; US Dollar currency only; mentioning of the following: "We ship world wide" and "We comply with the UK Data Protection Act 1988"; etc.); It can thus be assumed that the Respondent conducts its business in the English language;
c) The Respondent registered the disputed domain name using an English-language name, organization name, and email address: name: "tom jordan", organization: "Jordan", and email address: "wademan04@qq.com".

Based on these factors, the Panel determines that the Respondent apparently has sufficient knowledge of the English language. The Panel also determines that the Respondent has been given a fair chance to object to the use of the English language through the various notifications sent to him, but has not filed any objection. Finally, the Panel determines that the

Complainant, a British company, would be unfairly disadvantaged by being forced to translate the procedural documents in the Chinese language.

In conclusion, in conformity with the Panel's discretionary power under paragraph 11 (a) of the UDRP Rules, and for the combination of reasons mentioned above, the Panel accepts the language of proceeding request submitted by the Complainant and determines that the proceeding can be conducted in English rather than Chinese.

2. Substantive elements

A. Identical or confusingly similar

As regards paragraph 4(a)(i) of the UDRP, it is well established that the generic TopLevel Domains (“gTLDs”) may be disregarded in the assessment under paragraph 4(a)(i) of the Policy (e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D20000003). While accordingly ignoring the gTLD “.com”, the Panel finds that the disputed domain name is confusingly similar to the registered trademarks of the Complainant.

Although the words “honey”, “love”, and “toys” are common words in the English language, it is a fact that the combination of the first two words as “lovehoney” is protected as a word trademark by the Complainant (EU trademark and international trademark including China as a designation) in various classes, including class 28 (subclass: "games and playthings; gymnastic and sporting articles not included in other classes"). The reverse combination of the first two words as “honeylove” in combination with the word “toys” (which falls within class 28) makes that the disputed domain name is confusingly similar to the Complainant’s registered trademarks. The Panel finds it likely that internet users may be confused by the disputed domain name, and may actually believe that there is a connection between Complainant as a trademark owner and Respondent as a domain name holder.

B. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the UDRP, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often impossible task of proving a negative. Therefore, numerous previous Panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant contends:

"Complainant has not found that Respondent is commonly known by the Domain Name. The WHOIS information “Tom Jordan” is the only evidence in the WHOIS record, which relates Respondent to the Domain Name. Respondent has not by virtue of the content of the website, nor by its use of the Domain Name shown that they will be used in connection with a bona fide offering of goods or services. When entering the terms “LOVEHONEY” and “China” in the Google search engine, the top returned result points to Complainant and its business activity."

The Complainant also contends:

“Complainant has no relationship whatsoever with Respondent and has never authorized Respondent to use the Domain Name or any other domain name. It can be assumed that Complainant’s trade and service mark are known in the relevant industry, as Complainant is UK’s No 1 online adult store, has a strong presence in many other countries around the world and has been in the business since 2002. Further, there is no indication that Respondent is known under the disputed domain name.”

The Complainant also contends:

“Respondent’s use of the disputed Domain Name appears to be merely intended to divert (potential) customers to Respondent’s website and cannot be considered a bona fide offering of goods and services.”

The Complainant furthermore contends:

"Moreover, the use of the reversed version of the word LOVEHONEY, ie “Honeylove” (i) in the Domain Name and (ii) also on multiple occasions in the website text further created the impression that there is some official or authorized link with Complainant. As noted previously, the trademark LOVEHONEY is a wellknown trademark around the world including in China and given the references to a confusingly similar version of this mark on the website, it is clear that Respondent knows about it’s existence."

The Complainant furthermore contends:

“Firstly, Respondent is not offering the Complainant’s products or services through the Domain Name, but rather appears to be promoting similar products and possible fakes and counterfeits; Secondly, Respondent does not publish a disclaimer on the challenged pages. On the website connected to Disputed Domain Name there is no statement disclaiming a relationship or association with Complainant; Thirdly, Respondent is depriving the Complainant of reflecting its own mark in the Domain Name; and, finally, Respondent presents themselves as the trademark owner by using a confusingly similar version of Complainant`s registered LOVEHONEY trademark.”

Finally, the Complainant contends:

"Clearly, Respondent is not known by the Domain Name, nor does Respondent claim to have made legitimate, non-commercial use of the Domain Name."

Based on the arguments and the evidence presented by the Complainant, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Bad faith registration and use

The Panel notes that Complainant’s EU and international trademark registrations predate the registration of the disputed domain name.

The Complainant's international trademark covers the geographical area where the Respondent is based (i.e., China is a specific designation under the Complainant's international trademark). The Complainant's EU trademark also covers the United Kingdom, one of the specific target markets of the Respondent's website and the home country of the Complainant as a registered trademark owner.

In light of these facts, combined with the worldwide business presence of the Complainant, and the fact that the Respondent reversed the Complainant's registered trademark while merely adding the word "toys" (which falls within one of the classes specifically covered by the Complainant trademarks), it is highly unlikely that the Respondent would not have been aware of the the unlawful character of the disputed domain name at the time of its registration and use.

The Complainant submitted evidence of various communications (including a cease and desist letter) sent to the Respondent with regard to the unlawful character of the disputed domain name. These communications were sent to the e-mail address used by the Respondent at the time of registration of the domain name. The Complainant contends that it dit

not receive any response from the Respondent. This contention is not disputed by the Respondent.

The website linked to the disputed domain name appears to be an online shop, offering products for sale that are similar to the products sold by the Complainant (i.e., sex toys and other adult products). From these facts, the Panel determines that the Respondent uses the disputed domain name to disrupt the business of the Complainant and to intentionally attract, for commercial gain, internet users to its own website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

There is no indication before the Panel that the Respondent has been authorized or licensed by the Complainant to use the Complainant's trademarks in the Respondent's domain name or on its website, let alone to sell competing products or counterfeit products. The Panel further notes that the Respondent dit not file any response and thus did not object to any of the contentions made by the Complainant.

For all of the reasons set out above, the Panel determines that the disputed domain name was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **HONEYLOVETOYS.COM**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2017-09-05

Publish the Decision