

ADMINISTRATIVE PANEL DECISION

Associated Newspapers Limited v. jin
Case No. D2023-4418

1. The Parties

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

The Respondent is jin, China.

2. The Domain Name and Registrar

The disputed domain name <dailymail.shop> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2023. On October 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 25, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 26, 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 the same day.

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 November 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 4, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on December 11, 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 was 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 is the owner, amongst others, of the following trademark registrations, as per trademark registration details submitted as annex 4 to the Complaint:

- United Kingdom trademark registration No. UK00001207666 for DAILY MAIL (word mark), registered on November 22, 1983, in class 16;
- European Union trademark registration No. 000193433 for DAILY MAIL (word mark), filed on April 1, 1996, and registered on November 5, 1999, in classes 09, 16, 35, 38, 41, and 42; and
- United Kingdom trademark registration No. UK00002291220 for MAILSHOP (figurative mark), filed on January 28, 2002, and registered on July 26, 2022, in class 35.

The Complainant is also the owner of the domain names: <dailymail.co.uk>, registered before August 1996 and used by the Complainant to provide its services under the trademark DAILY MAIL, and <mailshop.co.uk>, registered on May 10, 1999, and used by the Complainant to promote its services as a dedicated retail website under the trademark MAILSHOP.

The disputed domain name <dailymail.shop> was registered on August 17, 2023, and redirects to a webpage where the disputed domain name is being offered for sale for USD 200.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to the trademark DAILY MAIL in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the generic Top-Level Domain ("gTLD") ".shop".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is in no way licensed or associated with the Complainant and has never been authorized to use the Complainant's marks in any way including for the registration of the disputed domain name.

The Complainant submits that the Respondent is not commonly known by the disputed domain name, and that it is not making a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name as it clearly registered the disputed domain name for commercial gain, since the disputed domain name is and has been offered for sale ever since its registration in August 2023.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent's sole aim appears to be that of selling the disputed domain name to the Complainant for a sum well in excess of the Respondent's out-of-pocket costs.

The Complainant also states that considering i) the distinctiveness and world renown of its marks; ii) the blatant association of the terms "daily mail" with the ".shop" suffix, both clearly designed to create an association with the Complainant's MAILSHOP trademark and iii) the implausibility of any good use to which the disputed domain name may be put, the Respondent is passively holding the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Indeed, the Complainant has provided evidence of ownership of valid trademark registrations for DAILY MAIL.

The Panel finds the entirety of the mark is reproduced within the disputed domain name within the gTLD ".shop". Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Therefore, based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

According to the evidence on record, there is no relationship between the Complainant and the Respondent, and the Complainant has not authorized the Respondent to register or use its trademark or the disputed domain name.

Moreover, there is no element from which the Panel could infer the Respondent's rights and legitimate interests over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The Panel notes that the disputed domain name resolves to a website where it is offered for sale for USD 200 and finds that such use does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

Furthermore, the disputed domain name, being identical to the Complainant's well-known trademark, is inherently misleading. Prior UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. WIPO Overview 2.5.1.

Therefore, based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that in light of i) the prior registration and use of the Complainant's trademarks DAILY MAIL and MAILSHOP in connection with the Complainant's services, offered online via the Complainant's websites at the domain names <dailymail.co.uk> and <mailshop.co.uk>, ii) the well-known character of the trademarks and iii) the identity of the disputed domain name with the Complainant's trademark DAILY MAIL and the similarity of the same with the Complainant's trademark MAILSHOP, the Respondent very likely registered the disputed domain name having the Complainant's trademarks in mind and intended to target the Complainant and its trademarks at the time of registration of the disputed domain name.

The Respondent has pointed the disputed domain name to a website where the disputed domain name is being offered for sale for USD 200. The Panel finds that the Respondent sought to capitalize on the Complainant's trademark rights by registering a domain name identical to the Complainant's DAILY MAIL mark and similar to the Complainants' MAILSHOP mark in order to create a likelihood of confusion with the Complainant's marks as to source, sponsorship, affiliation, or endorsement of the correspondent website, and clearly intending to sell the disputed domain name for an amount likely in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name.

Therefore, based on the available record, the Panel finds that the Complainant has established the third element 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.shop>, be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: December 25, 2023