

ADMINISTRATIVE PANEL DECISION

Lämpöpuuyhdistys Ry v. Transfer Agent, Dan.com, Global Forest Lumber Company LLC and Blue Lake Lumber LLC
Case No. D2023-4796

1. The Parties

The Complainant is Lämpöpuuyhdistys Ry, Finland, represented by Laine IP Oy, Finland.

The Respondents are Transfer Agent, Dan.com, Netherlands, Global Forest Lumber Company LLC, United States of America (“United States”) and Blue Lake Lumber LLC, United States, represented by Baril Advogados Associados, Brazil.

2. The Domain Name and Registrar

The disputed domain name <thermowood.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 November 24, 2023. On November 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 27, 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 (Registration private according to Whois service / Registration private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 30, 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 amended Complaint on December 5, 2023.

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 Respondents of the Complaint, and the proceedings commenced on December 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 27, 2023. A Response was filed with the Center on December 27, 2023 by Global Forest Lumber Company LLC (“Global”) and Blue Lake Lumber LLC

("Blue Lake"). On January 10, 2024 and January 17, 2024, the Complainant and the Global / Blue Lake, respectively, submitted Supplemental Filings.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on January 18, 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 is a non-profit association registered in Finland and oversees the International ThermoWood Association.

The Complainant is the owner of European Union Trademark No. 000922765, THERMOWOOD, in respect of building materials in International Class 19. The application to register this trademark was filed on August 25, 1998 and formally registered on September 27, 2000.

The Complainant licenses its trademark on a non-exclusive basis to a number of other entities which produce specific wood products. The non-exclusive licensees are themselves authorised to allow their distributors to use the THERMOWOOD trademark in relation to the relevant products and in accordance "with certain requirements".

One of those non-exclusive licensees is Nova Orman Ürünleri San. Tic. A.S. (or Novawood).

According to the Whois report, the disputed domain name was registered on January 4, 2000.

Extracts from the Wayback Machine included in Annex 6 to the Response show that from at least 2014 until at least 2022 the disputed domain name simply resolved to a parked page and, later, a "for sale" web page – most recently provided by Dan.com.

In about April 2023, the Complainant discovered the disputed domain name resolved to a website selling wooden building materials. The print-out of the website included in an Annex to the Complaint promotes various types of internal and external wood panelling products such as "Thermowood Ash" and "Thermowood Pine". The products are said to be an ultra stable thermally modified wood produced using a heat and steam process.

At the top of the page is a "logo": "**THERMOWOOD** Powered by Novawood Technology." Contact details for two suppliers – Lumber Plus (for Central and East Coast United States of America ("United States") and Tropical Forest Products for West and East Coast United States). In addition, there is an invitation to "Become a Distributor" providing contact details for "Novawood USA" which includes an email [...]@thermowood.com and "Novawood Europe" which includes an email [...]@novawood.com.

Before filing the Complaint, the Complainant inquired of Novawood whether or not it was the holder of the disputed domain name. Novawood replied that it was not.

Global and Blue Lake are companies entirely owned by Mr. Anderson Giovanni da Rocha. According to the Response, Global holds the domain names for Mr. da Rocha's companies. Blue Lake is an importer of lumber. Annex 4 to the Response is a written agreement, executed by both Novawood and Blue Lake, in which Blue Lake is appointed as the official distributor of Novawood's products under the name "Novawood USA". Although the document has been heavily redacted, it appears that Blue Lake, as Novawood USA, is entitled to import and sell "Thermowood" products under the Novawood trademark and not any other brand of "Thermowood" products.

Given the inter-corporate arrangements between Global and Blue Lake, the Panel will refer only to Blue Lake for simplicity.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondents 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 Respondents have 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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Supplemental Filings

As the Complainant acknowledges, the expedited nature of the proceedings, providing only for a Complaint and a Response, is a very significant feature of proceedings under the Policy. Apart from documents requested by the Panel pursuant to paragraph 12 of the Rules, neither the Policy nor the Rules expressly provide for supplemental filings. Their admissibility is therefore in the discretion of the Panel bearing in mind the requirements under paragraph 10 of the Rules to ensure that the proceeding is conducted with due expedition and both parties are treated equally, with each party being given a fair opportunity to present its case.

As the Response has been filed by parties different to the registrant identified in the WhoIS report and also by the Registrar in its verification Response, it is appropriate in this case to admit the Complainant's Supplemental Filing. In that Supplemental Filing, the Complainant advances a somewhat different case to that made in its Complaint and the amended Complaint. Accordingly, it is also appropriate to admit the Supplemental Filing from Global and Blue Lake.

B. Identical or Confusingly Similar

In comparing the disputed domain name to the Complainant's proven trademark rights, 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.11.

On that basis, the disputed domain name is identical to the Complainant's trademark.

The Response contends that, if one reviews Blue Lake's website, there is no risk of confusion as (according to the Response) the truthful association with Novawood and its Thermowood products is made clear.

This argument misunderstands the nature of this requirement under the Policy, which is essentially a standing requirement. In undertaking the comparison, all that is usually required is a simple 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, the date they were acquired 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 3.0](#), section 1.7.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

C. Registered and Used in Bad Faith

In the circumstances of this case, it is appropriate to consider next the third requirement under the Policy.

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 Respondents. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

The Complainant contends that the correct Respondent is Transfer Agent, Dan.com as the person identified by the Registrar in the verification response as the registrant. (Rules, paragraph 1 "Respondent") On this argument, the submissions of Blue Lake should be disregarded (although the Complainant's Supplemental Filing does make submissions in respect of them).

In a series of decisions beginning with *Mrs. Eva Padberg v. Eurobox Ltd.*, WIPO Case No. [D2007-1886](#) and *Smith & Nephew plc v. Wesley Perkins, Smith and Nephew Trading*, WIPO Case No. [D2008-1029](#), it has been recognized that it may not be significant who is named as the respondent on the face of the Complaint at least where there is other evidence before the Panel that some other person is in control of the domain name in question. A common example are the cases where a Complaint relates to a domain name registered in the name of a privacy or proxy service.

In that line of cases, it has been recognized that a Complaint will be procedurally compliant if it names as the respondent the person identified in the Whois record as the registrant when the Complaint is filed. That requirement has been met in this case both in the Complaint and, following the provision of different information in the verification response, the amended Complaint.

Neither Dan.com nor Blue Lake have sought to explain how it is that the disputed domain name remains registered in Dan.com's name while being used by Blue Lake. It may be that it is just some sort of administrative or clerical error on the part of the escrow holder. But that is just speculation on the information before the Panel.

Given:

- (a) there is evidence before the Panel that the disputed domain name has been resolving to an active website operated by Blue Lake (as Novawood USA) since at least April 2023;
- (b) a detailed Response and Supplemental Filing has been received from Blue Lake;
- (c) Dan.com is a domain broking arm of GoDaddy and in as recently as at least June 2022 was offering the disputed domain name for sale; and
- (d) mindful of the need to ensure all Parties are given a fair opportunity to present their respective cases, the Center has also provided copies of the documents filed in the proceeding to Dan.com as well,

common sense and natural justice indicate it is appropriate that Blue Lake as the actual user of the disputed domain name be heard in answer to the Complaint. And, as already noted, the Complainant has taken the opportunity to file an unsolicited Supplemental Filing in answer to the Response provided by Global and Blue Lake. Transfer Agent, Dan.com has not filed any submissions but has been on notice throughout the proceeding.

In the Supplemental Filing, the Complainant accepts now that Blue Lake (at least) is a distributor of the Complainant's licensee, Novawood.

Accepting that Blue Lake (at least) apparently has some right to use the trademark under the terms of the parties' distribution agreement, the Complainant contends first that the right to use the trademark does not confer a right to register and use a domain name corresponding to the trademark. (According to the Complainant, unspecified, accepted case law establishes that registration of a domain name is not use as a trademark.)

Secondly, the Complainant contends that allowing Blue Lake to hold the disputed domain name gives it an unfair competitive position over other licensees as Blue Lake will benefit from the promotion of the THERMOWOOD trademark by other licensees but the other licensees and their distributors will not be able to take advantage of the licensed trademark to the same extent. Accordingly, the Complainant contends Blue Lake is taking unlawful advantage of the Complainant's trademark.

On the other hand, Blue Lake contends it has the right to use the trademark THERMOWOOD in respect of Novawood's products, which are genuine THERMOWOOD products, and, the disputed domain name being available, registered and uses it in connection with the exercise of those rights.

Whether or not the registration of a domain name constitutes use as a trademark, it is well-established that using a trademark in a domain name for (for example) a website can constitute use as a trademark and, where the use is without the trademark owner's permission, may be an infringement.

The Panel considers therefore the distinction between registration of the disputed domain name and its use which the Complainant advances cannot be accepted. On general principles, the use of a domain name infringes a corresponding trademark only where use of the trademark is infringing. Where (as here) the user has a licence permitting use of the trademark, the person's registration and use of the trademark in a domain name would not be an infringement unless the terms of the licence itself imposed restrictions against such use. Accordingly, a trademark owner who wishes to control such use or restrict a licensee from registering a domain name corresponding to the trademark will ordinarily make appropriate provision against such conduct in the terms of the licensing arrangements. At the very least, the trademark owner is well-advised to do so.

The Panel understands the argument based on alleged unfairness to other licensees and distributors. The alleged unfairness would apply equally to other registrations in other domains. It is really a matter for the commercial arrangements between a licensor and its licensees. It does not, in the absence of appropriate restrictions on a licensee, appear to constitute an *unlawful* advantage as the Complainant contends. Much more argument about the legal position under relevant law than has been advanced in the Complaint would be required before such a conclusion could be reached to the extent it is within the scope of the Policy (i.e., in that it would speak to possible bad faith as is understood under the Policy).

While the terms of Blue Lake's licence or distributorship from Novawood before the Panel have been heavily redacted, it appears prima facie that Blue Lake is authorised to use THERMOWOOD in relation to the sales of products it is actually using the trademark and the disputed domain name for. In the absence of appropriate restrictions in the terms of its permission, therefore, the Panel is not prepared to find that Blue Lake has registered or is using the disputed domain name in bad faith.

The dispute in this proceeding really seems to be a dispute about the terms and scope of Blue Lake's rights through the licence from Novawood. A proceeding under the Policy is not the appropriate venue for the determination of a dispute of this nature in these circumstances. All the more so if, as Blue Lake claims (but has not substantiated), it has made substantial investments in promoting the disputed domain name.

Accordingly, the Complainant has failed to establish the third requirement under the Policy and the Complaint must fail.

D. Rights or Legitimate Interests

As the Complaint must fail, it is not necessary nor appropriate to consider this requirement under the Policy.

E. Reverse Domain Name Hijacking

The Response seeks a finding of reverse domain name hijacking against the Complainant on the basis that it should have been clear to the Complainant before the Complaint was filed that the disputed domain name was being used in association with the Complainant's own licensee, Novawood.

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

With the benefit of hindsight, the Complainant arguably could have pressed Novawood further and Novawood should, perhaps, have provided a more fulsome response. The Panel does not have, however, the full record of the communications between the two before it. Nor is Novawood a party to the proceeding.

Against that, it does appear that Novawood did give the Complainant an emphatic denial of any association with the disputed domain name – which is objectively true but appears to be less than the full story once one appreciates the involvement of Blue Lake with the disputed domain name.

In addition, it should also be remembered that the Whois record appears to have been in a less than accurate state. Moreover, no information has been provided about when, or how, Transfer Agent, Dan.com became involved or, for that matter, when or how Global and Blue Lake came to be using the disputed domain name while it remains registered in the name of Transfer Agent, Dan.com.

In these circumstances, the Panel does not consider it appropriate to make a finding of reverse domain name hijacking.

6. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: February 1, 2024