

ADMINISTRATIVE PANEL DECISION

Macmillan Publishers International Limited v. Zohaib Asad
Case No. DCO2023-0058

1. The Parties

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

The Respondent is Zohaib Asad, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <macmillanbookpublishers.co> 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 June 30, 2023. On July 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 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, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 6, 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 July 7, 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 July 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2023. The Respondent did not submit any formal response. However, in the July 21, 2023 dated email communications of the Respondent sent to the Center, the Respondent inquired on the settlement option and on where and how to transfer the disputed domain name.

In its email of July 25, 2023 the Complainant advised the Center and the Respondent that it does not wish to explore settlement options and requested continuation of the proceedings. Accordingly, the Center notified Commencement of Panel Appointment Process on August 22, 2023.

The Center appointed Zoltán Takács as the sole panelist in this matter on August 28, 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 is a private limited company incorporated in the United Kingdom and part of the Macmillan group of publishing companies created in 1984.

The Complainant operates in over 70 countries, including but not limited to United Kingdom, United States of America ("US"), Germany, Australia, South Africa and India.

The Complainant won a number of prizes and awards, including the "Publisher of the Year" at the British Book Awards 2017 and 2020.

In the US the Complainant trades under the MACMILLAN PUBLISHERS brand, which has 62,900 followers on Instagram and 34,000 followers on Facebook.

The Complainant's portfolio of registered trademarks includes by way of example the European Union Trademark Registration No. 000066225 for the word mark MACMILLAN, registered since March 18, 1998 for among others electronic and printed publications and publishing services.

The Complainant's US website is available at "www.us.mcmillan.com". The corresponding domain name <macmillan.com> was registered on August 11, 1994.

The disputed domain name was registered on May 1, 2023 and has been used for a website prominently featuring the Complainant's trademark and brand name purporting to offer book publishing and related services.

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, which fully incorporates its MACMILLAN trademark is confusingly similar to it because the addition of the terms "book" and "publishers" to the trademark in the disputed domain name is not sufficient to distinguish the disputed domain name from the trademark;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name, and
- the use of its trademark and brand name on the website at the disputed domain name shows the Respondent's awareness of its trademark at the time of registration of the disputed domain name as well as the Respondent's intent to deceive consumers into believing that it is a website operated or authorized by the Complainant.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

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

However, in the July 21, 2023 dated email communications of the Respondent sent to the Center, the Respondent inquired on the settlement option and on where and how to transfer the disputed domain name. In its email of July 25, 2023 the Complainant advised the Center and the Respondent that it does not wish to explore settlement options and requested continuation of the proceedings.

6. Discussion and Findings

6.1 Consent to Transfer

As mentioned above, in the July 21, 2023 dated emails sent to the Center the Respondent among others offered to settle the dispute through settlement and stated the following:

- "The domain and brand in question were outsourced to another company, who assured us that they had taken all necessary steps to ensure that the brand was entirely original and compliant with copyright laws";
- "We want to assure you that we had no knowledge of any potential infringement and that we are willing to cooperate fully to resolve this matter amicably";
- "After careful consideration, we have decided to relinquish all rights to the domain and brand";
- "Therefore, we are committed to ceasing any use of the disputed brand and domain immediately";
- "Let us know where to transfer the domain and what's the procedure to do the same?"

In its July 25, 2023 dated email the Complainant advised the Center and the Respondent that it "does not wish to explore settlement options and therefore requests that the proceedings continue".

Accordingly, before addressing the merits of the case, the Panel first considers whether in these circumstances it should make a substantive determination, or instead simply order the transfer of the disputed domain name, which appears to be the intent of the Respondent.

Section 4.13 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) that addresses whether a UDRP panel can decide a case based on a respondent's consent to transfer the disputed domain name reads:

"Where parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the 'standard settlement process' described above, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent. In such cases, the panel gives effect to an understood party agreement as to the disposition of their case (whether by virtue of deemed admission, or on a no-fault basis).

In some cases, despite such respondent consent, a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits. Scenarios in which a panel may find it appropriate to do so include (i) where the panel finds a broader interest in recording a substantive decision on the merits – notably recalling UDRP paragraph 4(b)(ii) discussing a pattern of bad faith conduct, (ii) where while consenting to the requested remedy the respondent has expressly disclaimed any bad faith, (iii) where the

complainant has not agreed to accept such consent and has expressed a preference for a recorded decision, (iv) where there is ambiguity as to the scope of the respondent's consent, or (v) where the panel wishes to be certain that the complainant has shown that it possesses relevant trademark rights".

Having reviewed the facts and circumstances of the case, in particular the issue how the Respondent has been using the disputed domain name the Panel has decided to proceed to a substantive determination of the case for the following reasons:

- In its July 21, 2023 dated email sent to the Center the Respondent expressly acknowledged that the registration and use of the disputed domain name infringes intellectual property rights of the Complainant and stated that they are "committed to ceasing any use of the disputed brand and domain immediately". However, the disputed domain name is still used in a manner that is clearly in violation of the Complainant's prior trademark rights;

- The Complainant clearly requested a decision on merits, and the Panel agrees with the view of UDRP panelists "that once a complainant has invoked the Policy and paid the fee, it is entitled to what it paid for" (see *e.g. Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. [D2009-0320](#)).

6.2 Three Elements

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (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.

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 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.

The Panel finds that the disputed domain name is confusingly similar to the mark for the purposes of the Policy.

The entirety of the mark is reproduced within the disputed domain name. While the addition of other terms (in this case "book" and "publishers" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7 and 1.8.

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.

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 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds that 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.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has made demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.;
- the Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3;
- the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4, and
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name.

The Respondent is not affiliated with the Complainant in any respect and the Complainant has not authorized the Respondent to use its MACMILLAN trademark in a domain name or otherwise.

Yet, the Respondent effectively impersonates or suggests sponsorship or endorsement by the Complainant as the website at the disputed domain name is prominently displaying the Complainant’s trademark and brand name and offers the same goods and services as the Complainant.

Panels have 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. [WIPO Overview 3.0](#), section 2.13.1.

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

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel considers that the record of this case reflects that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent' web site or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

The Complainant's mark is inherently distinctive and a basic Internet search with regard the disputed domain name returns merely the Complainant and its businesses.

The Respondent reproduced the Complainant's trademark in the disputed domain name and has been using it to redirect Internet users to its website purportedly offering the same goods and services as the Complainant.

Given the above mentioned, coupled with the Complainant's longstanding reputation in the publishing industry, in view of the Panel it is improbable that the Respondent registered the disputed domain name without knowledge of the Complainant and for any other purpose than to refer to and target the Complainant through impersonation or false association. Such conduct is fraudulent and constitutes bad faith under the Policy (see *Weber-Stephen Products LLC v. WhoisGuard Protected, WhoisGuard, Inc. / Daniela Gebauer, Kitchenhelpers GmbH*, WIPO Case No. [D2017-0118](#)).

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <macmillanbookpublishers.co> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: September 11, 2023