

## **ADMINISTRATIVE PANEL DECISION**

Belgravia Wood Limited v. BergeronRichard, BergeronRichard  
Case No. D2024-4569

### **1. The Parties**

The Complainant is Belgravia Wood Limited, United States of America (“U.S.”), represented by Troutman Pepper, U.S.

The Respondent is BergeronRichard, BergeronRichard, U.S.

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

The disputed domain names <funsiclepoolparadiseshop.shop> and <funsiclepoolstore.shop> (the “Disputed Domain Names”) are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 6, 2024. On November 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On November 8, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (UNLISTED OWNER) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 8, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 8, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 5, 2024.

The Center appointed Douglas M. Isenberg as the sole panelist in this matter on December 15, 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 states that it “holds certain intellectual property of the Polygroup family of companies, which group of companies comprise leading designers, manufacturers or distributors of pools, pool toys, and related aquatics products”; that “Polygroup has become a trusted name in the industry, offering a wide range of products designed to enhance the enjoyment and safety of aquatic activities for families and individuals around the world”; that “[t]he company’s product lines include above-ground pools, inflatable pools, pool accessories, and a variety of pool toys that cater to all age groups”; that “[t]he company’s dedication to customer satisfaction and continuous improvement has positioned it as a market leader, known for its durable, easy-to-use, and fun aquatic products”; and that “[o]ne of Complainant’s product lines is the FUNSICLE® pool products line.”

Complainant further states, and provides evidence in support thereof, that it is the owner of the following registrations for the trademark FUNSICLE (the “FUNSICLE Trademark”):

- U.S. Reg. No. 7,516,586 (registered September 24, 2024)
- U.S. Reg. No. 7,356,751 (registered April 9, 2024)

The Disputed Domain Names were created on August 14, 2024 (<funsiclepoolparadiseshop.shop>) and August 13, 2024 (<funsiclepoolstore.shop>). Complainant states that the Disputed Domain Name <funsiclepoolstore.shop> “is not in use” and that the Disputed Domain Name <funsiclepoolparadiseshop.shop> “results in a website that purports to be an online marketplace called ‘Funsicle’ and sells ‘Funsicle Pool Floats’ and other Funsicle-named products” and that the website contains “the famous fictional address of Sherlock Holmes” and an inaccurate telephone number.

#### 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 Names.

Notably, the Complainant contends that:

- Each of the Disputed Domain Names is confusingly similar to the FUNSICLE Trademark because, inter alia, the FUNSICLE Trademark “is the primary element of the Domain Names” and they “strongly convey the impression of sponsorship by or association with the Complainant”; and “[t]he addition of generic words like ‘pool,’ ‘store,’ and ‘shop’ do nothing to distinguish the Domain Names.”
- The Respondent has no rights or legitimate interests in either of the Disputed Domain Names because, inter alia, “Respondent is not a licensee of Complainant nor is Respondent otherwise authorized to use the [FUNSICLE Trademark] for any purpose”; “to Complainant’s knowledge, the Respondent owns no U.S. or international trademark applications or registrations for ‘FUNSICLE’ or any variants of the Domain Name, or that the Respondent has ever used this mark prior to the registration of the Domain Name. Upon information and belief, Respondent is not commonly known as “FUNSICLE” and because “the Domain Names do not resolve to bona fide websites[,] Respondent does not use and, upon information and belief, has not made preparations to use the Domain Names in connection with a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii).”

- The Disputed Domain Names were registered and are being used in bad faith because, inter alia, the FUNSICLE Trademark “is unique and arbitrary such that it is unlikely that the Respondent divined the term ‘FUNSICLE’ on its own” and “all chance of circumstance is removed by Respondent using additional words like ‘pool,’ which coincide with Registrant’s exact products and industry”; “false information,” including false contact information, on the Respondent’s website is “fraudulent activity [that] is a sign of bad faith”; and “[t]here is no reasonable chance that the Respondent would independently adopt the coined FUNSICLE mark for use as a domain name for services that overlap with the Complainant’s own offerings under the same mark.”

## **B. Respondent**

The Respondent did not reply to the Complainant’s contentions.

## **6. Discussion and Findings**

### **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.

Based on the trademark registrations cited in the Complainant, the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy, that is, the FUNSICLE Trademark. [WIPO Overview 3.0](#), section 1.2.1.

As to whether the Disputed Domain Name is identical or confusingly similar to the FUNSICLE Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Names only (i.e., “funsiclepoolparadiseshop” and “funsiclepoolstore”), as it is well-established that the top-level domain names (i.e., “.shop”) may be disregarded for this purpose. [WIPO Overview 3.0](#), section 1.11: “The applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”

The second-level portions of the Disputed Domain Names contain the FUNSICLE Trademark in its entirety, plus the words “pool,” “paradise,” “shop” and “store”. As set forth in [WIPO Overview 3.0](#), section 1.7: “[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.” Clearly here, the FUNSICLE Trademark is recognizable in each of the Disputed Domain Names. Inclusion of the additional words “pool,” “paradise,” “shop,” and “store” do nothing to alleviate confusing similarity, because “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.” [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

### **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.

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 Names. 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 Names such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

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

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in the Policy: (i) circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location. Policy, paragraph 4(b).

The Panel agrees with Complainant that Respondent could not have registered the Disputed Domain Names without knowledge of the FUNSICLE Trademark, given the distinctiveness of the mark and how Respondent has used the <funsiclepoolparadiseshop.shop> domain name (in connection with a website selling the same products sold by Complainant). Also, the Panel finds notable the fact that each of the Disputed Domain Names was created in August 2024, just four months after one of Complainant's registrations for the FUNSICLE Trademark was issued and while the other of Complainant's registrations was pending. See, e.g., *Sanofi and Genzyme Corporation v. Kerry Yao*, WIPO Case No. [D2016-1799](#) (finding bad faith where "Respondent registered... the Domain Name... shortly after Complainant filed its trademark applications").

As numerous decisions under the Policy have made clear, creating a website that appears to be a website for a complainant, as the Respondent has done in the instant case with respect to the Disputed Domain Name <funsiclepoolparadiseshop.shop>, is "likely fraudulent" and "indicates an intent to deceive or, at a minimum, act in bad faith with the intent for commercial gain." *DocuSign, Inc. v. Traffic CPMiPV, Maria Carter*, WIPO Case No. [D2010-0344](#). See also, e.g., *Emu (Aus) Pty Ltd. and Emu Ridge Holdings Pty Ltd. v. Antonia Deinert*, WIPO Case No. [D2010-1390](#) ("a reasonable person who visited the Respondent's website was likely to be misled in relation to the source, sponsorship, affiliation, or endorsement of the website and the products purportedly made available for online sale on the website").

With respect to the Disputed Domain Name <funsiclepoolstore.shop>, which is not being used in connection with an active website, the Panel has evaluated whether the so-called passive-holding doctrine is applicable here. "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered

relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." [WIPO Overview 3.0](#), section 3.3 (citing *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). Here, although the FUNSICLE Trademark is relatively new and apparently protected by only two U.S. trademark registrations, the Panel finds that it is a highly distinctive trademark. Further, the Respondent has failed to submit a response, the Respondent used a privacy service to mask its identity, and – especially considering how the Respondent has already used the Disputed Domain Name <funsiclepoolparadiseshop.shop> -- it is implausible that the Disputed Domain Name <funsiclepoolstore.shop> will be put to any good faith use.

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 Names <funsiclepoolparadiseshop.shop> and <funsiclepoolstore.shop> be transferred to the Complainant.

*/Douglas M. Isenberg/*

**Douglas M. Isenberg**

Sole Panelist

Date: December 27, 2024