

ADMINISTRATIVE PANEL DECISION

Usborne Publishing Limited v. quan liu
Case No. D2022-2393

1. The Parties

Complainant is Usborne Publishing Limited, United Kingdom, represented by Co-Counsel Limited, United Kingdom (“UK”).

Respondent is quan liu, China.

2. The Domain Name and Registrar

The Disputed Domain Name <usbornebooklady.com> is registered with DropCatch.com LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 30, 2022, including the Disputed Domain Name and the domain name <readusborne2me.com>. On July 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name and the other domain name. On July 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name and the other domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on July 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. On July 13, 2022, Complainant filed an amendment to the Complaint and a request to withdraw the domain name <readusborne2me.com> from the Complaint. The partial withdrawal was duly notified on July 13, 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 July 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 8, 2022.

The Center appointed Richard W. Page as the sole panelist in this matter on August 11, 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 well-known and internationally recognized publisher of children's books. Respondent has registered the Disputed Domain Name <usbornebooklady.com>. Respondent is not a licensee of Complainant, nor otherwise authorized by Complainant to use Complainant's mark.

Complaint has a worldwide reputation for its business conducted under the USBORNE Mark and is the owner of a large number of registrations for the USBORNE Mark in the UK, United States of America ("US") and China. Complainant owns, without limitation, the following registrations for the USBORNE Mark: UK trademark 00900339242 registered September 3, 1996, in classes 9, 16 & 28; US trademark 2,233,673 registered March 23, 1999, in class 16 (renewed January 17, 2019); and China trademark 18312729 registered December 21, 2016, in class 9.

The Disputed Domain Name was registered by Respondent on March 21, 2022, and it resolves to a website with pornographic and adult content.

5. Parties' Contentions

A. Complainant

Complainant contends that the use of the word "book" alongside the USBORNE Mark in the Disputed Domain Name is a deliberate reference to Complainant and its highly successful business as a publisher of children's books. Complainant further contends that it is the owner of substantial goodwill in and connected with the name USBORNE in relation to books and publishing.

Complainant further contends that Respondent owns and operates the Disputed Domain Name which fully incorporates the USBORNE Mark, thereby causing likelihood of confusion as to the source and/or sponsorship of the Disputed Domain Name. Complainant further contends that such conduct clearly infringes Complainant's rights in the USBORNE Mark.

As indicated above, the Disputed Domain Name was registered by Respondent on March 21, 2022, well after Complainant's established its rights in the USBORNE Mark. Complainant argues that UDRP Panels have consistently held that a domain name is identical or confusingly similar to a trademark for purposes of the Policy "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name." Hence the Disputed Domain Name and the USBORNE Mark are identical and a "confusingly similar approximation".

Complainant asserts that, under the Policy, Respondent is generally considered to have no rights or legitimate interests in the Disputed Domain Name if (a) Respondent does not use, or undertake demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods and services, (b) Respondent is not commonly known by the Disputed Domain Name, and (c) Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name,

Complainant further asserts that, in the present case, it is clear that Respondent has no rights or legitimate interests in the Disputed Domain Name. Complainant has not given any consent, license or authorization to Respondent for use or registration the Disputed Domain Name.

Complainant further asserts that the Disputed Domain Name is currently being used to publish pornographic and adult content. Complainant further asserts that such use of the Disputed Domain Name by Respondent is clearly an attempt to attract Internet users to Respondent's websites by creating a likelihood of confusion with the USBORNE Mark and consequently tarnishing the USBORNE Mark and Complainant's reputation.

Complainant alleges that Respondent has registered and used the Disputed Domain Name in bad faith by publishing pornographic and adult content. Complainant further alleges that registration and use of the Disputed Domain Name (which combines both the name USBORNE and refers to Complainant's business as a publisher of books) by Respondent is a clear attempt to attract Internet users to Respondent's websites by creating a likelihood of confusion with the USBORNE Mark as to the source, sponsorship, affiliation, or endorsement of Respondent's sites. The pornographic content of the site is damaging to Complainant's reputation.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Even though Respondent has failed to file a Response or to contest Complainant's assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

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

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to the USBORNE Mark in which Complainant has rights; and,
- ii) that 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

Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration of a trademark is *prima facie* evidence of Complainant having enforceable rights in the USBORNE Mark.

Complaint contends that it owns a large number of registrations for the USBORNE Mark in the UK, US and China. Complainant owns, without limitation, the following registrations for the USBORNE Mark: UK trademark 00900339242 registered September 3, 1996, in classes 9, 16 & 28; US trademark 2,233,673 registered March 23, 1999, in class 16 (renewed January 17, 2019); and China trademark 18312729 registered December 21, 2016, in class 9.

Respondent has not contested this contention. Therefore, the Panel finds that for purposes of this proceeding Complainant has enforceable rights in the USBORNE Mark.

Section 1.7 of the [WIPO Overview 3.0](#) says that inclusion of the entire trademark in a domain name will be considered confusingly similar. Also, section 1.8 of the [WIPO Overview 3.0](#) instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a

finding of confusing similarity. Also, section 1.11.1 of the [WIPO Overview 3.0](#) instructs that Top-Level Domains (“TLDs”) such as “.com” may be disregarded for purposes of assessing confusing similarity.

The Panel finds that the Disputed Domain Name includes the entirety of the USBORNE Mark, with addition of the words “book” and “lady”. The addition of these words does not prevent a finding of confusing similarity.

Therefore, Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant asserts that Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

Section 2.1 of the [WIPO Overview 3.0](#) states that once Complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of Respondent, Respondent carries the burden of demonstrating rights or legitimate interests.

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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 USBORNE Mark.

Complainant asserts that a pornographic website cannot be a *bona fide* or legitimate use. Complainant further asserts that Respondent has not been commonly known by “usbornebooklady”.

The Panel finds that these assertions are sufficient to make out a *prima facie* case, which has not been refuted by Respondent.

Therefore, Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant alleges that Respondent registered and is using the Disputed Domain Name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Name:

- (i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to Complainant who is the owner of the USBORNE Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or
- (ii) you [Respondent] have registered the Disputed Domain Name in order to prevent Complainant from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such

conduct; or

(iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Disputed Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the USBORNE Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

Complainant alleges that the Disputed Domain Name is being used to attract Internet users to a pornographic website. The Panel finds that such use is in bad faith in accordance with paragraph 4(b)(iv) of the Policy.

Therefore, Complainant has satisfied the requirements of 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, <usbornebooklady.com> be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: August 23, 2022