

ADMINISTRATIVE PANEL DECISION

Associated Newspapers Limited v. Wu Yu
Case No. D2023-3652

1. The Parties

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

The Respondent is Wu Yu, China.

2. The Domain Name and Registrar

The disputed domain name <dailymail.construction> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 30, 2023. On August 31, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 18, 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 September 20, 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 September 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 16, 2023.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on November 1, 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 of this case is Associated Newspapers Limited, a company incorporated in the United Kingdom on April 1, 1905 and is the management company and publisher of a range of publications in the United Kingdom including two national newspapers: the Daily Mail and The Mail on Sunday.

The first edition of the Daily Mail was published in 1896.

The Complainant also registered their trademarks including the following:

- a) DAILY MAIL United Kingdom trademark registration number 1207666 dated November 22, 1983; and
- b) DAILY MAIL European Union trademark registration number 193433 dated November 5, 1999.

The Daily Mail's average United Kingdom newspaper readership from July 2019 to June 2021 was over 2 million per issue.

The Complainant's website at "www.dailymail.co.uk" (also known as "MailOnline" and "Daily Mail Online") is one of the most-visited websites in the world.

The disputed domain name was registered on February 7, 2023.

According to the evidence presented by the Complainant the disputed domain name resolves to a website that contains a "parked page" with pay-per-click ("PPC") links including to "News Subscriptions". The page also included the following statement: "Buy this Domain. The Respondent is offering for the disputed domain name for sale for an asking price of 1000 EUR!"

As of July 6, 2023, the Mail exchange ("MX records") had been set up for the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is virtually identical to its DAILY MAIL trademark due to the fact that includes the complete trademark with the generic Top-Level Domain ("gTLD") ".construction". Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain name, and finally, that the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has established its trademark rights of the DAILY MAIL trademark. The test that a panel must carry out in order to establish if a domain name is confusingly similar to a trademark involves the comparison between the trademark and the disputed domain name. Regarding whether the disputed domain name is identical or confusingly similar to the DAILY MAIL trademark, in the present case this Panel observes that the disputed domain name is comprised, in the first place, with the Complainant's trademark DAILY MAIL followed by the gTLD ".construction".

This Panel, making the test for identical or confusing similarity under the first element, believes that the disputed domain name comprises the Complainant's trademark DAILY MAIL in its entirety. It is well established that where a domain name incorporates a complainant's trademark in its entirety, the domain name will be normally considered identical or confusingly similar to that trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Panel finds that the trademark DAILY MAIL is reproduced within the disputed domain name and the addition of the gTLD ".construction" is a technical requirement and therefore is usually disregarded to determine the identical or confusing similarity between the trademark and the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant's trademark and hence the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following: "(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are 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."

Even though the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a domain name, it is well established in section 2.1 of [WIPO Overview 3.0](#) that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made out, the burden of production shifts to the respondent to come forward with relevant allegations and evidence demonstrating rights or legitimate interests in the domain name.

The Complainant contends that the Respondent is not commonly known by the disputed domain name or the trademark DAILY MAIL. The Respondent has not been licensed or authorized by the Complainant to register or use the trademark DAILY MAIL in any way including the disputed domain name. At the moment of this Decision the disputed domain name resolves to a website displaying PPC links. Taking into account the section 2.9 of The [WIPO Overview 3.0](#) which states that use of a domain name to host a "parked 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. In this case, at least one of the PPC links on the "parked page" results in a connection to goods and/or services competitive with the Complainant. The PPC links that do not compete with the Complainant bear no relationship to any descriptive meaning of the disputed domain name. Therefore, the Respondent cannot avail itself of a claim to right or legitimate interest on the basis that the disputed domain name resolves to a website that has PPC links and such use of the disputed domain name cannot be considered a *bona fide* offering of goods or services and does not establish any rights or legitimate interests on behalf of the Respondent.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case was established by the Complainant and has not been refuted by the Respondent.

Based on the following reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name:

- (a) The Respondent has not rebutted and has not presented evidence in this case showing that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Therefore, the Respondent has not provided evidence of a legitimate use of the disputed domain name. There has been no evidence to show that the Complainant has licensed or otherwise permitted the Respondent to use the trademarks or to apply for or use any domain name incorporating the trademarks;
- (b) There has been no evidence presented in this case to demonstrate that the Respondent has been commonly known by the disputed domain name. There has been no evidence included in the present case showing that the Respondent has any registered trademark rights with respect to the disputed domain name. The Respondent registered the disputed domain name in February 2023, long after the trademarks became national and internationally known. The disputed domain name is identical to the Complainant's DAILY MAIL trademark;
- (c) There has been no evidence adduced to show that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name. According to the Complainant and the evidence presented in the Complaint, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

In light of the above, the Complainant has complied with the second element of the Policy. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

This Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy, which provides with scenarios that constitutes evidence of a respondent's bad faith. In order to prevail under the Policy, the Complainant must show that the disputed domain name has been registered and is being used in bad faith, accordingly it is a cumulative requirement.

The Panel accepts the Complainant's submissions that the trademark DAILY MAIL is distinctive, and that it is likely that the Respondent registered the disputed domain name with the intention of referring to the Complainant's trademark and the products associated. The Panel consents with the Complainant's argument that the Respondent knew of the Complainant's DAILY MAIL trademark when registering the disputed domain name.

The Panel is satisfied that the Respondent must have been aware of the trademark DAILY MAIL when it registered the disputed domain name as the disputed domain name contains the trademark DAILY MAIL in its entirety, together with the gTLD ".construction".

The Panel finds that the evidence in the case shows that the Respondent registered the disputed domain name in bad faith.

The Respondent registered the disputed domain name for the purpose of unfairly disrupting the business of the Complainant by diverting business intended for the Complainant. The website to which the disputed domain name resolves features PPC links/advertisements to other sites offering services similar to those of the Complainant.

In the present case, there is no doubt that the Respondent was clearly aware of the Complainant and its business when it registered the disputed domain name.

In conclusion, the Respondent has registered and used the disputed domain name to confuse, attract and profit from the Complainant's customers by creating a likelihood of confusion in the minds of the public as to an association between the Respondent and the Complainant.

The Panel finds that there is no doubt that the Respondent had the Complainant and its business in mind when registering and using the disputed domain name:

- a. the Respondent has used the disputed domain name for PPC links to services connected with the Complainant.
- b. the Complainant's trademark is well known, and it long pre-dates the registration of the disputed domain name.

The likelihood of confusion is not diminished by the fact that some users arriving at the Respondent's site may realize that it is not connected with the Complainant because some of the PPC links do not relate directly to the Complainant's industry. Paragraph 4(b)(iv) of the Policy is concerned with the intentional attracting of Internet users. Here, the disputed domain name creates an implied risk of affiliation with the Complainant, and the Respondent profits from at least some of the traffic intended for the Complainant. Section 3.5 of [WIPO Overview 3.0](#) states that respondents cannot disclaim responsibility for "automatically" generated PPC links on their websites and that neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith. Additionally, the setting up of MX records indicates it is likely that the disputed domain name has been registered and is being used for phishing or similar fraudulent purposes.

Taking into account all the circumstances of this case, the Panel concludes that the use of the disputed domain name by the Respondent is in bad faith.

In summary, the Panel finds that in the absence of convincing evidence and rebuttal to the contrary from the Respondent, the choice of the disputed domain name and the conduct of the Respondent are indicative of registration and use of the disputed domain name in bad faith. That also, includes the fact that the Respondent is offering the disputed domain name for sale for an asking price of EUR 1,000 which is a price that excess of the Respondent's out of pocket costs of registering it. In conclusion, the Panel considers that this offer for sale further reinforces the finding of bad faith in registration and use of the disputed domain name.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith. Therefore, the Panel sustains that the Complaint fulfils the third condition of paragraph 4(a) 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 disputed domain name <dailymail.construction> be transferred to the Complainant.

/Ada L. Redondo Aguilera/

Ada L. Redondo Aguilera

Sole Panelis

Date: November 15, 2023