

## **ADMINISTRATIVE PANEL DECISION**

### **Gannett Satellite Information Network, LLC v. Victory Outreach Case No. D2023-4245**

#### **1. The Parties**

The Complainant is Gannett Satellite Information Network, LLC, United States of America (“United States”), represented by Rankin, Hill & Clark LLP, United States.

The Respondent is Victory Outreach, United States.

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

The disputed domain name <usatodayinc.com> (the Disputed Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2023. On October 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 12, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 16, 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 amendment to the Complaint on October 18, 2023.

The Center verified that the Complaint together with the amendment to the 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 October 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 10, 2023.

The Center appointed Lynda M. Braun as the sole panelist in this matter on November 15, 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 publishes a newspaper, in print and online, under the USA TODAY trademark that is the largest United States newspaper by total daily circulation.

The Complainant owns multiple trademark registrations for trademarks incorporating its famous USA TODAY trademark with the United States Patent and Trademark Office (“USPTO”), including, but not limited to: USA TODAY, United States Trademark Registration No. 1,332,045, registered on April 23, 1985, in international class 16; USA TODAY, United States Trademark Registration No. 3,361,301, registered on January 1, 2008, in international class 41; and USA TODAY (and design), United States Trademark Registration No. 6,606,910, registered on January 4, 2022, in international class 41 (hereinafter collectively referred to as the “USA TODAY Mark”).

The Complainant owns the domain name <usatoday.com>, which resolves to its official website at “www.usatoday.com”, which the Complainant provides for online access to its newspaper.

The Disputed Domain Name was registered on May 12, 2023, long after the Complainant registered its USA TODAY Mark. The Disputed Domain Name redirects to the Complainant’s primary website at “www.usatoday.com”, which contains its online newspaper.

The Respondent also used the Disputed Domain Name to post fraudulent job listings in online newspaper advertisements using an email address that purported to come from the Complainant’s staff. The job postings sought to defraud applicants first by purportedly persuading them to provide personal information to the Respondent in connection with their job applications. The Respondent used the Disputed Domain Name to create email addresses and to fraudulently send emails to the addresses provided by the potential job seekers, using a “[...]@usatodayinc.com” email address associated with the Disputed Domain Name. In this way, the Respondent impersonated a member of the Complainant’s staff and falsely claimed an association with the Complainant by giving job applicants the false impression that the Complainant created the job posting. The Respondent purportedly hired some of the applicants, welcomed them to the Complainant as new salaried employees, and tasked them to visit two supermarkets as a client of those businesses to judge the quality of customer service, after which the employee would complete and return a written survey evaluating the customer service of the two institutions. The newly-hired employees were told that if they completed the tasks expeditiously, they would receive bonuses added to their salaries. The Complainant provided the letter, dated May 23, 2023, that the Respondent sent to the new employees as an Annex to the Complaint.

#### **5. Parties’ Contentions**

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

The following are the Complainant’s contentions:

- the Disputed Domain Name is confusingly similar to the Complainant’s USA TODAY Mark.
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.
- the Disputed Domain Name was registered and is being used in bad faith.
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent in accordance with paragraph 4(i) of the Policy.

## B. Respondent

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove the following three elements in order to prevail in this proceeding:

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

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the USA TODAY Mark.

It is uncontroverted that the Complainant has established rights in the USA TODAY Mark based on its decades of use as well as its registered trademarks for the USA TODAY Mark before the USPTO. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the USA TODAY Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Thus, the Panel concludes that the Complainant has rights in the USA TODAY Mark.

The Disputed Domain Name consists of the USA TODAY Mark in its entirety, followed by the term "inc", and then followed by the generic Top-Level Domain ("gTLD") ".com". Where the trademark is recognizable in the Disputed Domain Name, the addition of a term, such as "inc", does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8 ("where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element").

Finally, the addition of a gTLD such as ".com" in a domain name is a technical requirement. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#), and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant's USA TODAY Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

### B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant's *prima facie* case. Furthermore, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use its USA TODAY Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. See Policy, paragraph 4(c).

According to the evidence provided by the Complainant, the Respondent was using the Disputed Domain Name as part of a scheme in which the Respondent contacted job applicants using an email address associated with the Disputed Domain Name to create the impression that the emails were being sent by the Complainant in order to illegitimately induce them to provide their personal information, for instance, their email addresses, among other things. Such a scheme cannot be considered a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the Disputed Domain Name. See *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#) (finding that the respondent had no rights or legitimate interests in the disputed domain name, holding that "such phishing scam cannot be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name").

Such use of the Disputed Domain Name to impersonate the Complainant and perpetuate a fraudulent scheme does not confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically held that the use of a domain name for illegal *activity* (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.").

In sum, the Panel concludes that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Panel finds that the Respondent is using the Disputed Domain Name for commercial gain with the intent to mislead by potentially defrauding the Complainant's job applicants by incorporating the Disputed Domain Name into emails sent by the Respondent to those hired in the name of the Complainant. Such use cannot conceivably constitute a *bona fide* offering of a product or service within the meaning of paragraph 4(c)(i) of the Policy.

Moreover, the Respondent also redirected the Disputed Domain name to the Complainant's own website to create the appearance of legitimacy for its fraudulent impersonation of the Complainant. Since the Disputed Domain Name redirected to the Complainant's website, the Respondent's use of the Disputed Domain Name to redirect Internet traffic to the Complainant's own website does not demonstrate rights or legitimate interests and does not constitute a protected noncommercial or fair use of the Disputed Domain Name. See, e.g., *MySpace, Inc. v. Mari Gomez*, WIPO Case No. [D2007-1231](#) (holding that the respondent's use of the disputed domain name to redirect Internet users to the Complainant's own website where the Respondent was not authorized to use the Complainant's mark in this way is inherently misleading and cannot give rise to rights or legitimate interests in the disputed domain name).

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

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

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy.

First, the Respondent's phishing scheme to email job-seeking individuals fraudulent job offers purporting to come from the Complainant, and to collect the personal information of such individuals, evidences a clear intent to disrupt the Complainant's business, deceive individuals, and trade off the Complainant's goodwill by

creating an unauthorized association between the Respondent and the Complainant's USA TODAY Mark. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). Such conduct is emblematic of the Respondent's bad faith registration and use of the Disputed Domain Name. Numerous UDRP panels have found that email-based phishing schemes that use a complainant's trademark in the disputed domain name are evidence of bad faith. See, e.g., *BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#) (“[T]he use of an email address associated with the disputed domain name, to send a phishing email for the purposes of dishonest activity is in itself evidence that the disputed domain name was registered and is being used in bad faith.”). Moreover, several UDRP panels have found that email-based phishing schemes that use a complainant's trademark in a disputed domain name are evidence of bad faith. See, e.g., *DeLaval Holding AB v. Registration Private, Domains By Proxy LLL / Craig Kennedy*, WIPO Case No. [D2015-2135](#).

Second, the registration of a domain name that is confusingly similar to a registered trademark by an entity that has no relationship to that mark may be sufficient evidence of opportunistic bad faith. See *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#); *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) (use of a name connected with such a well-known service and product by someone with no connection to the service and product suggests opportunistic bad faith). Based on the circumstances here, the Respondent registered and used the Disputed Domain Name in bad faith in an attempt to create a likelihood of confusion with the Complainant's USA TODAY Mark. See [WIPO Overview 3.0](#), section 3.1.4 (“Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: ... redirecting the domain name to the complainant's website....”).

Finally, the Panel finds that the Respondent had actual knowledge of the Complainant's USA TODAY Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. Based on the Respondent's almost identical Disputed Domain Name to the Complainant's trademark and domain name, it strains credulity to believe that the Respondent had not known of the Complainant or its USA TODAY Mark when registering the Disputed Domain Name. Moreover, the Respondent sought not only to impersonate the Complainant via a fraudulent email scheme conducted through the Disputed Domain Name, but the Respondent also redirected the Disputed Domain Name to the Complainant's genuine domain name and website, representing an implied ongoing threat to the Complainant given the Respondent's control over said redirection. The Respondent's awareness of the Complainant and its USA TODAY Mark additionally suggests that the Respondent's decision to register the Disputed Domain Name was intended to cause confusion with the Complainant's USA TODAY Mark and to disrupt the Complainant's business. Such conduct indicates that the Respondent registered and used the Disputed Domain Name in bad faith.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

## 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 <usatodayinc.com> be transferred to the Complainant.

/Lynda M. Braun/

**Lynda M. Braun**

Sole Panelist

Date: November 29, 2023