

ADMINISTRATIVE PANEL DECISION

Build a Rocket Boy Games Ltd v. Build a Rocket GmbH, Alexander Albrecht
Case No. D2022-3404

1. The Parties

The Complainant is Build a Rocket Boy Games Ltd, United Kingdom, represented by Marks & Clerk Solicitors, United Kingdom.

The Respondent is Build a Rocket GmbH, Alexander Albrecht, Germany, represented by Osborne Clarke Rechtsanwälte Steuerberater Partnerschaft mbB, Germany.

2. The Domain Name and Registrar

The disputed domain name <buildarocket.com> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2022. On September 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 15, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 September 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was set at October 11, 2022. Upon request from the Respondent, the Response due date was extended to October 15, 2022. The Response was filed with the Center on October 14, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on October 21, 2022. 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 an independent “AAA” game developer based in Scotland and led by Leslie Benzies. It has operated under the name Build a Rocket Boy Limited since October 31, 2018.

The Complainant is the owner of the following trademark registrations for the sign BUILD A ROCKET BOY (the “Complainant’s BUILD A ROCKET BOY trademark”):

- the United Kingdom trademark registration No. UK00003312634, registered on August 17, 2018 for goods and services in International Classes 9, 41, and 42; and
- the International trademark registration No. 1443450, registered on June 12, 2019 for goods and services in International Classes 9, 41, and 42.

The Complainant has applied for different trademark applications on BUILD A ROCKET GIRL, BUILD A ROCKET BOY, and BUILD A ROCKET BABY in 2022, for various jurisdictions, including Australia, Brazil, China, India, Mexico, and Singapore.

The Complainant’s official website is located at the domain name <buildarocketboy.com>, registered on May 22, 2018.

The Respondent Build a Rocket GmbH is based in Germany. It provides advertising and consulting services regarding eSports and games and the organization of tournaments in the field of sports and event management. The Respondent’s business was started by the company Builda Rocket UG, established on June 22, 2016. The Respondent was itself established on November 23, 2016, when it acquired and continued the business of Build a Rocket UG.

The Respondent is the owner of the following trademark registrations for the sign “BUILD A ROCKET” (the “Respondent’s BUILD A ROCKET trademark”):

- the European Union trademark registration No. 018130643, registered on January 18, 2020 for goods and services in International Classes 9, 25, 35, 38, 41, and 42; and
- the European Union trademark registration No. 018149149, registered on October 15, 2020 for goods and services in International Classes 25, 35, 38, 41, and 42.

The Respondent operates the domain names <buildarocket.de> and <buildarocket.eu>, both registered on October 31, 2014, and <build-a-rocket.com>, acquired on October 5, 2017.

The Parties are involved in a number trademark opposition and invalidation proceedings concerning some of the trademarks listed above.

The disputed domain name was registered in 2006, and was acquired by the Respondent on November 10, 2018. Together with the domain names <buildarocket.de>, <buildarocket.eu>, and <build-a-rocket.com>, it resolves to the same Respondent’s official website, which promotes Respondent’s services.

5. Parties’ Contentions

A. Complainant

The Complainant submits that it has built a significant goodwill and reputation in the BUILD A ROCKET BOY trademark, and notes that from the first announcement of its adoption of the “Build A Rocket Boy” name there has been considerable public interest in its activities, partly due to the personal reputation of the developer Leslie Benzies – producer and developer of Grand Theft Auto, one of the most successful video

game series of all time. The Complainant adds that there is significant public engagement with the its upcoming AAA game (per the Complainant, an AAA game refers to a classification used within the video gaming industry to signify high-budget, high profile games which are considered blockbusters due to their extreme popularity) “Everywhere”.

The Complainant states that the disputed domain name is confusingly similar to the BUILD A ROCKET BOY trademark, because it consists of the words “build a rocket”, and only the short word “boy” that appears at the end of the trademark is missing.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is using the “.com” generic Top-Level Domain (“gTLD”). This implies and gives global relevance to the disputed domain name, which corresponds to the Complainant’s area of business activity. According to the Complainant, the Respondent further suggests a global reach by featuring on the website at the disputed domain name examples of work/presence outside Germany, such as the United States of America (“United States”), Spain, and France, and by the fact that the website at the disputed domain name is in English. The Complainant submits that the Respondent is based in Germany and does not have legitimate rights or interests in the BUILD A ROCKET trademark globally, including the United Kingdom and the United States. The Complainant maintains that it has prior rights to the BUILD A ROCKET BOY trademark and the use of the sign BUILD A ROCKET by the Respondent is trademark infringement in these jurisdictions.

The Complainant also points out that the Respondent’s use of the disputed domain name should not be considered legitimate or fair use because of the correlation between the BUILD A ROCKET BOY trademark and the disputed domain name. In the Complainant’s view, the similarity is so stark that there is a very high risk that consumers would be confused into believing that the services offered on the website at the disputed domain name are those of the Complainant or are otherwise affiliated with, sponsored or endorsed by the Complainant, especially since the Parties are active in identical or at least highly similar fields of business. The Complainant notes that the Respondent offers agency services in relation to eSports, which according to the Complainant is similar to the gaming, video, entertainment and virtual reality goods and services offered by the Complainant and included in the scope of protection of the BUILD A ROCKET BOY trademark.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the Respondent has registered the disputed domain name in the “.com” gTLD, which reflects the natural geographic area of operation of the Complainant’s business, and its intellectual property rights, instead of the Respondent’s limited geographical area. The Complainant states that it is widely known and it is highly likely that the Respondent knew or should have shown that the registration of the disputed domain name would constitute use of a trademark that is confusingly similar to the BUILD A ROCKET BOY trademark.

The Complainant adds that the Respondent is taking unfair advantage of the Complainant’s BUILD A ROCKET BOY trademark by using an infringing trademark as its disputed domain name, and significantly disrupts the business of the Complainant by exploiting the Complainant’s reputation and rights.

B. Respondent

The Respondent maintains that since 2014 it has been working in relation to an activity under the sign Build a Rocket. It points out that it registered its first domain names <buildarocket.de> and <buildarocket.eu> in October 2014 (at a time when the Complainant did not exist), and has consistently appeared in the traffic under the sign BUILD A ROCKET. In this respect, it acquired a German company designation right in 2016, acquired <build-a-rocket.com> domain name in 2017, registered its own BUILD A ROCKET trademarks in 2018 to protect its own business activities (advertising campaigns for other companies) and was also able to acquire the disputed domain name in 2018. The Respondent points out that the disputed domain name had already existed since 2005 and that at the time of its acquisition on November 10, 2018, the Respondent itself had been active on the international market for several years and was significantly better known than the Complainant. The acquisition of the disputed domain name served solely to expand the Respondent’s

own business and to supplement the Respondent's other domain names which the Respondent already owned since 2014 and thus well before the foundation of the Complainant's company. The Respondent adds that websites at its domain names have existed since 2017 and have remained steadily the same.

The Respondent points out that the Complainant did not apply for its BUILD A ROCKET BOY trademark until 2018. At that time, the Respondent had already been operating under the sign "Build a Rocket" for several years. The acquisition of the disputed domain name was therefore not in bad faith with regard to the then unknown company of the Complainant, and the Respondent has not attempted to sell the disputed domain name to the Complainant for an excessive price.

The Respondent points out that it is active but not in a limited geographic area. It is based in Germany and has a large part of its client base there, but at the time of the acquisition of the disputed domain name, it had already been active on the international market, including in the United States, under its company name Build a Rocket GmbH. The Respondent also points out that its entire website has already been in English in 2017 due to the intended and realized international activities of the Respondent.

The Respondent maintains that it has used the sign "Build a Rocket" for a longer period of time than the Complainant has used its BUILD A ROCKET BOY trademark. The Respondent notes in this regard that the evidence submitted by the Complainant shows that it opened its studio only in 2018 – several years after the start of the Respondent's business activity. The Respondent adds that the Respondent's services and the Complainant's services differ in their nature and purpose, usual distribution channels and producers and target different publics (businesses vs. the general public), so there is no link of complementarity or competition between them.

The Respondent notes that the Complainant's trademarks do not show a global reputation of the Complainant, as almost all of them have been applied for in 2022 in response to the mutual cancellation actions, and a large part of the trademarks has not been registered at all, while some other trademarks are in cancellation proceedings. According to the Respondent, the many trademark applications filed by the Complainant shortly before the initiation of the present proceeding indicates that they were made to claim global activity, but trademark applications from 2022 may not establish a global reputation of the Complainant at the time of the disputed domain name transfer to the Respondent several years earlier.

The Respondent contends that it has rights and legitimate interests in respect of the disputed domain name, as it is the owner of a company designation right in Germany and of trademarks protecting the name Build a Rocket. The Respondent notes that based on its company designation right and trademarks, it has commenced cancellation proceedings against the Complainant's European Union trademark BUILD A ROCKET BOY with registration No.1443450.

According to the Respondent, the Complainant is acting in bad faith as has already been aware of all the above as a result of the numerous proceedings in which the Parties are involved, and that the Complainant has engaged in Reverse Domain Name Hijacking and has brought the Complaint primarily to harass the Respondent.

6. Discussion and Findings

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

- (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 Respondent has registered and is using the disputed domain name in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided evidence that it is the owner of the BUILD A ROCKET BOY trademark and has thus established its rights in this trademark for the purposes of the Policy.

The disputed domain name incorporates the first three word elements of the BUILD A ROCKET BOY trademark, while the “boy” element is missing. This element contains only three letters and is located in the end of the trademark, so it can be accepted that the dominant feature of the BUILD A ROCKET BOY trademark is recognizable in the disputed domain name. As discussed in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), in 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.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the BUILD A ROCKET BOY trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] 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) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the domain name, even if [the Respondent has] acquired no trademark or service mark rights; or
- (iii) [the Respondent is] 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.

The Respondent’s company name is Build a Rocket GmbH, and the record confirms that it was duly registered in Germany in 2016. This name corresponds to the disputed domain name. The Respondent has provided evidence that, apart from the disputed domain name, it is also the owner of three other domain names containing “buildarocket” or “build-a-rocket”, and these domain names were registered or acquired in 2014 and 2017. There is also evidence that the Respondent has provided services under its name since 2016. At the same time, the evidence submitted by the Complainant shows that it has started its activities only in 2018, and there is nothing to support a conclusion that the Respondent could have known of the Complainant earlier. All this taken together satisfies the Panel that the Respondent is commonly known under a name that corresponds to the disputed domain name and has used its company name and three domain names, all corresponding to the disputed domain name, for offering *bona fide* services.

This is sufficient for the Panel to conclude that the Respondent has rights and legitimate interests in the disputed domain name for the purposes of the Policy.

C. Registered and Used in Bad Faith

As discussed on the issue of rights and legitimate interests in the disputed domain name, the Respondent has started using the name Build A Rocket as its company name and several corresponding domain names for a *bona fide* offering of goods or services in the period prior to the commencement of the Complainant’s activities in 2018, and the Respondent’s explanation that it acquired the disputed domain name to complement its other domain names and to use it for the same purposes is plausible, and there is no evidence to suggest otherwise.

On this basis, the Panel finds that the Complainant has failed to establish that the disputed domain name was registered and is being used in bad faith.

D. Reverse Domain Name Hijacking (RDNH)

Paragraph 15(e) of the UDRP Rules 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 was brought primarily 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”.

RDNH is furthermore defined under the UDRP Rules as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name.”

As discussed in section 4.16 of the [WIPO Overview 3.0](#), reasons articulated by panels for finding RDNH include, *inter alia*: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant’s lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith, such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the Whois database.

In the present case, the Complainant is represented by counsel. There is no question that the Parties are involved in numerous trademark cancellation and opposition proceedings, and the Respondent has submitted evidence showing that the facts about the Respondent’s company name and its activities prior to the commencement of the Complainant’s activities in 2018 have been brought forward by it in these proceedings. The Complainant was therefore aware of these facts and ought to have known that it could not succeed as a result, but nevertheless proceeded to file the Complaint.

The above is sufficient for the Panel that the Complainant has engaged in RDNH.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: November 4, 2022