

ADMINISTRATIVE PANEL DECISION

Macmillan Publishers International Limited v. Privacy Service Provided by Withheld for Privacy ehf / Mary Fortenbaugh, PubHub
Case No. D2022-1826

1. The Parties

The Complainant is Macmillan Publishers International Limited, United Kingdom, represented by Stobbs IP, United Kingdom.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Mary Fortenbaugh, PubHub, Philippines.

2. The Domain Name and Registrar

The disputed domain name <macmillanpublication.com> (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 May 20, 2022. On May 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 20, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 23, 2022, 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 May 24, 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 the Respondent of the Complaint, and the proceedings commenced on May 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 15, 2022.

The Center appointed Gregor Vos as the sole panelist in this matter on June 21, 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

The Complainant is part of the international Macmillan group of publishing companies. The Complainant was founded in 1843 and has offices in over 41 countries. The Complainant produces printed and electronic books, digital educational assessment products and it provides publishing and distribution services.

The Complainant is the owner of, *inter alia*, the following trademark registrations (hereinafter jointly referred to as: the "Trademarks"):

- German registration No. DD643144 for MACMILLAN registered on August 20, 1980; and
- Benelux registration No. 0315630 for MACMILLAN registered on December 22, 1972;

The Domain Name was registered on December 15, 2021 and currently (and at the time of filing the Complaint) resolves to a website on which pay-per-click ("PPC") links are depicted.

5. Parties' Contentions

A. Complainant

With the Complaint, the Complainant seeks that the Domain Name is transferred to the Complainant. The Complaint is based on the following factual and legal grounds: the Domain Name is identical or confusingly similar to the Trademarks of the Complainant, the Respondent has no rights or legitimate interests in the Domain Name and the Domain Name has been registered and is being used in bad faith.

Firstly, according to the Complainant, the Domain Name is confusingly similar to the Trademarks. The Trademarks are incorporated in the Domain Name in their entirety, with the mere addition of the descriptive element "publishing" and the generic Top-Level domain ("gTLD") ".com".

Second, according to the Complainant, the Respondent has no rights or legitimate interests in the Domain Name. The Respondent does not provide a *bona fide* offering of goods and services, since the Respondent is using the Domain Name to redirect visitors to websites of competing publishers and other third parties. Also, the Respondent is using the Domain Name to send phishing emails and has never received any authorization or license from the Complainant to use the Trademarks.

Further, the Respondent has not been commonly known under the sign "macmillanpublication" or "macmillan" and due to the well-known character of the Complainant's Trademarks it is unrealistic that the Domain Name was registered for any other reason than to take advantage of the Complainant's rights.

Third, the Complainant submits that the Domain Name has been registered and used in bad faith. The Complainant's Trademarks pre-date the registration of the Domain Name and in light of their well-known character, it is highly likely that the Respondent was aware of the Trademarks at the time of the registration of the Domain Name. Further, the Respondent has sent fraudulent emails using the Domain Name in combination with the Complainant's Trademarks for commercial and financial gain. Finally, the Complainant submits that the Domain Name is being used solely for the purpose of illegal activities, including fraud. This constitutes both registration and use of the Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual presentations.

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

- i. the Domain Name is identical or confusingly similar to a trademark or a service mark in which the Complainant has rights; and
- ii. the 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.

Only if all three elements have been fulfilled, the Panel is able to grant the remedies requested by the Complainant. The Panel will deal with each of the requirements in turn.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Domain Name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

With respect to having rights pursuant to paragraph 4(a)(i) of the Policy, it is noted that the Complainant is registered as the owner of the Trademarks. Consequently, the Panel finds that the Complainant has proven that it has rights in the Trademarks.

With regard to the assessment of identity or confusing similarity of the Domain Name with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant's Trademarks and the Domain Name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). In cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered confusingly similar to that mark (see section 1.7 of the [WIPO Overview 3.0](#)).

In the present case, the Trademarks are incorporated in their entirety in the Domain Name. The additions of the gTLD ".com" and the element "publishing" do not prevent a finding of confusing similarity with the Trademarks (see section 1.8 and 1.11.1 of the [WIPO Overview 3.0](#)). Consequently, the Panel finds that the requirement under paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Name. The onus of proving this requirement, like each element, falls on the Complainant. Given the difficulty in proving a negative, however, it is usually sufficient for a complainant to make out a *prima facie* case that a respondent lacks rights or legitimate interests. If a complainant does establish a *prima facie* case, the burden of production shifts to the respondent (see, e.g. [WIPO Overview 3.0](#), section 2.1).

Paragraph 4(c) of the Policy lists three non-limitative examples of instances in which a respondent may establish rights or legitimate interests in the disputed domain name.

The Complainant has substantiated that none of these circumstances apply in this case. This is reinforced by the fact that the Respondent has engaged in fraudulent activities by using the Domain Name to send phishing emails. By defaulting, the Respondent has failed to address the *prima facie* case thus established by the Complainant. Furthermore, based on the record before it, the Panel does not see an indication that any of the circumstances of paragraph 4(c) of the Policy is present.

In addition, the Panel finds that the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. Paragraph 4(a)(ii) is thereby fulfilled.

C. Registered and Used in Bad Faith

In the present case, the Trademarks are registered by the Complainant and predate the registration date of the Domain Name. In light of the reputation of the Complainant's Trademarks, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the Domain Name without knowledge of the Complainant's activities and its Trademarks under which the Complainant is doing business. The reputation and highly distinctive character of the Trademarks have been confirmed by earlier UDRP panels in decisions in which an affiliate company of the Complainant was involved (see *e.g. HM Publishers Holdings Limited, particularly HM Publishers Holdings Ltd v. Domainproxyagent.com / Compsys Domain Solutions Private Limited*, WIPO Case No. [D2008-1620](#) and *HM Publishers Holdings Ltd v. Marcus Costa Camargo Peres Limited*, WIPO Case No. [D2013-1597](#)).

Further, the Domain Name resolves to a website on which PPC links are depicted and the Respondent has engaged in sending phishing emails using the Domain Name, which is a clear indication of the Respondent's bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

Finally, in light of the lack of any rights to or legitimate interest in the Domain Name by the Respondent and in the absence of any conceivable good faith use of the Domain Name, the Panel finds from the present circumstances that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's Trademarks as to the source, sponsorship, affiliation or endorsement. Consequently, the Panel finds that the Respondent is using the Domain Name in bad faith.

Accordingly, the Panel finds that the Domain Name has been registered and is being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

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 <macmillanpublication.com> be transferred to the Complainant.

/Gregor Vos/

Gregor Vos

Sole Panelist

Date: July 6, 2022