

ADMINISTRATIVE PANEL DECISION

Avanquest pdfforge GmbH v. Deeptech Industries Limited, Samantha WIESE
Case No. D2024-1481

1. The Parties

The Complainant is Avanquest pdfforge GmbH, Germany, represented by Benoît & Côté Inc. Intellectual Property Law Firm, Canada.

The Respondent is Deeptech Industries Limited, Samantha WIESE, United Kingdom, represented by CHAPLIN, BÉNÉDICTE & Co., United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <forgepdf.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 April 8, 2024. On April 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 10, 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 (DEEPTech INDUSTRIES LIMITED) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 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 amendment to the Complaint on April 16, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 13, 2024. The Response was filed with the Center on May 13, 2024.

The Center appointed John Swinson as the sole panelist in this matter on May 22, 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 part of the Avanquest Group, a large international software publisher that has a portfolio of software products. The Complainant creates and develops OpenSource and Freeware products, as well as paid business offerings, allowing customers to create and modify PDF documents.

The Complainant's software products can be downloaded from the Complainant's website located at <pdfforge.org>. The Complainant has owned and used this domain name since August 2005.

The Complainant owns a portfolio of trademark registrations for PDFFORGE including, for example, United Kingdom Trademark Registration No. UK00912125183 for "pdfforge" and device, that was filed on September 9, 2013 and entered in the register on January 4, 2014. This trademark includes a red flame device.

In April 2022, Claranova, Avanquest's major stakeholder, publicly announced that its Avanquest division had entered into a binding acquisition agreement with pdfforge GmbH. In July 2022, Claranova announced the closing of its acquisition of pdfforge GmbH through its Avanquest division.

The disputed domain name was registered on May 10, 2022.

The Respondent is a business located in England. The Respondent was incorporated on June 28, 2021. The Respondent sells subscriptions to a software product toolset that allows users to edit and convert documents in the PDF format. The Respondent sells such subscriptions under the brand "Forge PDF" via a website at the disputed domain name. The Respondent also operates several websites that have similar content to that of the website at the disputed domain name to sell software subscriptions to what appears to be the same software product, including <flashpdf.net>, <shapepdf.com> and <documentpdf.net>. These domain names were all registered on May 10, 2022.

The Respondent promotes the website at the disputed domain name using search engine advertising, such as Google and Bing advertisements. According to the Respondent, these search engine advertisements direct users to one of seven websites (not identified in the Response) that are operated by the Respondent, which the Respondent calls "redirect websites" or "advertising websites". These websites then redirect users to the website at the disputed domain name or other websites of the Respondent where software subscriptions are sold.

The Respondent claims that majority of website traffic to the website at the disputed domain name is from the Respondent's redirect sites. It also appears that traffic is received from "social" websites.

The website at the disputed domain name states: "The user is informed that the site ForgePDF accessible via the address forgepdf.com is published by the company Deeptech Saas Limited." Apparently, the Respondent has been renamed as Deeptech Saas Limited, and this reflects information in the UK Companies House records viewed by the Panelist. The Respondent has a website located at <deeptechsaas.net> that states "Deeptech handle the complete range of SaaS distribution: e-commerce software, CMS solutions, ERP, CRM, customer loyalty management, digital marketing, email marketing, marketing automation, online collaboration tools, e-procurement, website monitoring, human resources software, social media, SEO, web analysis..."

The Complainant sent email and letter correspondence to the Respondent before filing this dispute. The Respondent claims not to have received such correspondence.

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 that the Complainant's PDFFORGE trademark is distinctive, and that consumers have unwittingly subscribed to the services offered by the Respondent at the website located at the disputed domain name because consumers mistakenly assumed a connection between the Respondent's offerings and those of the Complainant.

The Complainant also contends that the Respondent's strategy is an overt attempt to attract potential customers, generate traffic to its website, and ultimately earn commercial gain by leveraging the confusion created by the disputed domain name's similarity to the Complainant's trademark.

The Complainant provided evidence to demonstrate that third parties have unwittingly subscribed to the services offered by the Respondent under the name "ForgePDF."

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Respondent contends that the assessment of the global resemblance of "PDFFORGE" and "FORGEPDF" necessitates a consideration of the overall impression conveyed by said marks, considering their distinctive and predominant elements. The typical consumer typically perceives a mark holistically and does not engage in a detailed analysis of its individual components. The Respondent asserts that the Complainant's website and the Respondent's website has a different look-and-feel, and that it is appropriate to consider these websites in the present case for the purposes of the first element of the Policy.

The Respondent strongly disputes the claim that the Respondent is involved in fraudulent activities.

The Respondent contends that its business model differs significantly from that of the Complainant.

The Respondent further contends that the Complainant's product names (pdfcreator and pdfarchitect) may be widely recognised, but that PDFFOREGE is not well-known.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

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.

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.

In *Mallet. Footwear Limited v. Domain Protection Services, Inc. / Ajeio Qudeim*, WIPO Case No. [D2022-1904](#), the Panel found that the domain name <londonmallet.com> was confusingly similar to the Complainant's MALLET LONDON trademark. In *Novartis AG v. Seedy Loveth, ArtisNov Medical Chemical / Privacy Protection Service INC d/b/a PrivacyProtect.org, Domain Admin*, WIPO Case No. [D2015-1951](#), the Panel found that the domain name <artisnov.com> was confusingly similar to the Complainant's NOVARTIS trademark. The same principles apply in the present case.

The test to be applied for the first element is a side-by-side comparison of the Complainant's trademark with the disputed domain name. The Respondent submits that the Panel should look at the Complainant's and the Respondent's website as part of this comparison for the first element and relies on [WIPO Overview 3.0](#), section 1.7. The Respondent misunderstands the Policy. For the purposes of the first element, that the Complainant's and the Respondent's websites have a different color-scheme and a different look does not negate the fact that the disputed domain name is confusingly similar to the Complainant's trademark; those factors may be relevant under the second and third elements, but not here.

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 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.

The Respondent uses "ForgePDF" as its product branding. However, there is no evidence that the Respondent is commonly known by this name or by the disputed domain name. In fact, the Respondent asserts otherwise:

"... the Respondent has never depended on the brand name 'forgepdf' to cultivate its online presence. The original business development strategy indicates the contrary: the Respondent does not prioritize naming, operating under the notion that an average consumer requiring swift PDF file conversion would not be inclined to memorize the service's name. Moreover, as all similar services incorporate 'PDF' in their names, it is deemed of minimal significance to the average user."

The Panel also finds that, before notice to the Respondent of the dispute, the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services, as is discussed below in respect of the third element of the Policy.

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.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by the complainant. *Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. [D2014-1747](#).

The Panel is of the view that the Respondent was aware of the Complainant and the Complainant's PDFFORGE trademark when the disputed domain name was registered. The Complainant's product and brand seems to be well-known in its industry. It appears from the evidence provided by the Respondent that the Respondent is sophisticated in respect of Internet marketing and product promotion and was likely aware of the Complainant when registering the disputed domain name for the Respondent's software product. The Respondent's software product directly competes with the Complainant's software product.

The Respondent's explanation as to why the Respondent selected the disputed domain name does nothing to address the reality that it has chosen a domain name incorporating the Complainant's mark. As quoted above, the Respondent states that the Respondent "does not prioritize naming" and has a network of websites to direct traffic to the website at the disputed domain name, suggesting that the disputed domain name selected by the Respondent is of little relevance. The Respondent explicitly states that the disputed domain name "was chosen arbitrarily, akin to names such as ShapePDF or FlashPDF. It constitutes a commonplace dictionary term with the addition of the 'PDF' suffix. Employing a similar rationale, the Respondent had secured five domain names following this pattern." However this may be, it strikes the Panel that the use of "forge" here invokes the Complainant's trademark (which based on the way it is used (as a logo/mark, and not a verb or dictionary term) on the website, the Panel infers that the Respondent knew about) and therefore the Panel infers that "forge" was selected for that reason.

The Panel conducted a Google search from Australia for the term "forgepdf" and the Respondent's website at the disputed domain name was the first listed; the Complainant's website was listed second.

In short, the Respondent's conduct demonstrates the Respondent's knowledge of the Complainant and the Complainant's trademarks. Registering the disputed domain name which is a variation of the Complainant's trademark, and then using the disputed domain names to sell software products in direct competition with the Complainant, demonstrates that the Respondent specifically knew of and targeted the Complainant. See, for example, *Fédération Française de Tennis (FFT) v. Daniel Hall, dotCHAT, Inc.*, WIPO Case No. [D2016-1941](#).

The Panel concludes that paragraph 4(b)(iv) of the Policy applies in the present case.

The Complainant makes two additional assertions in respect of bad faith which the Panel will briefly discuss. The Panel does not find bad faith in respect of either of these additional assertions.

First, the Complainant asserts that the Respondent must have been aware of the Complainant due to the announcements made regarding the M&A activities taking place involving the Complainant, and that the Respondent registered the disputed domain name at that time because of such announcements. The Complainant makes similar arguments to those made in prior cases such as *Royal Bank of Canada, Dain Rauscher Corporation and Dain Rauscher Incorporated v. RBCD Ain Rauscher*, WIPO Case No. [D2001-1236](#). The Panel considers that the evidence in the present case is circumstantial in terms of demonstrating that the Respondent was likely to have been aware of the Complainant's proposed M&A activity.

Second, the Complainant asserts that the Respondent has been engaged in fraudulent conduct by signing consumers up to a subscription with a high monthly recurring credit card charge, and not stopping the charge when requested by consumers who cancel their subscription. The Complainant provided evidence of consumer emails in respect of this issue. The Respondent provided evidence that it does honor cancellation requests. The Panel does not find that the evidence is sufficient to show that the Respondent is engaged in fraudulent practices – and in any event this is a matter outside the scope of the Policy. However, the evidence does demonstrate that some consumers mistook the Respondent's product for that of the Complainant.

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 <forgepdf.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: June 5, 2024