

ADMINISTRATIVE PANEL DECISION

Hearst Communications, Inc. v. LLC HS Ukraine and ТОВАРИСТВО З ОБМЕЖЕНОЮ ВІДПОВІДАЛЬНІСТЮ “ЕЙЧ ЕС УКРАЇНА”

Case No. DUA2021-0029

1. The Parties

The Complainant is Hearst Communications, Inc., United States of America (“United States”), represented by Davis Wright Tremaine LLP, United States.

The Respondent is LLC HS, Ukraine and ТОВАРИСТВО З ОБМЕЖЕНОЮ ВІДПОВІДАЛЬНІСТЮ “ЕЙЧ ЕС УКРАЇНА”, Ukraine.

2. The Domain Names and Registrars

The disputed domain names <cosmo.com.ua> and <cosmopolitan.com.ua> are registered with ua.intersv (the “Registrar 1”), and the disputed domain name <harpersbazaar.com.ua> (jointly the “Disputed Domain Names”) is registered with Internet Invest, Ltd. Dbа Imena.ua (the “Registrar 2”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 1, 2021. On December 3, 2021, the Center transmitted by email to the Registrars a request for registrar verification in connection with the Disputed Domain Names. On December 10, 2021, the Registrar 1 transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names, which differed from the named Respondent and contact information in the Complaint. On December 9, 2021, the Registrar 2 transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name <harpersbazaar.com.ua>, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 2021 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 December 16, 2021.

The Center sent an email communication in both English and Ukrainian regarding the language of the proceeding on December 13, 2021. On December 16, 2021, the Complainant confirmed its request to proceed in English. On December 27, 2021, the Respondent filed a request that the language of the proceeding be Ukrainian.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of .UA Domain Name Dispute Resolution Policy (the “.UA Policy”), the Rules for .UA Domain Name Dispute Resolution Policy (the “.UA Rules”), and the WIPO Supplemental Rules for .UA Domain Name Dispute Resolution Policy (the “WIPO Supplemental Rules”).

In accordance with the .UA Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent in English and Ukrainian of the Complaint, and the proceedings commenced on December 28, 2021. In accordance with the .UA Rules, paragraph 5(a), the due date for Response was January 27, 2022. The Respondent submitted its Response on January 26, 2022 and informal communication on July 12, 2023.

The Center appointed Mariya Koval as the sole panelist in this matter on February 18, 2022. 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 .UA Rules, paragraph 7.

From March 2022 to this date, the WIPO Center was not in a position to accept .UA filings. On July 1, 2023 upon instructions of the .UA Registry, WIPO domain name dispute resolution service for .UA is available again. Accordingly, the decision in the present case is being issued to the parties.

4. Further Procedural Considerations

Under paragraph 10 (b) of the .UA Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent’s mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the .UA Rules, whether the proceeding should continue.

The Panel noted that the courier was able to deliver the written notice to the Respondent’s address in Ukraine as well as the Complaint together with the amended to the Complaint were delivered to the Respondent’s email address, approved by the Registrar. Moreover, the Respondent submitted the formal Response to the Center and some comments regarding the language of the proceeding.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

5. Factual Background

The Complainant, being founded in 1867, is a leading global media, information, and services company with more than 360 affiliated businesses with presence in 13 countries. The Complainant owns nearly 250 magazine editions around the world, including COSMOPOLITAN, HARPER’S BAZAAR, ELLE, MEN’S HEALTH, CAR and DRIVER, and digital services businesses such as iCrossing and KUBRA. Moreover, the Complainant has ownership interests in cable television networks such as A&E, HISTORY, LIFETIME, and ESPN.

The Complainant’s HARPER’S BAZAAR magazine is a worldwide monthly women’s fashion magazine, and is one of the first ever publications dedicated to women and fashion. The Complainant’s COSMOPOLITAN magazine (also known as COSMO), launched in 1886, is a monthly magazine for women, with more than 50 international editions.

The Complainant owns numerous HARPER’S BAZAAR Trademark (the “HARPER’S BAZAAR Trademark”),

COSMOPOLITAN Trademark (the “COSMOPOLITAN Trademark”) and COSMO Trademark (the “COSMO Trademark”), (collectively “the Trademarks”), worldwide registrations, including Ukraine, among which are:

Trademark	Country/Registration	Registration No.	Registration Date	International Class
HARPER'S BAZAAR	Ukraine	9956	June 30, 1998	16
HARPER'S BAZAAR	Ukraine	219966	December 12, 2016	9, 41, 45
HARPER'S BAZAAR	European Union	008439812	March 8, 2010	16, 41
HARPER'S BAZAAR	United States	274802	September 9, 1930	16
COSMOPOLITAN	Ukraine	9955	June 30, 1998	16
COSMOPOLITAN	Ukraine	30110	November 22, 1999	35
COSMOPOLITAN	International Trademark Registration	1312404	April 15, 2016	3, 7, 8, 9, 11, 14, 16, 18, 20, 22, 24, 25, 26, 27, 28, 35, 36, 41, 43, 44
COSMOPOLITAN	European Union	5014972	April 11, 2007	9, 16, 41
COSMOPOLITAN	United States	630028	July 3, 1956	16
COSMO	Ukraine	65525	August 15, 2006	16
COSMO	Ukraine	114244	November 10, 2009	16, 35, 38
COSMO	International Trademark Registration	1312404	April 15, 2016	3, 7, 8, 9, 11, 14, 16, 18, 20, 22, 24, 25, 26, 27, 28, 35, 36, 41, 43, 44
COSMO	European Union	005014998	July 31, 2010	9, 16, 41
COSMO	United States	3372644	January 22, 2008	16

The Complainant has a great online presence, it operates domain names <cosmopolitan.com> (registered on July 21, 2007), <harpersbazaar.com> (registered on August 25, 1997), and many others.

The Disputed Domain Names <cosmo.com.ua> and <harpersbazaar.com.ua> were registered on February 1, 2001 and August 20, 2009 respectively. On the date of this Decision, these Disputed Domain Names resolve to the websites with the Ukrainian versions of the Complainant's magazines COSMOPOLITAN and HARPER'S BAZAAR respectively.

The Disputed Domain Name <cosmopolitan.com.ua> was registered on March 19, 2004 and on the date of this Decision resolves to an inactive website.

On January 1, 2015, the Complainant and the Respondent entered into a license agreement under which the Complainant granted to the Respondent the right to use the Complainant's COSMOPOLITAN Trademark registrations in Ukraine and to register various domain names, including Disputed Domain Names <cosmo.com.ua> and <cosmopolitan.com.ua>.

On February 1, 2015, the Complainant and the Respondent entered into a license agreement under which the Complainant granted to the Respondent the right to use the Complainant's HARPER'S BAZAAR Trademark in Ukraine and to register the Disputed Domain Name <harpersbazaar.com.ua>.

On April 9, 2021, the Complainant requested the Respondent's transfer of the Disputed Domain Names to the Complainant's designee for the Complainant's benefit. On June 2, 2021, the Complainant sent a letter to the Respondent terminating the license agreements and requesting, *inter alia*, that the Respondent stop all

use of the Complainant's Trademarks and immediately transfer registrations of the Disputed Domain Names to the Complainant or its designee. As of the date of the Complaint, the Respondent has failed to transfer the Disputed Domain Names to the Complainant in breach of both license agreements.

6. Parties' Contentions

A. Complainant

The Complainant contends that it has extensively marketed and promoted the Trademarks with its magazines and related goods and services worldwide. Because of the Complainant's long-term use of the Trademarks for over 130 years, consumers around the world associate the Trademarks with the Complainant. The Complainant has established its ownership rights in the Trademarks through many registrations throughout the world, including Ukraine.

The Complainant asserts that the Disputed Domain Names are confusingly similar to the Complainant's Trademarks because the Disputed Domain Names incorporate the Complainant's Trademarks in their entirety.

The Complainant further asserts that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The Complainant and the Respondent entered into two license agreements under which the Complainant granted a limited license to the Respondent to use the Complainant's Trademarks and to register the Disputed Domain Names for specific purposes in Ukraine, subject to the Respondent's obligation to transfer the Disputed Domain Names to the Complainant at any time upon the Complainant's request.

On April 9, 2021, the Complainant requested the transfer of the Disputed Domain Names from the Respondent to the Complainant's designee for the Complainant's benefit. The Complainant formally terminated the license agreements on June 2, 2021 and again requested the immediate transfer of the Disputed Domain Names to the Complainant or its designee. On July 19, 2021, the Complainant sent a follow-up letter to the Respondent providing a supplemental basis for the termination of the license agreements and demanding that the Respondent confirm its transfer of the Disputed Domain Names to the Complainant or its designee by July 28, 2021. Because the Respondent was obligated to transfer the Disputed Domain Names upon request and failed to do so promptly in response to the Complainant's express requests, the Respondent no longer has the right to register or use the Disputed Domain Names.

The Respondent's commercial use of the Disputed Domain Names in connection with Ukrainian versions of the Complainant's magazines does not constitute *bona fide* offering goods and services to demonstrate the Respondent's rights or legitimate interests in, or noncommercial or fair use of, the Disputed Domain Names.

Moreover, to the best of the Complainant's knowledge, the Respondent is not and has never been commonly known by any of the Disputed Domain Names. The Respondent lost any right to register or use the Disputed Domain Names when the Respondent failed to transfer the Disputed Domain Names to the Complainant upon request per the terms of the license agreements.

The Complainant also contends that because of the Disputed Domain Names are confusingly similar to the Complainant's world-renowned Trademarks, the nature of the Disputed Domain Names carries a high risk of implied affiliation with the Complainant's Trademarks. Therefore, the consumers would naturally assume the Complainant is affiliated or associated with the Disputed Domain Names and their associated websites.

The Complainant further alleges that the Respondent is using the Disputed Domain Names in bad faith. The Respondent's use of the Disputed Domain Names <cosmo.com.ua> and <harpersbazaar.com.ua> to attract Internet users to its active websites creates a likelihood of confusion with the Complainant's Trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites. The Respondent's ongoing commercial use of the Disputed Domain Names in association with the Complainant's Trademarks and magazines after the Complainant requested the transfer of the Disputed Domain Names pursuant to the license agreements constitutes bad faith.

The Respondent's use of the Disputed Domain Name <cosmopolitan.com.ua>, which resolves to an inactive website, constitutes bad faith because such use does not represent a *bona fide* offering of goods or services.

The Respondent's refusal to transfer the Disputed Domain Names prevents the Complainant from using them. The existence of a previous business relationship between the Complainant and the Respondent does not preclude a finding of bad faith.

B. Respondent

The Respondent rejects the Complainant's contentions and requests that that the Complainant's remedies requested be rejected.

The Respondent does not contest that the Disputed Domain Names are identical or confusingly similar to the Complainant's Trademarks, but argues that the Respondent has rights or legitimate interests in respect of the Disputed Domain Names since it is making a legitimate or fair use of the Disputed Domain Names in accordance with the license agreements which the Respondent considers valid. The Respondent also claims that when using the Disputed Domain Names, it has no intention of misleading the Internet users or damaging the reputation of the Complainant's Trademarks. The Respondent also contends that it was or is commonly known by the Disputed Domain Names in Ukraine.

The Respondent further asserts that the Disputed Domain Names have been registered in accordance with the license agreements. The Disputed Domain Names have not been registered primarily for selling to the Complainant or its competitor for valuable consideration in excess of the Respondent's costs related to the Disputed Domain Names; the Complainant and the Respondent are not competitors, the Disputed Domain Names have not been registered for disrupting the Complainant's business; the Disputed Domain Names have not been registered for intentional attempting 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 Trademarks 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.

In its second informal communication on July 12, 2023, the Respondent highlighted again that it uses the Disputed Domain Names under the license agreements, which it considers valid. The Respondent also noted that determining the absence of rights or interests in the Disputed Domain Names requires an analysis and decision by an arbitrator on the merits of the license agreements, which is not subject to the UDRP panelists.

Furthermore, the Respondent contends that the websites "www.cosmo.com.ua" and "www.harpersbazaar.com.ua" are active and have become an incredibly important platform for covering the most important social issues.

7. Discussion and Findings

Paragraph 4(a) of the .UA Policy binds the Complainant to prove each of the following three elements to succeed:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered or is being used in bad faith.

Taking into consideration many similarities between the .UA Policy and the Uniform Domain Name Dispute

Resolution Policy (“UDRP”), the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) and, where appropriate, will decide consistent with the consensus views captured therein.

A. Preliminary Issue: Language of Proceedings

In accordance with paragraph 11 of the .UA Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Registrar confirmed that the language of the Registration Agreements for the Disputed Domain Names is Ukrainian.

The Complainant filed a request for the English language proceeding in view of the following:

- the Respondent is familiar with the English language;
- the Complainant and the Respondent entered into two license agreements, dated January 1, 2015 and February 1, 2015, both of which are written in English and governed by the laws of the State of New York, United States;
- the Complainant and the Respondent have exchanged by written communications with each other over several years in English, including the correspondences between the parties in which the Complainant requested that the Respondent transfer the Disputed Domain Names.

The Respondent requests that the language of the administrative proceeding be Ukrainian in order to avoid the additional expenses of requiring translation and the delay in the proceeding. However, the Respondent has submitted informal communications in English, which confirms that he is able to understand and communicate in English.

Neither the Complainant, nor its representative are not obviously able to understand and to communicate in Ukrainian. Forcing the Complainant to translate the Complaint and annexes thereto, would result in unfair additional expenses for the Complainant and would delay this proceeding.

Paragraph 10(c) of the .UA Rules sets out that the Panel shall ensure that the administrative proceeding takes place with due expedition.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties’ ability to understand and use the proposed language, time and costs.

The Disputed Domain Names and country-code Top-Level domain (“ccTLD”) comprise Latin script. The Panel has taken into account the fact the Complainant and the Respondent concluded two license agreements, which are in English, the Complainant and the Respondent have exchanged by many written communications with each other over several years in English. The Panel also notes the Respondent communicated with the Center in both Ukrainian and English, which demonstrates that the Respondent is sufficiently proficient in the English language.

Having considered all circumstances of this case, the Panel concludes under paragraph 11(a) of the .UA Rules that English shall be the language of the proceeding.

B. Identical or Confusingly Similar

In accordance with paragraph 4(a)(i) of the .UA Policy it should be established that the Disputed Domain Names are identical or confusingly similar to a mark in which the Complainant has rights.

The Panel accepts that the Complainant demonstrated that it has the rights in the COSMOPOLITAN, COSMO and HARPER'S BAZAAR Trademarks in view of a large number of registrations in different jurisdictions, including Ukraine, and long use of its Trademarks.

The Disputed Domain Names incorporate the COSMOPOLITAN, COSMO and HARPER'S BAZAAR Trademarks in their entirety, and ccTLDs ".com.ua". In accordance with prior decisions under the .UA Policy, the applicable ccTLD in a domain name is viewed as a standard registration requirement and as such is generally disregarded under the first element confusing similarity test. See *AB Electrolux v. Захаров Евгений*, WIPO Case No. [DUA2020-0006](#). The Panel considers it is appropriate to apply the same rules in this proceeding regarding ccTLD ".com.ua". Therefore, the addition of the ccTLDs ".com.ua" to the Disputed Domain Names in this case does not prevent a finding of identity or confusing similarity between the Complainant's Trademarks and the Disputed Domain Names.

Previous UDRP panels have recognized that incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the complainant's registered mark; see *bridport & cie S.A v. Privatewhois.net, Private Whois bridportadvisory.com*, WIPO Case No. [D2011-2262](#).

In view of the above, the Panel concludes that the Disputed Domain Names <cosmo.com.ua> and <cosmopolitan.com.ua> are identical to the Complainant's COSMO and COSMOPOLITAN Trademarks respectively; the Disputed Domain Name <harpersbazaar.com.ua> is confusingly similar to the Complainant's HARPER'S BAZAAR Trademark. Therefore, the Complainant has satisfied the first element of the .UA Policy.

C. Rights or Legitimate Interests

In accordance with paragraph 4(a)(ii) of the .UA Policy the Complainant has to establish that the Respondent has no rights or legitimate interests in the Disputed Domain Names.

According to prior decisions under the .UA Policy, while the overall burden of proof in .UA proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Names.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the Disputed Domain Names.

The Respondent asserts to have rights or legitimate interests in respect of the Disputed Domain Names since it was authorized to register the Disputed Domain Names by the Complainant under the license agreements of 2015. In spite of the Complainant's statement that the license agreements were terminated, the Respondent asserts the agreements are still in force.

According to the Section 1(c) of the License Agreement between the Complainant and the Respondent: "Registration of the Domain Names shall be immediately transferred to Hearst or a Hearst designee, upon the earlier of Hearst's request at any time or upon termination of this Agreement". The Panel interprets this provision of the license agreements as the Respondent's direct strict obligation to immediately transfer the Disputed Domain Names to the Complainant upon its request regardless of validity or termination of the license agreements.

The Respondent's considerations about the fact that the license agreements between the Complainant and

the Respondent are still in force are beyond the scope of this proceeding, since as stated above the Respondent is obliged to transfer the Disputed Domain Names on the first Complainant's demand.

The Respondent contends that "it is making a legitimate or fair use of the Disputed Domain Names, without any intent to misleadingly divert consumers or to tarnish the reputation of the Complainant's Trademarks."

In this regards the panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test" (see section 2.8.1 of the [WIPO Overview 3.0](#)), the following cumulative requirements will be applied in the specific conditions:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The Panel notes that the websites under the Disputed Domain Names <cosmo.com.ua> and <harpersbazaar.com.ua> do not include a clear, accurate and prominent reference to the lack of license relationship between the Respondent and the Complainant which does not prevent any potential confusion of the Internet users as to the relationship of the Respondent with the Complainant, and whether the Respondent is the owner of the COSMO and HARPER'S BAZAAR Trademarks. Thus, the Panel is of the opinion that the Respondent fails to comply with the Oki Data test. In addition, according to the evidence provided by the Complainant at some point the website at the disputed domain name only included "Copyright Cosmopolitan Ukraine, 2019 – All rights reserved", which is also not sufficient to comply with the Oki Data test.

The website under the Disputed Domain Name <cosmopolitan.com.ua> is inactive, which also is an indication that the Respondent is not involved in a *bona fide* offering goods or services or a legitimate noncommercial or fair use.

Based on the facts of this case, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Names and accordingly the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the .UA Policy.

D. Registered or Used in Bad Faith

The third element of paragraph 4(a) of the .UA Policy refers to the question of whether the Disputed domain Names have been registered or are being used in bad faith by the Respondent.

The Panel comes to the conclusions the Disputed Domain Names have not been registered in bad faith by the Respondent since the Respondent was authorized to register the Disputed Domain Names by the Complainant, namely under the license agreements of 2015 concluded between the Complainant and the Respondent.

However, the Panel considers the Respondent is using the Disputed Domain Names in bad faith in view of it did not transferred the Disputed Domain Names to the Complainant upon the Complainant's earlier demand (on April 9, 2021) as required by the license agreements provisions. The Respondent's contentions that it is using the Disputed Domain Names in good faith since the license agreements are still in force cannot be taken into account.

Thus, the Panel accepts the Complainant's contentions that the Respondent's use of the Disputed Domain Names to attract Internet users to its active websites creates a likelihood of confusion with the Complainant's Trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites. The Panel also agrees that the Respondent's ongoing commercial use of the Disputed Domain Names in association with the Complainant's Trademarks and magazines after the Complainant requested transfer of the Disputed Domain Names pursuant to the termination of License Agreement constitutes bad faith. The existence of a previous business relationship between the Complainant and the Respondent does not preclude a finding of bad faith use. See *Crocs, Inc. v. Матвеева Ангела Геннадьевна / Matveeva Angela*, WIPO Case No. [DUA2020-0015](#) "Existence of previous business relations do not preclude a finding of bad faith, since the use of the disputed domain name continued after the business relations ended and the Respondent refused to transfer the disputed domain name to the Complainant."

The Respondent's use of the Disputed Domain Name <cosmopolitan.com.ua>, which resolves to an inactive website, constitutes bad faith under the doctrine of passive holding.

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

9. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the .UA Policy and 15 of the .UA Rules, the Panel orders that the Disputed Domain Names <cosmo.com.ua>, <cosmopolitan.com.ua>, and <harpersbazaar.com.ua> be transferred to the Complainant.

/Mariia Koval/

Mariia Koval

Sole Panelist

Date: July 12, 2023