

ADMINISTRATIVE PANEL DECISION

Foundations Worldwide, Inc. v. Ammar Kubba, afterTHOUGHT, Inc.
Case No. D2023-0545

1. The Parties

The Complainant is Foundations Worldwide, Inc., United States of America (“United States”), represented by Walker & Jocke Co., LPA, United States.

The Respondent is Ammar Kubba, afterthought, Inc., United States, represented by John Berryhill, Ph.d., Esq., United States.

2. The Domain Name and Registrar

The disputed domain name <gaggle.com> (the “Disputed Domain Name”) 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 February 6, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 8, 2023, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 9, 2023 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 February 13, 2023.

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 February 14, 2023. The Respondent was granted an automatic four-day extension in accordance with the Rules, paragraph 5(b), and the due date for Response was set for March 10, 2023. The Response was filed with the Center on March 10, 2023.

The Center appointed Lynda M. Braun, Gabriela Kennedy, and Nick J. Gardner as panelists in this matter on

March 24, 2023. The Panel finds that it was properly constituted. Each member of 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 is a children's products company. The Complainant owns various trademark registrations for the trademark GAGGLE in the United States and other jurisdictions worldwide, including, but not limited to: United States Registration No. 4,321,945, registered on April 13, 2013, in International Class 12 for "Baby carriages; baby strollers; carts; child carrying trailers for use in transporting children while hiking, jogging, walking, skiing, snow shoeing or skating; prams; baby buggies; strollers; wagons" (hereinafter collectively referred to as the "GAGGLE Mark").

The Respondent operates in the secondary market for domain names and is a registrant of some ordinary or dictionary words as domain names. It appears the Respondent purchased the Disputed Domain Name on September 19, 2019.¹ According to the evidence provided with the Complaint, the Disputed Domain Name resolves to a parked landing page that contains a link to inquire about the purchase of the Disputed Domain Name, as well as other pay-per-click hyperlinks. The record shows that aside from the parked landing page, the Respondent uses no active website and has no connection to any business related to the children's products industry.

5. Parties' Contentions

A. Complainant

The Complainant owns multiple registered trademarks for the GAGGLE Mark for baby carriages and other children's products in the United States and other jurisdictions worldwide. See, for example, United States Trademark Registration No. 4,321,945, registered on April 16, 2013. As such, the Complainant argues that it satisfied the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. The Complainant argues that the Disputed Domain Name is identical to the GAGGLE Mark.

The Complainant contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name as it has not authorized, licensed or otherwise permitted the Respondent to use its GAGGLE Mark. The Complainant claims that the Respondent has never used the Disputed Domain Name in connection with a *bona fide* offering of goods or services. According to the Complainant, the Respondent's sole purpose of owning the Disputed Domain Name is to sell it for commercial gain.

The Complainant further claims that the Respondent registered and is using the Disputed Domain Name in bad faith because, among other reasons, the Respondent is not using the Disputed Domain Name for any legitimate purpose, selling the Disputed Domain Name for a large amount of money in excess of the Respondent's out-of-pocket costs directly related to the Disputed Domain Name, and is also infringing the Complainant's GAGGLE Mark under trademark law.

Based on the above, the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent claims that it purchased the Disputed Domain Name because it considered that it was a common dictionary word. The Respondent says that it had no knowledge of the Complainant or the GAGGLE Mark prior to the present Complaint. The Respondent further claims that it acquired the Disputed Domain Name to sell as part of its legitimate domain name business.

¹ The Disputed Domain Name was first registered in 2001 by a third party.

The Respondent agrees that the Complainant has trademark rights in the GAGGLE Mark for baby carriages and other children's products and that the Disputed Domain Name is identical to the GAGGLE Mark. The Respondent contends that the Complainant cannot claim to be the owner of a famous mark because the Complainant is one of many parties in the United States and worldwide who has trademark registrations for the term GAGGLE for goods and services other than children's products, ranging from chat room services to security software services, among others.

The Respondent contends that it is likely that no member of the Panel in this case has ever heard of the Complainant and that every panel member is aware that "gaggle" is a common dictionary word. As an example, the Respondent attaches the Merriam Webster dictionary definition of "gaggle" as an exhibit to its Response.

The Respondent claims that it has made no infringing or illegitimate use of the Disputed Domain Name because a general offer for sale of a non-exclusive, dictionary term does not implicate or violate the Complainant's limited rights. The Respondent contends that it has acquired the Disputed Domain Name because of its value as a dictionary term, and that the Respondent has never targeted the Complainant or its GAGGLE Mark.

The Respondent further claims that it has not registered or used the Disputed Domain Name in bad faith. The Respondent has not used the Disputed Domain Name for any purpose relating to children's products that the Complainant claims to sell. The Respondent further contends that it did not engage in bad faith registration or use of the Disputed Domain Name because it registered the Disputed Domain Name due to its potential value as a dictionary word that could be attractive to potential purchasers, and the Respondent did not target or exploit the Complainant or its GAGGLE Mark.

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry, a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark.

The Complainant has established rights in the GAGGLE Mark based on its registered trademarks for the GAGGLE Mark. The registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. As stated in section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case". Thus, the Panel finds that the Complainant satisfied the threshold requirement of having rights in the GAGGLE Mark.

The Panel further finds that the Disputed Domain Name is identical to the GAGGLE Mark insofar as GAGGLE is incorporated in its entirety in the Disputed Domain Name. The addition of a generic Top-Level Domain ("gTLD"), such as ".com", in a domain name is a technical requirement. Thus, it is well established

that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel concludes that the Disputed Domain Name is identical to the Complainant's GAGGLE Mark.

Accordingly, the Panel finds that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name.

The Panel finds that the Respondent has demonstrated that it has a legitimate right to register and use the Disputed Domain Name. The Panel sees no reason to disbelieve the Respondent when it says that it had never heard of the Complainant prior to this dispute. The Complainant has not established that its Gaggle Mark was so well known so as to cast doubt on the Respondent's account. The Panel accordingly accepts that the Respondent acquired the Disputed Domain Name because of its value as a dictionary word and there is not evidence presented that it has targeted the Complainant or its GAGGLE Mark. See *Montane Ltd. v. Orion Global Assets*, WIPO Case No. [D2017-0309](#).

The sale of domain names that are common, dictionary terms can be a valid enterprise. See *Patricks Universal Export Pty Ltd. v. David Greenblatt*, WIPO Case No. [D2016-0653](#). Demanding a high price for a disputed domain name is not in itself bad faith since the registration of such a domain name is legitimate provided that, as is the case here, the Respondent did not target the Complainant. See also [WIPO Overview 3.0](#), section 2.1, which provides that "panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be *bona fide* and is not per se illegitimate under the UDRP".

Accordingly, the Panel finds that the Complainant has failed to establish the second element of Paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Given the Panel's finding on the issue of rights and legitimate interests, *supra*, it is unnecessary to consider the issue of bad faith registration or use. The Panel, nevertheless, discusses its conclusion that the Respondent did not register or use the Disputed Domain Name in bad faith.

The fact that the Respondent offered the Disputed Domain Name for sale cannot by itself be deemed to indicate that the Disputed Domain Name was registered, or is being used, in bad faith. The fact that the Respondent in negotiations was seeking a price for the Disputed Domain Name that was more than the Complainant was prepared to pay is equally not an indication of bad faith.

The Respondent did not on the evidence before the Panel register or use the Disputed Domain Name in bad faith since the Respondent legitimately purchased the Disputed Domain Name as a dictionary term and the evidence presented does not show that the Respondent targeted the Complainant or its GAGGLE Mark in so doing. See *Tambour Ltd v. Alexander Lerman*, WIPO Case No. [D2019-0229](#). Moreover, the Respondent has credibly denied that it had knowledge of the Complainant or the GAGGLE Mark when the Respondent acquired the Disputed Domain Name.

Accordingly, the Panel finds that the Complainant has failed to establish the third element of Paragraph 4(a) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Lynda M. Braun/
Lynda M. Braun
Presiding Panelist

/Gabriela Kennedy/
Gabriela Kennedy
Panelist

/Nick J. Gardner/
Nick J. Gardner
Panelist
Date: April 4, 2023