

Decision for dispute CAC-UDRP-104696

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| Case number | CAC-UDRP-104696 |
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| Time of filing | 2022-07-07 11:32:27 |
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| Domain names | lovehoneygroup.net |
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Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (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

| | |
|------|-------------------|
| Name | Amanda Lee |
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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, founded in 2022, is the largest British company selling sex toys, lingerie and erotic gifts on the Internet, and a worldwide retailer, manufacturer and distributor.

The Complainant owns the following Trademarks:

- US trademark registration No. 3350209 LOVEHONEY registered on December 11, 2007, in force until December 13, 2027;
- International trademark registration No. 1091529 LOVEHONEY registered on June 27, 2011, in force until June 27, 2031, designating Australia, Switzerland, China, Iceland, Japan, Norway, New Zealand, Russian Federation and Singapore;
- EU trademark registration No. 003400298 LOVEHONEY, filed on October 10, 2003, registered on January 17, 2005, in force until October 10, 2023.

The disputed domain name <lovehoneygroup.net> was registered on March 20, 2022, and resolves to a parked website where the disputed domain name seems to be available for its purchase.

FACTUAL BACKGROUND

The Complainant, founded in 2002, 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. The Complainant has over 400 own brand products and exclusive licenses to design, manufacture and sell featured adult pleasure products. The Complainant 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. The Complainant 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.

The Complainant'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. The Complainant 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, the Complainant's on-line shops are easily recognized by the consumers.

Apart from the listed Trademarks, the Complainant has online presence through the following official websites:

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

Since 2002 the Complainant operates under the name Lovehoney Group Limited which became trade identifier of the Complainant and is its business name.

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 October 30, 1998); <lovehoneygroup.com> (created on March 14, 2012); <lovehoney.co.uk> (created on December 5, 2001); <lovehoney.ca> (created on September 8, 2008). Complainant uses these domain names to connect to websites through which it informs potential customers about its LOVEHONEY mark and its products and services.

According to the evidence presented before the Panel, the disputed domain name <lovehoneygroup.net> was registered on March 20, 2022, and until April 25, 2022 resolved to a Registrar's (Godaddy's) Domain Parking website with PPC links.

By the time of this Decision, the disputed domain name resolves to parked page at GoDaddy/Afternic, where the disputed domain name seems to be available for its purchase.

PARTIES CONTENTIONS

The Respondent did not submit its Response replying to Complainant's contentions.

Language of Proceedings.

The Complainant requested English as the language of the proceedings, in accordance with Paragraph 11 of the UDRP Rules, where 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).

COMPLAINANT CONTENTIONS:

- 1) The Complainant asserts that the disputed domain name is confusingly similar to Complainant’s Trademarks LOVEHONEY due to it is incorporated in its entirety along with the very term “group” which not only is a common term but also directly refer to the trade name of the Complainant – Lovehoney Group Ltd. and that therefore is closely relevant to the Complainant’s business. That, LOVEHONEY trademark is clearly recognizable in the disputed domain name. That, previous UDRP panels have constantly held that the mere addition of a descriptive term would not prevent a finding of confusing similarity to a trademark (see *WhatsApp Inc. v. Gil David*, WIPO Case No. D2019-1284; *Novartis AG v. Black Roses*, CAC No. 102137). Also that, according to the WIPO Jurisprudential Overview 3.0 para. 1.8 which states: Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.
- 2) That the Respondent has no rights or legitimate interests in respect of the disputed domain name due to it was created on March 20, 2022, many years after the registrations of the Complainant’s LOVEHONEY trademarks.
- 3) That the Complainant has never granted the Respondent any right or license to use LOVEHONEY trademark including 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.
- 4) That there is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademark including the terms “lovehoneygroup.net”.
- 5) That when searching for the term “lovehoney” or “lovehoney group” or “lovehoneygroup.net” in popular Internet search engines like Google.com, the vast majority of the results relate to Complainant’s official websites or websites directly referring to the Complainant and their products. That, when conducting searches on online trademark databases, no information was found in relation with trademarks corresponding to “lovehoney group” or “lovehoneygroup.net”. That, there were also no trademarks found in the name of the Respondent.
- 6) The Complainant sent Cease and Desist Letter to the Respondent and received response coming from the e-mail address ricker_xu@qq.com. The Complainant also conducted search by the e-mail address of the Respondent and the terms of disputed domain name and found no relevant results that would show that the Respondent is known by the disputed domain name. In addition, by searching the e-mail as of Respondent as disclosed by the Registrar 157684508@qq.com and the terms of disputed domain name there was no information found showing that the Respondent is known by the disputed domain name. Similarly, by searching by the name of the Respondent “Amanda Lee” and the terms, no results are found.
- 7) That at the time the Complainant found out about the disputed domain name (April 2022) it used to resolve to Pay Per Click Page displaying links such as “Consulting Services”, “Investment Services” and others. Such use of the aforesaid disputed domain name created a likelihood of confusion in Internet users’ mind and may have led 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).

8) At the time of filing of this Complaint the disputed domain name resolves to parked page at GoDaddy/Afternic stating that the domain name is available for sale. That, from the Complainant's perspective, the Respondent is not making a legitimate noncommercial or fair use the disputed domain name nor is using the disputed domain name in connection with a bona fide offering of goods or services, so as to confer a right or legitimate interest in it in accordance with paragraph 4(c)(i).

9) The Complainant also assert that, there is no "evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name" (see *Bollore v. Tywonina W Hill*, WIPO Case No. DCO2017-0012). That the disputed domain name has therefore not been used in connection with a bona fide offering of goods and services.

10) Since there is no evidence that the Respondent has been making legitimate noncommercial 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 by offering the domain name for sale.

11) Furthermore, the Complainant tried to reach the Respondent by sending cease and desist letter on April 24, 2022, via the abuse contact of the Registrar. 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 same day the Complainant received a response coming from the e-mail address ricker_xu@qq.com with the following text: "Hello, I own the domain name lovehoneygroup.net. Are you interested in it?".

12) The Complainant further replied to the e-mail by inserting the text of the Cease and Desist in the body of the e-mail and sent it on May 16, 2022. There was no further response to the e-mails from the Respondent despite reminders from the Complainant. The Respondent chose not to reply to the Cease and Desist letter with any compelling arguments 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).

13) Furthermore, the Whois associated with the disputed domain name <lovehoneygroup.net> at the time of sending cease and desist letter and filling the complaint shows 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).

14) That, the disputed domain name was registered and is being used in bad faith, due to the Respondent registered the disputed domain name many years after the first registrations of the Complainant's LOVEHONEY trademarks, the trademark is valid in many countries of the world including in China where the Respondent is located. The Respondent has chosen to incorporate the trademark LOVEHONEY in the disputed domain name in its entirety along with the term "group" which together forms the business name of the Complainant – Lovehoney Group.

15) That, by conducting a simple online search regarding the term "lovehoney", "lovehoney group", "lovehoneygroup.net" 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).

16) 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 and the trade name LOVEHONEY GROUP intentionally in order to take advantage of reputation of the trademark and Complainant's goodwill.

17) It should be noted that the Respondent also registered other domain name targeting the Complainant's trademark and namely the domain name <lovehoney.group> also clearly referring to the Complainant. The Complainant has filed the Complaint and it is pending with CAC, Case No. 104549. Therefore, the Respondent knew the Complainant's trademark at the time it registered the disputed domain name and registered it in bad faith.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the trademarks 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

Language of Proceedings.

The Complainant requested English as the language of the proceedings, in accordance with Paragraph 11 of the UDRP Rules, where 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.

On July 5, 2022, the Registrar Verification confirmed English as the Language of the Registration Agreement of the disputed domain name.

In addition, according with the language of the disputed domain name, the content of the website and furthermore, the Registrant's response of May 12, 2022, done in English, this Panel concludes that nothing is preventing the Registrant to understand the English Language, despite it seems to be in China. Therefore, English is the Language of the present Case, and also of its Decision.

In relation to the First UDRP Element:

The Complainant has sufficiently proved before the Panel, that owns Trademark Rights over the term LOVEHONEY, being:

- US trademark registration No. 3350209 LOVEHONEY registered on December 11, 2007, in force until December 13, 2027;
- International trademark registration No. 1091529 LOVEHONEY registered on June 27, 2011, in force until June 27, 2031, designating Australia, Switzerland, China, Iceland, Japan, Norway, New Zealand, Russian Federation and Singapore;
- EU trademark registration No. 003400298 LOVEHONEY, filed on October 10, 2003, registered on January 17, 2005, in force until October 10, 2023.

Despite the Complainant claimed Trademark Rights over the term LOVEHONEY in China, the Complainant has failed to provide such proof before the Panel (e.g.: Registration Certificates). Therefore, this Panel, will base its analysis on the list of Trademarks mentioned above.

The disputed domain name <lovehoneygroup.net> registered on March 20, 2022, it is composed by Complainant's Trademark "LOVEHONEY" and the term "GROUP", which according to the evidence it is intrinsically related to Complainant's Trade Name "Lovehoney Group Ltd.", however Trade Names as such are not part of the set of intangible assets described in the First UDRP Element (see 01059 GmbH v. VARTEX Media Marketing GmbH/Stefan Heisig, WIPO Case No. D2004-0541; Enmersan Granit Mermer ve İnşaat Taahhut Sanayi ve Ticaret A.S. v. Ibrahim Sahin, WIPO Case No. D2004-0439).

This Panel agrees with the following argument asserted by the Complainant, where the Domain Name Jurisprudence has established that:

"Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements." (see point 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0")).

The Complainant's trademark LOVEHONEY was exactly reproduced, and the additional term "group" which is, as stated above, intrinsically related to the Complainant.

It is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLD ".net", "is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test" (see point 1.11.1 of the WIPO Jurisprudential Overview 3.0").

Therefore, the disputed domain name <lovehoneygroup.net> is confusingly similar to Complainant's LOVEHONEY Trademarks.

Regarding the Second UDRP Element, to this Panel it is clear that:

(1) the Respondent registered the disputed domain name on March 20, 2022, meaning at least 19 years AFTER the Complainant's acquired its trademark rights over LOVEHONEY on October 10, 2003 (EUIPO, Reg. No. 003400298);

(2) the Complainant has never granted the Respondent any right or license to use LOVEHONEY trademark including 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;

(3) there is no evidence that the Respondent corresponds or has become commonly known by the disputed domain name or owns any corresponding registered trademark including the terms "lovehoneygroup.net";

(4) the Respondent is not making a bona fide offering of goods or services nor for a legitimate non-commercial or fair use of the disputed domain name, which is based on the Complainant's Trademark LOVEHONEY, to resolved in a Parking Page Website hosting PPC links (until April 25, 2022), and currently to a Parking Page Website where the disputed domain name seems to be available to its purchase.

In relation to this aspect, point 2.9 of the WIPO Jurisprudential Overview 3.0 states that: "Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or

legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark.”

Therefore, this Panel finds that the Complainant has successfully made a prima facie case, which was not rebutted in any manner by the Respondent and concludes that the Respondent have no rights or legitimate interests in respect of the disputed domain name.

In relation to the Third Element of the UDRP, the Bad Faith, this Panel analyses the following:

Registration in Bad Faith:

The Complainant has 20 years in the market, with strong online presence, including at social media, and acquired its first trademark rights at least since October 2003, meaning more than 15 years BEFORE the Respondent registered the disputed domain name on March 20, 2022. The disputed domain name is based on the Complainant's Trademark LOVEHONEY and its Trade Name Lovehoney Group Ltd.

The Complainant sent to the Registrant, a Cease-and-Desist Letter on April 25, 2022, via the abuse contact of the Registrar. On May 12, 2022, the Respondent replied, with the following question only: “Hello, I own the domain name lovehoneygroup.net. Are you interested in it?”. The Complainant sent its response on May 16, 2022, and reminders on May 25, 2022, and June 27, 2022. However, despite the amicable opportunities offered by the Complainant, the Respondent did not reply to these emails, choosing not to reply to the Cease-and-Desist letter with any compelling arguments 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).

Paragraph 4(b)(i) of the Policy provides the following non-exclusive scenarios as an evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 respondent's documented out-of-pocket costs directly related to the domain name.

Point 3.1 of the WIPO Jurisprudence Overview 3.0 indicates:

“(…) Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant's trademark would also satisfy the complainant's burden.”

In relation to the use of a privacy service by the Respondent in this present Case, to avoid being notified of a UDRP proceeding, supports an inference of bad faith as well (see point 3.6 of the WIPO Jurisprudential Overview 3.0).

Paragraph 4b.(ii) of the Policy indicates as a proof of bad faith registration and use of a domain name whether the respondent has engaged in a pattern of trademark-abusive domain name registrations. In the present Case scenario, the Complainant has indicated the existence of another Case with the same Respondent, identified as Amanda Lee, being Lovehoney Group Limited vs. Amanda Lee, CAC Case No. 104549, decided on July 26, 2022, where the disputed domain name <lovehoney.group> was successfully transferred to the Complainant. Emphasizing Respondent's knowledge concerning the Complainant's business and Trademark's value.

In relation to it, previous UDRP panels have held that “establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration.” (see point 3.1.2 of the WIPO Jurisprudential Overview 3.0).

Therefore, this Panel understands that this Decision will establish, from this point of time, such pattern of conduct.

Therefore, this Panel concludes that the Respondent was fully aware about the existence and Complainant's Trademark value at the time of the disputed domain name's registration and that also has incurred into paragraph 4(b)(i) of the Policy, meaning that the disputed domain name has been registered in bad faith.

Bad Faith Use:

Nothing in the evidence presented before this Panel shows that the PCC links were related to the Complainant or with any of its competitors. However, and as stated above in the analysis of the Second UDRP Element, the disputed domain name currently resolves to a Parking Page, where the disputed domain name seems to be available for its purchase.

In the present Case scenario, the Respondent on its e-mail of May 12, 2022: "Hello, I own the domain name lovehoneygroup.net. Are you interested in it?", recognizes its ownership and tempts a potential negotiation (confirming paragraph 4.b(i) of the Policy), however, the Respondent chose not to reply to the Cease-and-Desist Letter, extending the abuse, keeping the control over the disputed domain name, preventing the real activity of its website, and above all, representing an enormous, an imminent risk for the Complainant's business and Trademarks, circumstances in the view of this Panel, equivalent to The Passive Holding Doctrine.

Point 3.3 of the WIPO Jurisprudential Overview 3.0, has established in relation to the Passive Holding Doctrine, that:

"From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include:

- (i) the degree of distinctiveness or reputation of the complainant's mark;
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and
- (iv) the implausibility of any good faith use to which the domain name may be put."

In addition:

"(...) The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the specter of continuing bad faith abuse by Respondent of Complainant's Mark, name and related rights and legitimate business interests" (see *Comerica Inc. v. Horoshiy, Inc.*, WIPO Case No. D2004-0615).

Therefore, this Panel concludes that, the disputed domain name has been registered and is being used in faith as well.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LOVEHONEYGROUP.NET**: Transferred

PANELLISTS

| | |
|------|---|
| Name | Ms. MARÍA ALEJANDRA LÓPEZ GARCÍA |
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|------------------------|------------|
| DATE OF PANEL DECISION | 2022-08-09 |
|------------------------|------------|

Publish the Decision
