

ADMINISTRATIVE PANEL DECISION

Silicone Ltd v. Hubert Deveau

Case No. D2022-2160

1. The Parties

The Complainant is Silicone Ltd, United Kingdom, represented by Stuart Wolfe-Murray, United Kingdom.

The Respondent is Hubert Deveau, United States of America.

2. The Domain Name and Registrar

The disputed domain name <siliconlovers.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 14, 2022. On June 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 15, 2022, the Registrar transmitted by email to the Center its verification response:

- (a) confirming the disputed domain name is registered with it;
- (b) confirming the language of the registration agreement is English; and
- (c) disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on June 21, 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 amendment to the Complaint on June 22, 2022.

The Center verified that the Complaint together with 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 Respondent of the Complaint, and the proceedings commenced on July 6, 2022. In accordance with the Rules, paragraph 5,

the due date for Response was July 26, 2022. The Respondent did not submit any response.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on August 5, 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.

On June 29, 2022, the Center received an email communication from the Respondent.¹ On June 30, 2022, the Center acknowledged receipt of that email.

4. Factual Background

The Complainant is an online vendor of sex dolls. It was established and commenced operating in November 2018 from the website to which <silicone lovers.com> resolves. The website is prominently headed with its trademark “Silicone Lovers” with a small pink love heart placed between the two words.

In 2018, the Complainant achieved sales of GBP 8,288; in 2019, GBP 276,00; in 2020, sales rose to exceed GBP 2,140,000 and, in 2021, sales rose again to exceed GBP 3,118,000. In the first three months of this year, sales exceeded GBP 1,605,000. The Complaint also includes statistics for online store sessions; rising from 8,000 in 2018 to more 137,000 in 2019 and in excess of one million in each of 2020 and 2021. The figures for the first three months of this year are more than commensurate with those figures.

The Complainant’s website has 14,000 current email subscribers. Its Instagram account created in December 2018 has 3,575 followers. The Complainant is a registered vendor on The Doll Forum, an online forum related to sex dolls which has 82,000 members. The Complainant also has its own sub-forum within that site. The Complainant has 390 reviews on Trustpilot with a rating of 4.8 out of 5 – Excellent. The Complainant is rated as a “Trusted Sex Doll Vendor”, being listed first, on the Celes Dolls website which is the first ranked search result in a Google search for “Trusted Sex Doll websites”. It is also the highest rated sex doll vendor on the website “www.whichsexdoll.com”, the second ranked result in the Google search. The Complainant also has 2,292 5-star reviews on Yotpo, an e-commerce marketing platform. The Complainant has been featured in press articles and a full segment in the Channel 5 (United Kingdom) documentary “Sex Dolls Gone Wild”. The Complainant also features in online discussion forums including a sub-reddit r/SexDolls and the Doll Club channel on Discord.

The Complainant has two registered trademarks in the United Kingdom:

- (a) Registered Trademark No. UK00003708761, SILICONE LOVERS; and
- (b) Registered Trademark No. UK00003708772, for a black and white version of its logo.

Both trademarks were registered on January 14, 2022 with effect from October 7, 2021 in respect of a wide range of goods and services in International Classes 3, 5, 10, 25, 35, 40 and 45.

The Whois search result shows that the disputed domain name was first registered on February 9, 2019.

From at least August 2020, the disputed domain name resolved to a website apparently offering for sale sex dolls under the name “Silicon Lovers” with a device of bending figure in between the two words.

According to the Complaint, the website was taken down in or about May 2022. However, it appears to be operative at the time this decision is being prepared. (The landing page of the current website is the same as the landing page of the August 2020 capture by the Wayback Machine included in Annex 25 to the

¹ As the first-named Respondent is a privacy service, the Panel will refer to the second-named Respondent as the Respondent unless the context requires the contrary.

Complaint save that the copyright notice states “© 2022”.) The prices on the Respondent’s website are offered in United States dollars. The Respondent is offering his products worldwide. For example, the Respondent’s homepage offers free worldwide shipping and the website’s FAQ page indicates typical delivery times but says “Shipping times depend on the country being delivered to and how long it will take to get through customs.”

The Complainant includes evidence of two contacts in, respectively, August and October 2020 challenging the legitimacy of the Respondent’s website or questioning which business was the “legitimate” business.

When the Complainant approached the Respondent through GoDaddy’s domain broker service seeking a transfer of the disputed domain name, the Respondent offered to transfer the disputed domain name for USD 7,500.

5. Discussion and Findings

Although the Center received an email from someone claiming to be the Respondent on June 29, 2022, no response has been filed. The Complaint and Written Notice have been sent and delivered, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present his or its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

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

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the two registered trademarks for SILICONE LOVERS and SILICONE LOVERS and device. The Panel also accepts that the Complainant has a strong common law reputation in its trademark at this time.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an

assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

It is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, [WIPO Overview 3.0](#), section 1.10.

Disregarding the “.com” gTLD and the device element, the disputed domain name consists of the Complainant’s registered trademark omitting the letter “e”. This kind of misspelling cannot avoid a finding of confusing similarity. See e.g. [WIPO Overview 3.0](#), section 1.9.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

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

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The disputed domain name resolves to a website where products appear to be offered for sale under the brand “Silicon Lovers”. Therefore, paragraph 4(c)(iii) of the Policy is inapplicable.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The Complainant points out that the disputed domain name carries a high risk of falsely implied affiliation with the Complainant bearing in mind its very close similarity to the Complainant's trademark.

The Complainant further contends that the disputed domain name is being used for a website having a similar look and feel to the Complainant's website, appearing to offer for sale the same goods as the Complainant so that, having regard to the similarity of the disputed domain name to the Complainant's trademark, the Respondent is intentionally attempting to attract users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark. The Complainant also contends that the Respondent is not using the disputed domain name in connection with a good faith offering of goods or services as the disputed domain name infringes the Complainant's trademark and is a passing off.

For present purposes, it is sufficient to note that the Respondent appears to be offering its goods for sale in the United Kingdom. Although the Respondent appears to have become the registrant of the disputed domain name and was using it before the Complainant registered its trademarks there, both registration and use occurred after the Complainant began using its trademark and began acquiring rights. In these circumstances, as the Complainant contends, the Respondent's use would appear to infringe the Complainant's registered trademark and constitute passing off. Accordingly, the Respondent's conduct does not qualify as a good faith offering under the Policy. Further, as discussed below, the Respondent's use of "silicon(e)" in connection with its products is misleading.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The basis on which the Respondent has adopted the disputed domain name, therefore, calls for explanation or justification. The Respondent, however, has not sought to rebut that *prima facie* case or advance any claimed entitlement. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent: see *e.g. Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The Complainant contends that a cursory search of the Internet at the time the Respondent registered the disputed domain name would have disclosed the Complainant's website and its trademarks. There is no evidence advanced to support this claim.

Certainly, the Panel accepts that the Complainant has a strong reputation now and a search such as a Google search on a term like "Silicon Lover(s)" does return multiple hits for the Complainant and its website. However, the disputed domain name was registered in February 2019. At that time, assuming that was when the Respondent became the registrant, the Complainant's sales were comparatively small.

On the other hand, it appears from both the Complainant's website and the Respondent's current website that there are two main types of competing materials used in the manufacture of these products – silicone or "TPE" (a composite of thermoplastic and elastomer). Apparently, silicone is the more established material with TPE a more recent entrant. The websites, and the Internet generally, contain descriptions of the benefits and disadvantages of the two types of material indicating the issue is a matter of considerable concern for purchasers of such products. The Internet materials also indicate that TPE products are typically cheaper than silicone products.

It seems very likely that the Respondent, whose website capture by the Wayback Machine on August 11, 2020 proclaims itself as "America's Favourite Sex Doll Shop" was well aware of these matters.

Under the heading “Premium Quality”, however, the Respondent’s website states “All sex dolls are made with premium quality TPE and medical-grade TPE material” The prices products displayed on that page appear to be consistent with that claim.

In these circumstances, the adoption of the name “Silicon Lovers” is quite misleading. The term “silicon” itself is not apt for either type of material, being the name of the chemical element only.

The expression “Silicone Lover(s)” is arguably only allusive or suggestive of the Complainant’s products and not directly descriptive of sex dolls or aficionados of such products. It is not apt for use as the domain name or banner brand of products which are not made from silicone but the competing material TPE.

In these circumstances, the inference is available that, as the Complainant alleges, the Respondent registered the disputed domain name with knowledge of the Complainant’s adoption and use of the Complainant’s trademark; all the more so in the absence of any denial of knowledge by the Respondent or other explanation of how he came to adopt the name.

Accordingly, the Panel finds that the Respondent registered the disputed domain name in bad faith.

For the reasons discussed in section 5B above, the Panel further finds that the disputed domain name is being used in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 name, <siliconlovers.com>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: August 19, 2022