

## **ADMINISTRATIVE PANEL DECISION**

Maxim Media Inc. v. Domains By Proxy, LLC / Christian Heilesen  
Case No. D2022-2395

### **1. The Parties**

The Complainant is Maxim Media Inc., United States of America (“United States”), represented by Olshan Frome Wolosky LLP Lawfirm, United States.

The Respondent is Domains By Proxy, LLC, United States / Christian Heilesen, Hong-Kong, China, represented by Troutman Pepper, United States.

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

The disputed domain name <maximonline.com> 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, 2022. On July 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 8, 2022 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 11, 2022.

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 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2022. The Response was filed with the Center on August 1, 2022. On August 10, 2022, the Complainant submitted a supplemental filing. On August 15, 2022, the Respondent submitted a supplemental filing.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on August 8, 2022. 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 the owner of the MAXIM trademark, originally registered in connection with magazine publications concerning men's lifestyle and popular culture, and thereafter expanded to include an online magazine, together with casino, entertainment, model, and other goods and services. The Complainant has defended said trademark by opposing successfully certain third party United States federal trademark applications, and its predecessor has been successful in proceedings under the Policy relating to the domain name <maximmagazine.com>, in which the panel noted that the MAXIM mark represented "the title of a well-known publication" (see *Dennis Publishing, Inc. v. Arjun*, WIPO Case No. [D2002-0997](#)).

The Complainant owns a wide variety of MAXIM and MAXIM-formative trademark registrations in a wide variety of jurisdictions, although apparently not in the jurisdiction where the Respondent is based. Some of these marks are in the name of the Complainant's predecessor in interest, although the Complainant states that it is in the process of transferring these into its own name. The earliest such trademark listed in the Complaint appears to be United States Registered Trademark No. 2072696 for the word mark MAXIM, registered on June 17, 1997 in Class 16 (specifically, magazines concerning men's lifestyle and popular culture). The Complainant also owns a later trademark with respect to online activities, namely United States Registered Trademark No. 2449119 for the word mark MAXIM, registered on May 8, 2001 in Class 42 (specifically, providing online information on a variety of topics concerning men's lifestyle and popular culture). Such trademark claims a first use date of April 1997.

The Complainant's services include a website at "www.maxim.com" featuring articles about sports, entertainment, and clothing.

The disputed domain name was registered on March 14, 1999. It appears that such domain name was originally registered to the Complainant's predecessor in interest. The Complainant purchased its said predecessor's MAXIM trademarks, domain names, and various other intellectual property in 2014, including the disputed domain name. The disputed domain name was inadvertently allowed to lapse following its expiration date on August 22, 2019, after which the Respondent acquired it on September 26, 2019 in an expired domain auction organized by the Registrar.

For the last three years, the Respondent has used the disputed domain name in association with a website titled "Maxim Online" providing articles related to pop culture and lifestyle. The Respondent claims that its site has 2,000 daily unique visitors. Under the ownership of the Complainant's predecessor, the disputed domain name had been used for a website between 2000 and 2006, when it began to auto-forward to the Complainant's website at "www.maxim.com".

The Respondent's logo at said website has the following appearance at the top and bottom of the page respectively:

MAXIM ONLINE



MAXIM ONLINE

The Complainant's logo at the website "www.maxim.com" has the following appearance:



## 5. Parties' Contentions

### A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The Respondent began using the disputed domain name in connection with a newly created website nearly identical to the Complainant's "www.maxim.com" website, namely an online men's magazine that is highly similar to that of the Complainant, directed toward men and containing features and topics of interest to men, such as travel, food and drink, automobiles, fashion, and lifestyle. Given the history of the disputed domain name, and its origination of the MAXIM brand in the late 1990s and early 2000s, consumers throughout the world are likely to believe that the two websites are related and that the disputed domain name is still associated with the Complainant. This is especially true given the similarity of content and the fact that the disputed domain name was previously used by the Complainant and its predecessors.

Rights or legitimate interests

There is no evidence that the Respondent's use of the disputed domain name is in connection with a *bona fide* offering of goods or services, as the Respondent is clearly attempting to pass off its website as the Complainant's website. There is no evidence that the Respondent has been commonly known as "Maxim" or "Maxim Online" or has acquired any trademark or service mark rights in the MAXIM trademark. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name but is using it for commercial gain misleadingly to divert consumers to its website by passing off the same as the Complainant's website, using a domain name previously owned and used by the Complainant.

Registered and used in bad faith

The evidence shows that the Respondent is intentionally attempting to attract for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's MAXIM trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. The Respondent acquired the disputed domain name long after the Complainant and its predecessors began using the MAXIM trademark and long after said predecessors began operating their own website, originally by way of the disputed domain name.

### B. Respondent

In summary, the Respondent contends as follows:

Identical or confusingly similar

The Complainant has no trademark rights in MAXIMONLINE. The Complainant's predecessor abandoned trademark rights in MAXIMONLINE.COM (United States Registered Trademark No. 2565895) a decade ago in 2012, and in MAXIM ONLINE (United States Registered Trademark No. 2449110) in 2011. The Complainant has not alleged unregistered trademark rights in the disputed domain name or to claim trademark rights in the marks it has abandoned.

There is no basis to consider the disputed domain name to be confusingly similar to the Complainant's MAXIM trademark. The disputed domain name is different visually and aurally. Established trademark law is clear that marks must be considered in their entireties and cannot be dissected for the purpose of an analysis of confusing similarity. A brief search of the United States and European Union trademark registries shows that hundreds of registrants use the term MAXIM or MAXIM-formative marks besides the Complainant. There is no evidence of any actual confusion on the part of the billions of Internet users who have access to the Respondent's website. There is no basis for the Complainant's contention that

consumers are likely to believe that the Parties' websites are related.

#### Rights or legitimate interests

The Respondent has rights in and a legitimate interest in the disputed domain name. The Complainant has merely restated the language of the Policy with no factual support and the evidence is directly contrary.

Long before receiving notice of the Complaint, the Respondent has used the disputed domain name to resolve to a pop culture, lifestyle website that provides more than 245 substantive articles related to fashion, lifestyle, health and fitness, and dating and sex, with substantive lifestyle articles posted several times monthly. The term "maxim" has an ordinary, dictionary meaning of being "a short, pithy statement expressing a general truth or rule of conduct". The Respondent has used the disputed domain name to provide "maxims" related to general lifestyle and well-being. Examples of such maxims include, "How Long Does It Take to Lose 50 Pounds? 17 Tips to Achieve Your Ideal Weight," "Power Nap: Benefits and Tips on How to Energise Yourself with It," "How to be a Better Husband: 20 Best and Proven Tips," "10 Tips on How to be Dominant in Bed and in Life," and "Hip-Hop 2000 Fashion Trends to Look Back On". The Respondent's entertainment services have been commonly known by the disputed domain name.

The Respondent's legitimate interest in the disputed domain name is also demonstrated by the fact that its use is without any intent to receive commercial gain by misleadingly diverting consumers, given that they are provided at no cost to consumers. The Respondent's website is completely visually different from the Complainant's website and makes no reference to the Complainant's website or services. The Parties use distinctive and dissimilar logos with the Respondent's at the top left while the Complainant's is centered. The Respondent's "About Us" page demonstrates the difference and lack of relationship between the Parties' sites.

#### Registered and used in bad faith

The Respondent lawfully acquired the disputed domain name to operate a legitimate substantive website seven years after the Complainant's abandonment of any trademark rights in the disputed domain name. Since 2019, the Complainant has neither attempted to regain such rights nor to voice its discontent about the Respondent's website until now.

The Respondent registered the disputed domain name without any knowledge of the Complainant, conform to its sworn declaration. Before registering the disputed domain name, the Respondent conducted a search of the United States trademark registry and found only the Complainant's abandoned registrations. The disputed domain name registration is for the Respondent's own purposes and it has never attempted to sell or transfer it to the Complainant in exchange for consideration. It did not prevent the Complainant from using the disputed domain name. There is no likelihood of confusion, and consumers are no more likely to assume a relationship between the Complainant and the Respondent than they are with any of the other hundreds of entities who operate websites and businesses using MAXIM-formative domain names and trademarks.

## 6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### **A. Preliminary Matter: Parties' supplemental filings**

In terms of paragraph 12 of the Rules, the Panel may request, in its sole discretion, further statements or documents from either of the Parties which it may deem necessary to decide the case. Supplemental filings are generally discouraged, however, unless specifically requested by a panel. Panels have repeatedly affirmed that the party submitting or requesting to submit a supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response.

In the present case, both of the Parties have submitted unsolicited supplemental filings. Broadly speaking, these rehearse the arguments already made in the Complaint and Response, and in particular, are focused on specific interpretation of United States trademark law rather than to the wording of the Policy. In any event, the Panel does not consider that either of these supplemental filings contain any matters which should be admitted in order to assist the Panel in its decision. The Panel is satisfied that in terms of paragraph 10(b) of the Rules each of the Parties has already received a fair opportunity to present its case. The Panel therefore declines to admit the Parties' supplemental filings and will proceed to a Decision on the basis of the Complaint and Response.

### **B. Identical or Confusingly Similar**

The first element analysis under the Policy is usually carried out in two parts. First, the Panel ascertains whether the Complainant has UDRP-relevant rights in a trademark, which may be registered or unregistered. Secondly, the domain name concerned is compared with such trademark, typically on a straightforward side-by-side basis, in which the Top-Level Domain ("TLD") of said domain name (in the disputed domain name, ".com") is usually disregarded as being only a technical requirement. Confusing similarity may be found if the trademark is recognizable within the domain name concerned, whether or not accompanied by other terms. Identity may be found if the trademark is identical to the domain name concerned (with the exception of the TLD), having disregarded any special characters or spaces which cannot be reproduced in a domain name.

In terms of the first part of this analysis, the Panel finds that the Complainant has UDRP-relevant rights in its MAXIM registered trademark. The fact that the Complainant's predecessors may have had rights in a MAXIM ONLINE trademark that is now abandoned is not relevant to the analysis. Turning to the comparison process, it may be seen that the Complainant's MAXIM mark is reproduced in its entirety in the disputed domain name, accompanied by the word "online". This additional word does nothing to affect the recognizability of the Complainant's said mark and indeed it is the consensus view of panels under the Policy that the addition of other terms to a trademark (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Panel notes that the Respondent refers to United States trademark law in its discussion of whether the disputed domain name is confusingly similar to the Complainant's mark. As will be seen from the analysis above, the test for identity or confusing similarity under the Policy is not necessarily the same test as might be applied by the trademark law of a particular jurisdiction. In *Advance Magazine Publishers Inc. d/b/a Condé Nast Publications v. MSA, Inc. and Moniker Privacy Services*, WIPO Case No. [D2007-1743](#), the panel noted:

"UDRP panels deciding proceedings under the Policy need not engage in an evidentiary analysis of the likelihood of confusion between a contested domain name and a registered mark, as is common in many legal actions under national trademark laws. The nature of Policy proceedings — providing a swift administrative remedy with no hearings, no evidentiary discovery, and a limited factual and legal record — militates against such analysis. Rather, Panels have routinely held that the question under paragraph 4(a)(i) of the Policy is simply whether the alphanumeric string comprising the challenged domain name is identical to the Complainant's mark or sufficiently approximates it, visually or

phonetically, so that the domain name on its face is ‘confusingly similar’ to the mark.”

In all of the above circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s MAXIM trademark and accordingly that the Complainant has carried its burden in terms of paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. In the present case, the Panel finds that the Complainant has established the requisite *prima facie* case based on its submission and related evidence that the Respondent is attempting to pass off its website as the Complainant’s website, that there is no evidence that the Respondent has been commonly known as “Maxim” or “Maxim Online” or has acquired any trademark or service mark rights in the MAXIM trademark, and that the Respondent is using the disputed domain name for commercial gain misleadingly to divert consumers to its website by passing off the same as the Complainant’s website, using a domain name previously owned and used by the Complainant.

In the above circumstances, the burden of production shifts to the Respondent to bring forward evidence of any rights or legitimate interests which it might claim in the disputed domain name. The essence of the Respondent’s case is that it acquired the disputed domain name legitimately from an auction, selected same because of the dictionary meaning of “maxim”, had no knowledge of the Complainant (and by implication no knowledge of its past business activities under the disputed domain name or otherwise), believed the Complainant or its predecessor to have abandoned any trademark rights which they had previously possessed in the mark MAXIM ONLINE, is making a *bona fide* offering of goods or services under the disputed domain name in providing a pop culture, lifestyle website, and is commonly known by the disputed domain name.

The Panel accepts the Respondent’s submission that it acquired the disputed domain name at auction after it was allowed to lapse when in the hands of the Complainant. This in itself does not confer rights or legitimate interests upon the Respondent. A focal point to the Respondent’s submissions is its comment that it selected the disputed domain name because of its appeal as a dictionary word. Use of a domain name consisting of a dictionary word can in certain circumstances confer rights and legitimate interests upon a respondent in terms of the Policy. However, to confer such rights or legitimate interests, the dictionary word domain name would have to be used in connection with its ordinary dictionary meaning (see section 2.10 of the [WIPO Overview 3.0](#)).

Here, the Respondent stretches credulity well beyond breaking point in suggesting that the website associated with the disputed domain name has any credible link to the dictionary meaning of the word "maxim". The typical definition of this word is "a saying that expresses a general truth" or "a general and absolute principle", usually a pithy aphorism, coming from late Latin in phrases such as *maxima propositio* and *maxima sententiarium*, meaning "greatest premise or proposition". Examples of maxims include "It's better to be safe than sorry" and "You can't teach an old dog new tricks".

The Respondent tenders the following article titles from his website as examples of the maxims which it has published, namely "How Long Does It Take to Lose 50 Pounds? 17 Tips to Achieve Your Ideal Weight," "Power Nap: Benefits and Tips on How to Energise Yourself with It," "How to be a Better Husband: 20 Best and Proven Tips," "10 Tips on How to be Dominant in Bed and in Life," and "Hip-Hop 2000 Fashion Trends to Look Back On". These may be attention-grabbing headlines, but they are not maxims. What is more, even if these were maxims, the plural form of the word would be necessary to represent them descriptively in a dictionary word sense. The word "maxim", as it appears in the disputed domain name, if representing a dictionary word, denotes a single maxim rather than multiple aphorisms. To put it another way, for the dictionary meaning contended by the Respondent to have any credibility, the disputed domain name would have to be in the plural form, *i.e.*, "maximonline". Given these observations, the Panel considers that it is unrealistic of the Respondent to assert that any reader of its website, or any indeed any independent observer, would make the link to the Respondent's submitted dictionary meaning.

The Panel concludes that the Respondent's website is not concerned with maxims. It does, however, provide online information in connection with items of interest concerning men's lifestyle and popular culture, as the headlines above amply illustrate, namely the goods and services in respect of which the Complainant's United States Registered Trademark No. 2449119 is registered. Given the fame of the Complainant's MAXIM mark, recognized as long as two decades ago in *Dennis Publishing, Inc. v. Arjun, supra*, and as illustrated by the global extent of the Complainant's registered trademark portfolio, such use cannot be considered to be a *bona fide* offering of goods and services. The Panel is unconvinced that a person such as the Respondent, in the online publishing business and specializing in men's lifestyle and popular culture, would not have heard of the Complainant's MAXIM mark in general, and its online magazine at "www.maxim.com" in particular, specializing in exactly the same subjects.

While the Respondent claims that it relied upon the Respondent's predecessor's abandonment of the MAXIM ONLINE mark, the Panel finds it unlikely that having troubled to visit the United States trademark registry online to conduct this search, the Respondent would have looked no further than merely conducting a search for "Maxim Online". It is evident from that mark that the word "online" is descriptive in character and that the distinctive part of the mark is the MAXIM element. The notion therefore that the Respondent did not consider and search for the MAXIM-only marks as they pertained to its intended use for the disputed domain name is either not credible, or is only to be believed on the basis that the Respondent was already well-aware of the Complainant's MAXIM mark by reason of its notoriety.

The Panel also finds it hard to believe that the Respondent would have taken the trouble to visit the United States trademark registry, given that the Respondent is apparently based in Hong Kong, China, yet would not trouble to complete any general Internet searches for the term, which would undoubtedly have turned up a mark such as the Complainant's, already described as well-known 20 years ago. The Respondent would have the Panel believe that while it was prepared to perform a United States trademark search, albeit somewhat limited in extent, it did not bother to look into the history of the disputed domain name itself, despite having been aware that it was engaging in an expired domain name auction, *i.e.* that the disputed domain name had evidently had a life before it came to the Respondent's notice. Any of these potential searches would more probably than not have disclosed the Complainant's interest in the MAXIM mark in connection with publications of men's interest, and therefore in the disputed domain name.

Given that the Panel finds the Respondent's assertions to be so unconvincing as to be lacking in credibility, the conclusion that the Panel has reached is that the Respondent is likely on the balance of probabilities to have known of the Complainant and its MAXIM mark and to have set out to target this by taking advantage of the fact that the Complainant had inadvertently allowed the disputed domain name to lapse. The

Respondent's website content tends to affirm this, as it appears to be more than a coincidence that the Respondent has used the disputed domain name for a website focusing on the same sorts of lifestyle and popular culture aspects of interest to men as are found at the Complainant's "www.maxim.com" website. This use of the disputed domain name could not confer rights or legitimate interests upon the Respondent in the Panel's view.

The Panel next turns to the Respondent's assertion that it has a legitimate interest in the disputed domain name due to the fact that its use is without any intent to make commercial gain by misleadingly diverting consumers because the content is provided at no cost to consumers. The Panel notes from a review of the Respondent's website that it is commercial in nature, in that it seeks to benefit from online retailer affiliate links.<sup>1</sup> It is irrelevant that this may come at no direct cost to the consumer. The fact is that it is a commercial use which seeks to benefit from the increased Internet traffic from those consumers arriving at the website associated with the disputed domain name due to the likely confusion with the Complainant's well-known MAXIM mark. It matters not that there may be multiple other users of the MAXIM mark around the world in respect of various different goods and services. The key point is that the Respondent is offering the very goods and services in respect of which the Complainant's MAXIM mark is registered, neither something related to the general meaning of the word "maxim" nor to other kinds of goods or services.

The Respondent asserts that the Parties' websites are visually different. The Panel, on the contrary, sees a strong visual similarity which is most notable in the use of a monochrome logo featuring the word "MAXIM" in capital letters on both websites. The word "Online" in the Respondent's logo is de-emphasized by being in a lighter color and in a less prominent version of the selected typeface, having the appearance of a non-bold font. Granted, the Complainant's logo is centered while the Respondent's is blocked left, but that is not a particularly substantive difference. Of more significance is the fact that both websites consistently use a monochrome look and feel, from logos to headings to navigation. While the Complainant's site features an all-black top banner with white text for its logo and menu links, the Respondent uses a white-on-black banner for its headings and also a white-on-black banner for its menu links.

The Panel considers that the casual visitor would be likely to be deceived into believing that the Respondent's website either was the Complainant's website, or at least was an offshoot of the same. While the topics covered by the respective websites may not be identical, they are generally topics of male interest. Finally, the Panel does not see anything in the Respondent's "About Us" page which acts to differentiate the Parties' sites. The page describes the Respondent's site as "[...] for the men who are never truly satisfied [...]" *i.e.*, containing items of male interest. The tone may perhaps be more colloquial, and the topics on the Respondent's website may be aimed at a more mass-market audience than those of the Complainant's site, but both are focused on the same "men's interest" market in general, and the difference is not particularly remarkable.

Finally, the Panel notes that the Respondent argues that it is commonly known by the disputed domain name. The expression "commonly known by" is usually interpreted by panels under the Policy as meaning that a respondent must have been commonly known by at least some other people than those responsible for the disputed domain name prior to its registration. Equally, the adoption of such name must be unconnected with and wholly independent from any reference to the complainant. There is no evidence before the Panel to this effect, and indeed, the evidence points in the opposite direction regarding the issue of the disputed domain name's reference to the Complainant.

In all of these circumstances, the Panel finds that the Respondent has failed to rebut the Complainant's *prima facie* case, and that accordingly the Complainant has carried its burden with regard to paragraph 4(a)(ii) of the Policy.

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<sup>1</sup> The Respondent's website contains an "Affiliate Disclosure" stating that it participates in the affiliate program of a prominent online retailer. With regard to the Panel conducting limited factual research into matters of public record, such as consulting relevant publicly available websites including the website associated with the disputed domain name, see section 4.8 of the [WIPO Overview 3.0](#).



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

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out of pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

In the present case, the Complainant’s submissions focus upon paragraph 4(b)(iv) of the Policy. The Panel has already noted in the preceding section its view, on balance of probabilities, that the Respondent was aware of the Complainant’s rights when it acquired the disputed domain name, and that there was an evident intent to make commercial gain from the likelihood of confusion which would arise, due to the fact that the Respondent’s website offers a series of online articles of interest to men in the manner of, and with a similar style, look and feel, to that of the Complainant’s site at “www.maxim.com”. The alleged coincidence that the Respondent chose to use the disputed domain name in the exact same line of business as the Complainant, and allegedly without prior knowledge of its rights, is a coincidence too far for the Panel. The Respondent’s explanation of its allegedly independent selection of the disputed domain name because of the dictionary word meaning of “maxim” is unconvincing on the basis of the Panel’s analysis in the preceding section. The Respondent’s headlines are not maxims, and even if they were, the descriptive use would be “maxims online”, or more accurately, “online maxims”. The Respondent’s submission that it is not making commercial gain because consumers are not directly charged for its services is disingenuous, given that it makes money from affiliate links. The Respondent has intentionally created such links and acknowledges this on its said website. Such commercial gain takes unfair advantage of the Complainant’s rights in its MAXIM mark and in no way could be considered to be a good faith activity in the Panel’s opinion.

The Respondent acknowledges that it carried out a search before registering the disputed domain name. The Respondent also accepts that the disputed domain name was auctioned off as an expired domain name and that therefore it must have known that it had a predecessor in interest as regards that domain name. However, the Respondent contends that it carried out a single search which indicated the Complainant’s predecessor’s apparent abandonment of an exact-match United States registered trademark, and looked no further. This is, again, a coincidence too far for the Panel, given that any further search, including one for the Complainant’s MAXIM trademark standing alone, or even a basic Internet search, would on the balance of probabilities have disclosed the Complainant’s interest in what is a well-known trademark registered in respect of the exact same services as those provided on the website associated with the disputed domain name.

The Respondent asserts that there is some significance in the Complainant’s predecessor’s abandonment of the MAXIM ONLINE registered trademark. However, in the Panel’s opinion, this would only be the case if that mark was the Complainant’s only relevant trademark, and if it had no other related rights. The Complainant has, however, substantial rights in the MAXIM mark standing alone. The fact that the

Respondent has effectively used that mark together with the descriptive word “online” is nothing to the point. The additional word does not distinguish the disputed domain name from the Complainant’s mark. It has no special character or other significance. Indeed, Internet users more likely than not would understand the disputed domain name to mean that they will find an official online presence of the Complainant’s MAXIM mark there. In the context of online lifestyle articles of interest to men, the MAXIM mark refers to the Complainant’s business, due to the fact that it and its predecessors in interest have used such mark widely for many years in such line of business and have registered it in multiple jurisdictions, to the extent that it has been noted to be well-known in a previous case under the Policy (*Dennis Publishing, Inc. v. Arjun, supra*).

In all of the above circumstances, and on the balance of probabilities, the Panel rejects the Respondent’s contention that it acquired and used the disputed domain name in good faith. The Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of such website, and therefore finds that the disputed domain name has been registered and is being used in bad faith, in accordance with paragraph 4(b)(iv) 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 <maximonline.com> be transferred to the Complainant.

*/Andrew D. S. Lothian/*

**Andrew D. S. Lothian**

Sole Panelist

Date: August 22, 2022