

ADMINISTRATIVE PANEL DECISION

Forbes LLC v. Karishma Rawtani, Facilius Media Solutions Pvt. Ltd.
Case No. D2023-3540

1. The Parties

The Complainant is Forbes LLC, United States of America, represented by Fieldfisher LLP, United Kingdom.

The Respondent is Karishma Rawtani, Facilius Media Solutions Pvt. Ltd., India.

2. The Domain Name and Registrar

The disputed domain name <forbesbrunei.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 August 22, 2023. On August 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 23, 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, Domains By Proxy, LLC, <DomainsByProxy.com>) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 24, 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 August 29, 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 Respondent of the Complaint, and the proceedings commenced on September 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 25, 2023. The Respondent sent an informal communication to the Center on September 26, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on October 2, 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 is the registered owner of several trademarks for FORBES e.g. European Union Trade Mark registration No. 001226646 FORBES (word) registered on September 18, 2000, for services in classes 35, 41, and 42; United States of America Trade Mark registration No. 1141299 FORBES registered on November 11, 1980, for goods in class 16.

The disputed domain name was registered on November 29, 2022, and resolved to a webpage where the Complainant's trademark and logo are displayed without authorization and offering similar services, namely business news.

5. Parties' Contentions

A. Complainant

It results from the Complainant's allegations that the Complainant is a multi-media company headquartered in the United States of America. It publishes the renowned business magazine Forbes and provides business news online at its global website available at <forbes.com>. It also operates from regional websites, including <forbesafrica.com>, <forbesindia.com>, <forbeschina.com>, <forbesjapan.com>, <forbesmiddleeast.com>. The Forbes magazine was first published in 1917, and has since grown to a global readership of over 5,000,000. The magazine is published in 83 countries and has 49 global editions in 28 languages.

The Complainant contends that its trademarks FORBES are highly distinctive and well-known worldwide.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademarks since it reproduces the FORBES mark entirely. The addition of the non-distinctive and descriptive term "brunei", which simply refers to a country in Asia, is insufficient to avoid confusion; on the contrary, it merely suggests to Internet users that the disputed domain name relates to the Complainant.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, it has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the FORBES trademarks. According to the Complainant, the Respondent has not been commonly known by the name Karishma Rawtani, Facilius Media Solutions Pvt. Ltd.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, the registration of the disputed domain name is primarily intended to disrupt the Complainant's business, since the disputed domain name is highly similar to the Complainant's trademarks and the websites adopts a highly similar font to the Complainant's website, whilst offering similar services, namely business news. In addition, given the reputed and distinctive nature of the Complainant and its FORBES trademarks, and the activities undertaken by the Respondent, it is highly likely to have had actual notice of the Complainant's trademarks at the time it registered the disputed domain name.

B. Respondent

The Respondent did not submit a formal response to the Complainant's contentions. The Respondent sent an informal communication to the Center on September 26, 2023, after the Response due date had passed, stating: "While we're looking into this, we request you to allow us another three weeks to respond on this matter". Despite the Center's further instructions to the Respondent, no further communications were submitted by the Respondent.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a 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". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (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.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of trademark registration for FORBES as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7.

This Panel shares this view and notes that the Complainant's registered trademark FORBES is fully included in the disputed domain name, followed by the geographic term "brunei". Furthermore, it is the view of this Panel that the addition of the term "brunei" in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain ("gTLD") ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1). In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and, in particular, did not authorize the Respondent's use of the trademark FORBES, e.g., by registering the disputed domain name comprising the said trademark entirely.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation, since the disputed domain name contains the Complainant's trademark FORBES followed by the geographic term "brunei". Geographic terms are seen as tending to suggest sponsorship or endorsement by the trademark owner, see [WIPO Overview 3.0](#) at section 2.5.1.

It is acknowledged that once the panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

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

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant's documented allegations that the disputed domain name resolved to a website promoting similar services to those of the Complainant and reproducing without any authorization the Complainant's trademark and logo. For the Panel, it is therefore evident that the Respondent knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant's registered trademark FORBES followed by the geographic term "brunei".

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

(i) the nature of the disputed domain name (*i.e.*, incorporating the Complainant's mark plus the term "brunei");

- (ii) the content of the website to which the disputed domain name directs, promoting similar services to those of the Complainant and reproducing without any authorization the Complainant's trademark and logo;
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(iii) 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, <forbesbrunei.com>, be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: October 16, 2023