



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1600851
First Complainant:	Fawn James
Second Complainant:	India James
First Respondent:	Madame Jojo's Ltd
Second Respondent:	Paris Bloom also known as Paris Tkacyk
Disputed Domain Name(s):	<madamejojios.com>

1. The Parties and Contested Domain Name

The Complainants are Fawn and India James, of Soho Estates, 12-14 Greek Street, London W1D 4DL, United Kingdom.

The Respondents are Madame Jojo's Limited and Paris Bloom also known as Paris Tkacyk, of the Old Bank, 349 Archway Road, London N6 5AA, United Kingdom.

The domain name at issue is <madamejojios.com> registered by one of the Respondents with PDR LTD., of Nesco Complex, 501, Nesco IT Park, Western Express Highway, Goregaon(East), Mumbai, Maharashtra 400063 India.

2. Procedural History

This case has a somewhat tortuous but important procedural history. On 16 February 2016, the Complainant submitted the Complaint to the Hong Kong International Arbitration Center ("the Center"). On 17 February 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the Center its verification response indicating that the First Respondent was listed as the registrant and providing the contact details.

The Center notified the Complainants of a formal deficiency in the Complaint on 29 February 2016. On 3 March 2016, the Complainant filed with the Center its amended Complaint (the "Complaint"). The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") and the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the First Respondent of the Complaint, and the proceedings commenced on 4 March 2015. On 25 March 2016, the Second Respondent filed a Response with the Center. On the Form R, the Respondent inserted herself as the Respondent to the Complaint. The Complainant responded on 30 March 2016, by asking for the right to reply to the Response. The Center replied the following day correctly that this would be a matter for the Tribunal to decide.

On 7 April 2016 the Center notified the Parties of the Commencement of Panel Appointment Process and appointed Adam Samuel as the sole panelist in this matter. The Panel finds that it was properly constituted. The Panel submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On 8 April, the Panel issued a procedural order asking a number of questions of both parties about the Complaint and the Response. The purpose and effect of the procedural order was to give the Complainant the right of reply to the Response that it had requested and an opportunity to respond to concerns that the Panel had about certain elements of the Complaint. At the same time, the Procedural Order sought to obtain from the Respondent replies to factual matters raised in the Complaint which had not been answered in the Response.

The Procedural Order read:

“1. The Panellist has serious concerns about both Complaint and Response and would like to receive further submissions and clarifications as regards each of these documents.

2. The Panellist would appreciate it if the Complaint would respond to the following arguments that the Respondent could and/or has implicitly or explicitly raised in the Response. The Respondent is welcome to make any submissions on these points at the same time and/or in the 14 days following their receipt by the Centre and forwarding to the Respondent:

2.1 Why, if the Complainants’ family has owned common law trademark rights in the name MADAME JOJO’S presumably, according to the Complaint, since before 2000, the Complainants did not bring this complaint for sixteen years, until after the closure of the club on which the Complainants’ goodwill essentially rests.

2.2 There is an absence of both legal and evidential support for the statement that seems to appear in the complaint that the Complainants or their grandfather owned common law rights in the name Madam Jojo’s prior to 2013. The Panel knows about the club that used to bear that name and was owned by the Complainants. It is unclear how ownership of a business however well-known of itself would have constituted a common law trademark in 2000 or indeed prior to 2013. The common law trademark alleged must relate to a right in English law considering the context of the Complainant’s activities. The ownership of a well-known business does not in and of itself sufficient constitute such a right in English law or generally. (The Panellist notes in this context that the cases cited in the Complaint do not relate to English law.)

2.3 Even if a standard different from English law applies to the question of whether a common law right existed between 2000 and 2013, how could registration have been considered to have been in bad faith with respect to a trademark that would not, the Response alleges, have been enforceable in English law in 2000.

2.4 The allegation that the Respondent’s possession of the disputed domain name will result in the erosion of the exclusive goodwill owned by the Complainant in its trademark is incorrect since the Complainants are not currently using the trademark concerned and no

plans have been revealed to use it. Any erosion of goodwill or substantial damage to it, as alleged in the Complaint will presumably have happened already anyway during the 16 years in which the dispute domain name has been registered. There is concern expressed in the Response that this is essentially a false allegation which itself may suggest an element of bad faith on the part of the Complainant. That might support a finding of reverse domain name hijacking which is implicit in the Response.

3. The Panellist equally would appreciate it if the Respondent would respond to the following arguments that the Respondent could and/or has implicitly or explicitly raised in the Complaint or in a reply to the Response. The Complainant is welcome to make any submissions on these points at the same time and/or in the 14 days following their receipt by the Centre and forwarding to the Respondent.

3.1. There is no dispute as to the following facts in this case: (i) the disputed domain name is confusingly similar to the Complainant's trademark; and (ii) the Complainant is entitled to succeed in its complaint as regards the first two elements of the Policy even if it registered its trademark a considerable time after the registration of the domain name.

3.2 There is no evidence that the Respondent has any rights with regard to the name "Madame Jojos" or is entitled to succeed under the second test under the Policy.

3.3 The domain name and the Respondent's company were registered for no other reason than to take advantage of the name and reputation of the Complainant's grandfather's business and the goodwill associated with the Madame Jojo's club. (The Respondent should in this context explain why if this is not the case the domain name and company were registered.)

3.4 The Response's description of the use of the dispute domain name is false and indicative of bad faith on the part of the Respondent. There is a reference to SEO, back-linking, programming, branding and artwork and the building of traffic which masks the fact that the dispute domain name was simply used to divert traffic from people looking for websites connected to the Complainants' family business to the Respondent's website. No work was done at all to develop the Respondent's domain name.

3.5 The Respondent has retained the disputed domain name in bad faith in that it no longer has any business trading in the name of Madame Jojos if it ever had one. Indeed, there is no evidence of it having conducted any trading using that name as such apart from the registration of the now defunct company and the diversion of traffic from the disputed domain name to its website which was unrelated to Madame Jojos. The website to which the disputed domain name now resolves is inoperative further indicating that it must have been registered and used in bad faith.

3.6 The allegation that a letter being unsigned has not been received is evidence of bad faith by the Respondent. A signature is not normally required for a communication to have been received.

4. Finally, the Panellist notes the reference to rental payments in the Response which suggests a more complex relationship between the parties than is apparent from the Complaint or the Response. Both sides now need to provide information about the prior relationship between the parties which seems to have a depth that is not revealed by either party's submissions.

5. The parties have 14 calendar days to respond to this order by providing the evidence and submissions requested. The Centre will forward this material to the Panellist and the relevant opposite party. The latter will then have a further 14 calendar days in which to respond from which point onwards, the Panellist will decide the case on the material submitted."

The Complainants' lawyers responded on 21 April 2016 attaching further evidence which was forwarded to and acknowledged by the Second Respondent on 21 April 2016. An e-

mail from the Panel of the same date contained a reminder to the Respondents of the need to reply and allowed them 14 days to comment on the Complainant's response to the Procedural Order. On that date, the Second Respondent indicated that, due to a computer issue, she had not been able to reply and seeking further time to do so. At the same time, though, the Second Respondent did respond to points in the Panel's 21 April 2016 e-mail. On 4 May, the Second Respondent provided a reply to the Procedural Order and to the Complainant's response to the Procedural Order. On 12 May 2016, the Complainants' lawyers responded to the Second Respondent's Reply to the Procedural Order.

3. Factual background

The Second Complainant owns a UK registered trademark no. 00003025701 for MADAM JOJO'S dated 10 October 2013 which was entered on the register on 27 March 2015. The Complainants' company, Soho Estates Limited which is run by their father, John James, owns the freehold of 8 Brewer Street, London W1F 0SE.

Madame Jojo's was a club that operated from 8 Brewer Street, London W1F 0SE for many years until it was closed in November 2014, following an incident outside the club. Westminster City Council revoked the licence for the club to operate and it is currently a building site.

The disputed domain name was registered on 27 January 2000. Although the whois.com information suggests that the First Respondent was the Registrant, the Second Respondent maintains that she registered the domain name in 2000. This view is supported by the fact that the first Respondent did not exist until 2012. The first Respondent was created by the Second Respondent on 19 October 2012. On the Companies House Register, documents show that the Second Respondent was the sole director and shareholder of the First Respondent and the address for service of legal documents was 8 Brewer Street, London W1F 0SE. The First Respondent which never seems to have traded as such was dissolved in February 2016 prior to the filing of the Complaint in this case.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name, at the time of the filing of the complaint, resolved to a website at <electriccarousel.com> whose registrant is the Second Respondent. The address and telephone contact details for both domain names are the same.
- ii. The Second Complainant is well-known and owns the trademark right to the name Madame Jojo's which has an established reputation as a cabaret and burlesque club situated in Soho, London.
- iii. The main part of the disputed domain name is identical to the Second Complainant's trademark. The Respondents are not authorized by the Complainants to use the trademark MADAME JOJO'S. The Respondents have no business relationship with the Complainants.
- iv. The Complainants' grandfather, Paul Raymond developed the original nightclub, Madame Jojo's with Joe Wright. Following a dispute, the High Court ruled that the name belonged to Mr Raymond in 1989. Paul Raymond Organisation Limited granted a lease to Dancedraft Limited over the premises and granted a licence to the same

- company which allowed the tenant to use the name Madame Jojo's at the premises but not otherwise. The document mis-names the lessee as Dancecorp Properties Limited. The disputed domain name was presumably operated by Dancedraft Limited which was dissolved in February 2016.
- v. The Complainants inherited the bulk of their grandfather's estate including his ownership of Soho Estates Limited.
 - vi. In view of the substantial goodwill and reputation in the UK of the Complainant's trade mark, the registration and maintenance of the Disputed Domain Name amounts to a false representation and this constitutes trade mark infringement.
 - vii. The Respondents' possession of the Disputed Domain Name will result in the erosion of the exclusive goodwill owned by the Complainant in the trade mark, MADAME JOJOS which is likely to cause substantial damage to that goodwill. The Disputed Domain Name is an instrument of fraud that is being used to appropriate goodwill and reputation. It is accepted that the damaging use of the disputed domain name commenced in August or September 2015 and not before.
 - viii. Although the Disputed Domain Name was registered before the Complainant's trade mark there is no doubt that the Respondent knew of the Complainant's substantial goodwill and reputation since the Disputed Domain Name was registered almost forty years after the original night club commenced use.
 - ix. The unregistered trade mark of MADAME JOJO'S was widely known in the UK and has always been the subject of substantial media attention of which the Respondent would have been aware. It is clear that the aim of the registration was to take advantage of the goodwill and reputation and cause confusion between the Disputed Domain Name and the Second Complainant's rights. Accordingly, bad faith can be found to exist.
 - x. Even if it was used in good faith to promote a nightclub called Madame Jojo's at the premises for a period of time, the use of the disputed domain after the club was closed in 2014 was not in good faith. There can be no justification whatsoever for the automatic re-direction from the disputed domain name to the <the electriccarousel.com> from August/September 2015 which was clearly intended to boost the business of the much less known, if known at all, Electric Carousel nightclub. This constituted deliberate, misleading and damaging misuse of the dispute domain and the Complainants' registered and common law rights in the Name and as such, constitutes use in bad faith.
 - xi. The Complainant still does not have any details of the domain registration or the re-direction of the domain name. This point has not been addressed in the Response or any correspondence. There is a clear lack of transparency in this matter and the lack of information from the Respondent about the disputed domain which indicates a lack of good faith.
 - xii. The Second Respondent opposed the Complainants' trademark registration in 2014. She was a director and shareholder of Hurricane Ltd which in turn owned shares in Dancedraft Ltd.
 - xiii. The Respondents were aware of the "Madame Jojos" unregistered UK trademark well before registering the Disputed Domain Name and the Respondent is using the Disputed Domain Name to attempt to attract internationally, for commercial gain, internet users to their website or other on-line location, by creating confusion with the Complainants mark as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on their website or location.
 - xiv. The first Respondent is not the correct Respondent, being a dissolved company whose assets have passed to the Crown as bona vacantia.

B. Respondent

The Respondents' contentions may be summarized as follows:

- i. When the Second Respondent registered the domain name, there was no registered trademark for MADAME JOJO'S and this remained the situation until after the Respondents ceased operating the club at that address. While the Second Respondent operated her business and domain name, this remained the case. The Complainants, their company and their grandfather expressed no interest in this until at least the registration of their trademark was confirmed. The only communications between the parties otherwise, until recently, concerned rental payments for the lease of the property.
- ii. When the lease over Madame Jojo's premises was granted to Dancedraft Limited, in 1993, the Second Respondent was 16 years of age and was never made aware of the terms of the accompanying licence on which the Complainants now rely. In 2000, the Second Respondent bought the lease from Dancedraft Limited or took an assignment of it and operated both venues from then until 2014.
- iii. The Second Respondent bought the domain name so that she could further build the brand's identity, connect with the club's client base and use digital media marketing. For 14 years, the Second Respondent paid a substantial amount of rent to Soho Estates Limited, the Complainants' company.
- iv. On 25 April 2016, the Second Complainant e-mailed the address electriccarousel@icloud.com:

"To who this may concern

I'm trying to buy the web domain for Madame Jojo's but when I've tried I'm forwarded to your website. I was wondering if you can explain this? And if you won the web domain can I buy it off you? I am reopening the venue and I saw the website domain was available not long ago, so slightly confused why it has been rebought?"

- v. The Respondent did not think that this e-mail was appropriate in the light of the current proceedings and or that it was appropriate for her to respond to it.

5. Findings

A preliminary jurisdictional matter

The Complainants' legal representatives filed this complaint against the First Respondent and now argue that neither Respondent is the proper Respondent. This point was raised for the first time after the Panel's Procedural Order. This followed the Center's and the Complainants' receipt of the Response and the appointment of the Panel.

There is a serious legal problem with an arbitration or any other form of legal proceeding being commenced by a Complainant against a Respondent company that has been dissolved. If one commenced legal proceedings in England, where all the parties are located, against a dissolved company, the Court would dismiss them as being brought against a non-existent entity. The Court could not make an order against such an entity.

In UDRP practice, it is common for complaints to be filed against parties that everyone knows do not exist. In that situation, a real potential respondent has registered a domain name using a fictitious name. Sometimes, these are presented as companies. In one of these

fictional Respondents cases, everyone knows or assumes that the real Respondent exists and is actually the owner of the disputed domain name even though that person's identity remains concealed throughout the case. This does not matter because the only meaningful orders that can be made in favour of the Complainant in UDRP proceedings concern instructions addressed not to the Respondent but the Registrar, to either cancel or transfer the domain name.

In one sense, this case resembles the fictitious Respondent type of case because it is obvious from the date of registration of the First Respondent that it did not register the domain name in 2000 because it did not legally exist at the time and that it has actually never operated. It is reasonably clear from the evidence set out below that the Second Respondent registered the domain name in 2000 and continues to control it, regardless of what is on the "whois" information held by the Registrar in this case.

The second Respondent has in effect identified herself as the correct Respondent. What the Complainants cannot do is file a complaint against a Respondent they know does not exist and then seek to remove both Respondents from the case and conclude as a result that the Complaint must succeed. Either the Panel must dismiss the Complaint altogether on the basis that the Complainant has brought it against an entity which it knows does not exist in any sense or it must take the view that the Complaint is brought against the moving mind behind the Respondent who has identified herself as the correct Respondent, namely the Second Respondent.

The Complainants have brought a complaint. A party has responded who appears on the surface to be an appropriate Respondent even though she has technically never been addressed by the Complaint. The Complainants then allowed the case to proceed to the appointment of the Panel and the issuing of the Procedural Order before raising any objection to the Respondent's participation in the case. The Complainant has continued to seek the transfer of the disputed domain name in these proceedings even after the Panel raised the question of how it could make an order against a dissolved Respondent.

The Panel has to decide this difficult matter in something of a legal vacuum. No authority has been cited on how a UDRP panel should deal with this type of situation. By continuing to pursue their Complaint, following the receipt of the Response, the Complainants must be accepting that the Second Respondent is the Respondent even while formally denying this. They must have waived their objection to the Second Respondent's participation in the proceedings by pursuing the remedy they seek which can only be granted against her not the First Respondent. For this reason, the Panel concludes that it does have jurisdiction over this case, as a complaint against the Second Respondent.

The Panel reaches the same result for another reason. The evidence shows clearly that the disputed domain name was not registered by the first Respondent but almost certainly by the Second Respondent.

The Complainants were invited by the Procedural Order to describe their relationship with the Second Respondent and essentially denied that one existed. Yet, the Second Respondent has provided a screenshot of an iMessage conversation between her and the Complainants' father, John James who runs Soho Estates, the Complainants' company that begins:

“Hi John, I trust you’re well. Why didn’t you contact me direct with regard to the domains? Paris.

Paris not sure what you mean.”

This is not the language of two people who do not know each other. If John James did not know the Second Respondent, he would not have addressed her by her first name and would not have joined in a conversation with someone he did not know. The Complainants have had the opportunity to describe the relationship that they and their companies have with the Second Respondent and they have not taken it. The Panel is left with little alternative but to believe the Second Respondent’s version of events.

Throughout the evidence presented, the Second Respondent has appeared authentic in the presentation of her role in registering the disputed domain name in 2000. She says that she ran Madame Jojo’s at the time and registered the disputed domain name to promote it. This is borne out by a report on the BBC website in 2004 at <http://news.bbc.co.uk/1/hi/england/london/4071811.stm>. It reads:

“Staff at Madame Jo Jo's, in Soho, have been given a list of Polari words compiled by linguistic history expert Paul Baker to use at work.

Polari, last spoken in the 1970s, is derived from sources including rhyming slang and Cant; a language used by criminals in the 18th century.

Club owner Paris Tkaczyk said it was a way of bridging language gaps.

"By offering staff at Madame Jo Jo's the option of learning and using Polari to refer to familiar aspects and objects of their works we are offering a fun, yet practical way of bridging any language gaps," she said.

"It also celebrates the cultural history and diversity of Soho.

"Members of our staff from overseas have really taken to the initiative, because Polari expressions such as fabulosa and aqua have such international origins."

Polari was used from the turn of the 20th century to the early 1970s by the gay community and theatre workers.”

This assertion requires some findings of fact about the Second Respondent’s role or otherwise, in relation to the Madame Jojo’s club.

As reflected in the Procedural Order, the Panel has some serious concerns about the accuracy of the Complaint. In the absence of a Response, it could have been led to believe that the Complainants or their predecessors in title had operated the Madame Jojo’s club without interruption from its creation in the 1960s until its closure in 2014. The Complainants now accept that someone else operated the club under a lease granted in 1993 until that closure. The club was an extremely well-known Soho club venue for many years. It is implausible that neither the Complainants, their grandfather (through whom they hold their rights in this case) nor their company, Soho Estates knew who was running the club.

The Response refers to rent being paid by the Second Respondent to the Complainants' company. The Procedural Order asked the Complainants to describe the relationship between themselves and the Second Respondent. The reply was that there was no such relationship. To convince the Panel of this position, when it was clearly contradicted by the Respondent, the Complainants could easily have produced the records of the rent paid on Madame Jojo's site and who was paying it. They chose instead to deny any relationship with the Second Respondent except to refer to the ownership of the Respondent's company of an interest in the lessee. The Complainants are extremely well-resourced and legally represented in this case and so one could expect a better response to this question if the Second Respondent was not correct in her factual assertions.

Another element that supports the Second Respondent's recollection of what happened and her relationship with the Complainants and Madame Jojo's is the press publicity surrounding the launch of the Electric Carrousel club to whose website, the dispute domain name resolved in 2015.

On 15 June 2015, <http://wjllondon.com/madame-jojoes-open-new-venue-the-electric-carousel/> noted:

“The Electric Carrousel, created by the team behind Soho's most storied and successful venue Madame Jojo's is bringing the excitement, glamour and good times of Old Soho back, shocking the faltering heart of London's West End back to life!

THE ELECTRIC CAROUSEL is heir to the legendary Pigalle Supper Club at 215-217 Piccadilly and was devised by the creative team behind Madame Jojo's.”

<http://www.londontown.com/LondonInformation/Nightlife/Electric-Carousel/2f4c9/> currently contains a posting:

“The team behind Madame Jojo's (RIP) return (hurrah!) with The Electric Carrousel on the site where the legendary Pigalle Supper Club used to be, at 215-217 Piccadilly. When JoJo's closed down there was an outcry and fears of the sanitisation of Soho so it's great to see them bouncing back and at one of London's most historic venues. With their return comes Lost & Found, a club night which packed-out Madame Jojo's for nine years.”

None of this makes sense if the second Respondent was not involved in running the Madame Jojo's club prior to its closure. Why would she divert the disputed domain name to a club that was unconnected to her? It does not appear to be a coincidence that the Electric Carrousel seems or seemed to have offered a similar entertainment to Madame Jojo's.

The Complainants, well-resourced, legally advised individuals, owning a company which owns significant real estate holdings in the Soho area, never seem to have objected to the Respondents' use of the disputed domain name for many years. Suddenly then in 2015, the Complainants started asserting that whoever registered the domain name in 2000 did so in bad faith and had no connection with the Madame Jojo's club which has a very distinctive name. This has to affect the credibility of their evidence.

For these reasons, the Panel accepts the Second Respondent's contention that she ran the Madame Jojo's club from 2000 to 2014. It similarly concludes that the Second Respondent

appears to have operated the Madame Jojo's club under a lease or sub-lease from the Complainants' predecessors in title, through her ownership of a company which in turn owned an interest in the lessee of the premises from 1993 until 2016 when it dissolved at a similar time to the First Respondent.

The Panel consequently finds as a fact that the Second Respondent probably registered the disputed domain name in 2000, whose registration has remained constant since then. All that seems to have happened is that she registered the domain name, either by using a fictitious name, one which became the First Respondent's name a decade later or the whois information was altered by the Second Respondent when she created the First Respondent. However, no transfer of the domain name ever occurred as is reflected in the "whois" information which shows no registration of the disputed domain name after 2000.

For all of the above reasons, the Panel concludes that it has jurisdiction over this Complaint on the basis that, in law (both of Hong Kong and English law), it is a complaint brought against the Second Respondent.

The Policy

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The disputed domain name is identical to the Complainants' trademark except for the addition of the gTLD, ".com". The Second Respondent argues with some force here that the domain name was registered 13 years before the registration of the trademark.

The test, however, is whether the disputed domain name is confusingly similar to a trademark in which the Complainants have rights, not whether the Complainants had them when the dispute domain name was registered. So, the situation at the date of registration is not relevant, only that at the time when the Complainants filed their complaint. The Panel does not, therefore, have to consider whether the Complainants or their legal predecessors in title owned any common law rights in the name at least for the purposes of this Policy requirement.

The Policy lays down no time-limits for bringing a Complaint. So, the delay in objecting to the disputed domain name is not relevant as such although it may and in this case does have an impact on the question of whether the domain name was registered in good faith.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainants' trademark.

B) Rights and Legitimate Interests

It is difficult to reach a conclusion on this test. The Respondents do not seem to have any rights over the disputed domain name except perhaps by long usage or waiver. In its conclusions on jurisdiction set out above, the Panel has already concluded that the Second Respondent is the proper Respondent in this case having registered the domain name in 2000 and operated the Madame Jojo's club at that time. Consequently, the First Respondent's role can be ignored for this purpose.

Paragraph 4(c) of the Policy goes beyond the legal rights involved, saying:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

As regards the Second Respondent, one can rule out sub-paragraphs (ii) and (iii) because she, unlike the first Respondent, has never been commonly known by the dispute domain name and she has been making a commercial use of the disputed domain name with “intent for commercial gain”.

However, the Second Respondent has a defence under (i) in that she seems to have used or made demonstrable preparations to use a name corresponding to the domain name in connection with a bona fide offering of services, namely the services of the Madame Jojo's club which she seems to have provided through operating the club of that name. This all happened prior to the notice to the Second Respondent of any complaint.

The Panel has already concluded that the Second Respondent registered the disputed domain name while running the Madame Jojo's club, something she did until 2014.

The Complainants or their company accepted her rent for the premises over many years. They now rely on a licence agreement which they accept names the wrong party entered into on what looks like a single scrap of paper to say that the Second Respondent had no right to register the disputed domain name, over 15 years after she registered the domain name concerned. This may be legally correct although one can imagine some interesting questions concerning waiver of a term in an agreement over this length of time.

However, the Complainants' assertion of their legal rights does not overcome the objection that the Respondents used a name corresponding to the domain name in connection with a bona fide offering of goods and services until 2014. The fact that there have been other uses of the name after that time makes no difference under the terms of paragraph 4(c)(i) of the Policy.

For these reasons, the Panel concludes that the Second Respondent used the Madame Jojo's name in connection with a bona fide offering of goods or services. The Complaint, therefore, fails.

C) Bad Faith

In case, the Panel is wrong about (2), it is appropriate to address the third test.

This requires the Complainant to prove registration and use of the disputed domain name in bad faith. The issue then is whether the Second Respondent registered the disputed domain name in 2000 in bad faith.

The evidence filed in this case suggests that after the Complainants' grandfather granted the lease of the premises over the club in 1993, he ceased to be concerned with the protection of the "Madame Jojo's" name. His role and that of Soho Estates Limited reverted to that of landlord of those actually running the club. This interest has only revived with the closure of the club in 2014.

The Second Respondent would have been well aware of this change of or at least the state of this relationship when she became part of the team running the Madame Jojo's club in 2000. She has contended that she registered the disputed domain name as part of her marketing of the club's brand.

The Complainants argue that the Second Respondent had notice of the licence agreement with Dancecorp although this was supposed to be with Dancecraft that prohibited her from registering the domain name. This was even though on the Complainants' evidence, the Second Respondent seems to have become involved in the running of the club if at all through her company's interest in Dancecraft.

Regardless of the legal niceties of the licence agreement, the Complainants' predecessors in title knew perfectly well that those operating the club would have to generate external publicity to make it work, be it through advertising, magazine articles about the club and the like. The idea that those operating the club were expected never to use this type of activity is difficult to comprehend. In any event, the Complainants' predecessors-in-title were reasonably content to allow this provision to be broken. It seems inherently implausible that the Second Respondent who was not a party to the Licence Agreement anyway would appreciate the restriction on her ability to register the disputed domain name.

The Complainants argue that the result of the court case against Joe Wright means that the Second Respondent should have been aware of their legal predecessors' rights to the name "Madame Jojo's". In spite of their considerable resources, the Complainants' grandfather and his and now their company, Soho Estates, never decided to put the matter beyond doubt by registering the trademark concerned until 2013. The Panel accepts the Second Respondent's contention that she did not know of these rights and the court case concerned, let alone any effect they might have on her entitlement to register the disputed domain name. She could not have found the Complainants' trademark in 2000 through a search because it was not registered.

The Complainants have objected that the Second Respondent has not disclosed details relating to the registration of the disputed domain and the diversion of it to the Electric Carousel website and generally accuses the Respondent of a lack of transparency.

There is no obligation on any Respondent to supply information and supporting documents on every aspect of his or her case. The Complainants have to prove their case and the Panel has to decide this case on the balance of probabilities not some higher standard. In fact, if there are going to be any arguments about transparency, the Complainants would have to respond to the fact that their company knew all along who the Respondent was and that she ran Madame Jojo's club at the time of the domain name's registration. The Panel has some knowledge of how small a neighbourhood Soho is, has read the exchange between the Complainants' father and the Second Respondent and the 2004 BBC report and finds it implausible that the Complainants, their father or Soho Estates Limited did not know that the Respondent ran the club when she registered the domain name, particularly in the light of the 2004 story on the BBC website.

On the basis of the totality of the evidence, the Panel concludes that the Second Respondent registered the domain name in 2000 in good faith and rejects the Complainants' contentions on this point.

The Respondent sought to argue that the Complainant's use of the disputed domain name after 2014 shows that the "disputed domain name has been registered and is being used in bad faith". The UDRP contains the word "and" between the two elements. Other policies for different gTLDs have dispensed with that requirement. ICANN has not done so in spite of considerable discussion of the subject. One must infer from this there is no basis for re-writing the Policy to remove the word "and" here. This is actually quite a good case for retaining it in this case in that many years of good faith use following a good faith registration should not end with the loss of a domain name due to a brief period of possibly bad faith use.

As a result of all the above, the Panel must find that the Complainants have failed to show that "the disputed domain name has been registered and is being used in bad faith".

The Panel could have reached the same result as regards the use of the disputed domain name. At present, the Complainants are not using their Madame Jojo's trademark apart from making exploratory remarks in the Press about possibly re-opening the club. The Second Respondent has diverted the disputed domain to a club that she was involved in running of a similar type to the old Madama Jojo's. As she was well aware, she was not harming the Complainants in doing so because they did not have a business to promote using their MADAME JOJO'S trademark.

6. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel declines to order that the disputed domain name <madamjojos.com> be transferred to the Complainant and dismisses the Complaint. The Respondent has asked for other remedies in this case but the Policy does not give Panelists such powers.

Adam Samuel

Panelist

Dated: 23 May 2016