

ADMINISTRATIVE PANEL DECISION

BookBeat AB v. Martin Lam
Case No. D2024-2552

1. The Parties

The Complainant is BookBeat AB, Sweden, represented by Abion GmbH, Switzerland.

The Respondent is Martin Lam, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <bookbeat.store> is registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2024. On June 25, 2024, 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 (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, 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 June 28, 2024.

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 July 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 21, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 22, 2024.

The Center appointed James Bridgeman as the sole panelist in this matter on July 24, 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 is a provider of digital subscription services for audiobooks and e-books. It owns and uses the BOOKBEAT trademark for which it holds an international portfolio of registrations including the following:

- United Kingdom trademark BOOKBEAT No. 913927661, registered on July 29, 2015, in classes 9, 35, 38, and 41;
- European Union trademark BOOKBEAT No. 13916631, registered on September 18, 2015, in classes 9, 35, 38, and 41;
- United Kingdom trademark BOOKBEAT No. 913916631, registered on September 18, 2015, in classes 9, 35, 38, and 41;
- International trademark BOOKBEAT No. 1498161, registered on October 14, 2019, in classes 9, 35, 38, and 41.

The disputed domain name was registered on March 6, 2024. While at the time of filing this Complaint, it does not resolve to an active webpage, it has recently resolved to a website that mimicked the Complainant's own website.

There is no information available about the Respondent, except for that provided in the Complaint and by the Registrar.

5. Parties' Contentions

A. Complainant

The Complainant claims rights in the BOOKBEAT trademark and service mark established by its ownership of the portfolio of registrations described above and contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant submits that it uses the BOOKBEAT mark in its online offering of digital subscription services for audiobooks and e-books throughout Europe, including the United Kingdom where the Respondent is based.

The Complainant asserts that it enjoys a strong reputation and goodwill in the mark through its sales and online presence via its official website and social media. It owns and uses numerous domain names containing the trademark BOOKBEAT including <bookbeat.com> and <bookbeat.uk> which resolve to its official website. In 2023, the Complainant's revenues surpassed SEK 1 billion in sales and had 915,000 paying users.

The Complainant firstly alleges that the disputed domain name is identical or confusingly similar to the BOOKBEAT trademark and service mark in which it has rights because it in its second-level portion, consists of the Complainant's registered and widely-known trademark which is captured in its entirety.

It is contended that the generic Top-Level Domain (gTLD) extension “.store” may be disregarded when making the comparison between the disputed domain name and the Complainant’s mark.

It is next alleged that the Respondent has no rights or legitimate interests in respect of the disputed domain name because:

- the disputed domain name was registered on March 6, 2024, many years after the first registrations of the Complainant’s BOOKBEAT mark;
- the Complainant has neither licensed nor authorized the Respondent to register or use the disputed domain name;
- neither is the Respondent affiliated to the Complainant in any form;
- there is no evidence that the Respondent is either known by, or owns any corresponding registered trademarks;
- the Respondent’s name is “Martin Lam” which does not correspond to the disputed domain name or the name “bookbeat”;
- screen captures of the results of searches on online trademark databases against the term “bookbeat.store” which are exhibited in an annex to the Complaint do not produce any information on any trademarks corresponding to the aforementioned terms;
- when searching on popular Internet search engines for the term “bookbeat” alone or in combination with “store”, the vast majority of the results directly relate to the Complainant, its website, its social medias accounts or related topics;
- additionally an exhibited screen capture annexed to the Complaint shows that a similar search against the term “bookbeat” produced results relating to the Complainant’s trademarks;
- the Respondent is also using a privacy shield service, masking his identity on the publicly available Registrar’s WhoIs and so he appears to be hiding his true identity rather than being known by the disputed domain name.
- moreover, the Respondent has not been using, or preparing to use, the disputed domain name in connection with a bona fide offering of goods and services, nor is he making a legitimate noncommercial or fair use of the disputed domain name and an exhibited screen capture shows that it currently resolves to an inactive web page;
- the structure of the disputed domain name, incorporating as it does in its second level, the BOOKBEAT trademark and in its first level portion the gTLD “.store” reflects the Respondent’s intention to create an association, and a subsequent likelihood of confusion, with the Complainant, its BOOKBEAT trademark and its domain name <bookbeat.com> in the minds of Internet users;
- in its structure the disputed domain name is also very close to the Complainant’s own extensively used domain name <bookbeat.com>;
- as shown in another exhibited screen capture, the disputed domain name previously resolved to a website which was entirely reproducing the Complainant’s official website associated to the domain name <bookbeat.com> on which there was no clear and explicit references regarding the Respondent itself or the actual person (individual or company) operating the website, but on the contrary, the website was merely mimicking the Complainant’s website, thereby implying a direct affiliation with the Complainant and the BOOKBEAT trademark in Internet users’ mind,

The Complainant next alleges that the disputed domain name was registered in bad faith many years after the first registrations of the Complainant's BOOKBEAT trademark.

It is submitted that the Complainant has an active business presence in the United Kingdom where the Respondent is reportedly based and by conducting a simple search online on popular search engines regarding the term "bookbeat"– alone or in association with the term "store" – the Respondent would have inevitably learnt about the Complainant, its trademark and business.

The Complainant adds that the structure of the disputed domain name shows that the Respondent registered it having the Complainant and its BOOKBEAT trademark in mind, and it reflects the Respondent's clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users' mind.

The Complainant further alleges that the disputed domain name is being used in bad faith because it incorporates the Complainant's trademark, it has resolved to a website which entirely copied the Complainant's website and is currently being passively held by the Respondent.

The record shows that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website to which the disputed domain name resolved, by creating a likelihood of confusion with the Complainant's mark as to the source of the website, and such conduct is clearly constitutes use in bad faith, and is very harmful for the Complainant and Internet users.

Finally, the Complainant refers to a copy of a cease-and-desist letter which the Complainant sent to the Respondent regarding the disputed domain name, informing the Respondent of the Complainant's rights regarding the BOOKBEAT trademark, to which the Respondent did not reply. The Complainant submits that such behaviour may infer bad faith.

B. Respondent

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

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 identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds therefore that 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.

In addition, the disputed domain name which is identical to the Complainant’s trademark carries a high risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. Such affiliation was clearly the intent of the Respondent given the evidence provided in the Complaint regarding the prior use of the disputed domain name to resolve to a website passing off as the Complainant. In this regard, panels have held that the use of a domain name for such impersonation of the Complainant) by using the disputed domain name to resolve to a website that was effectively identical to the Complainant’s own website, would not confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. 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 as shown in the exhibited screen capture annexed to the Complaint, the disputed domain name has recently resolved to a website which was mimicking the Complainant’s website associated to the domain name <bookbeat.com> on which there was no clear and explicit references regarding the Respondent itself or the actual person (individual or company) operating the website.

On the contrary, the Respondent’s exhibited website was merely mimicking the Complainant’s website, thereby implying a direct affiliation with the Complainant and the BOOKBEAT trademark in Internet users’ mind.

The Respondent has therefore intentionally attempted to attract, for commercial gain, Internet users to the website to which the disputed domain name resolved, by creating a likelihood of confusion with the Complainant’s mark as to the source of the website, and such conduct is clearly constitutes use in bad faith and is very harmful for the Complainant and Internet users.

Furthermore 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.

The evidence adduced shows that the disputed domain name currently does not resolve to any active website, but is being passively held by the Respondent.

Panels have found that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 <bookbeat.store> be transferred to the Complainant.

/James Bridgeman/

James Bridgeman

Sole Panelist

Date: August 5, 2024