

## **ADMINISTRATIVE PANEL DECISION**

**Marshmallow II (St. Lucia) Limited v. Privacy Service Provided by Withheld for Privacy ehf / Mueziq Ent.**  
**Case No. D2022-0321**

### **1. The Parties**

1.1 The Complainant is Marshmallow II (St. Lucia) Limited, Saint Lucia, represented by Riebling IP, PLLC, United States of America (“U.S.”).

1.2 The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Mueziq Ent., U.S.

### **2. The Domain Name and Registrar**

2.1 The disputed domain name <hedonismofatlanta.com> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2022. At that time the publicly available Whois data for the Domain Name recorded the registrant as “Redacted for Privacy”. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. Also on January 31, 2022, the Registrar transmitted by email to the Center its verification response disclosing the underlying registrant and contact details held by the Registrar for the Domain Name.

3.2 The Center sent an email communication to the Complainant on February 8, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 8, 2022.

3.3 The Center verified that the Complaint together with the amended 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”).

3.4 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 9, 2022. In accordance with the Rules, paragraph

5, the due date for Response was March 1, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 3, 2022.

3.5 The Center appointed Matthew S. Harris as the sole panelist in this matter on March 8, 2022. 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**

4.1 The Complainant is a company incorporated and located in St Lucia. It is the owner of a clothing optional all-inclusive resort located in Jamaica and with the name "Hedonism II". The resort has used that name since 1981. The Complainant's predecessor in business also operated another resort which for a number of years used the name "Hedonism III", but it changed its name in 2010 and closed in 2011.

4.2 The Hedonism II resort has been featured in many newspapers and magazines around the globe including CNN, the Daily Mail (UK), Fox News, Huffington Post, NBC News, New York Post, The New York Times, The Washington Post, Pittsburgh Post-Gazette, Toronto Sun, USA Today, Agent@Home Magazine, Black Hairstyles and Trends, Brides, Cosmopolitan, DreamScapes, Forbes, Fortune, Glamour, Marie Claire, Men's Journal, Peng Travel, Playboy, Shape, Smooth, Travel Holiday, and Women's Own. Hedonism II was also featured on numerous segments on The Howard Stern Show including an episode that is available on demand that originally aired in July 2006. In addition, it has been featured and/or mentioned on numerous TV programs including Jeopardy, the Office, HBO's Real Sex, Playboy TV, Workaholics, Tosh.O and a number of times on Naked News. A travel / humor book about the resort, titled The Naked Truth About Hedonism II by Chris Santilli, was released in its 3rd edition in December 2019.

4.3 The Complainant is the owner of a number of U.S. registered trade marks that incorporate or comprise the term "Hedonism". They include:

(i) U.S. registered trade mark No 2271059 for HEDONISM as a typed drawing in class 42, with a filing date of July 22, 1997 and a registration date of August 17, 1999; and

(ii) U.S. registered trade mark No 3606112 for HEDONISM as a standard character mark in classes 43 and 44 with a filing date of January 10, 2006 and a registration dated of April 14, 2009.

4.4 The Complainant also operates a website from the domain name <hedonism.com> that promotes its resort. The domain name <hedonism.com> was registered on June 22, 1993 and has been used by Complainant and/or its predecessor in business since at least March 2006. The website adopts a colour scheme that is predominantly black and gold with red elements, on a white background.

4.5 The Domain Name was registered on July 28, 2021. It has been used since registration to host a website that promotes an "all-inclusive, clothing optional adult TWO (2) day experience ... in one luxurious estate" located in Helen, Georgia. The website adopts a colour scheme that is predominantly white and gold with red elements, on a black background. The website remains operational at the date of this decision.

#### **5. Parties' Contentions**

##### **A. Complainant**

5.1 The Complainant refers to its business, website, and marks and to the publicity it has obtained in various media. It contends that its marks are internationally famous and well known. The Domain Name is

said to incorporate the whole of the Complainant's HEDONISM mark to which have been added the generic terms "of" and "Atlanta", and the ".com" top level domain ("TLD").

5.2 In one part of the Complaint the Complainant contends that the Domain Name has been used to impersonate the Complainant and to trade off the goodwill the Complainant has established under its, HEDONISM marks. In other part of the Complaint the allegation is that the Respondent is attempting the Domain Name as being affiliated with the Complainant. In yet another, the allegation is one of "fraud". In this respect the Complainant relies upon alleged similarities in colour schemes between its and the Respondent's website, and the fact that the website operating from the Domain Name states that its vacation experience is "all-inclusive" and "clothing optional". This is said to demonstrate that the Complainant does not have a right or legitimate interest in the Domain Name and that the Domain Name was registered in bad faith.

5.3 The Complainant acknowledges (in a footnote to the Complaint) that "Hedonism" is a word that "can be found in the dictionary and is generally defined as "the doctrine that pleasure or happiness is the sole or chief good in life", but contends that in this case the word is not genuinely being used in its dictionary sense.

5.4 The Complainant also alleges that a particular concern regarding the Respondent's use of the term is that the Respondent's events, in alleged contrast to the Complainant's resort do not "follow any COVID protocols" and that if as a result any of the Respondent's customers get sick, could significantly and irreparably tarnish Complainant's reputation.

## **B. Respondent**

5.5 The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

6.1 There are no exceptional circumstances within paragraph 5(f) of the Rules so as to prevent this Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to lodge a formal Response.

6.2 Notwithstanding the default of the Respondent, it remains incumbent on the Complainant to make out its case in all respects set out in paragraph 4(a) of the Policy. Namely, the Complainant must prove that:

(i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights (paragraph 4(a)(i)); and

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name (paragraph 4(a)(ii)); and

(iii) the Domain Name has been registered and is being used in bad faith (paragraph 4(a)(iii)).

6.3 However, under paragraph 14(b) of the Rules, where a party does not comply with any provision of the Rules, the Panel shall "draw such inferences therefrom as it considers appropriate".

## **A. Identical or Confusingly Similar**

6.4 The Complainant has satisfied the Panel that it has registered U.S. trade marks that comprise or incorporate the word "Hedonism". In order to satisfy the first element of the Policy it is usually sufficient for a complainant to show that the relevant mark is "recognizable within the disputed domain name" (as to which see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)))).

6.5 The Panel accepts that the only sensible reading of the Domain Name is as the term “Hedonism” in combination with the words “of” and “Atlanta”, and the “.com” TLD. As a consequence, the term “Hedonism”, in which the Complainant has trade mark rights, is clearly recognisable in the Domain Name. The Complainant has, therefore, satisfied paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

6.6 For reasons that are set out in greater detail in the “bad faith” section of this decision, the Panel has formed the view that the Respondent has chosen and is using the Domain Name in order to suggest that the Respondent’s business is in some manner affiliated with that of the Complainant when it is not or at the very least in a way that seeks to take unfair advantage of the reputation of the Complainant’s trade marks. There is no right or legitimate interest in using a Domain Name in this way and it is *prima facie* evidence that no such right or legitimate interest exists (see section 2.15 of the [WIPO Overview 3.0](#)). Therefore, in the absence of any argument or evidence to the contrary the Complainant has made out the requirements of paragraph 4(a)(iii) of the Policy

### **C. Registered and Used in Bad Faith**

6.7 The Complainant contends (at least in parts of its Complaint) that the Respondent is engaged in fraudulent impersonation of the Complainant. On the material before it, the Panel considers that the Complainant puts its case too highly. The Panel does not accept that the Respondent is deliberately holding itself out as the Complainant and as the operator of the Complainant’s resort in Jamaica. There is no direct reference to the Complainant or the Complainant’s business on the website operating from the Domain Name. The Panel also finds the Complainant’s references to similar colour schemes being used on the Complainant’s website and the Respondent’s website unconvincing. The colours are used in very different ways (with the Respondent’s website using a black background, as opposed to the Complainant’s crisper look and white background), and each website has a very different look and feel. The Respondent website is not a clone or even an imitation of the site of the Complainant.

6.8 However, the Panel does accept on the balance of probabilities that the Respondent is at best deliberately seeking both by way of the Domain Name alone, and by the website operating from the Domain Name, to associate itself with the Complainant’s business in order to gain financial advantage from that association, and most likely with a view to suggesting some form of affiliation with the Complaint.

6.9 This is not because the Respondent is offering “all inclusive” packages on its website. There is nothing unique in that. It is because:

- (i) The Complainant has demonstrated to the satisfaction of the Panel that its resort had established a high degree of publicity and reputation, at least in the U.S., for its “Hedonism” branded resort in the 40 or so years that it has used that name prior to the registration of the Domain Name.
- (ii) The Respondent is offering a very similar sort of “clothing optional” experience (albeit in a different location) to that offered by the Complainant.
- (iii) Given the business in which the Respondent is engaged, the Panel accepts that the Respondent was aware of the Complainant’s use of and reputation in the HEDONISM mark when it chose the Domain Name.
- (iv) Although the word “Hedonism” is an ordinary English word, the Panel accepts that the Respondent is not using and did not intend to use the term “Hedonism of Atlanta” in a purely descriptive sense. First, the phrase “Hedonism of Atlanta” (as opposed to “Hedonism in Atlanta”) is grammatically awkward. Although, it is possible to use those words descriptively in a sentence, the words on their own strongly suggests something called “Hedonism” operating in the Atlanta area. Further, any doubt about this is dispelled by the way in which “Hedonism” is being used on the Respondent’s website. There “Hedonism” is clearly being

used as part of a name for a business rather than descriptively. No doubt both the Complainant and the Respondent are offering what might be described as a hedonistic experience, and the choice of the word "Hedonism" is a deliberate reference to this. Nevertheless, that is not inconsistent with the conclusion that the Respondent's use involves a deliberate reference to the Complainant's mark.

(v) The Complainant has made a series of serious allegations as to the Respondent's motives that the Respondent has chosen not to refute. A Complainant bears the burden of demonstrating that the requirements of the Policy have been satisfied. But there are occasions where a failure to respond to allegations that have clearly been made in a complaint, is something that of itself is of some evidential weight. This is one of them.

6.10 In the opinion of the Panel the use of the Domain Name in this case falls within the example of circumstances that are evidence of bad faith set out in paragraph 4(b)(iv) of the Policy. However, even if that is not right, the Domain Name involves an unfair taking advantage of the reputation of the Complainant's mark for its own financial advantage. This is sufficient to justify a finding of bad faith registration or use (as to which see section 3.1 of the [WIPO Overview 3.0](#)).

6.11 The Complainant has, therefore, satisfied the requirements of paragraph 4(a)(iii) of the Policy

## 7. Decision

7.1 For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <hedonismofatlanta.com> be transferred to the Complainant.

*/Matthew S. Harris/*

**Matthew S. Harris**

Sole Panelist

Date: March 16, 2022