

Decision for dispute CAC-UDRP-103925

Case number CAC-UDRP-103925

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Domain names lovehoney.shop

Case administrator

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

Complainant

Organization Lovehoney Group Limited

Complainant representative

Organization BRANDIT GmbH

Respondent

Name SNOW JON

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

Lovehoney Group Limited is the owner, among others, of the following trademark registrations related to LOVEHONEY:

- US Registration "LOVEHONEY" no. 3350209 for classes 3, 5, 10, 25, 28 and 35 registered on December 11, 2007;
 - International Registration "LOVEHONEY" no. 1091529 for classes 3, 5, 10, 25, 28 and 35 registered on June 27, 2011;
 - EU Registration "LOVEHONEY" no. 3400298 for classes 3, 5, 10, 25, 28 and 35 registered on January 17, 2005.
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FACTUAL BACKGROUND

The Complainant informs that Lovehoney is the largest British company selling sex toys, lingerie and erotic gifts on the Internet continuing to grow rapidly across the world as a retailer, manufacturer and distributor.

In addition, the Complainant proves that the trademark LOVEHONEY is regularly registered, since 2005, in many countries for different classes of products and services. The Complainant has also registered, since 1998, numerous domain names

including the term "lovehoney".

The Complainant contends that it extensively uses said domain names to connect to websites through which it informs potential customers about its LOVEHONEY mark and its products and services. The disputed domain name <lovehoney.shop> was created on November 2, 2020 and therefore, the Complainant trademark registrations around the world significantly predate the registration of the disputed domain name.

The Complainant notes that its LOVEHONEY trademark is entirely reflected in the domain name in dispute which is therefore identical to the Complainant's trademark.

Furthermore, the Complainant informs that the Respondent has no relationship whatsoever with the Complainant or its LOVEHONEY trademark and is not commonly known by the domain name here contested.

Additionally, in the Complainant's view, it is inconceivable that the Respondent was not aware of Complainant and of its trademark at the time of registering the disputed domain name.

In addition, according to the Complainant, the Respondent is using the domain name in dispute to resolve to an active website, which seems to be a web-shop selling toys, in which there are materials and contents expressly copied from the Complainant's official website and mentioning the Complainant. The above circumstance, in the Complainant's view, obviously indicates that the domain name in dispute was registered and has been used with the intent to attract and mislead Internet users looking for the Complainant and therefore in bad faith.

Finally, in order to emphasize the Respondent's bad faith, the Complainant informs that (i) it tried to contact the Respondent on June 25, 2020 through a cease and desist letter but the Respondent never replied and that (ii) the Respondent is clearly trying to conceal its identity by the use of privacy shield hiding the registrant's identity and contact details.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

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

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1) The Panel finds that the disputed domain name <lovehoney.shop> is confusingly similar to the Complainant's trademark LOVEHONEY. Many panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see, among others, Chubb Security Australia PTY Limited v. Mr. Shahim Tahmasebi, WIPO Case No. D2007-0769; Société Air France v. Virtual Dates, Inc., WIPO Case No. D2005-0168 and Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale, WIPO Case No. D2000-0662). This is the case in the present situation where the Complainant's registered trademark LOVEHONEY is fully included in the disputed domain name. The additional element, namely the gTLD ".shop", is a mere technical requirement, which does not affect the identity between the signs and should be disregarded. In any event, even if the Panel were to consider the gTLD ".shop" in the assessment of the first requirement under Para. 4(a)(i) of the Policy, it is the Panel's view that the addition of this gTLD, will even increase the likelihood of association between the signs to be compared on the consumer's side. As a matter of fact, the Complainant's activity is the manufacture and sale of its products, and the gTLD ".shop" is clearly suitable to persuade users that the disputed domain name is an e-commerce platform of the Complainant (see Brunello Cucinelli S.p.A. v. Y. v. Oostendorp, CAC Case No. 101427). The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant demonstrated that the website connected to the disputed domain name is a website with contents and materials clearly copied from the Complainant's website. The Panel finds that said activity, of course, does not provide a legitimate interest in the disputed domain name under the Policy. Furthermore, the Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use the LOVEHONEY trademark by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy sets out the following examples of circumstances that will be considered by an Administrative Panel to be evidence of the bad faith registration and use of a domain name:

(i) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the domain name registrant's out-of-pocket costs directly related to the domain name; or

(ii) the domain name was registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the domain name registrant has engaged in a pattern of such conduct; or

(iii) the domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the domain name registrant intentionally attempted to attract for financial gain, Internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

The above examples are not exclusive and other circumstances may exist that demonstrate the registration and use of a domain name in bad faith. As to the registration of the disputed domain name in bad faith, the reputation of the Complainant's trademark is such that, in the Panel's view, the Respondent could not ignore the trademark LOVEHONEY at the time of the registration of <lovehoney.shop>. Furthermore, the fact that the Respondent uses the disputed domain name

in connection with a website providing contents directly copied from the Complainant's websites makes it more likely than not that the Respondent registered the disputed domain name being fully aware of the Complainant and its rights in the LOVEHONEY mark (see Südkurier GmbH v. Reinhard Herrmann, WIPO Case No. D2011-1437). As to bad faith use, it is the Panel's view that, by using the disputed domain name in connection with a website which also includes content directly copied from the Complainant's websites and mentioning the Complainant, the Respondent is misleading Internet users into thinking that his business is in some way connected to, sponsored by or affiliated with the Complainant or that his business or his activities are approved or endorsed by the Complainant. The Respondent therefore is trying to divert traffic intended for the Complainant's website to its own for commercial gain as set out under paragraph 4(b)(iv) of the Policy (see OANDA Corporation v. PrivacyProtect.org, WIPO Case No. D2013-1133 and Dyson Technology Limited v. Edenilson Rodriguez, WIPO Case No. D2018-2646). Furthermore, the Respondent has ignored Complainant's attempt to resolve this dispute outside of this administrative proceeding by refusing to answer the cease and desist letters. Past UDRP panels have held that failure to respond to a cease and desist letter may properly be considered a factor in finding bad faith (see, for instance, Encyclopedia Britannica v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330 and RRI Financial, Inc., v. Chen, WIPO Case No. D2001-1242). The Panel also draws an adverse inference from the Respondent's use of a privacy protection service to conceal its identity. Whilst privacy shields may be legitimate in certain cases, it is difficult to see why the Respondent in this case needs to protect its identity "except to frustrate the purposes of the Policy or make it difficult for a brand owner to protect its trade marks against infringement, dilution and cybersquatting" (see Ustream.TV, Inc. v. Vertical Axis, Inc, WIPO Case No. D2008-0598). Finally, the Panel also finds that the Respondent's failure to take part in the present proceedings constitutes an additional indication of its bad faith. Accordingly, the Panel finds that the Complainant has satisfied also paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. LOVEHONEY.SHOP: Transferred

PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION 2021-08-11

Publish the Decision
