

ADMINISTRATIVE PANEL DECISION

Scribd, Inc. v. Ngo Tien Phat
Case No. D2024-0864

1. The Parties

The Complainant is Scribd, Inc., United States of America, represented by IPLA LLP, United States of America (“United States”).

The Respondent is Ngo Tien Phat, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <scribdownload.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 28, 2024. On February 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 29, 2024, 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 (GMO Internet Group, Inc. d/b/a/ Onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 29, 2024, 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 March 1, 2024.

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 March 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 28, 2024. On March 29, 2024, the Respondent sent an email communication to the Center.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on April 4, 2024. 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 operates in the field of computer, electronics and software and owns many trademark registrations for SCRIBD worldwide such as the following:

1. United States Trademark Registration No. 3,777,227, registered on April 20, 2010;
2. United States Trademark Registration No. 5,898,302, registered on October 29, 2019;

The Complainant owns and operates the domain name “www.scribd.com”, which is its official website.

The disputed domain name was registered on June 12, 2023, and resolves to a page, which seems to offer access to material available to the Complainant’s customers.

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 or confusingly similar to a trademark or service mark in which the Complainant has rights. The disputed domain name incorporates the Complainant’s trademark in its entirety. The addition of the term “download” does not eliminate confusion but instead increases it given the nature of the Complainant’s business.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. There is no bona fide offering of goods or services as at the time of filing, the disputed domain name redirected to a website which seems to offer download content from the Complainant’s platform without subscription. The disputed domain name then redirects to what seems to be blocked or unsafe websites or to pop-up ads. The Complainant did not authorize the Respondent to use its trademark. There is no evidence that the Respondent is commonly known by the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Respondent must have had knowledge of the Complainant’s trademark as the Complainant’s trademark rights date back to 2006 when it launched its website and its trademark registration dates back to 2009. This was many years before the registration of the disputed domain name. Also, the disputed domain name wholly incorporates the Complainant’s trademark and references its goods and services. Additionally, the disputed domain name advertises the ability to download the Complainant’s material for free and redirects users to third-party websites, pop-up advertisements and/or potential malware for its own commercial gain.

B. Respondent

The Respondent did not reply to the Complainant’s contentions. However, on March 29, 2024, the Respondent sent an email claiming that it removed all content from the disputed domain name.

6. Discussion and Findings

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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "download", 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 1.8.

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.

The disputed domain name redirected to a website which seemed to offer download content from the Complainant's platform without subscription. The disputed domain name then redirected to what seemed to be blocked or unsafe websites or to pop-up ads.

Panels have held that the use of a domain name for illegal activity here, claimed distributing malware, unauthorized access, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Moreover, the Panel finds that the disputed domain name is inherently misleading. [WIPO Overview 3.0](#), section 2.5.1.

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.

In the present case, the Panel notes that the Respondent must have been aware of the Complainant's trademark as the disputed domain name was registered thirteen years after the registration of the Complainant's trademark and it directs to a page, which seems to offer access to material available to the Complainant's customers.

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.

Panels have held that the use of a domain name for illegal activity here, claimed distributing malware, unauthorized access, or other types of fraud, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. 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 Respondent in this case is either allowing unauthorized access to the material of the Complainant or misleading users to believe that they will be allowed such access or may be spreading malware.

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 <scribdownload.com> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: April 12, 2024