

ADMINISTRATIVE PANEL DECISION

Forbes LLC v. Waqar Ali
Case No. D2023-3632

1. The Parties

The Complainant is Forbes LLC, United States of America (“United States”), represented by Riker Danzig LLP, United States.

The Respondent is Waqar Ali, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <forbesmagazine.net> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 29, 2023. On August 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 30, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 1, 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 September 8, 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 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2023. The Respondent sent an informal email to the Center on October 4, 2023 and on October 13, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on October 11, 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 Trade Mark registration No. 1141299 FORBES registered on November 11, 1980, for goods in class 16.

The disputed domain name was registered on April 30, 2020 and resolved to a website where the Complainant's trademark is displayed without authorization and offering similar services to the Complainant *i.e.*, a blog and news articles relating to fashion and lifestyle, business, technology, sports, travel, entertainment, and general news. At the time of the decision, the disputed domain name resolved to a page stating "403 Forbidden").

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>. Since 1917, the Complainant has published FORBES magazine, a bi-monthly business magazine that has an extensive United States and worldwide circulation. Through the "www.forbes.com" website, the Complainant also makes available to the public online versions of its print publications such as FORBES, FORBESLIFE, and FORBES MEXICO.

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 trademarks since it contains Complainant's FORBES trademark and simply adds the term "magazine" to the end of Complainant's trademark. The mere addition of this term to Complainant's trademark does not negate the confusing similarity between the disputed domain name and the Complainant's trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent is not sponsored by or affiliated with The Complainant in any way, nor is it commonly known by the disputed domain name. The Complainant has not given the Respondent permission to use Complainant's trademarks in any manner, including in domain names. Respondent is not making a *bona fide* offering of goods or services, nor a legitimate, noncommercial fair use of the disputed domain name. The Respondent is merely using the disputed domain name to create a false association with FORBES, so as to benefit from its good will. The Respondent is using the disputed domain name to attract users to its competing website where the Respondent offers services, namely online news articles relating to fashion and lifestyle, business, technology, sports, travel, entertainment, etc. by means of a global computer network.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, in addition to the worldwide recognition and fame of Forbes magazine and the Forbes business model, the FORBES trademarks are known internationally. Thus, the Respondent knew, or at least should have known, at the time of registration of the disputed domain name of the existence of the Complainant's Forbes trademarks. Moreover, given that the Respondent (i) is offering a blog and news articles in the fields of fashion and lifestyle, business, technology, sports, travel, entertainment, and

general news by means of a global computer network; and (ii) is utilizing the Complainant's registered trademarks to receive the benefits of the association with the Complainant, it is highly unlikely that Respondent is unaware of this worldwide fame, serving as further evidence that the registration of the disputed domain name improperly targeted the Complainant, its business, and viewers. The Respondent's use of the disputed domain name also constitutes a disruption of the Complainant's business and qualifies as bad faith registration and use because the disputed domain name is confusingly similar to the Complainant's trademarks and the Respondent is using it to offer competing services. Such use is a blatant attempt by the Respondent to divert traffic away from a more prominent competitor for the Respondent's own commercial benefit and satisfies the requirements of bad faith registration and use under UDRP.

B. Respondent

The Respondent did not submit a formal response to the Complainant's contentions. The Respondent sent two informal communications to the Center after the Response due date had passed, on October 4, 2023, stating: "Please check my domain again. I do not use forbes branding and also i can't copy anything from forbes and <forbesmagazine.com> so please reactivate my domain or please provide me with my investment. Because I run only informative blogs" and on October 13, 2023, stating: "i don't know about this if is illegal then wahy you allow to sell these name and domain provider show available these domain so now you allow me you use this domain or pay my investment and losses".

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 registrations 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 term "magazine". Furthermore, it is the view of this Panel that the addition of the term "magazine" 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”) “.net” 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.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name is clearly constituted by the Complainant’s registered trademark FORBES and the term “magazine”, which clearly indicates services related to the Complainant’s brand, tending to suggest sponsorship or endorsement by the Complainant. The Panel finds it most likely that the Respondent selected the disputed domain name with the intent to attract Internet users for commercial gain. This is also confirmed by the content of the website to which the disputed domain name resolved, offering similar services *i.e.*, a blog and news articles relating to fashion and lifestyle, business, technology, sports, travel, entertainment, and general news and reproducing without authorization the Complainant’s trademarks.

Furthermore, the composition of the disputed domain name directly targeting the Complainant’s field of activity enhances the false impression that the disputed domain name is somehow officially related to the Complainant and an official website promoting the Complainant’s business. Such composition of the disputed domain name cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner, see section 2.5.1 of the [WIPO Overview 3.0](#).

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. 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 term "magazine", indicating services related to the Complainant's brand.

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 "magazine");
- (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;
- (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, <forbesmagazine.net> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: October 25, 2023