

ADMINISTRATIVE PANEL DECISION

Consumer Reports, Inc. v. Privacy service provided by Withheld for Privacy ehf / Saad Khan

Case No. D2022-1476

1. The Parties

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

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Saad Khan, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <consumerreportsit.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 22, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 25, 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 May 16, 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 amended Complaint on May 20, 2022. The Respondent sent informal communication to the Center on May 16, 17, and 23, 2022. The Center sent a Possible Settlement email to the Parties on May 23, 2022; the Parties were unable to reach a settlement.

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 May 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 19, 2022. The Center proceeded to Panel Appointment on July 5, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on July 7, 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 a non-profit consumer product testing and advocacy organization that produces publications under the title “Consumer Reports”. The Complainant changed its name from “Consumers Union of United States, Inc.” to its current name in November 2016.

The Complainant is the owner of several trademark registrations for CONSUMER REPORTS, including the following:

- United States trademark registration No. 0672849 for CONSUMER REPORTS (word mark), filed on January 13, 1958, and registered on January 20, 1959, in international Class 16;
- United States trademark registration No. 5064394 for CONSUMER REPORTS (word mark), filed on May 5, 2016, and registered on October 18, 2016, in international Classes, 9, 35, and 41.

The Complainant is also the owner of the domain name <consumerreports.org>, registered on June 20, 1997, pointed to a website showing a green “CR” logo along with the CONSUMER REPORTS trademark on the top left corner of the home page and displaying product ratings and reviews, along with “Shop” buttons which redirect to retailers’ websites (including “www.amazon.com”, hereinafter referred to as “Amazon website”) where the reviewed products are offered for sale.

The disputed domain name was registered on June 27, 2020, and is currently not pointed to an active website. According to the screenshots provided by the Complainant, prior to the present proceeding, the disputed domain name pointed to a website publishing reviews and ratings for consumer products, providing links to the Amazon website where the referenced products could apparently be purchased.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is virtually identical to the trademark CONSUMER REPORTS in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term “it” and the generic Top-Level Domain “gTLD” “.com”.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that, considering the content of the website to which the disputed domain name resolves, the Respondent does not appear to be making a *bona fide* offering of goods or services, since the Respondent is using the disputed domain name as a means of attracting users to its copycat website where it offers product reviews of various consumer products in order to lure users into buying those reviewed products on the Amazon website.

The Complainant further states that the Respondent identifies itself as an “Amazon affiliate”, which means that it receives a commission on every sale it directs to the Amazon website from its website, and highlights that the Respondent’s website prominently features the Complainant’s registered trademark CONSUMER REPORTS (*i.a.*, in the heading “10 Best Sunglasses Consumer Reports 2022” displayed on the Respondent’s website as shown in Annexes to the Complaint).

The Complainant submits that the Respondent’s use of the disputed domain name appears to be a deliberate attempt to pass itself off as Complainant in order to leverage the Complainant’s goodwill.

The Complainant also states that the Respondent was never granted permission to use its registered trademarks or register a domain name in its name, nor is the Respondent commonly known by the disputed domain name since the disputed domain name has no relationship with the Complainant.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering that: i) the disputed domain name incorporates the Complainant's registered trademark, ii) a substantial number of users are likely to be confused as to the source, sponsorship, affiliation or endorsement of the website to which the disputed domain name resolves, iii) the Respondent undoubtedly intended to trade off the Complainant's mark and world renown for commercial gain by using pay-per-click ("PPC") links on the website, to profit from its affiliation with Amazon, and iv) the Respondent is attempting to provide the same types of product reviews and rating that the Complainant provides, there is no plausible circumstance under which Respondent could have legitimately registered or used the domain name at issue and that, therefore, the disputed domain name was registered and is being used by the Respondent in bad faith.

B. Respondent

The Respondent did not file a formal Response but only sent informal email communications to the Center. In its initial communication on May 15, 2022, it stated that, following a third-party notice regarding the use of the Complainant's trademark on its website, it proceeded to remove the trademark, but noticed that the disputed domain name was still locked.

On May 16, 2022, the Respondent sent a second informal communication to the Center, requesting that the name servers be updated since they were due to expire at the end of the month.

On the same day, the Respondent sent a third informal communication to the Center, suggesting that the disputed domain name be redirected to a new domain name in order to remove any reference to the trademark.

On May 20, 2022, the Center received a further informal communication from the Respondent stating that it had redirected the disputed domain name in order to avoid using the Complainant's trademark, apologizing and stating that it was unaware of the consequences of its use of such trademark.

6. Discussion and Findings

According to 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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark CONSUMER REPORTS based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as annexes to the Complaint.

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 a

complainant's trademark and the disputed domain name to assess whether the trademark is recognizable within the disputed domain name (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Moreover, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (section 1.8 of the [WIPO Overview 3.0](#)).

The Panel finds that the disputed domain name is confusingly similar to the trademark CONSUMER REPORTS as it reproduces the trademark in its entirety with the mere addition of the two letters "it", which does not prevent a finding of confusing similarity. Moreover, as stated in section 1.11 of the [WIPO Overview 3.0](#), the gTLD ".com" can be disregarded when comparing the similarities between a domain name and a trademark.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(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.”

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and the Respondent has failed to raise convincing circumstances that could demonstrate, pursuant to paragraph 4(c) of the Policy, its rights or legitimate interests in the disputed domain name.

According to the evidence on record, there is no relationship between the Complainant and the Respondent, and the Complainant has not authorized the Respondent to register or use its trademark or the disputed domain name in any way.

Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain name, or that the Respondent, whose name disclosed in the Registrar's WhoIs records for the disputed domain name is Saad Khan, might be commonly known by the disputed domain name.

As highlighted above, the Respondent has used the disputed domain name, prior to the filing of the Complaint, in connection with a competing website that published product reviews. The Complainant asserted that the Respondent's website was a copycat version of its own official website. The Panel has reviewed the Complainant's website at <consumerreports.org> and the screenshots of the website previously displayed at the disputed domain name submitted as annexes to the Complaint, as well as the ones available on the Internet Archive at <archive.org>¹ and notes that, while some of their fonts are similar,

¹ As stated in section 4.8 of the [WIPO Overview 3.0](#), “Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include visiting

they use different colors, logos, and layout. However, the Respondent has reproduced the wording “Consumer Reports”, identical to the Complainant’s trademark CONSUMER REPORTS, on the top of its website as well as in titles of reviews displayed herein and published the same type of content as the one featured on the Complainant’s website. The Panel finds that such similarities were intended to generate confusion amongst Internet users as to the source, endorsement or affiliation of the Respondent’s website and that, therefore, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods and services.

In view of the circumstances of the case and also in view of the fact that the Respondent has not rebutted the Complainant’s contentions providing any arguments from which a right or legitimate interest may be inferred, the Panel finds that, on balance of probabilities, the Respondent has used the disputed domain name in connection to trade off the Complainant’s trademark rights and has not been commonly known by the disputed domain name either a trademark.

The circumstance that the Respondent has used the disputed domain name, confusingly similar to the Complainant’s trademark, to offer product reviews as an Amazon Affiliate, thus earning from qualifying purchases, also demonstrates that the Respondent has not made a noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark.

See, along these lines, the decision issued in the similar case *Consumer Reports, Inc. v. Artur Solovev*, WIPO Case No. [D2022-0558](#) (<theconsumersreports.com>).

Moreover, the disputed domain name is currently not resolving to an active website. The Panel shares the view held *i.a.*, in *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#), where the Panel found that “Absent some contrary evidence from Respondent, passive holding of a Domain Name does not constitute legitimate noncommercial or fair use”.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel finds that, in light of i) the prior registration and use of the Complainant’s trademark CONSUMER REPORTS in connection with the Complainant’s product reviews including on the website “www.consumerreports.org”, ii) the circumstance that the disputed domain name reproduces the Complainant’s trademark in its entirety with the mere addition of the two letters “it”, iii) the fact that a search for “consumer reports” on main search engines returns results related only to the Complainant in the first page, and iv) the Respondent’s redirection of the disputed domain name to a website displaying the same content as the one displayed on the Complainant’s website, *i.e.*, product reviews, the Respondent had more likely than not the Complainant’s trademark in mind when registering the disputed domain name.

The disputed domain name is not currently pointed to an active website. As established in a number of prior cases the concept of “bad faith” in paragraph 4(b) of the Policy includes not only positive action but also passive holding. See the landmark case *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name, consulting historical resources such as the Internet Archive (www.archive.org) in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopedias (e.g., Wikipedia), or accessing trademark registration databases.

Moreover, as highlighted above, the Respondent was previously using the disputed domain name in connection with a website that offered product reviews along with links to the Amazon website where the reviewed products could be purchased. Furthermore, the Respondent likely earned from any qualifying purchases on the Amazon website in light of the Amazon Affiliate Program subscribed.

In view of the foregoing and considering the Panel's findings in section 6.2 above, the Panel finds that, by registering and using the disputed domain name, the Respondent has, on balance of probabilities, intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and the related content, according to paragraph 4(b)(iv) of the Policy. See, along these lines, *Consumer Reports, Inc. v. Artur Solovev, supra*.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and has been using the disputed domain name in bad faith according to paragraph 4(a)(iii) 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, <consumerreportsit.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: July 21, 2022