

ADMINISTRATIVE PANEL DECISION

Consumer Reports, Inc. v. Nick Roskam, Elite Domains LLC / Tinh Nguyen
Case No. D2022-2808

1. The Parties

Complainant is Consumer Reports, Inc., United States of America (“United States”), represented by Cozen O'Connor, United States.

Respondent is Nick Roskam, Elite Domains LLC, United States / Tinh Nguyen, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <bestconsumerreports.com> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 29, 2022. On August 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 1, 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 August 2, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 2, 2022.

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 Respondent of the Complaint, and the proceedings commenced on September 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 21, 2022. The Center received e-mail messages from the first named Respondent on August 2, 2022 and September 28, 2022. The Center received e-mail messages from the second named Respondent on August 5, 2022, September 6, 2022, and October 3, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on September 28, 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 is a non-profit consumer product testing and advocacy organization based in the United States. Complainant is the proprietor of numerous registrations for its CONSUMER REPORTS mark, including the following:

- United States Trademark Registration No. 672849 for CONSUMER REPORTS (word mark), registered on January 20, 1959 for goods in class 16, claiming a date of first use in 1942;
- United States Trademark Registration No. 5064394 for CONSUMER REPORTS (word mark), registered on October 18, 2016 for goods and services in classes 9, 35 and 41.

The disputed domain name was registered on June 12, 2021. It resolves to a website featuring consumer product reviews. It displays a discreet disclaimer stating “Please note that our ‘AI Consumer Reports’ trademark is neither part of nor related to the ‘Consumer Reports’ trademark belonging to Consumer Reports, Inc., with federal registration numbers 0672849, 2465186, 5064394, 5751644”.

5. Parties’ Contentions

A. Complainant

Complainant’s contentions may be summarized as follows:

Under the first element, Complainant states that it was founded in 1936 and has operated under the CONSUMER REPORTS mark since at least 1942. As an independent non-profit organization, Complainant serves the public through unbiased product testing and ratings, research, journalism, public education and advocacy. The disputed domain name is virtually identical to Complainant’s “Consumer Reports” family of registered trademarks. The only difference between Complainant’s registered mark and the disputed domain name is the addition of the generic term “best.”

Under the second element, Complainant states that it has not given Respondent permission to use its registered trademarks or any domain name confusingly similar to Complainant’s registered trademarks. Respondent has not been commonly known by the disputed domain name. Respondent’s website features product reviews and ratings and is thereby virtually identical to Complainant’s legitimate business. Respondent uses the disputed domain name to attracting users to its copycat website so that they purchase the products reviewed. Respondent identifies itself as an “Amazon affiliate” which means that it receives a commission on every sale it directs to Amazon from its website. Respondent’s website prominently features Complainant’s registered CONSUMER REPORTS mark. Respondent is using the disputed domain name to pass itself off as Complainant and to profit from its Amazon affiliation.

Under the third element, Complainant states that the disputed domain name is virtually identical to Complainant’s registered CONSUMER REPORTS mark. Respondent deliberately selected Complainant’s mark as a salient part of his domain name knowing it was a reference to Complainant, rather than a non-infringing alternative. Respondent intended to create a likelihood of confusion since, among other reasons, Respondent’s use of the disputed domain name as a trademark on its website is virtually identical to Complainant’s family of registered CONSUMER REPORTS marks. Respondent is using Complainant’s registered trademark CONSUMER REPORTS throughout the website in an intentional attempt to cause consumer confusion.

The website to which the disputed domain name resolves is operated for commercial gain. Respondent is an Amazon affiliate, through which he earns a commission when an Internet user clicks a review on Respondent's website and is sent directly to Amazon to purchase the product.

Complainant requests transfer of the disputed domain name.

B. Respondent

Respondent did not provide a formal Response. In both e-mail communications with the Center, the first named Respondent stated that he was no longer the registrant of the disputed domain name, which had been sold to the second named Respondent in December 2021.

The second named Respondent provided an e-mail to the Center in which he stated the following: the term "Consumer Reports" is a common term. Whereas Complainant's organization tests products and provides its own ratings and reviews, the website at the disputed domain name uses artificial intelligence to provide product comparisons, reviews, and buying tips. The "AI Consumer Reports" trademark is unrelated to CONSUMER REPORTS registered federal trademarks 0672849, 2465186, 5064394, and 5751644.

In a second e-mail message, the second named Respondent stated that he agrees to transfer the disputed domain name to Complainant.

6. Discussion and Findings

6.1. Procedural Matters

As a preliminary matter, the Panel notes that the first named Respondent states that the disputed domain name has been sold to the second named Respondent and that therefore the proceedings should not be directed at him. The second named Respondent has stated that he is operating the website.

The Panel has reviewed the record and finds that the Registrar has confirmed that the first named Respondent remains the registrant of the disputed domain name. Under paragraph 1 of the Rules, "Respondent means the holder of a domain-name registration against which a complaint is initiated". For that reason, Respondent is identified as the stated registrant of the disputed domain name. Communications from the second named Respondent are considered for the sake of completeness.

6.2. Substantive Matters

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint 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. Identical or Confusingly Similar

Complainant has provided evidence establishing that it has trademark rights in the CONSUMER REPORTS mark through registrations in the United States. Complainant thereby satisfies the threshold requirement of

having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.2.1.

In comparing Complainant’s marks with the disputed domain names, the Panel finds that the disputed domain name is confusingly similar to Complainant’s mark. The disputed domain name reflects Complainant’s CONSUMER REPORTS mark in its entirety, preceded by the dictionary term “best”. It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, where the relevant trademark is recognizable within the disputed domain names, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that the generic Top-Level Domain (“gTLD”) “.com” is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, respondent’s 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) respondent has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel finds that there is no evidence that Respondent is commonly known by the disputed domain name nor is using the CONSUMER REPORTS mark with the permission of Complainant.

The Panel therefore finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent’s statements do not rebut Complainant’s arguments. The Panel does not doubt that the CONSUMER REPORTS mark has, through decades of use, acquired distinctiveness. Further, the Panel finds that, under the circumstances, noting the disputed domain name Complainant’s mark in its entirety together with a descriptive term, the technical differences between how Complainant and Respondent offer consumer product reviews are insufficient to distinguish Respondent’s offering. The record reflects that the disputed domain name was used by Respondent to develop a website through which it offered services identical to those offered by Complainant and using Complainant’s mark, thereby attracting Internet users. Respondent sought to profit when these users purchased goods viewed on this website. Respondent’s disclaimer does not mitigate the overall effect of the disputed domain name and the website, which repeatedly features Complainant’s CONSUMER REPORTS mark. Respondent’s use of the disputed domain

name does not confer rights or legitimate interests for the purposes of the Policy. See [WIPO Overview 3.0](#), section 2.5.2.

As noted earlier, the first named Respondent indicated that the proceedings should not be directed at him and that the second named Respondent stated that he agrees to transfer the disputed domain name to Complainant. Therefore, it would appear that currently neither has an interest in the disputed domain name.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain name. Complainant's rights in its CONSUMER REPORTS marks predate by more than 60 years the registration of the disputed domain name. The disputed domain name reflects Complainant's CONSUMER REPORTS mark in its entirety, together with the dictionary term "best". UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

In this case, the record shows that Respondent deliberately targeted Complainant and its CONSUMER REPORTS mark. The Panel finds the evidence in the record establishes that Respondent used the disputed domain name in an attempt to attract Internet users to the website by taking unfair advantage of the likelihood of confusion arising from the similarity between the disputed domain name and Complainant's marks. The Panel notes that the disclaimer identifies Respondent as "AI Consumer Reports". The Panel notes that the overall circumstances of the case point to Respondent's bad faith, and under these circumstances, the Panel finds that the existence of a disclaimer does not mitigate the finding of bad faith. See [WIPO Overview 3.0](#), section 3.7.

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) 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 <bestconsumerreports.com> be transferred to Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: October 11, 2022