

ADMINISTRATIVE PANEL DECISION

Bloomsbury Publishing Plc v. Angela White / Muhammad Kashif, MadCom Digital

Case No. D2023-3741

1. The Parties

The Complainant is Bloomsbury Publishing Plc, United Kingdom (“U.K.”), represented by Kilburn & Strode, U.K.

The Respondent is Angela White, United States of America (“U.S.”), and Muhammad Kashif, MadCom Digital, Pakistan.

2. The Domain Names and Registrars

The disputed domain names <bloomsburybookpublisher.com>, <bloomsburybookpublishers.com>, and <bloomsburypublisher.com> are registered with Network Solutions, LLC, and GoDaddy.com, LLC (the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 7, 2023. On September 8, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On September 11, 2023, and on September 12, 2023, respectively, the Registrars transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which added to the named Respondent and contact information (Angela White) in the Complaint. The Center sent an email communication to the Complainant on September 18, 2023, providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint September 19, 2023.

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 September 22, 2023. In accordance with the Rules,

paragraph 5, the due date for Response was October 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 13, 2023. The Complainant then sent an unsolicited Supplemental Filing on October 16, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on October 19, 2023. 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, Bloomsbury Publishing Plc, is a global publishing house established in 1986. The Complainant has offices in London, New York, New Delhi, Oxford, and Sydney. The Complainant has published books by authors that have won the Nobel, Pulitzer, and Booker Prizes, and is the originating publisher of the famous Harry Potter series of books.

The complainant is the owner of the trademark BLOOMSBURY registered in several jurisdictions, including:

- EU Trade Mark Registration Nos. 005227715 and 009270588, registered on July 17, 2007, and on January 7, 2011, respectively;
- U.K. Trade Mark Registration Nos. 905227715 and 909270588, registered on July 17, 2017, and on January 7, 2011; and
- U.S. Trademark Registration Nos. 3779055, 3650277 and 5343771, registered on April 20, 2010, July 7, 2009, and on November 28, 2017, respectively.

The complainant also trades under the name BLOOMSBURY PUBLISHING.

The complainant operates a website located at "www.bloomsbury.com".

The disputed domain names <bloomsburybookpublisher.com> and <bloomsburypublisher.com> were registered on June 7, 2023, and the domain name <bloomsburybookpublishers.com> was registered on February 9, 2023.

The record shows that the disputed domain names (i) lead to, (ii) previously lead to, or (iii) are featured in the content of infringing websites prominently using the Complainant's trademark BLOOMSBURY throughout the content in connection with a range of publishing services.

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 confusingly similar to its trademarks;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

However, on October 19, 2023 the Respondent submitted an email communication. He explained that "upon receiving your complaint, we immediately stopped working on the domains associated with Bloomsbury and were prepared to release them on the open market. However, due to the lock placed by the hosting company, we have been unable to do so yet. I have attached a screenshot as proof that we no longer control the Bloomsbury-related domains".

He added that "I want to assure you that we are not engaged in any scam activities. We are an offshore service provider that offers quality book writing, publishing and design services to clients globally [...] I hope to clarify that our business is legitimate".

Finally he stated "The additional domain names listed that are similar to other publishers' names were created as placeholders while we considered expanding our services. However, we will refrain from using any domain names that could be confusingly similar to existing companies going forward. Our intention is not to mislead consumers".

6. Discussion and Findings

6.1. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the disputed domain names are under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain names registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain names registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that:

- The disputed domain names <bloomsburybookpublisher.com> and <bloomsburypublisher.com> were registered on June 7, 2023 while the domain name <bloomsburybookpublishers.com> was registered on February 9, 2023.
- All the disputed domain names share a common pattern: they combine the trademark of the Complainant with the addition of a geographic term "book" or "publisher/s", which are related to the Complainant's business.
- Not all of the disputed domain names are not currently not in use, but some of the domain name were in use before the filing of the complaint, displaying the Complainant's trademark BLOOMSBURY in connection with a range of publishing services.
- The Respondent's Twitter account that previously provided a link to the website associated to the disputed domain name <bloomsburybookpublishers.com>, registered under "Muhammad Kashif,

MadCom Digital”, subsequently provided a link to the website associated with the domain name <bloomsburypublisher.com>, registered under “Angela White”, when the content at the first domain name was removed.

As regards fairness and equity, the Panel sees no reason why consolidation of the Respondents would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain names registrants (referred in the Decision as “the Respondent”) who appear to be under common control or acting in concert, in a single proceeding.

6.2. Supplemental Filing

The Panel, before taking up the discussion on the merits of the case, first addresses the issue of the uninvited supplemental submissions made by the Parties to the Center.

Paragraphs 10 and 12 of the Rules in effect grant the Panel sole discretion to determine the admissibility of Supplemental Filings (including further statements or documents) received from either Party.

On October 16, 2023, the Complainant sent a supplemental submission, and on October 19, 2023 the Respondent filed a supplemental submission.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. On receipt of a request to submit an unsolicited supplemental filing or the actual receipt of such filing, the WIPO Center will confirm receipt of the request or filing to the parties, and forward such request or filing to the panel for its consideration as to admissibility. In all such cases, panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited 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 (e.g., owing to some “exceptional” circumstance). See [WIPO Overview 3.0](#), section 4.6.

In this case, the supplemental filing (like the Amended Complaint) filed by the Complainant provides additional information that the Complainant obtained about the Respondent including registration of additional domain names related to other publishing companies and web design services in the name of the Respondent (Muhammad, Shakir and MadCom). In addition, the supplemental filing filed by the Respondent provides an explanation of the registration of the disputed domain name and his current position towards the disputed domain names.

For those reasons, the supplemental filings will be accepted.

6.3. Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements with respect to each disputed domain name:

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

The burden of proof of each element is borne by the Complainant. The Respondent’s default does not by itself mean that the Complainant is deemed to have prevailed. See [WIPO Overview 3.0](#), section 4.3.

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.

Based on the available record, the Panel finds 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 Panel finds the entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, in this case "book" or "publisher" (in singular or plural), may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, 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.

While 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 often impossible 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. 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 record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

In fact the Respondent has recognized that he was using the disputed domain names with the Complainant trademark when he stated that "We are an offshore service provider that offers quality book writing, publishing and design services to clients globally". Nevertheless, the record shows that the Respondent was not authorized to use the BLOOMSBURY trademark in any way or form.

The Panel further finds that the composition of the disputed domain names consisting of the Complainant's mark plus the terms "book" or "publisher" carries a high risk of implied affiliation and effectively suggest sponsorship or endorsement by the Complainant.

Based on the available record, 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 Complainant is a well-known global publishing company established in the year 1986.
- The Complainant trademark were registered in the year 2007, while the Respondent registered the disputed domain names in the year 2023.
- The Respondent registered three (3) disputed domain names that share a common pattern: they combine the trademark of the Complainant with the addition of a term, namely “book” or “publisher/s”, related to Complainant business.

The record shows that the disputed domain names (i) lead to, (ii) previously lead to, or (iii) are featured in the content of infringing websites prominently using the Complainant's trademark BLOOMSBURY throughout the content in connection with a range of publishing services.

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 names, <bloomsburybookpublisher.com>, <bloomsburybookpublishers.com>, and <bloomsburypublisher.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: November 2, 2023