

## **ADMINISTRATIVE PANEL DECISION**

Associated Newspapers Limited v. Privacy service provided by Withheld for Privacy ehf / ARIE ARIYANTO, CV.ARIE JAYA  
Case No. D2022-0374

### **1. The Parties**

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

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / ARIE ARIYANTO, CV.ARIE JAYA, Indonesia.

### **2. The Domain Name and Registrar**

The disputed domain name <dailymailrewards.org> (the “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 February 3, 2022. On February 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on February 4, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 7, 2022.

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 Respondent of the Complaint, and the proceedings commenced on February 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 1, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on March 8, 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 Rules, paragraph 7.

#### **4. Factual Background**

Complainant is a UK company that was incorporated in 1905. It is the management company and publisher of the UK national newspapers "Daily Mail" and "The Mail on Sunday". The first edition of the Daily Mail was published in 1896. The Daily Mail's average UK newspaper readership from July 2019 to June 2021 was over 2 million per issue. The Daily Mail's average UK newspaper circulation in September 2021 was approximately 920,000 per issue.

Per Complaint, Complainant's website at "www.dailymail.co.uk" is the most-read online UK newspaper with 518 million page views and 4.1 average daily visitors in July 2021. Complainant runs a rewards scheme for the benefit of its readers operated from its website at "www.mymail.co.uk". The scheme is partnered with Nectar, one of the UK's most well-known rewards schemes.

Complainant owns various trademarks for DAILY MAIL including:

- a) United Kingdom trademark registration number 1207666, DAILY MAIL (word), filed and registered on November 22, 1983 for goods in international class 16;
- b) European Union trade mark registration number 193433, DAILY MAIL (word), filed on April 1, 1996 for goods and services in international classes; 9, 16, 35, 38, 41 and 42; and
- c) United Kingdom trade mark registration number 2582173, MAIL REWARDS CLUB (word), filed on May 20, 2011 for goods and services in international classes 9, 16, 35 and 38.

The Domain Name was previously registered on February 28, 2020. As of May 27, 2021, it was used for a website purporting to provide information about Complainant's rewards scheme. The website was suspended at the behest of Complainant and then it expired.

The Domain Name was then re-registered on May 28, 2021. Complainant cannot tell if it is ultimately owned by the same person as before. As of May 29, 2021, the Domain Name was used for a parking page with pay-per-click ("PPC") advertising pages containing third party, commercial advertising links related to rewards schemes, including a link to "Daily Mail" and to "Nectar". As of February 3, 2022, under the Domain Name operated a blog/news website prominently displaying "Daily Mail" in the top left of the header. A copyright symbol followed by "© 2021 - DAILY MAIL" appeared in the footer. There were no blog posts but links to "KLAWING N ews", downloadable apps and other information topics. Currently the mentions "DAILY MAIL" and "© 2021 - DAILY MAIL" have been replaced by "DM" on the header and "© 2021 - DM" in the footer, while all links have been removed (all the above, the Website).

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements that Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Domain Name incorporates Complainant's trademark DAILY MAIL in its entirety. This is sufficient to establish confusing similarity (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7).

The addition of the word "rewards" does not prevent a finding of confusing similarity, as the trademark DAILY MAIL remains clearly recognizable ([WIPO Overview 3.0](#), section 1.8).

The generic Top-Level Domain ("gTLD") ".org" is disregarded, as gTLDs typically do not form part of the comparison as they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); and *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Name is confusingly similar to the DAILY MAIL mark of Complainant.

Complainant has established Policy, paragraph 4(a)(i).

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business, or other organization) has been commonly known by the Domain Name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

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

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complainant, Respondent was not authorized to register the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name was used to host the Website which currently includes empty post spaces and the prominent mentions "DM" and "© 2021 - DM", namely the initial letters of the words "Daily Mail", and in the past included the prominent mentions "DAILY MAIL" and "© 2021

- DAILY MAIL”, along with links to *inter alia* “KLAWING News”.

Respondent has therefore been using the Domain Name, without Complainant’s authorization, giving the false impression of being operated by Complainant or an entity affiliated to Complainant or an official partner of Complainant. The Panel finds that the Domain Name has been operated by Respondent intentionally, for commercial gain, creating a likelihood of confusion with Complainant’s trademark and business as to the source, sponsorship, affiliation or endorsement of the Website it resolved to.

Furthermore, prior to that, the Domain Name lead to a PPC parking page which contained advertising links related to rewards schemes, including a link to Complainant’s “Daily Mail” and to “Nectar”, the entity that runs Complainant’s client rewards scheme. It has been recognized that PPC links do not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users (*SAP SE v. Domains by Proxy, LLC / Kamal Karmakar*, WIPO Case No. [D2016-2497](#); [WIPO Overview 3.0](#), section 2.9).

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or

(ii) that Respondent 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 Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith.

Because the DAILY MAIL mark had been widely used and registered by Complainant before the Domain Name registration, the Panel finds it more likely than not that Respondent had Complainant’s mark in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); and *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. D2000-0226).

Respondent should have known about Complainant’s rights, as such knowledge is readily obtainable through a simple browser search (see *Caesars World, Inc. v. Forum LLC.*, WIPO Case No. [D2005-0517](#); and *Compart AG v. Compart.com / Vertical Axis, Inc.*, WIPO Case No. [D2009-0462](#)).

Furthermore, Respondent could have conducted a trademark search and would have found Complainant's prior registrations in respect of DAILY MAIL (*Citrix Online LLC v. Ramalinga Reddy Sanikommu Venkata*, WIPO Case No. [D2012-1338](#)).

The content of the Website has throughout given the impression that it originates from Complainant, eminently displaying the words "DAILY MAIL" or "DM", thereby giving the false impression that the Website emanates from Complainant. This further supports registration in bad faith reinforcing the likelihood of confusion with Complainant's trademark and business, as Internet users are likely to consider the Domain Name as in some way endorsed by or connected with Complainant ([WIPO Overview 3.0](#), section 3.1.4 and 3.2.1).

The above further removes any doubt that Respondent knew of Complainant and chose the Domain Name with knowledge of Complainant and its industry (*Safepay Malta Limited v. ICS Inc*, WIPO Case No. D2015-0403).

As regards bad faith use, Complainant demonstrated that the Domain Name was employed to host the Website which included empty post spaces and the mention "© 2021 - DM", namely the initial letters of the words "Daily Mail" and in the past it led to the same website where the mention "DAILY MAIL" was prominently displayed as well as the mention "© 2021 - DAILY MAIL", with links to *inter alia* "News".

Accordingly, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's Website, by creating a likelihood of confusion with Complainant's mark. It has been recognized that use of a third party trademark to generate revenue from Internet advertising can constitute registration and use in bad faith (*McDonald's Corporation v. ZusCom*, WIPO Case No. [D2007-1353](#); *Volkswagen Aktiengesellschaft v. Robert Brodi*, WIPO Case No. [D2015-0299](#); *SAP SE v. Domains by Proxy, LLC / Kamal Karmakar*, WIPO Case No. [D2016-2497](#); [WIPO Overview 3.0](#), section 3.5).

Prior to that the Website consisted of a PPC parking page with a link to "Daily Mail" and to "Nectar", namely Complainant's newspaper and Complainant's collaborating entity that run Complainant's rewards scheme of the same newspaper, respectively.

The Panel considers the following factors:

- the fact that the Website has prominently displayed the DAILY MAIL trademark of Complainant;
- the fact that the Website included content related to that of Complainant, particularly insofar as the Website offered "News" links;
- the Website formerly featured PPC links to sites offering rewards schemes, including "Nectar";
- the PPC Website included a link referring to Complainant itself; and
- the failure of Respondent to submit a response.

The current inactivity or lack of post content of the Website does not alter the above findings. The non-use of a domain name would not prevent a finding of bad faith (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the Domain Name in bad faith.

Complainant has established Policy, paragraph 4(a)(iii).

## 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 Domain Name, <dailymailrewards.org>, be transferred to Complainant.

*/Marina Perraki/*

**Marina Perraki**

Sole Panelist

Date: March 22, 2022