

ADMINISTRATIVE PANEL DECISION

Associated Newspapers Limited v. marouane elkasmi, elkasmishop
Case No. D2024-1434

1. The Parties

The Complainant is Associated Newspapers Limited, United Kingdom (“UK”), represented by Adlex Solicitors, U. K.

The Respondent is marouane elkasmi, elkasmishop, Morocco.

2. The Domain Name and Registrar

The disputed domain name <dailymailinfo.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 April 4, 2024. On April 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 10, 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 amended Complaint on the same day.

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 April 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 1, 2024. The Respondent sent an email communication to the Center on April 14, 2024.

The Center appointed Knud Wallberg as the sole panelist in this matter on May 20, 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 the Rules, paragraph 7.

4. Factual Background

The Complainant was incorporated in the UK on April 1, 1905 (exhibit 3) and is the management company and publisher of a range of publications in the UK including two national newspapers: the Daily Mail and The Mail on Sunday. The first edition of the Daily Mail was published in 1896.

The Complainant owns a range of registrations of the trademark DAILY MAIL including the following: UK trademark 1207666 registered on November 22, 1983, for goods in class 16, and European Union trademark 193433 registered on November 5, 1999, for goods and services in classes 9, 16, 35, 38, 41 and 42.

The Complainant's website at "www.dailymail.co.uk" (also known as "MailOnline" and "Daily Mail Online") is one of the most-visited websites in the world.

The disputed domain name was registered on July 9, 2023, and was used for a website that contained a parking page with pay per click ("PPC") links. At the time when the Complaint was filed the disputed domain name did not resolve to an active website.

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 the Complainant's trademark. It wholly incorporates the trademark and differs only by addition of the word "info". This term fails to dispel the connection between the disputed domain name and the trademark; indeed, it reinforces the link as this term implies that the disputed domain name is providing information relating to the Complainant's newspaper.

Furthermore, the Complainant has no association with the Respondent and has never authorized or licensed the Respondent to use its trademarks. The PPC links that appeared on the original parking page bear no relationship to any descriptive meaning of the disputed domain name, so the Respondent cannot avail itself of a claim to right or legitimate interest on this basis, just as there is no other evidence that the Respondent has been commonly known by the name comprised in the disputed domain name.

The Complainant finally contends that it is clear from the massive global fame of the Complainant's mark that the Respondent had the Complainant and its business in mind when registering and using the disputed domain name. The likelihood of confusion is not diminished by the fact that some users arriving at the Respondent's site may realize that it is not connected with the Complainant, for example because the PPC links that appeared previously do not relate directly to the Complainant's industry. Here, the disputed domain name creates a risk of implied affiliation with the Complainant, and a profit is made from at least some of the traffic intended for the Complainant. Insofar as the disputed domain name has not been actively used, the Complainant respectfully contends that also "passive holding" constitutes use under the UDRP. The Complainant also draws attention to the fact that the Respondent appears to have used false details for his contact address in the information provided by him to the Registrar of the disputed domain name, as part of the address is in Morocco, but the address also refers to Missouri, a state in the United States of America.

B. Respondent

The Respondent did not reply to the Complainant's contentions but sent the following communication to the Center on April 14, 2024.

"I am writing in response to the notification we received regarding the UDRP complaint filed against our domain name. I appreciate the opportunity to discuss this matter and explore the possibility of an amicable settlement.

We would like to clarify that our registration and use of the domain name was with no intention of infringing upon or conflicting with the trademark rights of "Daily Mail." We have owned this domain name with Namecheap prior to transferring it to GoDaddy, and it has been actively used as a hostname for our mail servers. These servers are integral to sending transactional emails and newsletters to subscribers across various websites managed by our clients.

Our use of the domain name is strictly functional, aiming to serve our business and our clients' needs without causing confusion or association with the trademark "Daily Mail.

Given the circumstances and our established use of the domain name, we propose to negotiate a compensation arrangement that recognizes our investment in and use of the domain. We believe that a fair compensation for the relinquishment of the domain name could benefit both parties and allow for a resolution that avoids further dispute.

We are open to discussing this further at your earliest convenience and hope to reach a mutually agreeable solution. Please let us know a suitable time for a meeting or if we should handle this discussion through our legal representatives.

Thank you for considering this approach. We look forward to your response."

6. Discussion and Findings

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.

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 mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "info", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Although 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 difficult 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 (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. [WIPO Overview 3.0](#), section 2.1.

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 the Panel finds that the Respondent’s above cited email to the Center is not supported by relevant evidence to demonstrate that the Respondent has any rights or legitimate interests in the disputed domain name.

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.

The disputed domain name contains the Complainant’s well-known trademark and the Panel finds it is more likely than not that the Respondent registered the disputed domain name prior knowledge of the Complainant and the Complainant’s marks, and due to its similarity. [WIPO Overview 3.0](#), section 3.2.2.

In addition, while not fully determinative, the Panel considers that the Respondent’s explanation for the registration and use of the disputed domain name, in view of the lack of evidence supporting the Respondent’s contentions, does not fit well with the Respondent’s willingness for transferring the disputed domain name for a fee.

Furthermore, the Respondent previously used the disputed domain name for a website that contained PPC links which may have generated fees to the Respondent, but the Panel notes that even if the Respondent itself may not have profited directly, that would not in itself prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.5. In addition, the Panel understands the Respondent’s email communication to the Center to read that the Respondent is prepared to transfer the disputed domain name to the Complainant provided that the Respondent receives a compensation “that recognizes our investment in and use of the domain.”. It seems that the requested compensation is likely in excess of the Respondent’s out-of-pocket costs directly related to the disputed domain name, which is in itself an indication of bad faith use cf. Paragraph 4(b)(i) of the Policy.

The Panel therefore finds that the Respondent registered and used the disputed domain name in bad faith and that the Complainant has established the third element 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 <dailymailinfo.com> be transferred to the Complainant.

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: June 3, 2024