Decision for dispute CAC-UDRP-101817

Case number	CAC-UDRP-101817
Time of filing	2017-12-27 10:13:35
Domain names	LOVEHONEY-OUTLET-SALE.COM

Case administrator

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

Complainant

Organization	Lovehoney Group Limited

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	lovehoney-outlet-sale.com

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings between the parties to this dispute or relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant owns the trademarks “LOVEHONEY” with UK registration number 003400298, registered since January 17, 2005 and International Registration number 1091529 since June 27, 2011.

FACTUAL BACKGROUND

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

The Complainant, Lovehoney Group Limited (hereinafter “Lovehoney”) is the owner of the LOVEHONEY trademarks. 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.

Overview of trademark registrations for “LOVEHONEY”:

UK registration number 003400298, registered since January 17, 2005.
International Registration number 1091529 since June 27, 2011.

According to the Complainant, these trademark registrations predate the registration of the Disputed Domain Name. Due to being an online business with extensive use, advertising and revenue associated with its trademarks worldwide, Complainant enjoys a high degree of renown around the world, including in Russia where Respondent appears to be located.

The Complainant notes that it 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

PARTIES’ CONTENTIONS:

COMPLAINANT:

i) THE DOMAIN NAME IS IDENTICAL

The Domain Name <lovehoney-outlet-sale.com> (hereinafter referred to as the” Disputed Domain Name”), registered on September 7, 2017, directly and entirely incorporates Complainant’s well-known, registered trademark LOVEHONEY with merely the addition of the highly relevant phrase “outlet sale”. Furthermore, there have been many domain disputes involving a trademark and the words “outlet” and or “sale”, where the panel has found such terms do not create distinctiveness (see for example WIPO case D2017-1891 concerning the domain <goldengooseoutlet.net> and FORUM case 1757548 concerning the domain <guess-sale.com>). The incorporation of the LOVEHONEY trademark into the Domain Name creates the impression that the Respondent is somehow affiliated with the Complainant, and the Respondent is somehow doing business using the Complainant’s trademark.

ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name. Respondent has not by virtue of the content of the website, nor by its use of the Disputed 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 “Russia” in the Google search engine, most of the top returned result points to the Complainant and its business activity. The Respondent could easily perform a similar search before registering the Disputed Domain Name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks extensively in Russia and around the world.

There is no evidence that the Respondent has a history of using, or preparing to use, the Disputed Domain Name in connection with a bona fide offering of goods and services. It is clear that the Complainant has become a distinctive identifier associated with the term “LOVEHONEY” and that the intention of the Domain Names is to take advantage of an association with the Complainant’s business.

At the time of filing this complaint, the Respondent was using the Disputed Domain Name to attract internet users to its website where it is stated that it is “Lovehoney” including a LOVEHONEY logo and slogan, as well as “store” prominently on the top left hand side of the page. The Respondent is not authorized to use the LOVEHONEY trademarks, nor is there any relationship between the Complainant and the Respondent. Moreover, the use of the word LOVEHONEY (i) in the Disputed 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 the Complainant. As noted previously, the trademark LOVEHONEY is a well-known trademark around the world and given the references to this mark on the website and unauthorized use of a variation of the logo, it is clear that the Respondent knows about its existence.

In addition, the website invited visitors to contact Respondent via the “Contact Us” form accessible on the Contact Us page.

In WIPO Case No. D2015-1024 Steven Madden, Ltd. v. Daniel Monroy the Respondent collected personal information from Internet users visiting the website (name, phone number, email address, age etcetera) who filled out a form, and the Panel noted that: "users presumably would not provide such data unless they believe they are dealing with Complainant or with a representative of Complainant….since personal data are a valuable commodity, eliciting such data as described is not a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers, pursuant to Policy paragraph 4(c)(iii)". This finding should also apply here declaring that Respondent's attempt to "phish" for users' personal information is neither a bona fide offering of goods and services nor a legitimate noncommercial or fair use pursuant to Policy.

According to the Complainant, the Respondent fails the Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001–0903, test, as per the following:

• Firstly, the Respondent is not offering the Complainant's products or services through the Disputed Domain Name, but rather appears to be offering similar products and possible fakes and counterfeits and claims to be a discount outlet, offering up to 88% discounts;
• Secondly, Respondent does not publish a disclaimer on the website associated with the Disputed Domain Name. On the website connected to the Disputed Domain Name there is no statement disclaiming a relationship or association with the Complainant;
• Thirdly, Respondent is depriving the Complainant of reflecting its own mark in the Disputed Domain Name; and,
• Finally, the Respondent presents themselves as the trademark owner by using Complainant's LOVEHONEY trademark.

The Respondent's use of the Disputed Domain Name creates an overall impression that they are the Complainant. In the present case, the Respondent does meet all the Oki Data criteria. It is undeniable that Respondent was aware of the Complainant's marks prior to the acquisition of the Disputed Domain Name and the establishment of the Respondent's website. The Respondent has made no claims to either having any relevant prior rights of its own, or to having become commonly known by the Disputed Domain Name. Clearly, the Respondent is not known by the Disputed Domain Name, nor does the Respondent claim to have made legitimate, non-commercial use of the Disputed Domain Name.

The Respondent has been granted several opportunities to present some compelling arguments that it has rights in the Disputed Domain Name but has failed to do so. This behavior coupled with the use of the Disputed Domain Name cannot be considered as legitimate use of the Disputed Domain Name.

iii) THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

THE DOMAIN NAMES WERE REGISTERED IN BAD FAITH

It has to be highlighted that the Complainant's trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Moreover, the active business presence, growth and success of the Complainant worldwide in recent years shows that it seems to be unlikely that the Respondent was not aware of the unlawful registration of the Disputed Domain Name.

THE DOMAIN NAME IS BEING USED IN BAD FAITH

The Complainant tried to contact the Respondent on April 25, 2017, through a cease and desist letter, sent to the official e-mail address provided in the WhoIs. This message was not able to be delivered. Therefore, Complainant tried to contact the Respondent using the e-mail provided in the email address on the website associated with the Disputed Domain Name, which was also unable to be delivered. Therefore, the Complainant tried to contact the Respondent via the Registrar's contact e-mail. In the cease and desist letter, the Complainant advised the Respondent that the unauthorized use of its trademarks within the Disputed Domain Name violated their trademark rights and Complainant requested a voluntary transfer of the Disputed Domain Name. However, the Registrar stated:

"We have locked the domain <lovehoney-outlet-sale.com> while waiting for you to provide letter from court for this URDP

case."

Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant filed this complaint according to the UDRP process.

The Respondent has never been granted permission to register the Disputed Domain Name. The Respondent was taking advantage of the LOVEHONEY trademark by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's products, services, website or location.

From the Complainant's point of view, Respondent intentionally chose the Disputed Domain Name based on registered and well-known trademark in order to generate more traffic to its own business. Nowhere does Respondent disclaim an association between itself and the Complainant. The Disputed Domain Name is currently connected to a what appears to be an online shop, selling adult products and sex toys, consequently, the Respondent is using the Disputed Domain Name to intentionally attempt to attract, for commercial gain, internet users to the website, by creating a likelihood of confusion with Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website. This conduct has been considered as bad faith under the Policy, and other WIPO decisions have also arrived to the same conclusion, for example Philip Morris Incorporated v. Alex Tsypkin, WIPO Case No. D2002-0946.

Finally, the Complainant's trademark registrations predates the Respondent's Disputed Domain Name registration. These cumulative factors clearly demonstrates that Respondent should be considered to have registered and to be using the Disputed Domain Name in bad faith as stated at the WIPO case No. D2016-0456 Amis Paris v. Amiparis, Amipa.

To summarize, LOVEHONEY is a well-known trademark in the adult sex toys industry including Russia where the Respondent is purportedly located and where the website associated with the Disputed Domain Name is operating under the name "Lovehoney". It is clear on the evidence that Respondent was aware of the rights Complainant has in the trademark and the value of said trademark, at the point of the registration. Inference of bad faith registration and use of the Disputed Domain Name is also given by the fact that the Respondent has not provided a valid e-mail address in the WhoIs and therefore never replied to Complainant's cease and desist letter nor reminders. It is reasonable to assume that if the Respondent did have legitimate purposes in registering and using the Disputed Domain Name it would have responded to defend its rights. In addition, the Respondent did not meet the Oki Data principles on all elements: lack of a distinctive disclaimer; Respondent can be regarded to corner the market preventing Complainant from operating the Disputed Domain Name; and they represent themselves as the trademark owner by displaying Complainant's trademark prominently on the website. Consequently, the Respondent should be considered to have registered and to be using the Disputed Domain Name in bad faith.

RESPONDENT: No administratively compliant Response has been filed.

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

According to paragraph 4(a) of the Policy, the Complainant must prove the following in order to succeed in relation to the Disputed Domain Name:

(i) The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
(ii) The Respondent has no rights or legitimate interests in respect of the Domain Name; and
(iii) The Domain Name has been registered and is being used in bad faith.

As the Respondent did not submit a Response, the Panel may treat as uncontested the Complainant's factual assertions. The Panel will now turn to review each of these above-mentioned elements.

A. Identical or Confusingly Similar

In relation to the trademark rights, the Panel notes that the Complainant established through evidence on record the existence of its trademark "LOVEHONEY", since at least 2005. The Panel then turns to the matter of confusing similarity between the Disputed Domain Name and the Complainant's trademarks. For this, the Panel notes that the Disputed Domain Name incorporates the entirety of the trademark, namely "LOVEHONEY", with the addition of two generic words (outlet and sale) plus a couple of hyphens succeeding the trademark.

The Panel determines that the dominant element of the Disputed Domain Name is the Complainant's trademark and the addition of two generic words does not detract from the confusing similarity between the trademark and the Disputed Domain Name, as per section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO 3.0 Overview).

Accordingly, in the Panel's view, the first element of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

The Complainant contents that the Respondent is not commonly known by the Disputed Domain Name, nor has the Complainant licensed or permitted the Respondent to use its "LOVEHONEY" trademark. The Complainant also contends that the intention behind the use of the Disputed Domain Name is to take advantage of an association with the Complainant's business and derive an economic benefit. Furthermore, the Complainant asserts that the Respondent is attempting to use the Disputed Domain Name "phish" for users' personal information via the "Contact Us" form in the website associated with the Disputed Domain Name. With these assertions and the evidence on record, the Panel is of the view that these are enough to establish a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Since there is no available evidence on record that would allow the Panel to find any rights or legitimate interests for the Respondent in the Disputed Domain Name coupled with the fact that the Respondent did not provide evidence to refute the Complainant's prima facie showing under this second element (see section 2.1 of WIPO 3.0 Overview).

The Panel is left with no choice but to find that the Complainant has satisfied the requirements set forth under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The evidence on record supports a finding that the Respondent was more than likely aware of the Complainant and had the Complainant's trademarks in mind when registering the Disputed Domain Name. The Panel further notes that as per the evidence on record, the Respondent registered the Disputed Domain Name incorporating the entirety of the trademark in it in order to derive an economic benefit and with an indication of being used for phishing purposes. Viewing the evidence as a whole, it appears that one of the primary objectives of the Respondent, if not the only objective, is aiming to take advantage of the reputation of the Complainant and its trademarks, with the sole purpose to create likelihood of confusion with the Complainant's trademark and the Disputed Domain Name.

This leads the Panel to conclude that the registration and use of the Disputed Domain Name has been done in bad faith, as it encapsulates the breadth of the indicative list of conducts described under paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the final element required under paragraph 4(a)(iii) of the Policy.

D. Decision

For the aforestated reasons and in accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transferal of the Disputed Domain Name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LOVEHONEY-OUTLET-SALE.COM**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2018-01-24

Publish the Decision