

## **ADMINISTRATIVE PANEL DECISION**

Silicone Ltd v. VARTAN PEREZ

Case No. D2024-1384

### **1. The Parties**

The Complainant is Silicone Ltd, United Kingdom, internally represented.

The Respondent is VARTAN PEREZ, United States of America (“United States”).

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 2, 2024. On April 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 4, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 8, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Respondent sent an email communication to the Center on April 8, 2024, stating “Hi, What is this about? I don’t understand”. The Complainant filed an amendment to the Complaint on April 15, 2024.

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”).

The Respondent sent, on April 15, 2024, an informal message to the Center stating “Good morning, Can anyone explain in plain English what’s this about? Thank you.”, to which the Center replied on April 18, 2024, summarizing the main aspects of the proceedings. On the same date, April 18, 2024, the Respondent replied stating that “You keep sending these emails when you could have reached out directly. I don’t use that domain at all. It was part of a learning project and I haven’t made a single sale since I launched it. This domain/site accomplished its purpose when I uploaded it.”

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2024.

The Complainant's representative replied to the Respondent on April 19, 2024, indicating that the Complainant had no intention of taking any further action if the disputed domain name would be successfully transferred.

On May 3, 2024, the Respondent replied stating that: "Good morning, As mentioned before, this was part of a project that didn't end with the desired results. It has cost me greatly and I'd appreciate it if you could offer me a way out that wouldn't leave me bearing the costs of the past. What type of settlement are we talking about? Thank you."

The Complainant's representative, on May 18, 2024, informed the Center that the Complainant would like to continue with the proceedings given that, under its view, the Respondent was requesting financial compensation for using a domain name that exploits its trademark and thus constitutes cybersquatting and lacks good faith.

On May 19, 2024, the Respondent replied to the Complainant's message arguing that it did not commit cybersquatting and was not acting in bad faith given that it had registered the disputed domain name because it was available and it had registered for someone else who "wanted to build a store and changed his mind along the way. So I ended up with a project I spent money on, and I would like to know if you could help me cover those expenses", to which the Complainant's representative replied on May 20, 2024.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on May 30, 2024. 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 registered on August 27, 2018, and operates, since November 2018, the <silicone lovers.com> domain name where love dolls and love doll parts, accessories and kits, sex aids and sex toys are offered under the SILICONE LOVERS trademark.

The Complainant is the owner of the following, amongst others, trademark registrations:

- United Kingdom trademark registration No. UK00003708761 for the word mark SILICONE LOVERS, registered on January 14, 2022, in classes 3, 5, 10, 25, 35, 40, and 45;
- United Kingdom trademark registration No. UK00003708772 for the word and device mark SILICONE LOVERS, registered on January 14, 2022, in classes 3, 5, 10, 25, 35, 40, and 45;
- United States trademark registration No. 7,095,579 for the word mark SILICONE LOVERS, registered on July 4, 2023, in classes 10 and 35;
- International trademark registration No. 1673506 for the word mark SILICONE LOVERS, registered on February 25, 2022, in classes 10 and 35; and
- Australian trademark registration No. 2288180 for the word mark SILICONE LOVERS, registered on February 25, 2022, in classes 10 and 35.

The disputed domain name was registered on March 9, 2020, and presently resolves to an online shop offering silicone sex dolls.

## 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 name.

Notably, the Complainant contends to hold registered and unregistered or common law trademark rights in the SILICONE LOVERS trademark which, under its point of view, acquired distinctiveness (secondary meaning) before the date of the registration of the disputed domain name (March 9, 2020) given that:

- (i) from November 2018 the Complainant's website and SILICONE LOVERS trademark has been extensively and continuously used in connection with love dolls and love doll parts, accessories and kits, sex aids and sex toys;
- (ii) the first order of a love doll from the Complainant's website was made on November 27, 2018 (Annex 5 to the Complaint);
- (iii) sales prior to the registration of the disputed domain name exceed USD 595,000 (Annex 7 to the Complaint);
- (iv) since December 9, 2018, the SILICONE LOVERS trademark and the Complainant's domain name have been used on the Complainant's Instagram account, which now counts with 3,998 followers (Annex 10 to the Complaint);
- (v) since December 9, 2018, the Complainant has been a registered vendor on The Doll Forum, the largest sex doll forum in the world (counting with 96,000+ members), and made its first post on The Doll Forum on January 9, 2019;
- (vi) a link to the Complainant's website is featured permanently on the home page of The Doll Forum, and the Complainant counts with an entire SILICONE LOVERS sub-forum within The Doll Forum dedicated to the Complainant's website, containing thousands of posts with thousands of views and contributions (Annex 11 to the Complaint);
- (vii) the Complainant claimed its profile on Trustpilot in December 2018, having received its first positive review on December 29, 2018, and presently counting with over 575+ reviews from customers from all around the world with an overall rating of "Excellent", being the Complainant's trademark domain name featured prominently on the Complainant's Trustpilot profile (Annex 12 to the Complaint);
- (viii) since April 2019, the Complainant has had the active Twitter (now X) account, featuring the Complainant's SILICONE LOVERS trademark and domain name (Annex 13 to the Complaint);
- (ix) an interview with the Complainant depicting the Complainant's SILICONE LOVERS trademark and domain name was featured in the May 2019 edition of EAN, one of the market-leading trade magazines for the European erotic industry (EAN is read by the owners of erotic stores, erotic store chains, video rental stores, and online shops all over Europe) (Annex 14 to the Complaint);
- (x) since August 16, 2019, the Complainant appears as the recommended sex doll vendor on the reputable sex doll website Celes Dolls (Annex 15 to the Complaint);
- (xi) the Complainant has over 3,400 certified 5-star (out of 5 star) reviews on Yotpo (where the Complainant's SILICONE LOVERS trademark is featured) (Annex 16 to the Complaint);
- (xii) the Complainant has a very good reputation on Reddit, particularly on the subreddit r/SexDolls, which now has over 70,000 members and is "for discussion and media related to dolls and robots for sex, photography, companionship, etc." - Annex 17 to the Complaint;

(xiii) the Complainant is the highest rated sex doll vendor on "[www.whichsexdoll.com](http://www.whichsexdoll.com)" - Annex 18 to the Complaint;

(xiv) the Complainant is one of only five recommended sex doll vendors worldwide on the popular chat room app Discord on the sub-channel The Doll Club - Annex 19 to the Complaint;

(xv) the Complainant is a registered retailer on XBIZ, America's leading publisher of business news and business information for the sex industry - Annex 20 to the Complaint;

(xvi) the Complainant was featured within at least 9 exclusive articles and interviews for the Daily Star's global online publication between 2019 and 2024, having the SILICONE LOVERS trademark, as well as images of the Complainant's products been featured throughout the articles and interviews; having the Complainant also been featured in an article dated March 14, 2020, in the Toronto Sun - Annex 21 to the Complaint; and

(xvii) on February 1, 2021, Channel 5 (United Kingdom) broadcast a documentary film called "Sex Dolls gone Wild", featuring an exclusive interview and full segment on SILICONE LOVERS (Annex 22 to the Complaint).

The Complainant therefore contends that its SILICONE LOVERS trademark and domain name acquired relatively rapid recognition prior to the date of registration of the disputed domain name, due to a significant Internet presence and a high degree of actual awareness of the Complainant's registered trademark and domain name within the sex doll industry and the sell doll market across multiple media, what is corroborated by the exponential growth of sales, exponential growth of numbers of online store sessions, extensive exposure on essential industry platforms, high levels of engagement on social media, significant mainstream press coverage and thousands of positive consumer and industry reviews and comments, evidencing the substantial recognition of the Complainant's SILICONE LOVERS trademark in its specialized market.

The Complainant further contends that from about December 2021 the disputed domain name has been used in connection with a website that has a similar look and feel to the Complainant's website, offering for sale goods identical and/or similar to the Complainant's goods and services, including sex dolls and related goods (see the earliest screenshot of such website on the Wayback Machine of December 23, 2021 – Annex 23 to the Complaint).

According to the Complainant, the disputed domain name is near-identical to the Complainant's prior domain name and SILICON LOVERS trademark, merely suppressing the letter "s" in the word "lovers" what is insufficient to avoid a finding of confusing similarity which is enhanced by the same look and feel of the website available at the disputed domain name and the Complainant's official one.

Furthermore, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

(i) there is no evidence that the disputed domain name corresponds to the Respondent's actual given name, stage name, nickname, or other observed moniker, or that the Respondent is commonly known by the disputed domain name;

(ii) the Respondent is not making a legitimate or fair use of the disputed domain name without intent for commercial gain misleadingly to divert consumers or to tarnish the Complainant's trademark; given that the website available at the disputed domain name has the same look and feel as the Complainant's website, offering for sale goods which are identical to those offered on the Complainant's website, such that the Respondent's use of the disputed domain name falsely suggest affiliation with the Complainant;

(iii) by using the disputed domain name and publishing a website which has a similar look and feel to the Complainant's website and which offers for sale goods that are identical and/or similar to those offered on the Complainant's website, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website at the disputed domain name, by creating a likelihood of confusion with the

Complainant's trademark and prior domain name as to the source, sponsorship, affiliation, or endorsement of the Respondent's website of goods on the Respondent's website;

(iv) the Complainant has not granted the Respondent any license, consent, permission or authorization for the registration or use by the Respondent of the disputed domain name or any domain name which is confusingly similar to the Complainant's SILICONE LOVERS trademark and domain name.

As to the Respondent's bad faith, the Complainant asserts that the Respondent, being a person or entity operating in the same specialized market as the Complainant, knew or should have known of the existence and reputation of the Complainant's SILICONE LOVERS trademark and domain name prior to registration of the disputed domain name (and prior to publishing the website at the disputed domain name); furthermore, having the Respondent chosen to publish a website with a similar look and feel to the Complainant's website and which offers for sale goods that are identical and/or similar to those offered on the Complainant's website, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website at the disputed domain name, by creating a likelihood of confusion with the Complainant's trademark and domain name as to the source, sponsorship, affiliation, or endorsement of the Respondent's website of goods on the Respondent's website.

## **B. Respondent**

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

As seen above, the Respondent, in its informal message to the Center dated April 18, 2024, briefly states to have registered the disputed domain name in connection with a learning project, not having made a single sale since it was launched, therefore having the project accomplished its purpose when uploaded.

In a later message, the Respondent further states that the project had great costs and, in its last message, dated May 19, 2024, the Respondent further states to have registered the disputed domain name for someone else who wanted to build a store but changed his mind along the way, therefore, leaving the Respondent with a project it spent money on and which the Respondent expected the Complainant to help it cover such expenses.

The Panel notes that while the Respondent claimed to have registered the disputed domain name for someone else (the "beneficial holder"), the Respondent did not disclose the identity of the beneficial holder, nor provide evidence to support such argument. The Panel considers Vartan Perez to be the Respondent in this proceeding and will refer to the use by the Respondent to comprise any use of the disputed domain name (irrespective of whether the disputed domain name is being used by Vartan Perez or by the beneficial holder, as it would not alter the Panel's conclusion).

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

## **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 name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1., in addition to substantial evidence showing common law rights in the SILICONE LOVERS mark as well as evidence of reputation acquired in the specific segment of the Complainant's activities.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Although the suppression of a letter "s" may bear on assessment of the second and third elements, the Panel finds the suppression of such letter does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

## **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.

As seen above, the Complainant has produced evidence showing that in the specific segment of its activities it has been able to achieve a good reputation with its relevant consumer public (as shown by the positive reviews, accreditation of its products in the relevant discussion forums and growing volume of sales) prior to the registration and use of the disputed domain name.

On the other hand, the Respondent expressly recognizes to have registered the disputed domain name for someone else who wanted to build a store but changed his mind along the way, therefore, leaving the Respondent with a project it spent money on and which the Respondent expected the Complainant to help it cover such expenses.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In addition to that, the use for the website at the disputed domain name of a similar look and feel to the Complainant's official website further corroborates a finding of lack of legitimate interest (panels have held that the use of a domain name for illegal activity such as impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1).

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The registration and use of the disputed domain name in bad faith can be found in the present case in view of the registration of a domain name consisting of a combination of terms almost identical to the one used by the Complainant for its business (which predates the Respondent's registration of the disputed domain name), followed by a use with a look and feel on the website at the disputed domain name similar to the Complainant's official website. The Respondent did not provide a credible explanation supported by evidence for the registration of the disputed domain name different to the targeting of the Complainant. The Panel's conclusion on the Respondent's bad faith is further supported by:

- (i) the indication that the Respondent would be willing to assign the disputed domain name for compensation for the "great costs" it had incurred in the failed project relating to the disputed domain name;
- (ii) the Respondent's choice to retain a privacy protection service so as to conceal its true identity; and
- (iii) the indication of what appears to be false or incomplete contact details, given that the Center was unable to deliver the Written notice to the address indicated by the Respondent.

Based on the available record, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website at the disputed domain name, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the website.

The Panel finds that the Complainant has established the third element of the Policy.

### **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 name <siliconlover.com> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: June 13, 2024