

Decision for dispute CAC-UDRP-104007

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| Case number | CAC-UDRP-104007 |
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| Time of filing | 2021-09-03 10:20:34 |
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| Domain names | lovelhoney.com |
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Case administrator

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| Organization | Denisa Bilík (CAC) (Case admin) |
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Complainant

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| Organization | Lovehoney Group Limited |
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Complainant representative

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| Organization | BRANDIT GmbH |
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Respondent

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| Organization | Fundacion Privacy Services LTD |
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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 holds the following trademark registrations:

- US trademark registration No. 3350209 LOVEHONEY registered on December 11, 2007 for products/services in classes 3, 5, 10, 25, 28 and 35;
- International trademark registration No. 1091529 LOVEHONEY registered on June 27, 2011 for products/services in classes 3, 5, 10, 25, 28 and 35, designating Australia, Switzerland, China, Iceland, Japan, Norway, New Zealand, Russian Federation and Singapore; and
- EU trademark registration No. 003400298 LOVEHONEY, registered on January 17, 2005 for products/services in classes 3, 5, 10, 25, 28 and 35.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:**Language of Proceeding**

To the best of Complainant's knowledge, the language of the Registration Agreement of the disputed domain name

<lovehoney.com> is English according to the Registrar Verification.

In accordance with Paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the language of the proceedings is the language of the registration agreement. The Complainant therefore requests the language of the proceedings to be English.

Factual and Legal Grounds

A. Factual background

The Complainant, LOVEHONEY Group Limited (hereinafter “Lovehoney” or “the 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 continuing to grow rapidly across the world as a retailer, manufacturer and distributor. Lovehoney's has over 400 own brand products and exclusive licenses to design, manufacture and sell featured adult pleasure products. Lovehoney employs around 300 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's 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 products have received numerous awards (<https://www.lovehoney.co.uk/> including the Best Customer Service Award for online retailers at the eCommerce Awards for Excellence, Queen's Award for Enterprise in International Trade (2021), Best Online Retailer (2020), International Pleasure Products Company of The Year (2020) and many other. 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 medias. Due to extensive use and advertising, Lovehoney's on-line shops are easily recognized by the consumers. Here is a non-exhaustive list of the official pages of Lovehoney:

lovehoney.com <https://www.lovehoney.com/>
lovehoney.eu <https://www.lovehoney.eu/>
lovehoneygroup.com <https://www.lovehoneygroup.com/>
lovehoney.co.uk <https://www.lovehoney.co.uk/>

The Complainant owns trademark registrations for LOVEHONEY registered in different classes of Nice Classification (thereafter the “Complainant's trademarks”), such as but not limited to:

- US trademark registration No. 3350209 LOVEHONEY registered on December 11, 2007;
- International trademark registration No. 1091529 LOVEHONEY registered on June 27, 2011 designating Australia, Switzerland, China, Iceland, Japan, Norway, New Zealand, Russian Federation and Singapore; and
- EU trademark registration No. 003400298 LOVEHONEY, registered on January 17, 2005.

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), <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, the Complainant owns trademark registrations for LOVEHONEY registered in different countries of the world.

The disputed domain name incorporates, in its second-level portion, type of the Complainant's trademark LOVEHONEY in its entirety by merely adding a letter "l" between "love" and "honey", and, in its first-level portion, the generic Top-Level Domain ("gTLD") ".com". 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, *Sanofi v. Francisco Sánchez Fernández*, *insurious*, WIPO Case No. D2019-0169; *Bugatti International S.A. v. Ruanxiaojiang*, WIPO Case No. D2017-2555).

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 created on February 23, 2021 according to the Registrar Verification, 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 trademark including the terms "lovelhoney":

- When searching for the term "lovelhoney" or "lovelhoney.com" in popular Internet search engines like Google.com, the vast majority of the results relate to Complainant's official websites, Social Media account and third parties' websites directly referring to the Complainant and their products;
- When conducting searches on online trademark databases, no information is found in relation with trademarks corresponding to "lovelhoney".

At the time of filing of this amended complaint, the disputed domain name first redirected visitors to a website with URL <http://ww2.affinity.net/> before eventually resolving to the Complainant's website <https://www.lovehoney.com/>.

In WIPO Overview 3.0, section 3.1.4, it provides that:

"[...] panels have found that a respondent redirecting a domain name to the complainant's website can establish bad faith insofar as the respondent retains control over the redirection thus creating a real or implied ongoing threat to the complainant."

This is further confirmed in the case *Dell Inc. v. Chong Sam Lee*, Claim Number: FA1910001865104 where the panel stated that:

"[...] likewise, using a confusingly similar Domain Name in a manner over which a complainant has no control does not qualify as a bona fide offering of goods or services for the purposes of Policy paragraph 4(c)(i) or as a legitimate non-commercial or fair use for the purposes of Policy paragraph 4(c)(iii), even if it resolves to the complainant's own web site. *Direct Line Ins. plc v. Low-cost-domain*, FA 1337658 (FORUM September 8, 2010) ('The Panel finds that using Complainant's mark in a domain name over which Complainant has no control, even if the domain name redirects to Complainant's actual site, is not consistent with the requirements of Policy paragraph 4(c)(i) or paragraph 4(c)(iii).')."

The Complainant concludes that the Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

Furthermore, the Complainant tried to reach the Respondent by sending a cease-and-desist letter on April 27, 2021 to the Respondent's e-mail domains@fundacionprivacy.com as provided in WHOIS, followed by a reminder sent on June 23, 2021.

However, the Complainant has not received any response 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 Complainant therefore concludes that the Respondent has 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 many years after the first registrations of the Complainant's LOVEHONEY trademarks. The Respondent has chosen to incorporate a typo of the trademark LOVEHONEY in the disputed domain name.

By conducting a simple online search regarding the term "lovelhoney" or "lovelhoney.com", the Respondent would have been aware of the Complainant and its mark. As previously stated by UDRP Panels, in such circumstances, the Respondent would have learnt about the Complainant, its mark and activities (see *Intesa Sanpaolo S.p.A. v. Abayomi Ajileye*, CAC Case No. 102396) and "it is inconceivable that the Respondent was unaware of the existence of the Complainant when he registered the disputed domain name" (See, *Novartis AG v. Chenxinqi*, Case No. 101918). As mentioned, 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 42,538 people on Facebook, on Instagram the Complainant is followed by 139 thousand followers, Twitter account is also popular among consumers and followed by 56 thousand people. (See, *Laboratoires M&L v. Zhaoxingming*, CAC Case No. 102277).

It is inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the disputed domain name. On the contrary, as the disputed domain name redirected to the Complainant's website, it is blatant that the Respondent intentionally registered the disputed domain name incorporating a typo of the trademark LOVEHONEY to take advantage of reputation of the trademark and Complainant's goodwill.

In addition, the Respondent Fundacion Privacy Services LTD has been engaged in numerous domain name disputes in the past, which has formed a pattern of conduct that adds up to the finding of bad faith registration of the disputed domain name. Therefore, the Respondent knew the Complainant's trademark at the time it registered the disputed domain name and registered the disputed domain name in bad faith.

2) Use of the disputed 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."

As provided in previous paragraphs, the disputed domain name redirected to a website with URL <http://ww2.affinity.net/> before eventually resolving to the Complainant's website <https://www.lovehoney.com/> which has been established as bad faith use according to previous UDRP decisions.

The Complainant would like to draw the panel's attention that the disputed domain name has been listed for sale by the Respondent. Although the Respondent did not specify the price, it is obvious that the Respondent has been trying to collect commercial gain from the disputed domain name.

Moreover, also as provided in the previous paragraphs, the Complainant tried to contact the Respondent through a cease-and-desist letter. In the cease-and-desist letter, the Complainant advised the Respondent that the unauthorized use of their trademarks within the disputed domain name violated their trademark rights and the Complainant requested a voluntary transfer of the disputed domain name. 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 view of the above, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith and its conduct falls within the meaning of Paragraph 4(a)(iii) of the Policy.

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. RIGHTS

The disputed domain name LOVELHONEY is confusingly similar to the Complainant's registered trademarks LOVEHONEY, since it reproduces the Complainant's mark, merely adding the letter "L" between LOVE and HONEY.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the domain name in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D20020856:

“As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed domain name, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists.” WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

The Complainant has proved that the Respondent does not appear to hold any trade mark with the name LOVELHONEY.

Moreover, it seems reasonable to assume that if the Respondent had had rights or legitimate interests in the name, and would have made them known by replying to the Complainant's C&D letter.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant's allegations and evidence with regard to the Respondent's registration and use of the disputed domain name in bad faith.

The Complainant has filed evidence of the well-known character of its LOVEHONEY trademark. The disputed domain name resolves to the Complainant's website. Therefore, it seems clear that the Respondent is trying to impersonate the Complainant.

Paragraph 4(b) (iii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location.

As mentioned in *Andrey Ternovskiy dba Chatroulette v. Alexander Ochki*, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see *AT&T Corp. v. Amjad Kausar*, WIPO Case No. D2003-0327)."

The Respondent has also been a Respondent in a large number of UDRP proceedings before the WIPO in which the complaints have been upheld because the domain names also included well-known trademarks and had been registered in bad faith. This circumstance clearly constitutes evidence of bad faith, as the Respondent has engaged in a pattern of such conduct.

It has, therefore, been satisfactorily demonstrated to the Panel that the disputed domain name has been 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. **LOVELHONEY.COM**: Transferred

PANELLISTS

| | |
|------|--------------------------------|
| Name | José Ignacio San Martín |
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DATE OF PANEL DECISION 2021-10-14

Publish the Decision
