Decision for dispute CAC-UDRP-103483

Case number	CAC-UDRP-103483
Time of filing	2021-01-05 13:12:42
Domain names	lovehoneyvn.com

Case administrator

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

Complainant

Organization	Lovehoney Group Limited

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	CAO VAN DIEN

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the registered trademarks LOVEHONEY in different Countries. In particular it has the following registrations:

- US Registration No.3350209 LOVEHONEY granted on December 11, 2007 renewed;

- International Registration No.1091529 LOVEHONEY granted on June 27, 2011;

- EUTM Registration N0.003400298 LOVEHONEY granted on January 17, 2005 renewed.

Furthermore the Complainant has several domain names comprising the trademark LOVEHONEY, such as <lovehoney.com>; <lovehoneygroup.com>; <lovehoney.co.uk>; <lovehoney.ca>; and many others as shown in one of the Complainant's Attachments.

Last but not least LOVEHONEY is also the tradename of the Complainant.

FACTUAL BACKGROUND

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

Language of Proceedings

To the best of the Complainant's knowledge the language of the Registration Agreement is Vietnamese.

In accordance with Paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its "discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs" (see Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

The Complainant requests the language of the proceedings to be English so it is fair to both parties. Should the Respondent request the language of the proceedings be different from English, the Complainant requests that the language of the present administrative proceeding be English based on the following reasons:

- the disputed domain name in its second-level portion is composed of the brand name "LOVEHONEY" and the abbreviation "vn" which presumably stands for Vietnam. The brand name "LOVEHONEY" consists of very common English terms "love" and "honey" which proves that the Respondent understands English well and that the Respondent's intention is to target Internet users who understand English;

- the website associated with the disputed domain name resolves to an active page mimicking the official website of the Complainant and contains numerous English terms and sections of the websites presented in English such as "Your Sexual Happiness", "Discover New Beginners Toys", "Dreamy Designs to seduce your Lover" and many others as copied from the official website of the Complainant. It demonstrates that the Respondent has a good knowledge of English and the intention of the Respondent to address its visitors in English language;

- furthermore, the sub-sections of the website are also presented in English as copied from the website of the Complainant: "Bondage for beginners", "Handcuffs and Restraints", "Electro and Medical Fetish" and others. This indicates that the Respondent can provide information on the products and assistance for the products offered on the website in English;

- the Complainant is a UK based company, having its website at <lovehoney.com> or <lovehoneygroup.com> displayed in the English language, and it appears that according to the WHOIS records the Respondent is located in Vietnam. The English language, being commonly used internationally, would be considered as neutral for both parties in the present case. It would therefore be fair to the Parties that the language of the present proceeding be English (See Intesa Sanpaolo S.p.A. v. Ida Ekkert, CAC Case No. 102263).

Moreover, should the language of the Registration Agreement be different from English, a translation by the Complaint to such a language (Vietnamese) would entail significant additional costs for the Complainant and delay in the proceedings.

The Complainant therefore requests the Panel to exercise its discretion and allow the language of the proceeding to be English.

Factual and Legal Grounds

A. Factual background

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

Founded in 2002, Lovehoney is the largest British company selling sex toys, lingerie and erotic gifts on the Internet still growing rapidly across the world as a retailer, manufacturer and distributor. Lovehoney has over 400 own brand products and exclusive licenses to design, manufacture and sell featured adult pleasure products. Lovehoney employs around 230 people and their headquarters are open seven days a week selling products to 46 countries in Europe, North America and Australasia through nine web-sites. Lovehoney focuses on exceptional customer service, product innovation, website usability and creative marketing to always be at the forefront of developments in sexual wellbeing and ecommerce.

Lovehoney’s company, website and the products the company sells have received numerous awards (https://www.lovehoney.co.uk/) including the Best Customer Service Award for online retailers at the eCommerce Awards for Excellence. Lovehoney is also rated as ‘Excellent’ in over 80,000 customer reviews on Trustpilot, the renown independent review website.

The Complainant also enjoys a strong online presence via its official websites and social media. Due to extensive use and advertising, Lovehoney’s on-line shops are easily recognized by the consumers.

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), <lovehoneygroup.com> (created on March 14, 2012) <lovehoney.co.uk> (created on April 30, 2006), <lovehoney.ca> (created on September 9, 2008) and others. Complainant uses these domain names to connect to websites through which it informs potential customers about its LOVEHONEY mark and its products and services.

B. Legal grounds

In accordance with Paragraph 4(a)(i) of the Uniform Dispute Resolution Policy (the “Policy”), in an administrative proceeding the complainant must prove that (i) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights, (ii) the respondent has no right or legitimate interests in respect of the domain Name, and (iii) the domain Name has been registered and is being used in bad faith.

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

As mentioned earlier Complainant owns trademark registrations for LOVEHONEY registered in different countries of the world. Complainant’s trademark registrations predate the registration of the disputed domain name <lovehoneyvn.com> (hereinafter “Disputed Domain Name”), created on May 23, 2020.

The Disputed Domain Name incorporates, in its second-level portion the Complainant’s trademark “Lovehoney” in its entirety along with the 2 letters “vn” which presumably is abbreviation standing for Vietnam.

Furthermore, the generic Top-Level Domain “.com” is a standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see, Arcelormittal S.A v. James, supra and Credit Mutuel Arkea v. Domain Administration, CAC Case No. 102345).

The Disputed Domain Name is therefore confusingly similar to the Complainant’s trademarks LOVEHONEY.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;

The Disputed Domain Name was registered on May 23, 2020, many years after the registrations of the Complainant's LOVEHONEY trademarks.

The Complainant has never granted the Respondent any right or license to use LOVEHONEY trademark within the Disputed Domain Name, nor is the Respondent affiliated to the Complainant in any form or has endorsed or sponsored the Respondent or the Respondent's website.

There is no evidence that the Respondent is known by the Disputed Domain Name or owns any corresponding registered trademarks including the terms "lovehoneyvn", or "lovehoneyvn.com":

- when conducting the search regarding the terms "lovehoneyvn" or "lovehoneyvn.com" on popular Internet search engines such as "Google.com" the very first results relate to the Complainant's official website and the remaining results relate to the Disputed Domain Name and pages connected to the same;

- according to the WHOIS records the Respondent is CAO VAN DIEN, when conducting the search in the popular search engine such as "Google.com" searching for the name of the Respondent along with the term "lovehoneyvn" there are no relevant returned results;

- when conducting searches in online trademark databases, no information is found in relation to trademarks corresponding to the terms "lovehoneyvn" or "lovehoneyvn.com".

The Disputed Domain Name resolves to an active page mimicking the look and feel of the Complainant's official website by using similar colors, logos, copyrighted images, fonts and style and offering for sale the same range of products (sex toys, lingerie, erotic gifts and related products). Among others, the website associated with the Disputed Domain Name also offers for sale the products of the Complainant.

Namely, the website associated with the Disputed Domain Name follows the structure of the Complainant's website, displays identical colors and reproduces identical copyrighted images and texts (slogans, names of sub-sections) of the Complainant. Furthermore, the Respondent made minor alterations to the logo of the Complainant which visually is confusingly similar to the trademark of the Complainant. Namely, the website displays "Lovehoneyvn" name and logo having dominant position at the website and having close visual similarity with the logo of the Complainant (image of with the shape of heart). The website clearly refers to the Complainant, its trademarks and products.

As it is shown in one of the evidence – apart from mimicking the look and feel of the Complainant's official website, the Respondent also uses copyrighted imagery without any authorization. The official website of the Complainant and the website associated with the Disputed Domain Name clearly shows that the Respondent followed the structure, chose the identical colors and that the imagery along with slogans and names of the sections have been copied from the Complainant's websites. One of the annexes also contains comparison of the product's imagery and names of the product bearing the Complainant's logo (as explained above) which Respondent clearly simply copied from the official websites of the Complainant. It therefore seems the Respondent is allegedly offering for sale the Respondent's products.

Previously panels stated that: Regardless of whether the products sold on the Respondent's website were genuine or counterfeit, the website did not disclose the lack of a relationship between the Respondent and the Complainant. On the contrary, the display of the Complainant's SERGIO ROSSI figurative mark gave the misleading impression that the website was affiliated with, or approved by, the Complainant. Therefore, the Panel does not find this to be a use of the disputed domain names in connection with a bona fide offering of goods or services within the circumstances of paragraph 4(c)(i) of the Policy." Sergio Rossi S.P.A. v. Liu dexing / Name Redacted / Kyu, John Rex / Jia Qi Yuan, Yi Wu Shi Yi Yun Dian Zi Shang Wu You Xian Gong Si, WIPO Case No. D2019-2330. The Panel concurs with this view. The Respondent's use of the Disputed Domain Names in connection with copycat websites does not establish rights or legitimate interests in favor of the Respondent (See Maple Mountain Group, Inc. v. Name Redacted, Case No. D2020-0989).

It is likely that the Respondent, by mimicking the look and feel of the Complainant's website, attempts to mislead the consumers by creating the impression that the website associated with the Disputed Domain Name is the Vietnamese version of the official website of the Complainant. The Complainant did not authorize the creation of such website and it is therefore impersonation.

Rather to be known by the Disputed Domain Name, by registering and using the Disputed Domain Name the Respondent aimed at impersonating the Complainant.

Such conduct does not constitute the use in connection with bona fide offering of goods or services, or for a legitimate noncommercial or fair use. In similar circumstances when the "Respondent is using the Disputed Domain Name to pass itself of as Complainant, as evident from the display of Complainant's MIGROSBANK design mark on Respondent's website", it has been stated that the "Impersonation of a complainant cannot confer rights or legitimate interest on a respondent" (see Migros-Genossenschafts-Bund v. WhoisGuard Protected, WhoisGuard, Inc. / Jasmine Julius, WIPO Case No. D2020-0327).

In addition, where the Disputed Domain Name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

Therefore, there is no evidence 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, neither is it making a legitimate, noncommercial or fair use of the Disputed Domain Name.

Furthermore, the Complainant sent a cease and desist letter to the Respondent on June 24, 2020 at the e-mail address available in the WHOIS records: lovehoneyvn.com@gmail.com. The Complainant further sent reminder on July 10, 2020. However, there was no response received from the Respondent. The Respondent has been granted several opportunities to present some compelling arguments that it has rights or legitimate interests in the Disputed Domain Name but has failed to do so.

The Respondent has therefore no rights or legitimate interests in respect of the Disputed Domain Name.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

1) Registration of the Disputed Domain Name in bad faith

The Respondent registered the Disputed Domain Name (May 23, 2020) many years after the first registrations of the Complainant's LOVEHONEY trademarks. The Complainant is very active on social media (Facebook, Instagram and Twitter) to promote its mark, products and services and its LOVEHONEY trademark is easily recognized by consumers around the world. The Complainant is followed by 39, 795 people on Facebook, on Instagram the Complainant is followed by 92,7 thousand followers, Twitter account is also popular among consumers and followed by 53,7 thousand people. (See, Laboratoires M&L v. Zhaoxingming, CAC Case No. 102277).

By conducting a simple online search regarding the terms "lovehoney" or "lovehoneyvn", the Respondent would have inevitably learnt about the Complainant, its trademarks and business (see Intesa Sanpaolo S.p.A. v. Abayomi Ajileye, CAC Case No. 102396).

Furthermore, the Disputed Domain Name incorporates the Lovehoney® trademark in its entirety with the addition of two letter "vn" which often is referred to as abbreviation of Vietnam. As described earlier, the website associated with the Disputed Domain Name is mimicking the look and feel of the official website of the Complainant, displays copyrighted images and texts of the Complainant and therefore impersonates the Complainant. The same content was present at the time of sending cease and desist letter, namely on June 24, 2020.

The use of the Disputed Domain Name clearly shows that the Respondent had the Complainant and the Lovehoney trademark in mind when it registered the Disputed Domain Name. It appears that the goal of this registration has been to take advantage of the reputation of the Complainant. It is therefore inconceivable that the Respondent was unaware of the Complainant and the Lovehoney trademark when it registered the disputed domain name.

Previousl panels have held: The Respondents' choice to incorporate the identical "bottega veneta" element as the primary distinctive element of both of the Disputed Domain Names suggests that the Disputed Domain Names were registered in bad faith. In addition, the fact that the Respondents imitate the look and feel of the Complainant's official website in the websites to which the Disputed Domain Names resolve strongly suggests that the Respondents registered the Disputed Domain Names not only with the knowledge of existence and reputation of the Complainant's trademark but also with the intention of misappropriation of the Complainant's well-known trademark to gain the commercial advantages (See Bottega Veneta SA v. Chen Kai a.k.a. Kai Chen/ WhoIs Agent, Domain WhoIs Protection Service, WIPO Case No. D2013-0436).

Therefore, the Respondent knew the Complainant's trademark at the time it registered the Disputed Domain Name and registered the Domain Name in bad faith.

2) Use of the Domain Name in bad faith

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which shall be evidence of the registration and use of a domain name in bad faith. Among those circumstances Paragraph 4(b)(iv) of the Policy reads: "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The Disputed Domain Name includes in its entirety the Complainant's trademark Lovehoney and resolves to active page mimicking the look and feel of the Complainant's website by using similar colors tones, displaying Complainant's products, copyrighted images, fonts and style as described in more details in previous paragraphs. Such mimicking and use of the Complainant's Lovehoney trademark catch the Internet users' attention and infer that the website associated with the Domain Name is connected to, or managed by, the Complainant.

Moreover, the Complainant tried to contact the Respondent on June 24, 2020 through a cease-and-desist letter regarding each Disputed Domain Name. Further reminder was sent in July, 2020. The Respondent chose not to reply to the cease and desist letter sent by the Complainant which infers bad faith (see International Business Machines Corporation v. Adam Stevenson, Global Domain Services, WIPO case No. D2016-1695; Carrefour v. PERFECT PRIVACY, LLC / Milen Radumilo, WIPO Case No. D2018-2201).

In similar circumstances, the panels have previously held: In relation to use in bad faith, the evidence of the content available on the websites to which the Disputed Domain Names resolve (…) clearly shows that the websites imitate the look and feel of the Complainant's official website with reproductions of images taken from the Complainant's advertising campaigns and fashion shows and as well as with a copyright notice referring to the Complainant's trademark BOTTEGA VENETA. The websites to which the Disputed Domain Names resolve offer for sale purported BOTTEGA VENETA bags and ready-to-wear garments without any disclaimers. Even after a cease and desist letter from the Complainant's representative to the Respondent Chen Kai, the websites to which the Disputed Domain Names resolve continue to copy the look and feel of the Complainant's website, reproduce images taken from the Complainant's advertising and fashion shows, and provide copyright notices that refer to the Complainant's BOTTEGA VENETA trademark. Based on these facts in the record, the Panel finds that the Respondents are intentionally attempting to attract, for commercial gain, Internet users to their websites by creating a likelihood of confusion with the Complainant's trademark. Thus, the Panel finds that the Respondents are using the Disputed Domain Names in bad faith. (See Bottega Veneta SA v. Chen Kai a.k.a. Kai Chen/ WhoIs Agent, Domain WhoIs Protection Service, WIPO Case No. D2013-0436).

The overall described circumstances are clear demonstration of the implausibility of any good faith use of the disputed

domain name (see Alstom v. Itete Peru S.A., WIPO Case No. D2009-0877).

In view of the above, the Respondent registered and has been using the Disputed Domain Name in bad faith.

SUMMARY:

Lovehoney is the largest British company selling sex toys, lingerie and erotic gifts on the Internet still growing rapidly across the world as a retailer, manufacturer and distributor.

The Complainant's trademark is entirely reflected in the Disputed Domain Name and is therefore confusingly similar to the Complainant's trademark.

The Respondent bears no relationship to the trademarks nor to the Complainant. The fact that the Respondent is using the Disputed Domain Name to resolve to a "look and feel" website, which impersonates the Complainant and most likely generate revenue, by capitalizing on the reputation of the Complainant's trademark, does not constitute a legitimate noncommercial or fair use of the Disputed Domain Name. Hence, the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name.

The Respondent knew the Complainant's trademark when they registered the Domain Name. Consequently, the Respondent has registered the Domain Name in bad faith. By using the Domain Names in order to resolve to a "look and feel" website, the Respondent also intentionally attempted to attract, for commercial gain, Internet users to their website, by creating a likelihood of confusion with the Complainant's trademark.

Respondent is using the Disputed Domain Name to resolve to active "look and feel" website mimicking official website of the Complainant; the website associated with the Disputed Domain Name offers for sale similar range of products, including products of the Complainant. Therefore, the Respondent is using the Disputed Domain Name in bad faith.

PARTIES CONTENTIONS

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

Since the language of the Registration Agreement of the Disputed Domain Name is Vietnamese the Complainant has requested that English was the language of the proceeding for several reasons that have been considered well grounded and accepted. Therefore this Panel accepts that the language of the proceeding is English.

II. ABOUT COMPLAINANT AND THE BRAND LOVEHONEY

Lovehoney Group Ltd (hereinafter referred to as Complainant) is the proprietor of the Lovehoney trademarks. It is the largest British Company selling sex toys, lingerie and erotic gifts on line. Lovehoney employs more than 200 people and it is present in 46 countries in Europe, North America and Australia through nine web sites.

Lovehoney is well recognized and has been awarded several awards thanks to its extensive use and advertising.

The Complainant is the owner of the registered trademarks LOVEHONEY in different Countries.

Furthermore the Complainant has several domain names comprising the trademark LOVEHONEY.

When the Disputed Domain Name was registered by the Respondent in June 2020, the trademark LOVEHONEY was already registered for years and recognized in the specific sector of sex toys and similar goods.

LEGAL GROUNDS:

A. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain name <LOVEHONEYVN.COM> (hereinafter referred to as the “disputed domain name”) incorporates the Complainant’s, registered trademark LOVEHONEY. The addition of the gTLD “.com” does not add any distinctiveness to the disputed domain name. The addition of the term “VN” is not distinctive and may refer to Vietnam therefore to a geographical code that cannot be monopolised by anyone.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant has never granted the Respondent any right to use the LOVEHONEY trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name or the major part of it. When entering the terms “LOVEHONEY in the Google search engine, the returned results all point to the Complainant and its business activity.

The Respondent does know the reputation of the trademark in re because it has been operating a web site that is a blatant copy of the Complainant's website.

There is no evidence showing that the Respondent’s use of the disputed domain name is in connection with a bona fide offering of goods or services.

Taking into account of the above, the Respondent shall be considered as having no right nor legitimate interest in respect of the disputed domain name.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It has to be highlighted that the Complainant's trademarks predate the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to use these trademarks nor to register the disputed domain name. The Respondent has chosen to incorporate LOVEHONEY in the disputed domain name combined with the geographical term "VN" as a suffix, which is confusingly similar to 'the Complainant's trademarks and domain names. From the Complainant's perspective, it is very likely that the Respondent had the trademark in mind when he registered the disputed domain name and registered it only to mislead Internet users. The Respondent was in bad faith at the moment of the registration of the contested domain name as well as in its use later on building up a copycut website.

This in fact directly proves the willing and scientific imitation of the Complainant's websites carried out by the Respondent.

The Respondent has built its own website which looks exactly like those of the Complainant's one: same colors, same kind of presentation and, some times, same photos or same good taken form the Complainants itself.

The Respondent did not answer to the Complainant's cease and desist letter sent on June 24, 2020. The three factual circumstances of 1) no reply to the Complainant's letter 2) domain name identical to a well known trademark and 3) mimicking the look and feel of the Complainant's official website, are sufficient to state that the domain name in re was registered and used in bad faith

Therefore, it is reasonable to conclude that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or website of others, by creating a likelihood of confusion with the Complainant's trademark.

Principal Reasons for the Decision

The Panel is satisfied with Complainant's arguments and supporting evidence on the three UDRP prongs on (i) confusingly similarity of the disputed domain name with Complainant's registered trademark; (ii) the lack of legitimate interest on Respondent, and (iii) the bad faith requirement.

Indeed, by adding the generic term "VN" to the well characterized domain name does not avoid similarity and confusing similarity with the LOVEHONEY trademarks tradename and previous domain names belonging to the Complainant. That similarity inevitably gives rise to confusion.

The Respondent has shown no legitimate interest and on the contrary his behavior is quite dangerous for the LOVEHONEY reputation. Mimicking the look and feel of the Lovehoney's website can destroy the unique link between the Complainant's operation and its customers.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LOVEHONEYVN.COM**: Transferred

PANELLISTS

Name	**Massimo Cimoli**

DATE OF PANEL DECISION 2021-02-10