

Decision for dispute CAC-UDRP-104484

Case number **CAC-UDRP-104484**

Time of filing **2022-04-08 08:54:44**

Domain names **lovehoney.cat**

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

Organization **Lovehoney Group Limited**

Complainant representative

Organization **BRANDIT GmbH**

Respondent

Name **Sebastian Moreno**

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- US trade mark registration no. 3350209, registered on 11 December 2007, for the word mark LOVEHONEY, in classes 3, 5, 10, 25, 28 and 35 of the Nice Classification;
- International trade mark registration no. 1091529, registered on 27 June 2011, designating Australia, Switzerland, China, Iceland, Japan, Norway, New Zealand, Russian Federation and Singapore, for the word mark LOVEHONEY, in classes 3, 5, 10, 25, 28 and 35 of the Nice Classification; and
- EU trade mark registration no. 003400298, registered on 17 January 2005, for the word mark LOVEHONEY, in classes 3, 5, 10, 25, 28 and 35 of the Nice Classification.

(hereinafter and interchangeably, “the Complainant’s trade mark”; “the Complainant’s trade mark LOVEHONEY”; or “the trade mark LOVEHONEY”).

FACTUAL BACKGROUND

The Complainant's contentions can be summarised as follows:

A. Background history

The Complainant is LOVEHONEY Group Limited, founded in 2002, and the largest British company selling sex toys, lingerie and erotic gifts on the Internet operating as a retailer, manufacturer and distributor. The Complainant has over 400 own brand products and exclusive licenses to design, manufacture and sell featured adult pleasure products, which the Complainant commercialises in 46 countries across Europe, North America and Australasia.

The Complainant also enjoys a strong online presence via its official websites and social media channels, notably <lovehoney.com>; <lovehoney.eu>, <lovehoneygroup.com>; and <lovehoney.co.uk>.

In addition to the trade marks mentioned under the above section "Identification of rights", and other trade marks in its portfolio, the Complainant informs that it is also the owner of numerous domain names which contain the term "LOVEHONEY", including <lovehoney.com>, which was registered as far back as 1998.

The Complainant seeks the transfer of the disputed domain name <lovehoney.cat> to it ("the disputed domain name") on the grounds set out in section B below.

B. Legal grounds

I. The disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

The Complaint submits that the disputed domain name <lovehoney.cat> is identical to the Complainant's trade mark LOVEHONEY; and that the generic Top-Level Domain ("gTLD") <.cat> should be disregarded in the assessment of this Policy ground given that a TLD is a domain name's standard registration requirement.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant states that the disputed domain name was registered on 25 November 2021, many years after the registration of the Complainant's trade mark LOVEHONEY, and that it resolves to an inactive webpage ("the Respondent's website").

The Complainant further states that the Respondent has never been given any right or license to use the trade mark LOVEHONEY, nor is the Respondent affiliated to the Complainant in any form or has the Respondent or the Respondent's website been endorsed or sponsored by the Complainant.

In addition, the Respondent is not known by the disputed domain name, nor does the Respondent own any corresponding registered trade mark including the terms "lovehoney.cat"; the Respondent is not making a bona fide offering of goods or services by means of the disputed domain name, nor is the Respondent using the disputed domain name for legitimate non-commercial or fair use.

In order to further support the Complainant's assertions under this Policy ground, the Complainant alludes to paragraphs 2.5.1 and 3.3 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0").

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

Registration

The Complainant avers that it is inconceivable that the Respondent was unaware of the existence of the Complainant when it

registered the disputed domain name. The Complainant further avers that it is very likely that the Respondent registered the disputed domain name in order to take advantage of both the trade mark LOVEHONEY's reputation and the Complainant's goodwill.

Use

The Complainant contends that the disputed domain name is held passively, and that the Respondent has intentionally used it name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (paragraph 4(b)(iv) of the UDRP Policy).

In order to further support the Complainant's assertions under this Policy ground, the Complainant alludes to paragraphs 3.1.4 and 3.3 of the WIPO Jurisprudential Overview 3.0.

As additional indicia giving rise to a presumption of bad faith, the Complainant refers to the Respondent's failure to respond to the Complainant's cease-and-desist letter.

The Complainant therefore concludes that the Respondent has registered and 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 that the disputed domain name is identical or confusingly similar to a trade 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

A. Preliminary Matter: Language of Proceeding

A.1 The Complainant's language request

The Complaint was filed in English.

The registrar's verification response indicated that the language of the registration agreement for the disputed domain name is Spanish.

In the Complaint, the Complainant submitted a request for English to be the language of proceedings, in respect of which the Complainant advanced the following grounds:

(i) the disputed domain name is composed of the trade mark LOVEHONEY, which consists of the English words "love" and "honey";

(ii) the choice of the gTLD <.cat> reinforces the assertion that the Respondent understands English and aims to target English speaking visitors;

- (iii) the Complainant is a UK based company whereas the Respondent is located in Colombia. Therefore, the English language, being commonly used internationally, would be considered as neutral for both Parties in the present case; and
- (iv) a translation of the Complaint would entail significant additional costs for the Complainant and would delay the proceedings.

A.2 The Panel's determination

The Panel is given wide discretion under Rule 11 (a) of the UDRP Rules to determine the appropriate language of the administrative proceedings having regard to all the case circumstances. The Panel notes, however, that Rule 10 (b) and Rule 10 (c) of the UDRP Rules vest the Panel with authority to conduct the proceedings in a manner that it deems appropriate, while also ensuring that the parties are treated with equality, that each party is given a fair opportunity to present its case, and that the proceedings be conducted with due expedition. The Panel is therefore mindful to exercise such discretion carefully and judiciously.

The Panel's determination on the language of proceedings is centred on the following six guiding factors:

- (i) the language of the disputed domain name string: the Panel accepts that English is the only identifiable language in the disputed domain name string. The Panel agrees with the Complainant's assertion that the gTLD <.cat> is a relevant factor which sways in favour of English in this instance;
- (ii) the content of the Respondent's website: at the time of writing, the Respondent's website has no content, and it does not appear to have ever displayed any content, such that this guiding factor is immaterial to the Panel's assessment in this case;
- (iii) the language(s) of the Parties: the Complainant is based in the UK while the Respondent resides in (and may potentially be a national of) Colombia. Neither English nor Spanish would appear to be the lingua franca in the present matter, the result of which being that this guiding factor also has no bearing on the Panel's determination;
- (iv) the Respondent's behaviour (pre-dispute and in the course of the proceedings): the Panel notes that the Respondent has shown no inclination to participate in the proceedings; the Respondent did not object to the Complainant's language request, nor did it file a Response or reply to the Complainant's cease-and-desist letter;
- (v) the Panel's overall concern with due process: the Panel has discharged its duty under Rule 10 (c) of the UDRP Rules; and
- (vi) the balance of convenience: while determining the language of proceedings, the Panel has a duty to consider who would suffer the greatest inconvenience as a result of the Panel's determination. On the one hand, the determination of English as the language of proceedings is unlikely to have any bearing on the Respondent, not least given the Respondent's default throughout the proceedings. The determination of Spanish as the language of proceedings, on the other hand, is very likely to cause the Complainant inconvenience, and to interfere with the overall due expedition of the proceedings under the UDRP Rules.

In view of the above guiding factors, the Panel declares that English be the language of the proceedings.

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

B. General

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to divest the Respondent of the disputed domain name:

- i. The disputed domain name is identical or confusingly similar to a trade mark 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.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities, which lays down the foundations for panels to determine each of the three Policy elements.

C. Identical or Confusingly Similar

The UDRP test under the first element provides for a juxtaposing approach, according to which the textual components of the disputed domain name and the Complainant's trade mark are to be compared side by side.

In order to succeed under the first element of the Policy, the Complainant must provide evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark.

The Panel is satisfied that the Complainant owns trade mark rights in "LOVEHONEY" since 2005.

The disputed domain name is <lovehoney.cat>, and the Complainant's trade mark is LOVEHONEY.

The Panel notes that the disputed domain name wholly incorporates the Complainant's trade mark LOVEHONEY.

The Panel takes the view that TLD suffixes may, in some instances, operate to enhance the confusion, such that panels should be wary of this eventuality while determining this Policy ground (see e.g. CAC Case No. 103774, BOURSORAMA SA v Benjamin Kors). Nevertheless, TLD suffixes are often disregarded in the assessment of identity/confusing similarity, the reason being that the TLD is part of a domain name's anatomy (see WIPO Jurisprudential Overview 3.0, paragraph 1.11). In the present matter, the Panel considers that the suffix <.cat> has no bearing on the assessment of this Policy ground.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

D. Rights or Legitimate Interests

The Respondent has not participated in these UDRP proceedings. The Panel is however empowered to draw adverse inferences from the Respondent's disinclination to participate (Rule 14 (b) of the UDRP Rules).

The Panel notes that the Complainant denies any affiliation and/or association with, or authorisation for, the Respondent of any nature. Moreover, the Complainant further argues that the Respondent is not known by the disputed domain name; and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

The Complainant has provided evidence to support its contentions, whereas the Respondent did not deny or contradict any of the Complainant's assertions.

In addition, in the Panel's view, the choice of a domain name which incorporates a complainant's trade mark wholly (as in this case) or virtually wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for this coincidence, could further evidence a lack of rights or legitimate interests.

The Panel has perused the available record and considers that substantial evidence sways in favour of the Complainant in this case.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

E. Registered and Used in Bad Faith

In order to meet the third requirement under the Policy, the Complainant must provide evidence that the disputed domain name was registered and is being used in bad faith.

The Policy enumerates non-exhaustive circumstances which would evidence bad faith registration and use of a domain name, as follows:

- i. circumstances indicating that the respondent has registered or has acquired the domain name 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 your documented out-of-pocket costs directly related to the domain name; or
- ii. the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- iii. the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

E.1 Registration in bad faith

The following elements are compelling indicia to this Panel that the disputed domain name was registered in bad faith:

- The Complainant has been in operation since 2005, whereas the disputed domain name was registered in 2021;
- The disputed domain name is identical to the Complainant's trade mark LOVEHONEY;
- The Complainant operates its activities through various domain names which bear the trade mark LOVEHONEY. For instance, and most notably, the domain name <lovehoney.com>, which was registered in 1998;
- The lack of any credible evidence-backed rationale for the Respondent's choice of the disputed domain name;
- UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known in its field of business; and
- The Respondent's lack of participation in the course of these UDRP proceedings and at the pre-dispute stage (cease-and-desist letter).

E.2 Use in bad faith

The Complainant alleges that the Respondent has held the disputed domain name passively, and further contends that the

Respondent has engaged in the conduct described in paragraph 4(b)(iv) of the UDRP Policy, which provides as follows:

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

Furthermore, the Complainant alludes to the Respondent's failure to respond to the Complainant's cease-and-desist letter as additional evidence of bad faith use.

The Panel has perused paragraph 3.3 of the WIPO Jurisprudential Overview 3.0 to determine whether or not there has been bad faith use of the disputed domain name. UDRP panels have found that the non-use of a domain name may support a finding of bad faith under certain circumstances.

In the present matter, the Panel considers the most conducive factors to a finding in favour of the Complainant under this Policy ground (i) the degree of distinctiveness or reputation of the Complainant's trade mark; (ii) the Respondent's default; and (iii) the implausibility of any good faith use to which the disputed domain name may be put.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LOVEHONEY.CAT**: Transferred

PANELLISTS

Name	Dr Gustavo Moser
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DATE OF PANEL DECISION	2022-05-08
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Publish the Decision