Decision for dispute CAC-UDRP-104469

Case number	**CAC-UDRP-104469**
Time of filing	**2022-04-01 09:21:28**
Domain names	**lovehoney.website**

Case administrator

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

Complainant

Organization	**Lovehoney Group Limited**

Complainant representative

Organization	**BRANDIT GmbH**

Respondent

Name	**Wu Yu**

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 owns trademark registrations for LOVEHONEY registered in different classes of Nice Classification (hereafter 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 Zeeland, Russian Federation and Singapore;
EU trademark registration No. 003400298 LOVEHONEY, registered on January 17, 2005;
China trademark registration No. 2969311 LOVEHONEY, registered on January 28, 2020;
China trademark registration No. 27012901 LOVEHONEY (figurative), registered on October 7, 2019; and
China trademark registration No. 27624024 LOVEHONEY, registered on January 21, 2019.

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. The Complainant uses these domain names to connect to websites through which it informs potential customers about its LOVEHONEY mark and its products and services.

FACTUAL BACKGROUND

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 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, 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.

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 disputed domain name, and (iii) the disputed 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.

The disputed domain name incorporates, in its second-level portion, the Complainant’s trademark LOVEHONEY in its entirety and, in its first-level portion, the generic Top-Level Domain (“gTLD”) “.website”. The generic Top-Level Domain “.website” 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, inserious, WIPO Case No. D2019-0169; Bugatti International S.A. v. Ruanxiaojiao, WIPO Case No. D2017-2555).

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

The disputed domain name was registered on October 9, 2021, 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.

It has been mentioned in earlier WIPO decisions that the domain names identical to third parties' trademarks create a very high risk of association with the trademark owner. Namely, WIPO Case No. D2016-1698 Eli Lilly and Company and Novartis Tiergesundheit AG v. Manny Ghumman/Mr.NYOB/Jesse Padilla where the Panel stated the following: Generally speaking, UDRP panels have found that domain names identical to a third-party trademark carry a high risk of such affiliation. Where the domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP jurisprudence broadly holds that this cannot constitute nominative fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The same is stated in Section 2.5.1 of "WIPO Jurisprudential Overview 3.0".

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademark including the terms "lovehoney.website". The Complainant asserted this by providing result of we searcher for the terms "lovehoney" or "lovehoney.website", "Wu Yu" along with the terms "lovehoney.website"or <wy65535@126.com> along with the terms "lovehoney.website".
At the time the Complainant found out the disputed domain name (October 20, 2021) the disputed domain name used to resolve to an active page Pay Per Click Page containing the links to third party's websites such as: "Sell on Google with Shopify", "Easy With Drag & Drop" and alike. Such links also displayed third parties' websites or e-commerce platforms (shopify.com, magezon.com).

At the time of filling of this complaint the disputed domain name resolves to an active page Pay Per Click Page containing the links such as "Promotion", "Trending Products for Dropshipping" and others. By clicking on such links the web-site further redirects to third parties' web-sites where visitors can purchase goods and/or services.

UDRP Panel held that "UDRP panels agree that using a domain name to host a PPC website does not present a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's trademark or otherwise mislead Internet users" (see UNIQA Insurance Group AG v. Super Privacy Service LTD c/o Dynadot, WIPO Case No. D2017-0334). More precisely, when the Respondent has sought to take commercial advantage of the goodwill associated with the Complainant's trademarks, UDRP Panel have found that the Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy (see Calzedonia S.p.A. v. Super Privacy Service LTD c/o Dynadot, WIPO Case No. D2019-0754).

In similar circumstances Panels have stated "The Respondent's use of the Domain Name for a parking page displaying sponsored links for a variety of goods and services, including for goods and services for which the Complainant's trademarks have been registered, cannot constitute a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the Domain Name, as the Respondent is unduly profiting from the trademark value attached to the Complainant's trademarks. Indeed, prior panels deciding under the Policy have held that pay-per-click ("PPC") parking pages built around a trademark (as opposed to PPC pages built around a dictionary word and used only in connection with the generic or merely descriptive meaning of the word) do not constitute a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy, nor do they constitute a legitimate non-commercial or fair use pursuant to paragraph 4(c)(iii). See Ustream.TV, Inc. v. Vertical Axis, Inc, WIPO Case No. D2008-0598. See also paragraph 2.6 of the WIPO Overview 2.0." Please see Fontem Holdings 4, B.V. v. J- B-, Limestar Inc., WIPO case No. D2016-0344.

Moreover, the website associated with the disputed domain name displays a message offering the domain name for sale. Namely, the message at the bottom of the page reads: "The owner of lovehoney.website is offering it for sale for an asking price of 1999 USD". This way, the Respondent is trying to obtain commercial gain from owning the disputed domain name rather than using it in good faith.

Moreover, the Respondent's identity is not disclosed on the publicly available Registrar's WHOIS regarding the disputed domain name <lovehoney.website>. The Respondent is using a privacy shield. Hence, the Respondent is most likely aiming at hiding its identity rather than being known by the disputed domain name.

Furthermore, the Complainant tried to reach the Respondent by sending a cease and desist letter on February 8, 2022 to the abuse contact of the Registrar as available WHOIS records. The Complainant also tried to reach out to the Respondent by sending on-line form as provided by the Registrar for contacting the registrants. The Registrant did not reply but 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 many years after the first registrations of the Complainant's LOVEHONEY trademarks. The Respondent has chosen to incorporate the trademark LOVEHONEY in the disputed domain name in its entirety.

By conducting a simple online search regarding the term "lovehoney" or "lovehoney.website", the Respondent would have been aware of the Complainant and its mark. In the most popular search engines, the Complainant's website or social media accounts or related topics will appear as top first results. As previously stated by UDRP Panels, in such circumstances, the Respondent would have learnt about the Complaint, 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 43,749 people on Facebook, on Instagram the Complainant is followed by 154 thousand followers, Twitter account is also popular among consumers and followed by 57,5 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, it is very likely that the Respondent registered the disputed domain name incorporating the trademark LOVEHONEY intentionally in order to take advantage of reputation of the trademark and Complainant's goodwill.

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"

Firstly, the disputed domain name contains the Complainant's trademark LOVEHONEY entirely.

UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation (Section 2.5.1 of "WIPO Jurisprudential Overview 3.0").

Secondly, as noted previously, the disputed domain name redirects to a website containing pay-per-click links. The pay-per-click website to which the disputed domain name redirects displays links to the e-commerce marketplaces and third parties' web-sites where customer can purchase different type of goods. Such use of the aforesaid disputed domain name creates a likelihood of confusion in Internet users' mind and may lead them to click on sponsored links displayed on the PPC page, action which generates revenues for the Respondent.

PPC pages aim at generating revenues by diverting Internet traffic to sponsored links. PPC pages generate revenues when Internet users click on the links displayed on the page. Where such links are based on trademark value, UDRP panels have

tended to consider such practices generally as unfair use resulting in misleading diversion" (see Camilla Australia Pty Ltd v. Domain Admin, Mrs Jello, LLC, WIPO Case No. D2015-1593).

Also, the panels earlier stated: In similar circumstances Panels stated the following “[t]hrough either displaying a PPC parking page or using a dynamic redirection scheme on the website at the disputed domain name …” it has been held that the “Respondent is likely to have made substantive commercial gain by ‘freeriding’ on the reputation of Complainant and its trademarks, which is indicative of Respondent’s bad faith use of the disputed domain name” (See BASF SE v. Zhang Xiao, WIPO Case No. D2017-2200).

In addition, as mentioned earlier the website associated with the disputed domain name displays a message offering the domain name for sale. Namely, the message at the bottom of the page reads: “The owner of lovehoney.website is offering it for sale for an asking price of 1999 USD”. Since the Respondent, as the Complainant have stated in the previous paragraphs, has not been making legitimate non-commercial or fair use of the disputed domain name nor is using the disputed domain name in connection with a bona fide offering of goods or services, it is likely that the Respondent has registered the disputed domain name with the intention to obtain commercial gain.

Moreover, the Complainant tried to contact the Respondent on December February 8, 2022 through a cease-and-desist letter. In the cease-and-desist letter sent via Registrar, 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 Complainant also tried to reach out by sending on-line form provided by the Registrar to contact the registrant. 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).

Furthermore, the WHOIS associated with the disputed domain name <lovehoney.website> at the time of sending cease and desist letter and filling the complaint used to show Privacy shield hiding the registrant’s identity and contact details. It is very likely that the Respondent was trying to conceal its identity which is further evidence of bad faith (see Avast Software s.r.o. v. Victor Chernyshov, CAC Case No. 101962).

Lastly, by conducting reverse WHOIS records with the e-mail address of the Respondent <wy65535@126.com> it appears that there are 2,861 domain names registered by the Respondent, some of which also contain third-party trademarks and/or with misspelling (e.g. apppe.us, misspelling of Apple’s domain name apple.us or airblatic.us, misspelling of Air Baltic® trademark, and many others) which has formed a pattern of conduct of abusive domain name registration that further demonstrates the bad faith on the part of the Respondent.

In view of the above, the Complainant 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).

It is well established that the specific top level of a domain name such as “.com”, “.org” or in this case “.website” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar. Therefore, the disputed domain name is identical to the Complainants trademark LOVEHONEY.

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).

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use his trademarks in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark LOVEHONEY and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name currently resolves to an active website with pay-per-click links, on the website the disputed domain name is furthermore offered for sale. The registrant's identity is hidden behind a Privacy shield for the disputed domain name and the Respondent is according to WHOIS the owner of more than 2.800 domain names that to a large extent include third party trademarks or misspellings thereof.

The Respondent is in the view of this Panel engaged in a pattern of conduct. Not discussing all the elements in this pattern this Panel concludes that already the Respondent's use of the disputed domain name for a parking page displaying sponsored links for a variety of goods and services, including for goods and services for which the Complainant's trademarks have been registered, cannot constitute a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name, and such use does not constitute a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy, nor does it constitute a legitimate non-commercial or fair use pursuant to paragraph 4(c)(iii) of the Policy. Therefore, this Panel finds that the disputed domain name is being used in bad faith.

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.

Furthermore, the Panel has been advised that the language of the registration agreement for the disputed domain name is English. As the Respondent has failed to file a Response or any other manner of submission in this case and has also not objected to use of the English language for the pleadings, the Panel has decided that it is equitable and appropriate for the language of this decision to be English.

PRINCIPAL REASONS FOR THE DECISION

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

i. the disputed 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 with respect to the disputed domain name; and
iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is identical to its trademarks and its domain names. Indeed, the trademark is fully incorporated in the disputed domain name.

The disputed domain name is therefore deemed identical.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered. Several examples of bad faith use have been presented to this Panel. It is concluded that the Respondent by at least using the disputed domain name to host a PPC website makes bad faith use of the disputed domain name.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) 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.WEBSITE**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2022-05-10

Publish the Decision