

ADMINISTRATIVE PANEL DECISION

Associated Newspapers Limited v. Erik Shiffer
Case No. D2023-1057

1. The Parties

The Complainant is Associated Newspapers Limited, United Kingdom, represented by Adlex Solicitors, United Kingdom.

The Respondent is Erik Shiffer, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <dailymailfinancial.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2023. On March 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same day, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 10, 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 March 13, 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 March 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2023.

The Center appointed Mariya Koval as the sole panelist in this matter on April 14, 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 was founded in 1905 and is the management company, as well as the publisher of a range of publications in the United Kingdom including two national newspapers: “the Daily Mail” and “The Mail on Sunday”. Started in 1896, “the Daily Mail” is currently the highest paid circulation newspaper in the United Kingdom, having an average daily circulation of 1.13 million copies in February 2020. Between April 2019 and March 2020, the newspaper had an average daily readership of approximately 2.18 million.

The Complainant is the owner of following DAILY MAIL trademark registrations (the “DAILY MAIL Trademark”):

- United Kingdom Trademark Registration No. 00001207666, registered on November 22, 1983, in respect of goods in class 16; and
- European Union Trademark Registration No. 000193433, registered on November 5, 1999, in respect of goods and services in classes 09, 16, 35, 38, 41, and 42.

The Complainant operates the domain name <dailymail.co.uk> (now also known as “MailOnline” and “Daily Mail Online”) for a news website, which is one of the most-visited websites in the world and the most-read online United Kingdom newspaper brand in 2021 with 518 million page views. The Complainant is also active on social media platforms such as Facebook, LinkedIn, Twitter, Instagram, YouTube, and Pinterest.

The Disputed Domain Name was registered on September 20, 2022. As at the date of this Decision, the Disputed Domain Name resolves to an inactive website. However, according to the evidence presented by the Complainant (Exhibit 10), at the date the Complaint was filed the Disputed Domain Name resolved to a website containing the message “Your app dailymailfinancial is set up”.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that the Disputed Domain Name is confusingly similar to the Complainant’s DAILY MAIL Trademark in view of it wholly incorporates the Trademark and differs only by addition of the word “financial”. This word fails to dispel the connection between the Disputed Domain Name and the DAILY MAIL Trademark; on the contrary, it reinforces the link as the Complainant is well known for its financial news coverage and operates a relevant financial news website. The Complainant’s DAILY MAIL Trademark is a dominant feature of the Disputed Domain Name.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its DAILY MAIL Trademark. There is no evidence that the Respondent has ever actively used the Disputed Domain Name. The Complainant has not been able to find any evidence that the Respondent has used the Disputed Domain Name in connection with the “dailymailfinancial” app (Exhibit 10). If the Disputed Domain Name has been used in this way, then it is difficult to conceive of any legitimate purpose for such an application, which was likely to have been a scam of some sort. Such usage would clearly not have been *bona fide* and cannot generate rights or legitimate interests.

There is no evidence that the Respondent has been commonly known by the name comprised in the Disputed Domain Name. It is clear that the Respondent was out for commercial gain insofar as it was using the Disputed Domain Name for a scam.

The Complainant also claims that the Respondent registered and is using the Disputed Domain Name in bad faith since the Disputed Domain Name has not been actively used, the Respondent concealed its identity or used of false contact details (in breach of its registration agreement), and it is impossible to consider any good faith use to which the Disputed Domain Name may be put.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which 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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has properly asserted its rights in the DAILY MAIL Trademark due to registration and the long use.

The Disputed Domain Name completely reproduces the Complainant's DAILY MAIL Trademark with the addition of the descriptive term "financial" and the generic Top-Level domain ("gTLD") ".com". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. In this case, the addition of the term "financial" to the DAILY MAIL Trademark does not prevent a finding of confusing similarity.

According to the [WIPO Overview 3.0](#), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's DAILY MAIL Trademark pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy. The Complainant has never authorized in any way or licensed the Respondent to use its DAILY MAIL Trademark.

The Panel concludes that the Respondent lacks rights or legitimate interests in respect of the Disputed Domain Name.

The Panel finds that the Complainant has made a *prima facie* case. The Respondent registered the Disputed Domain Name almost forty years after the DAILY MAIL Trademark had been registered and more than one hundred years after the first “the Daily Mail” newspaper had been published for the first time. There is no evidence that the Respondent owns any DAILY MAIL Trademark, nor that it is commonly known by the Disputed Domain Name. Therefore, the Respondent has failed to come forward with any evidence to rebut such *prima facie* case.

Furthermore, the Panel concludes that in view of the reputation and notoriety of the DAILY MAIL Trademark it is highly unlikely that anybody could legitimately adopt the Disputed Domain Name for commercial use other than for an intent to create confusion with the Complainant.

Also, taking into consideration the long use of the Complainant’s DAILY MAIL Trademark, it is implausible to assume that the Respondent was unaware of the Complainant’s DAILY MAIL Trademark at the time of registration of the Disputed Domain Name and instead purposefully registered the Disputed Domain Name in an aim to mislead unsuspecting Internet users expecting to find the Complainant. In accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The addition of the term “financial”, which is descriptive for the Complainant’s range of special economic news, to the Complainant’s DAILY MAIL Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant’s DAILY MAIL Trademark and business at the time of registration of the Disputed Domain Name and has done so for the only purpose of creating a clear impression that the Disputed Domain Name is connected with the Complainant’s DAILY MAIL Trademark.

The Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Disputed Domain Name. Prior to the notice of the dispute, the Respondent did not demonstrate any use of the Disputed Domain Name or a trademark corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services. According to the evidence presented by the Complainant (Exhibit 10), the Disputed Domain Name previously resolved to the website which may have been used for scam.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that indicate bad faith conduct on the part of the respondent, namely:

- (i) circumstances indicating that the respondent has registered or has acquired the disputed 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 respondent’s documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed 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 respondent has engaged in a pattern of such conduct; or

- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent'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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant's DAILY MAIL Trademark is well known throughout the world. The Panel thus concludes that the Respondent must have been aware of the Complainant's Trademark and its reputation when he registered the Disputed Domain Name.

According to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is of the opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the Complainant's well-known DAILY MAIL Trademark, intended to disrupt the Complainant's business and confuse Internet users seeking for or expecting the Complainant. In view of the absence of any evidence to the contrary and that the Respondent did not file any response to claim otherwise, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

The Disputed Domain Name previously resolved to the website allegedly related to some sort of app "dailymailfinancial", and may have been used for scam. In accordance with the [WIPO Overview 3.0](#), section 3.4, UDRP panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution (in some such cases, the respondent may host a copycat version of the complainant's website). Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers. Taking into account the above the Respondent's previous use of the Disputed Domain Name, such behavior cannot be in any way considered as in good faith.

In addition, this Panel notes that currently the Disputed Domain Name does not resolve to an active webpage. However, previous UDRP panels have frequently found that the apparent lack of so-called active use of the domain name (*i.e.* passive holding) does not prevent a finding of use in bad faith in specific circumstances, which include the degree of distinctiveness or reputation of the complainant's mark and the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use (section 3.3 of [WIPO Overview 3.0](#) and e.g. *Virgin Enterprises Limited v. Cesar Alvarez*, WIPO Case No. [D2016-2140](#); *"Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc.*, WIPO Case No. [D2017-0246](#)).

Finally, the Respondent, not participating in these proceedings, has failed to indicate any facts and/or evidence, which would show a good faith registration and use of the Disputed Domain Name. Moreover, the Respondent masked its identity in the publicly-available Whois via the use of a privacy service, which, under the circumstances of this proceeding, is a further indication of bad faith.

In view of the foregoing, the Panel finds that paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, the Disputed Domain Name has been registered and is being used in bad faith.

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, <dailymailfinancial.com>, be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: April 28, 2023