

ADMINISTRATIVE PANEL DECISION

Associated Newspapers Limited v. Milen Radumilo
Case No. D2022-2094

1. The Parties

The Complainant is Associated Newspapers Limited, United Kingdom (“UK”), represented by Adlex Solicitors, UK.

The Respondent is Milen Radumilo, Romania.

2. The Domain Name and Registrar

The disputed domain name <dailymailrewards.club> (the “Domain Name”) is registered with CommuniGAL Communications Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 9, 2022. On June 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 16, 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 June 16, 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 June 17, 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 June 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 14, 2022.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on July 19, 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 to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is the management company and publisher of a range of publications in the UK including two national newspapers: the 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 Complainant's website at "www.dailymail.co.uk" is one of the most-visited websites in the world. The Complainant runs a rewards club for the benefit of its readers operated from its website "www.mymail.co.uk".

The Complainant holds trademark registrations in several jurisdictions, such as UK Trademark Registration No. 1207666 dated November 22, 1983 for DAILY MAIL, European Union Trademark Registration No. 193433 filed on April 1, 1996 and registered on November 5, 1999 for DAILY MAIL and UK Trademark Registration No. 2582173 filed on May 20, 2011 and registered on August 10, 2012 for MAIL REWARDS CLUB.

The Domain Name was registered on May 26, 2022. The Domain Name has been subject to a dynamic redirect, sometimes to a third party website launching a new digital currency using a system of "rewards tokens", or to a parking page with pay-per-click ("PPC") links relating to reward and credit cards. The parking page also offered the Domain Name for sale.

5. Parties' Contentions

A. Complainant

The Complainant argues common law rights and provides evidence of trademark registrations. The Complainant argues that the Domain Name is confusingly similar to the Complainant's trademarks, *inter alia* because the Domain Name differs from the DAILY MAIL trademark only by addition of the word "rewards". This addition reinforces the link rather than to weaken it, as the word describes a popular rewards scheme offered by the Complainant.

The Complainant asserts that the Respondent is not authorized to use the Complainant's trademark. The Respondent has not made any use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services. Use of a domain name to host a parking page comprising PPC links does 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.

The Complainant argues bad faith registration and use, based on several fitting arguments. The Domain Name has been offered for sale, probably to elicit an offer from the Complainant to buy the Domain Name for valuable consideration in excess of the Respondent's out of pocket costs. The registration of the Domain Name also prevents the Complainant from reflecting its trademark in the Domain Name. The Complainant argues that the Respondent must have been aware of the Complainant and its business when the Respondent registered the Domain Name. The Respondent has been found to have acted in bad faith in at least eighty previous UDRP cases concerning domain names reflecting well-known trademarks.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has established that it has rights in the trademarks DAILY MAIL and MAIL REWARDS CLUB. The test for confusing similarity involves a comparison between the trademarks and the Domain Name. The Domain Name incorporates the Complainant's trademark DAILY MAIL, with the minor addition of "rewards". The addition does not prevent a finding of confusing similarity between the Domain Name and the trademark.

For the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level-Domains ("gTLDs"), see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1.

The Panel finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

As stated in [WIPO Overview 3.0](#), section 2.1, "while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 Complainant has made unrebutted assertions that it has not granted any authorization to the Respondent to register a domain name containing the Complainant's trademark or otherwise make use of the Complainant's mark. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired unregistered trademark rights. The Respondent has not made use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering. The Respondent's use is, as explained below, evidence of bad faith.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Based on the fame of the Complainant's trademark and the Respondent's use of the Domain Name, the Panel finds that the Respondent must have been aware of the Complainant and its trademark when the Respondent registered the Domain Name.

The Respondent appears to have used the Domain Name to attract for commercial or other gain, users to its website or other online location, by creating a likelihood of confusion with the Complainant's trademark. The Domain Name has been offered for sale, and the Respondent has been found to have acted in bad faith in at least eighty previous UDRP cases on well-known trademarks.

For the reasons set out above, the Panel concludes that the Domain Name was registered and is being used in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy.

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.club> be transferred to the Complainant.

/Mathias Lilleengen/

Mathias Lilleengen

Sole Panelist

Date: July 28, 2022