Decision for dispute CAC-UDRP-106927

Case number	**CAC-UDRP-106927**
Time of filing	**2024-10-11 09:25:55**
Domain names	**blue-forest-invest.com**

Case administrator

Name	**Olga Slanařová (Case admin)**

Complainant

Organization	**Blue Forest Management GmbH**

Complainant representative

Organization	**Lubberger Lehment Rechtsanwälte Partnerschaft mbB**

Respondent

Organization	**EASY HOSTER LIMITED**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has provided evidence of ownership of the following unregistered trademarks rights:

- Company name BLUE FOREST MANAGEMENT GMBH registered on 17 April 2024;
- Domain name <blueforest.ventures> registered on 13 September 2023;

The Complainant equally put forth two European trademark applications for BLUE FOREST.

FACTUAL BACKGROUND

The Complainant is Blue Forest Management GmbH, a venture capital firm. The Complainant's business activities include the acquisition and management of company shares with focus on technology start-ups.

The disputed domain name <**blue-forest-invest.com**> was registered on 23 August 2024 and directs to a financial investment website.

PARTIES CONTENTIONS

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COMPLAINANT:

The disputed domain name is confusingly similar to the Complainant's unregistered trademarks BLUE FOREST and its domain names. The Complainant contends that the marks are entirely reproduced in the disputed domain name, with the addition of the generic term "invest" to the mark.

The Respondent has no rights or legitimate use in the disputed domain name <blue-forest-invest.com>. In particular, the Respondent is not making legitimate non-commercial or fair use of the domain name. On the contrary, the Respondent uses the disputed domain name to operate a fraudulent website that appears, by hijacking the Complainant's company name and using the Complainant's company details, as if was operated by the Complainant.

The Respondent has registered and is using the domain in bad faith. The domain name is identical to the Complainant's trademark. The website intentionally creates the impression of being an official page of the Complainant, which is prove that the Respondent is aware of the Complainant and their trademark.

RESPONDENT:

The Respondent submitted a Non-Standard communication asking the Center how the Center's platform works. However, no administratively compliant response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant. Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

1. that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
2. that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark for the Complainant to succeed.

The Complainant is Blue Forest Management GmbH, a venture capital firm trading under the name BLUE FOREST VENTURES. The Complainant's business activities include the acquisition and management of company shares with focus on technology start-ups. The Complainant asserts unregistered trademark rights on the terms BLUE FOREST or BLUE FOREST VENTURES on the basis of its company name and domain name registration.

Turning first to the Complainant's applications for registered trademarks, it is the preponderant view of panels under the Policy that unless such applications have proceeded to grant, they do not constitute trademarks in which a complainant has UDRP-relevant rights. This topic has received comprehensive treatment in Fashiontv.com GmbH v. Mr. Chris Olic, WIPO Case No. D2005-0994. In these circumstances, the Panel finds that the Complainant does not have UDRP-relevant rights in respect of its various applications for registered trademarks.

The Panel therefore turns to the question of whether BLUE FOREST or BLUE FOREST VENTURES may be considered to be a common law trademark of the Complainant. Paragraph 1.3 of the WIPO Overview 3.0 addresses the question of what needs to be shown for a complainant to successfully assert unregistered or common law trademark rights and provides the following consensus view.

Based on the date of launch of the Complainant's BLUE FOREST or BLUE FOREST VENTURES company as referred to in the press articles which it has produced, coupled with the additional material from the Complainant's website, it appears that the Complainant has been in the market under that name since April 2024, a period of less than one year. This is not a particularly long period of time, and this information has not been supplemented with evidence of the amount of sales, extent of advertising or consumer surveys.

The Complainant has received some press coverage which might indicate that it has become a distinctive identifier associated with the Complainant's goods or services. The Panel notes that the Complainant has simply provided a small selection of articles.

The Complainant asserts common law rights to the trademark and service mark BLUE FOREST or BLUE FOREST VENTURES in connection with the provision of financial investment services. The Panel does not find a direct descriptive correlation between the terms "blue forest" and a venture capital company. Imagination must be exercised to make a connection between the combination of these terms and the services rendered by the Complainant. With that established, the combination of terms is inherently distinctive.

The Panel equally notes that the fact that secondary meaning may only exist in a particular geographical area or market niche does not preclude the complainant from establishing trademark rights (and as a result, standing) under the UDRP.

In a civil law jurisdiction such as Germany, the Panel believes that the Complainant could achieve a result comparable to that available under an action for passing off by way of an unfair competition action, provided of course that it could prove a reputation and goodwill in respect of the name, the deceptive activity of the defendant and the likelihood of damage. In other words, albeit by way of a somewhat different route, the Complainant's rights in respect of its name are potentially no different from those of a trader in a common law jurisdiction.

It is on that basis that this Panel is prepared to hold that the Complainant has rights in respect of the name, "BLUE FOREST VENTURES", for the purposes of paragraph 4(a)(i) of the Policy provided that it can satisfy the Panel that the three elements necessary for a passing off action are present.

In fact, the Complainant has put only limited evidence before the Panel in this regard. Under its general powers, the Panel conducted Google searches. While NO reference on the first page of results relate to the Complainant when searching for "BLUE FOREST", all of the results on the first page are references to the Complainant when searching for "BLUE FOREST VENTURES".

It is clear to the Panel that that name "BLUE FOREST VENTURES" is a unique identifier of the Complainant in Germany, and that this name has acquired some level of distinctiveness within the financial investment market. Moreover, the fact that the Respondent's website impersonates the Complainant suggests that the name is well-known to the German financial market sector.

That deception of Internet users and damage to the Complainant is likely to result from the Respondent's use of the Domain Name is clear to the Panel from the matters set out below.

The Panel also takes into account the fact that the Respondent has not challenged the Complainant's evidence or its claim to unregistered trademark rights.

Taking all the above into account, the Panel finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights, and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent's rights or legitimate interests in the disputed domain name:

1. before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
2. the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or

service mark rights; or
3. the respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: "[…] 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The record shows that the Respondent uses the Complainant's trademark in the disputed domain name and on the content of the website associated with that disputed domain name without authorization from the Complainant. The Respondent does not create a false impression of affiliation with the Respondent, but rather blatantly impersonates the Complainant by reproducing its trademark, company name and company details in the header and footer sections of the website associated with the disputed domain name.

Additionally, the evidence on record does not show that the Respondent was commonly known, as an individual or an organization, by the disputed domain name.

The Panel concludes that the Respondent has no right or legitimate interests in the disputed domain name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith
For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

1. circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holders documented out-of-pocket costs directly related to the domain name; or
2. the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
3. the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
4. by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 your website or location or of a product or service on the holder's website or location.

The Panel considers that the Respondent' conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of paragraphs 4(a)(i) and 4(a)(iv)of the Policy. The evidence on the record shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant, and that the Respondent, by registering and using the disputed domain name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark, for commercial gain.

The Complainant set up in business in Germany in April 2024. The name BLUE FOREST VENTURES, comprising a combination of generic words is not a common name. On the face of it, it is a distinctive name. In August 2024, the Respondent registered the disputed domain name, a very similar name to the name of the Complainant and connected it to a webpage in German impersonating the Complainant.

The inevitable inference is that the Respondent registered the disputed domain name knowing it to be a confusingly similar name to the name of the Complainant, for the purpose of defrauding customers hoping to reach the Complainant, visiting the Respondent's site in error. The allegation is made out clearly in the Complaint and, in the view of the Panel, the evidence and the surrounding circumstances support that allegation. The Respondent does not challenge the allegation.

The Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith, and finds that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **blue-forest-invest.com**: Transferred

PANELLISTS

Name	**Arthur Fouré**

DATE OF PANEL DECISION 2024-11-16

Publish the Decision