

## **ADMINISTRATIVE PANEL DECISION**

Envato Pty Ltd v. Umair Jawed, Themeoforest  
Case No. D2023-0793

### **1. The Parties**

The Complainant is Envato Pty Ltd, Australia, represented by King & Wood Mallesons, Australia.

The Respondent is Umair Jawed, Themeoforest, Pakistan.

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

The disputed domain name <themeoforest.com> (the “Disputed Domain Name”) is 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 February 22, 2023. On February 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 23, 2023, 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 for the Disputed Domain Name.

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 March 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2023. The Respondent sent informal email communications on March 10, March 13, and March 16, 2023. Apart from a few comments on the merits of the case (see below), the Respondent essentially asked the Center to clarify which documents needed to be provided. The Center responded to each communication and referred to the information previously provided to the Respondent. The Center informed the Parties of its commencement of Panel appointment process on March 28, 2023.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on April 3, 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.

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

The Complainant, Envato Pty Ltd, provides a broad range of technological, design, marketing, advertising, publishing and media related goods and services, including through its online marketplace for professional WordPress themes and website templates available at "www.themeforest.net".

The Complainant holds several registered trademarks for THEMEFOREST, including the following:

- THEMEFOREST, Australian word mark registered under No. 1389736 as from October 20, 2010 in classes 9, 35, 38 and 42;
- THEMEFOREST, International word mark covering the European Union and the United States of America, registered under No. 1081047 on April 18, 2011 in classes 9, 35, 38 and 42.

The Disputed Domain Name was registered on January 5, 2022 and appears to refer to a website offering products and services identical or at least similar to the Complainant's products and services.

On October 20, 2022, the Complainant's representative sent a cease and desist letter to the Respondent.

According to the Complainant, the Respondent did not respond.

#### **5. Parties' Contentions**

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

In summary, the Complainant considers the Disputed Domain Name to be confusingly similar to trademarks in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant:

- the Respondent uses the Disputed Domain Name for illegal activity by impersonating the Complainant or at the very least mislead Internet visitors to the website linked to the Disputed Domain Name;
- the Respondent uses the Complainant's mark without authorization or license;
- the Disputed Domain Name is used without a *bona fide* offering of goods or services and without any legitimate non-commercial or fair use;
- the Respondent is not commonly known by the Disputed Domain Name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. The Complainant contends that the Respondent:

- has registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant (within the meaning of paragraph (4)(b)(iii) of the Policy);
- by using the Disputed Domain Name, has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (within the meaning of paragraph (4)(b)(iv) of the Policy);

- has used the website at the Disputed Domain Name to facilitate per se illegitimate activity (namely impersonation and copyright infringement) (within the meaning of sections 3.1.4 and 3.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")); and/or
- noting that the scenarios described in UDRP paragraph 4(b) are non-exclusive, has also sought to take unfair advantage of, abuse, and otherwise engage in behaviour detrimental to the Complainant's marks, which is evidence of bad faith registration and use (see section 3.1 [WIPO Overview 3.0](#)).

## **B. Respondent**

The Respondent did not send a formal Response but essentially claimed the following in an email communication of March 13, 2023:

- the Respondent's name is different from the Complainant's name and <themeforest.net> domain name. Forest is a word that is mostly used for "Jungle" and the Respondent's company name is "themeOforest".
- the Respondent's name indeed matched with the Complainant's name but the Respondent added "O" in between the two words and the Disputed Domain Name is registered under the ".com" TLD.

## **6. Discussion and Findings**

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

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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 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.

The Panel will therefore deal with each of these requirements.

### **A. Identical or Confusingly Similar**

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there is a trademark in which it has rights. The Complainant's THEMEFOREST trademark has been registered since more than a decade and used in connection with the Complainant's online marketplace for professional WordPress themes and website templates.

The Panel observes that the Disputed Domain Name incorporates the Complainant's THEMEFOREST trademark, adding the letter "o" between the words "theme" and "forest".

A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark. Examples of such typos include the addition or interspersion of other terms or numbers (see section 1.9 [WIPO Overview 3.0](#)). The Panel finds that the interspersion of one letter within the Complainant's mark can be considered as "typosquatting" and does not prevent the Complainant's mark to be recognizable within the Disputed Domain Name.

Additionally, it is well established that generic Top-Level Domains ("gTLDs"), here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's THEMEFOREST trademark.

## **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 [WIPO Overview 3.0](#)).

The Panel notes that the Respondent does not seem to have acquired trademark or service mark rights. The Respondent's use and registration of the Disputed Domain Name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent exists or existed.

According to the information provided by the Registrar, the Respondent is "Umair Jawed" from the organization "Themeoforest". The Complainant indicates that the Respondent incorporated a UK company under the name "Themeoforest Ltd" on June 6, 2022, over 5 months after the Respondent registered the Disputed Domain Name.

The Panel agrees with the Complainant that the mere incorporation of a company on its own does not lead to a finding of rights and legitimate interests under the Policy (see *Royal Bank of Canada v. RBC Bank*, WIPO Case No. [D2002-0672](#)). In the present case, the Respondent does not provide any evidence showing that it is commonly known by the Disputed Domain Name.

Moreover, UDRP panels will additionally typically assess whether there is a general lack of other indicia of cybersquatting (see section 2.3 [WIPO Overview 3.0](#)).

The Disputed Domain Name <themeoforest.com> exactly matches the Complainant's THEMEFOREST trademark except for one added letter in the middle of the mark. The Panel finds that employing a misspelling in this way signals an intention on the part of the Respondent to confuse users seeking or expecting the Complainant.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 [WIPO Overview 3.0](#)).

Based on the evidence provided by the Complainant, the Panel observes that the Disputed Domain Name refers to a website which appears to offer products and services similar to the Complainant's products and services at discounted prices. The Complainant even provides evidence of the fact this website copies text,

images and source code from the proprietary WordPress themes and website templates listed on the Complainant's official website. Moreover, the Panel observes that the logo used on the top of the website virtually corresponds to the Complainant's THEMEFOREST mark, as it is not self-evident that the circular logo in between the words "theme" and "forest" would be considered to refer to the letter "o". In the Panel's view, this does not amount to a legitimate noncommercial or fair use of the Disputed Domain Name.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. The Respondent's communications to the Center do not address any of the above findings and no official Response was filed. In the absence of a formal Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

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

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 website or location or of a product or service on the website or location.

In the present case, the Panel finds that it is inconceivable that the Respondent was unaware of the Complainant and its trademark rights when it registered the Disputed Domain Name. The Disputed Domain Name matches the Complainant's distinctive trademark in its entirety with the addition of one single letter, the website linked to the Disputed Domain Name includes a logo which virtually corresponds to the Complainant's mark and this website appears to offer products and services identical or at least similar to the Complainant's products and services at discounted prices. Moreover, the Complainant provides evidence showing that the website linked to the Disputed Domain Name even mentions the Complainant's THEMEFOREST mark and other trademarks of the Complainant. In the Panel's view, the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#)).

The Respondent uses the Disputed Domain Name to resolve to a website, which appears to offer products and services identical or at least similar to the Complainant's products and services at discounted prices. In the Panel's view, the above circumstances indicate that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

The Panel further holds that the addition of one single letter in the Disputed Domain Name as compared to the Complainant's mark is a form of typosquatting which is further evidence of bad faith (*ESPN, Inc. v. XC2*, WIPO Case No. [D2005-0444](#); *WestJet Airlines Ltd. v. Taranga Services Pty Ltd*, WIPO Case No. [D2010-1814](#); and *Compagnie Générale des Etablissements Michelin v. Terramonte Corp*, Domain Manager, WIPO Case No. [D2011-1951](#)).

In its communications to the Center, the Respondent did not take any initiative to contest the foregoing. The Respondent merely stated that its name differed from the Complainant's name and that the Complaint was "false" without providing any supporting evidence despite the Center's explanations as to the filing of a

formal Response. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate. Moreover, it does not appear that the Respondent replied to the Complainant's cease & desist letter.

Therefore, the Panel finds that, on the balance of probabilities, it is established that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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 <themeoforest.com> be transferred to the Complainant.

*/Flip Jan Claude Petillion/*

**Flip Jan Claude Petillion**

Sole Panelist

Date: April 17, 2023