

ADMINISTRATIVE PANEL DECISION

Macmillan Publishers International Limited v. Dahlia Gerlach
Case No. D2024-4876

1. The Parties

The Complainant is Macmillan Publishers International Limited, United Kingdom, represented by NORDEMANN, Germany.

The Respondent is Dahlia Gerlach, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <macmillanebookspublisher.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 November 26, 2024. On November 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 26, 2024, 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 (UNKNOWN, Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 28, 2024, 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 November 29, 2024.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 2, 2024. In accordance with paragraph 5 of the Rules, the due date for Response was December 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 23, 2024.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on December 27, 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 paragraph 7 of the Rules.

4. Factual Background

The Complainant is a global book publishing company with prominent imprints around the world and publishes a broad range of award-winning books for children and adults in all categories and formats. The Complainant is a part of Holtzbrinck Publishing Group, a large family-owned media company headquartered in Stuttgart, Germany. The Complainant offers products online, inter alia on the website “us.macmillan.com”. The Complainant also owns, inter alia, the domain names <macmillanlearning.com> and <panmacmillan.com>, and a large number of other domain names incorporating the trademark MACMILLAN, which direct to the websites of the Complainant.

The Complainant is the owner of trademarks MACMILLAN (“MACMILLAN Trademarks”) registered all around the world, including German Trade Mark No. 1001188 (registered on April 24, 1980), European Union Trade Mark No. 000066225 (registered on March 18, 1998), United Kingdom Trade Mark No. UK00001102865 (registered on October 12, 1978), Switzerland Trademark No. P-401760 (registered on May 21 1993), and Mexico Trademark No. 1133104 (registered on November 30, 2009).

The disputed domain name was registered on October 1, 2024. The disputed domain name is linked to an English-language website appearing like the official website of the Complainant.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for the transfer of the disputed domain name.

Notably, the Complainant’s contentions may be summarized as follows:

The descriptive element “ebooks publisher” adds no distinctive value to the disputed domain name and thus, the disputed domain name is confusingly similar to the Complainant’s MACMILLAN Trademarks. It cannot be questioned that the relevant part of the disputed domain name is identical to the Complainant’s MACMILLAN Trademarks, and the additional verbal element “ebooks publisher” solely serves further approximation of the disputed domain name to the Complainant’s MACMILLAN Trademarks.

The Respondent has no trademark rights for the term MACMILLAN used in the disputed domain name. The Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the disputed domain name or to seek the registration of any domain name incorporating the Complainant’s MACMILLAN Trademarks. The Respondent is not commonly known by the disputed domain name, whereas the Complainant has prior rights in the MACMILLAN Trademarks, which precede the Respondent’s registration of the disputed domain name by years. To the Complainant’s knowledge, the Respondent has never used, or made any preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. The Respondent’s behavior shows a clear intent to obtain a commercial gain by misleading consumers and tarnishing the MACMILLAN Trademarks owned by the Complainant.

The Respondent is using the disputed domain name to operate a website which gives the impression that it is affiliated with or approved, licensed or operated by the Complainant, while providing publishing services under the MACMILLAN Trademarks. The website linked to the disputed domain name includes copies of the

Complainant's MACMILLAN Trademarks and also imitates the general brand image of the Complainant. As a result, the Respondent must have had knowledge of the Complainant's rights at the time of registering the disputed domain names. The Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith. Moreover, the actions of the Respondent in attempting to sell the services which can result in the public being misled as to the accuracy of the information provided or the origin, sponsorship, or association of the services offered or sold on the Respondent's website, are use in bad faith.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

- (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. 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. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)").

The Complainant is the rightful owner of the MACMILLAN Trademarks registered in numerous jurisdictions. The disputed domain name contains the Complainant's MACMILLAN Trademark in its entirety, combined with the descriptive indication "ebooks publisher" without spaces between the words, under the generic Top-Level Domain (gTLD) ".com".

As noted in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other descriptive terms would not prevent a finding of confusing similarity under the first element in paragraph 4(a) of the Policy. The Complainant's MACMILLAN Trademark is clearly recognizable within the disputed domain name. The additional term "ebooks publisher" does not prevent a finding of confusing similarity between the disputed domain name and the MACMILLAN Trademark under the first element in paragraph 4(a) of the Policy (see *Macmillan Publishers International Limited v. Saqib Nizam*, WIPO Case No. [D2024-2900](#); *Macmillan Publishers International Limited v. Privacy Service Provided by Withheld for Privacy ehf / Mary Fortenbaugh, PubHub*, WIPO Case No. [D2022-1826](#); and *Macmillan Publishers International Limited v. Macmillan, Jennifer Tate*, WIPO Case No. [D2021-2565](#)).

Moreover, it is well established that the applicable generic Top-Level Domain in a domain name is viewed as a standard registration requirement and as such is disregarded for assessing the confusing similarity under the first element in paragraph 4(a) of the Policy. See section 1.11.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the first element in paragraph 4(a) 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.

Noting the composition of the disputed domain name, as well as the fact that the Respondent's website identifies itself as "MACMILLAN EBOOKS PUBLISHER", the website operated under the disputed domain name will be inevitably perceived as a website operated, endorsed, or licensed by the Complainant (which is not the case). The Respondent's website suggests being an official and authorized website of the Complainant by using the MACMILLAN Trademark on a website that mimics the official website of the Complainant. However, as the Complainant asserts, the Respondent has no trademark rights for the term MACMILLAN used in the disputed domain name, the Respondent is not affiliated with the Complainant, and the Respondent has not been authorized by the Complainant to register or use the disputed domain name or to seek the registration of any domain name incorporating the Complainant's MACMILLAN Trademark.

Moreover, there is no evidence to suggest that the Respondent is commonly known by the disputed domain name, as contemplated by paragraph 4(c)(ii) of the Policy. Further, considering the Respondent's illegitimate use of the disputed domain name and the lack of clarity regarding the Respondent's relationship with the Complainant on the website accessible under the disputed domain name, the Respondent's use of the disputed domain name does not amount to a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy.

Although the overall burden of proof in the proceedings is on the complainant, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on the second element in paragraph 4(a) of the Policy 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 in paragraph 4(a) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

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.

Thus, the Panel finds that the second element in paragraph 4(a) of the Policy of the Policy has been established.

C. Registered and Used in Bad Faith

The Complainant's MACMILLAN Trademarks have been widely used since 1843, the founding year of the Complainant, were first registered about fifty years ago, and are currently well-known. Taking into account that the website operated under the disputed domain name is a pure imitation of the Complainant's website, the Respondent must have been undoubtedly aware of the Complainant's MACMILLAN Trademarks at the time of the registration and use of the disputed domain name. Therefore, the Respondent is considered to be intentionally attempting to create a likelihood of confusion with the Complainant's MACMILLAN Trademarks and general brand image in order to obtain commercial gain pursuant to paragraph 4(b)(iv) of the Policy. The combination of the term "ebookspublisher" with the Complainant's MACMILLAN Trademark in the disputed domain names further supports the finding of bad faith (see *Bloomsbury Publishing Plc v. Angela White / Muhammad Kashif, MadCom Digital*, WIPO Case No. [D2023-3741](#); *Scholastic Inc. v. Kanwal Khan*, WIPO Case No. [D2024-3695](#); and *Lagardere SA v. AMG Digital Agency*, WIPO Case No. [D2023-2027](#)).

In conclusion, the Panel finds that the third element in paragraph 4(a) 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 name <macmillanebookspublisher.com> be transferred to the Complainant.

/Yuji Yamaguchi/

Yuji Yamaguchi

Sole Panelist

Date: January 9, 2025