

ADMINISTRATIVE PANEL DECISION

Jo Malone Inc. v. Liu Peng; Domain Administrator, See PrivacyGuardian.org; Carolynn Acierno; Holmstrom Bobbie; chengju lin, chengjuyouxiangongsi; bingkun bing, kanpeilaltd; huiping zeng, huipingmaoyi; and mingxin zeng, mingxinmaoyi
Case No. D2023-4099

1. The Parties

The Complainant is Jo Malone Inc., United States of America (“United States”), represented by Fross Zelnick Lehrman & Zissu, P.C., United States.

The Respondents are Liu Peng, China; Domain Administrator, See PrivacyGuardian.org, United States; Carolynn Acierno, United States; Holmstrom Bobbie, United States; chengju lin, chengjuyouxiangongsi, Ireland; bingkun bing, kanpeilaltd, New Zealand; huiping zeng, huipingmaoyi, United Kingdom; and mingxin zeng, mingxinmaoyi, Russian Federation.

2. The Domain Names and Registrar

The disputed domain names <jomaloneoutlets.com>, <jomalonenz.com>, <jomaloneuksales.com>, and <jomaloneuk.com> are registered with 1API GmbH; the disputed domain name <jomaloneoutlet.shop> is registered with NameSilo, LLC; the disputed domain name <jomalone-sale.com> is registered with Bizcn.com, Inc.; the disputed domain name <jomalone-sale.top> is registered with Gname.com Pte. Ltd.; and the disputed domain name <jomaloneslondon.shop> is registered with HOSTINGER operations, UAB.

1API GmbH, NameSilo, LLC, Bizcn.com, Inc., Gname.com Pte. Ltd., and HOSTINGER operations, UAB are separately and collectively referred to below as the “Registrar”.

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 29, 2023. On October 2, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On October 2, 3, 4, and 7, 2023, the Registrar transmitted by email to the Center its verification responses disclosing registrant and contact information for the disputed domain names that differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 11, 2023 with the registrant and contact information of the underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaints for the disputed domain names

associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or under common control. The Complainant filed an amended Complaint in English on October 14, 2023. In response to a notification by the Center seeking clarification regarding the involved domain names in this proceeding, the Complainant filed an amendment to the Complaint in English on October 18, 2023.

On October 11, 2023 the Center sent an email communication to the Parties in Chinese and English, informing them that the language of the Registration Agreement for the disputed domain name <jomalone-sale.com> is Chinese, and inviting the Parties to comment on the language of the proceeding. On October 14, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondents did not submit any comment.

The Center verified that the Complaint together with the amended Complaint and the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents in English and Chinese of the Complaint, and the proceedings commenced on October 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 12, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on November 13, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on November 17, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant markets and sells fragrances, candles, skin care, and cosmetic products under the JO MALONE brand. Worldwide, there are currently more than 170 retail and online vendors that offer JO MALONE goods, and more than 180 JO MALONE retail stores. The Complainant holds trademark registrations for JO MALONE in multiple jurisdictions, including the following:

- United Kingdom trademark registration number UK00002009577, registered on February 16, 1996, specifying goods and services in classes 3, 25, and 43;
- United Kingdom trademark registration number UK00900062299 registered on April 14, 1998, specifying goods and services in classes 3, 4, 5, 18, 24, 25, and 42; and
- Chinese trademark registrations numbers 1150379, 1093578, and 1104647, registered on February 14, 1998, September 7, 1997, and September 21, 1997, specifying goods in classes 3, 4, and 5, respectively.

The above trademark registrations are current. The Complainant has also registered "jomalone" in multiple Top-Level Domains ("TLDs") and Secondary Level Domains ("2LDs"), including <jomalone.com>, which it uses in connection with online stores where it offers JO MALONE products for sale. The Complainant also operates social media accounts with the JO MALONE mark.

The Respondents are identified in respect of seven disputed domain names as various individuals, companies and businesses; in five of these cases their names are transcribed from Chinese. The Registrar did not disclose the underlying registrant of one disputed domain name.

The disputed domain names were registered on the dates and in the names shown below.

Registration Date	Disputed Domain Name	Registrant	Registrar
August 4, 2023	<jomaloneuk.com>	mingxin zeng, mingxinmaoyi	1API GmbH
August 6, 2023	<jomaloneslondon.shop>	Carolynn Acierno	HOSTINGER operations, UAB
August 7, 2023	<jomaloneoutlet.shop>	Domain Administrator, See PrivacyGuardian.org	NameSilo, LLC
August 9, 2023	<jomalone-sale.top>	Holmstrom Bobbie	Gname.com Pte. Ltd.
August 11, 2023	<jomaloneoutlets.com>	chengju lin, chengjuyouxiangongsi	1API GmbH
August 17, 2023	<jomalone-sale.com>	Liu Peng	Bizcn.com, Inc.
August 19, 2023	<jomaloneuksales.com>	huiping zeng, huipingmaoyi	1API GmbH
August 20, 2023	<jomalonenz.com>	bingkun bing, kanpeilald	1API GmbH

The disputed domain names resolve or formerly resolved to online stores that prominently display the JO MALONE mark and purportedly offer for sale the Complainant's JO MALONE candles, cologne, hand wash, and other products at heavily discounted prices. The websites virtually have the same layout and display photographs of the Complainant's products. Prices are displayed in different currencies, including GBP and USD. At least five of the websites display a copyright notice reserving the rights of "SHOP INC.", while another reserves the rights of "Jo Malone SHOP INC."

At the time of this Decision, only the disputed domain name <jomalonenz.com> resolves to an online store. The disputed domain name <jomalone-sale.com> resolves to a webpage that displays the JO MALONE mark with the notice "This store is currently unavailable". The other six disputed domain names no longer resolve to any active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to its JO MALONE mark. The Respondents have no rights or legitimate interests in respect of the disputed domain names. The Complainant has never authorized the Respondents to use its JO MALONE marks, or any marks confusingly similar thereto, for any purpose, including as or in a domain name. The disputed domain names were registered and are being used in bad faith. The disputed domain names all are or were being used in connection with websites meant to mimic the Complainant's own website. Orders placed through a number of the active websites by or on behalf of the Complainant were never actually fulfilled.

B. Respondents

The Respondents did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1 Procedural Issues

A. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are under common ownership and control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules. The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that the disputed domain names follow a pattern in that they all contain "jomalone" as their initial element, followed by descriptive or geographic terms, or both, and they were all registered within a short period of 16 days, with contact details that are incomplete or manifestly false in some cases. All disputed domain names resolve or formerly resolved to very similar websites displaying the JO MALONE mark and, in most cases, the same photographs. In view of these circumstances, the Panel is persuaded that the nominally different disputed domain name registrants are under common control.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

B. Language of the Proceeding

The Registration Agreements for the disputed domain names are in English, except the Registration Agreement for <jomalone-sale.com>, which is in Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint and amended Complaint were filed in English. The Complainant requested that the language of the proceeding be English for several reasons, notably the fact that the disputed domain names are all in the English language, and the active websites associated with the disputed domain names are in the English language with prices displayed in GBP. The Respondent did not comment on the language of the proceeding.

In exercising its discretion to use a language other than that of the Registration Agreement for one disputed domain name, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, 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 [WIPO Overview 3.0](#), section 4.5.1.

The Panel notes that the active websites to which the disputed domain names (including <jomalone-sale.com>) resolve or formerly resolved are in English, from which it is reasonable to infer that the Respondent is able to communicate in that language. This inference is confirmed by the fact that the

disputed domain names are under common control and the Registration Agreements for all but one of them are in English. Therefore, the Panel considers that requiring the Complainant to translate the Complaint into Chinese would create an undue burden and delay whereas accepting the Complaint in English does not cause prejudice to either Party.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

- (i) the disputed domain names are 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 in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The burden of proof of each condition is borne by the Complainant.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names. See [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds that the Complainant has shown rights in respect of the JO MALONE trademark. See [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the JOMALONE mark is recognizable within each disputed domain name. Accordingly, the disputed domain names are identical or confusingly similar to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.7. While the addition of descriptive terms (*i.e.*, "outlet", "outlets", "sale" or "sales") or geographic terms ("nz", "uk" or "london"), a plural or possessive "s", or some combination of these, may bear on the assessment of the second and third elements, the Panel finds that the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See [WIPO Overview 3.0](#), section 2.1.

The Complainant shows that the disputed domain names resolve, or formerly resolved, to websites that prominently display the JO MALONE mark and purportedly offer for sale the Complainant's JO MALONE products at heavily discounted prices. The websites display the mark above the place name "London" in the same way that it appears on the Complainant's website, and they display product and promotional photographs from the Complainant's website. The website associated with the disputed domain name <jomalone-sale.com> claimed to be an official JO MALONE site. The Respondent's websites do not offer any other products for sale (although the About Us page on three of them and a contact email address in the returns policy on a fourth make reference to third party brands). Regardless of whether the products offered for sale are genuine or counterfeit, the Respondent's websites give the overall impression that they are operated or endorsed by, or affiliated with, the Complainant. Yet the Complainant submits that it has never authorized the Respondent to use its JO MALONE marks and that the Respondent is not its authorized distributor. Nothing on the websites clarifies the lack of relationship between the Parties. In the Panel's view, this is not a use of the disputed domain names in connection with a *bona fide* offering of goods or services within the terms of paragraph 4(c)(i) of the Policy. Nor is it a legitimate noncommercial or fair use of the disputed domain names within the terms of paragraph 4(c)(iii) of the Policy. Moreover, nothing on the record indicates that the Respondent is commonly known by any of the disputed domain names within the terms of paragraph 4(c)(ii) of the Policy.

For the above reasons, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's *prima facie* case because it did not respond to the Complainant's contentions.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth of these is as follows:

(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location or of a product or service on [the respondent's] web site or location.

In the present case, the Panel notes that the Respondent registered the disputed domain names in 2023, years after the registration of the Complainant's JO MALONE marks, including in China. The disputed domain names wholly incorporate the JO MALONE mark as their respective initial elements. The disputed domain names resolve or formerly resolved to websites displaying the JO MALONE marks and photographs of the Complainant's products from its own website. In view of these circumstances, the Panel finds that the Respondent had the Complainant and its JO MALONE mark in mind when it registered the disputed domain names.

The disputed domain names are used or were formerly used to resolve to websites that mimic the Complainant's own website. In the Panel's view, the Complainant has shown that by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's JO MALONE mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or of a product on the Respondent's websites within the terms of paragraph 4(b)(iv) of the Policy.

The Panel takes note that the use of seven disputed domain names has changed and they no longer resolve to online stores. This does not alter the Panel's conclusion. In the case of two of these (the disputed domain names <jomaloneoutlets.com> and <jomaloneuk.com>), the Complainant submits that they ceased to resolve due to the Complainant's intervention prior to the filing of the Complaint. In the case of the other five of these, the change in use may be a further indication of bad faith.

Based on the available record, the Panel finds the third element of the Policy has been established.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names, <jomalonez.com>, <jomaloneoutlets.com>, <jomaloneoutlet.shop>, <jomalone-sale.com>, <jomalone-sale.top>, <jomaloneslondon.shop>, <jomaloneuk.com>, and <jomaloneuksales.com>, be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: December 1, 2023