

## **ADMINISTRATIVE PANEL DECISION**

Forbes LLC v. David Carrascosa Mendoza  
Case No. D2022-4719

### **1. The Parties**

The Complainant is Forbes LLC, United States of America (“U.S.”), represented by Fieldfisher LLP, United Kingdom (“U.K.”).

The Respondent is David Carrascosa Mendoza, Spain.

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

The disputed domain names <forbeslatino.com> and <forbesnegocios.com> are registered with Soluciones Corporativas IP, S.L. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 8, 2022. On December 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 10, 2022, 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 (Soluciones Corporativas IP, S.L., c/o Whois Proxy) and contact information in the Complaint.

The Center sent an email communication in English and Spanish to the parties on December 12, 2022 regarding the language of the proceeding, as the Complaint has been submitted in English and the language of the registration agreements for the disputed domain names is Spanish. The Complainant submitted a request for English to be the language of the proceeding on December 14, 2022. The Respondent did not comment on the language of the proceeding.

The Center sent an email communication to the Complainant also on December 12, 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 December 15, 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 December 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 17, 2023. The Response was filed with the Center on January 5, 2023.

The Center appointed Edoardo Fano as the sole panelist in this matter on January 12, 2023. 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.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers, or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

#### **4. Factual Background**

The Complainant is Forbes LLC, a multi-national media company headquartered in U.S., publishing the renowned business magazine FORBES and owning several trademark registrations for FORBES, among which:

- U.S. Trademark Registration No. 1,141,299 for FORBES, registered on November 11, 1980;
- European Union Trademark Registration No. 001226646 for FORBES, registered on September 18, 2000;
- Spanish Trademark Registration No. 2.389.286 for FORBES, registered on February 16, 2002.

The Complainant also operates on the Internet, being “www.forbes.com” its main website.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain names <forbeslatino.com> and <forbesnegocios.com> were both registered on June 21, 2019, and they both resolve to almost identical websites in which the Complainant’s trademark is reproduced and the same services as the Complainant’s, namely business news, are offered.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant states that the disputed domain names are confusingly similar to its trademark FORBES, since they fully incorporate the Complainant’s trademark FORBES with the addition of the descriptive terms “latino” (referring to the region) and “negocios” (translating to “businesses” in English).

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names since he has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names, and he is not commonly known by the disputed domain names.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant’s trademark FORBES is distinctive and known in the business news field. Therefore, the

Respondent targeted the Complainant's trademarks at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names with the purpose of offering business news by using the Complainant's trademark, creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites and trading upon the Complainant's goodwill, qualifies as bad faith registration and use.

## **B. Respondent**

The Respondent, in his Response in Spanish, states that there is no dispute but only a partial coincidence, due to the fact that his business acronym is made by three letters "B", which is phonetically pronounced "three bes" (3 B's) in the Spanish language. The three letters "B" stand for "Bueno, Bonito, Barato", which when referred to a purchase or a business would mean "Good, Pretty, Cheap". When the Respondent decided to use the acronym as "por bes" ("for bes" in English), he preferred to adopt the English version "for bes" as the Spanish version "por bes" could be taken as "pobres" ("poor" in English), a very unsuitable term when dealing with business.

Since the domain name <forbes.com> was already registered by the Complainant, the Respondent claims he decided to add to "forbes" the terms "negocios" y "latino", in order to avoid confusion with the Complainant's business, also considering that the Respondent is based in Spain while the Complainant is in U.S., that the Respondent is using a web while the Complainant is publishing a magazine, that the Respondent is using Spanish as a language while the Complainant is using English.

The Respondent states that his registration of the disputed domain names is legitimate and cannot be considered as cybersquatting, since he did not acquire them with the purpose to sell them, or typosquatting, or phishing.

The Respondent asserts that there are many other domain names available containing the term "forbes", like <forbes.travel>, <forbes.casa>, <forbes.uno>, <forbes.work>, <forbes.forum>, <forbes.rich>, and that the Complainant decided to file the present Complaint four years after the disputed domain names have been registered, when they are having web traffic of Spanish readers.

In order to supposedly reach a peaceful settlement of the matter, the Respondent proposed to change his graphic representation of the name so that "for" is separated from "bes", making it a three words wording instead of the actual two words, and combining capital and small letters, as well as changing the typography in use in order to differentiate it from the Complainant's one.

## **6. Discussion and Findings**

### **6.1 Language of Proceeding**

According to paragraph 11(a) of the Rules, the Panel decides that the language of the proceeding will be English. The language of the Registration Agreements of the disputed domain names is Spanish. The Complainant has requested English to be the language of the proceeding since the Complainant's language is English and the website of the disputed domain names' Registrar, together with the relevant documentation, is in both Spanish and English.

The Panel finds particularly relevant the fact that the Respondent replied in Spanish to the Complaint in English, without asking for a translation of the latter in Spanish and therefore showing he could understand the English language. It would therefore be not only unnecessary but also unfair, both economically and timewise, to request the Complainant to translate the Complaint. Furthermore, the Respondent did not comment to the Complainant's request to use English. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.5.1.

## 6.2 Substantive Issues

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark FORBES and that the disputed domain names are confusingly similar to the trademark FORBES as they fully incorporate the Complainant's trademark FORBES, with the addition of the terms "latino" and "negocios".

Regarding the addition of the terms "latino" and "negocios", the Panel notes that it is now well established that the addition of other terms (whether descriptive, geographical terms, letters, or otherwise) to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark (see, e.g., *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. [D2005-0037](#); *Red Bull GmbH v. Chai Larbthanasub*, WIPO Case No. [D2003-0709](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)). The addition of the terms "latino" and "negocios" does not therefore prevent the disputed domain names from being confusingly similar to the Complainant's trademark. See [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic Top-Level Domain ("gTLD"), in this case ".com", is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

### B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain names.

The Respondent may establish a right or legitimate interest in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

- "(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."

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain names according to paragraph 4(a)(ii) of the Policy is potentially quite

difficult, since proving a negative circumstance is always more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain names in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. It asserts that the Respondent is not currently associated with the Complainant in any way and he is not commonly known by the disputed domain names.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that he has rights or legitimate interests in the disputed domain names. However, the Respondent in his Response has not presented any relevant evidence of any rights or legitimate interests it may have in the disputed domain names, and the Panel is unable to establish any such rights or legitimate interests on the basis of the reasons provided by the Respondent as a ground for the inclusion of the term “forbes”, identical to the Complainant’s trademark FORBES, as part of both disputed domain names.

Moreover, the Panel finds that the composition of the disputed domain names carries a risk of implied affiliation as they effectively impersonate or suggest sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Based on the facts of this case, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

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

Paragraph 4(b) of the Policy provides that “for the purposes of paragraph 4(a)(iii) [of the Policy], the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or has 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 its documented out-of-pocket costs directly related to the domain name; or
- (ii) [the respondent 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 respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] web site or location or of a product or service on [the respondent’s] web site or location.”

Regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademark FORBES in the business news field is clearly established and, given the composition of the disputed domain names and their use in the relevant almost identical websites, the Panel finds that the Respondent obviously knew of the Complainant and deliberately registered the disputed domain names.

The Panel further notes that the disputed domain names are also being used in bad faith since the Respondent is trying to attract Internet users to its websites by creating likelihood of confusion with the Complainant's trademark in order to offer the same type of services as the Complainant's, namely business news, an activity detrimental to the Complainant's business.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain names in order both to disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to its websites in accordance with paragraph 4(b)(iv) of the Policy.

While the Respondent claims that the terms "latino" and "negocios" were added to avoid confusion, the Panel finds this logic blatant as the Complainant's trademark is fully reproduced in its entirety. Furthermore, the nature of the inherently misleading disputed domain names, reproducing the Complainant's trademark FORBES with the mere addition of the terms "latino" and "negocios", which are easily associated with the Complainant, further supports a finding of bad faith and intent to confuse users about a non-existent affiliation trading off of the Complainant's reputation and goodwill. See [WIPO Overview 3.0](#), section 3.2.1.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

## 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 <forbeslatino.com> and <forbesnegocios.com> be transferred to the Complainant.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: January 26, 2023