

## **ADMINISTRATIVE PANEL DECISION**

Scribd, Inc. v. Private Whois, Global Domain Privacy Services Inc / Robert Brink

Case No. D2022-2662

### **1. The Parties**

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

Respondent is Private Whois, Global Domain Privacy Services Inc, Panama / Robert Brink, United States.

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

The disputed domain name <scribdfree.com> is registered with URL Solutions, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 21, 2022. On July 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 22, 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 Complainant on July 22, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on July 26, 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 Respondent of the Complaint, and the proceedings commenced on August 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 22, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on August 29, 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**

Complainant Scribd, Inc. (“Complainant” or “Scribd”) is a United States corporation and online software and retail platform providing a wide variety of computer, electronic, and software related goods. Since 2007, Complainant has served over 1,800,000 paying subscribers and has over 200,000,000 unique visitors per month on its website, “www.scribd.com” (“Complainant’s Website”). Complainant is the 19th most downloaded application in Apple’s App Store under Books, with over 24,000 reviews and a 4.6 rating. On Google Play, Complainant’s App has over 575,000 reviews and a 4.6 rating overall.

Complainant owns thirty-seven trademark registrations and six pending applications for SCRIBD (the “Mark”) worldwide for use in connection with a wide variety of computer, electronic, and software related goods, with ample registration details as follows:

- SCRIBD, United States Trademark Reg. No. 3,777,227, registered on April 20, 2010;
- SCRIBD, United States Trademark Reg. No. 5,898,302, registered on October 29, 2019;
- SCRIBD, European Union Trademark Reg. No. W01422028, registered on July 11, 2018.

Complainant has continuously used, and owned trademark registrations for, the SCRIBD Marks in connection with its computer software goods and services since at least as early as 2009. Complainant also owns and operates the <scribd.com> domain name which was created on September 24, 2006. The disputed domain name was registered on January 14, 2021. The disputed domain name currently resolves to a website claiming to offer free downloads of documents from Complainant’s Website by copy/pasting any URL from Complainant’s Website.

#### **5. Parties’ Contentions**

##### **A. Complainant**

According to Complainant, the disputed domain name is identical or confusingly similar to Complainant’s SCRIBD trademark in which Complainant has rights as demonstrated through its cited registrations. The Mark was adopted and has been continuously used since at least as early as 2009 in connection with a wide variety of computer, electronic, and software related goods. Complainant maintains its online presence through its website hosted at its domain name <scribd.com>.

Complainant argues that the disputed domain name fully incorporates the Mark. Complainant also argues that the addition of the word “free” at the end of the Mark is clearly not sufficient to avoid a likelihood of confusion with Complainant’s prior rights. Complainant argues that, due to the complete reproduction of Complainant’s company name and prior well known trademarks, Internet users will wrongly think that the disputed domain name belongs to Complainant or has been registered in its name. Complainant argues that a likelihood of confusion is therefore undeniable and is reinforced by the high degree of recognition enjoyed by Complainant.

Complainant asserts that Respondent lacks any rights or legitimate interests in the disputed domain name. According to Complainant, Respondent does not have any trademark rights to the Mark. Complainant alleges that Respondent is not using the disputed domain name in connection with any legitimate noncommercial or fair use without intent for commercial gain. Complainant argues that Respondent’s explicit use of the disputed domain name to provide its users the ability to download content from Complainant’s platform without subscribing by acting as a proxy and manipulating a URL link clearly shows that

Respondent is intentionally using Complainant's SCRIBD Marks to redirect potential customers away from Complainant's subscription service. Complainant also asserts that it has not granted Respondent, by license or otherwise, permission to use the Mark in any way. Complainant argues that the disputed domain name was registered by Respondent without Complainant's consent.

Complainant argues that Respondent both registered and is using the disputed domain name in bad faith. According to Complainant, Respondent registered and used the disputed domain name intentionally in an attempt to attract Internet users to its website by creating a likelihood of confusion with Complainant's trademark. Complainant argues that Respondent intends to attract Internet users and consumers looking for legitimate Scribd goods and services and/or authorized partners to Respondent's own webpage. Complainant argues that Respondent could not have been unaware of the existence of Complainant's famous trademarks and company name when registering the disputed domain name. Complainant argues that Respondent's use of a disclaimer (*i.e.*, "ScribdFree.com is not affiliated with any websites (such as Scribd.com and Slideshare.net).") and specific targeting of Complainant prove that Respondent was aware of Complainant's Mark and uses it for the purpose of misleading and diverting Internet traffic. Complainant also argues that the mere fact that Respondent has registered the disputed domain name which incorporates the famous SCRIBD mark belonging to a famous online retail and software business is alone sufficient to give rise to an inference of bad faith. Complainant further argues that the content and use of Respondent's website also evidences bad faith on account of the diversion and downloading of content from Complainant's own website. Complainant argues that such actions clearly show the disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

Under paragraphs 5(f) and 14(a) of the Rules, the effect of a default by a respondent is that, in the absence of exceptional circumstances, the panel shall proceed to a decision on the basis of the complaint.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

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

A respondent's default does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that the complainant's allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Thus, even though Respondent has failed to address Complainant's contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, *e.g.*, *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

### **A. Identical or Confusingly Similar**

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the SCRIBD trademark as referenced above. Therefore, Complainant has established that it has rights in the Mark.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain (“TLD”) in which the domain name is registered) is identical or confusingly similar to Complainant’s mark. It is well accepted that the first element functions primarily as a standing requirement and that the 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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain name incorporates the entirety of the Mark, adding only the word “free” to the end, which does not prevent a finding of confusing similarity between the disputed domain name and the Mark. A side-by-side comparison of the Mark and the disputed domain name reveals that the Mark is easily identifiable within the disputed domain name.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its SCRIBD mark.

## **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

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

- (i) before any notice of the dispute, Respondent’s use of, or 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; or
- (ii) Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is 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.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant’s contention that Respondent is not an assignee or licensee of Complainant and that Respondent has no other business relationship with Complainant. Complainant has contended that Respondent is not commonly known by the disputed domain name and that there is no evidence that Respondent has established trademark rights in the disputed domain name. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain name.

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

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

Here, Respondent's actions align with paragraph 4(b)(iv) of the Policy. The disputed domain name contains the entirety of the SCRIBD mark, with the addition of the word "free" to the end. Due to the well-known nature of Complainant's brand, evidenced by its numerous global trademark registrations for SCRIBD, along with the unauthorized use of the Mark in the disputed domain name, and in conjunction with the content on Respondent's website explicitly identifying Complainant, Respondent was undoubtedly aware of Complainant and the Mark when it registered the disputed domain name. Further, the explicit intended use of Respondent's website, which functions to download content from Complainant's own website and circumvent subscription fees, can only serve to create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website for commercial gain. Respondent's use of the Mark in the disputed domain name in connection with Respondent's website clearly evidences bad faith on the part of Respondent in the registration and use of the disputed domain name.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain name, intentionally creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website with the purpose of attracting Internet users for commercial gain as per 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 <scribdfree.com> be transferred to Complainant.

*/Brian J. Winterfeldt/*

**Brian J. Winterfeldt**

Sole Panelist

Date: September 12, 2022