

## **ADMINISTRATIVE PANEL DECISION**

Associated Newspapers Limited v. Domain Privacy,  
Domain Name Privacy Inc.  
Case No. D2024-1613

### **1. The Parties**

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

The Respondent is Domain Privacy, Domain Name Privacy Inc., Cyprus.

### **2. The Domain Name and Registrar**

The disputed domain name <dailymail-co-uk.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2024. On April 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 18, 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 (Contact Privacy Inc. Customer 0167381269) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 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 April 19, 2024.

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 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 15, 2024.

The Center appointed Meera Chature Sankhari as the sole panelist in this matter on May 24, 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, Associated Newspapers Limited, incorporated in the UK on April 1, 1905, is the management company and publisher for various publications in the UK, including two national newspapers: the Daily Mail and The Mail on Sunday. The Daily Mail released its first edition in 1896.

The Complainant has registered their marks, including the ones below, which it relies upon for the present Complaint:

MARK	Registration No.	Class	Date of registration	Status	Jurisdiction
DAILY MAIL	000193433	9, 16, 35, 38, 41, 42	November 5, 1999	Registered	European Union
DAILY MAIL	UK00001207666	16	November 22, 1983	Registered	UK

The Complainant uses its official domain name <dailymail.co.uk> to resolve to an active website in relation to its publishing business.

The Respondent has registered the disputed domain name <dailymail-co-uk.com> on May 26, 2023, under the “.com” generic Top-Level Domain (“gTLD”), with the Registrar. The Respondent is located in Cyprus.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant, placing reliance on its registered trademarks and common law rights, inter alia, through the use thereof, claims to have built a substantial reputation and goodwill in the trademark DAILY MAIL. The Complainant contends that the disputed domain is confusingly similar to its trademark and that same incorporates the trademark DAILY MAIL in its entirety. Further, the Complainant asserts that adding “-co-uk”, reinforces, rather than dispels, the connection to the Complainant’s official website. The Complainant’s trademark remains the dominant feature of the disputed domain name.

The Complainant further contends that it has no association with nor has it authorized the Respondent to use the trademark DAILY MAIL. The Complainant further notes that hosting a parking page with pay-per-click (“PPC”) links that exploit the Complainant’s mark does not amount to “a bona fide offering” by the Respondent. The PPC links on the parking page were related to competing services and/or even the Complainant itself, and the other website version to which the disputed domain name resolved is, according to the Complainant, malicious. The Complainant claims that the disputed domain name was also offered for sale as on March 26, 2023 and April 4, 2024. The Respondent’s use of the disputed domain name, mirroring the Complainant’s mark, is intended to attract and confuse users, which indicates bad faith and cannot be bona fide. For these reasons, the Complainant contends that the Respondent does not have any legitimate rights or interests.

The Complainant contends that the Respondent’s actions were not only financially motivated but also aimed at undermining the business interests of the Complainant. Moreover, the Complainant argues that the Respondent was aware of the business of the Complainant at the time of registering the disputed domain name. The Complainant contends that the Respondent registered and used the disputed domain name to confuse and attract the Complainant’s customers for profit, leveraging the Complainant’s globally

recognized mark. The use of the trademark DAILY MAIL alongside “UK” and the presence of PPC links related to the Complainant indicate that the Respondent was aware of and intended to exploit the Complainant’s business.

The Complainant argues that the setting up of MX records and the presence of a browser safety warning suggest that the disputed domain name is likely being used for phishing or similar fraudulent activities. Additionally, the Registrar has identified the underlying registrant as another privacy service, indicating that the Respondent was determined to remain anonymous.

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

## **B. Respondent**

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

## **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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The gTLD “.com”, is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.

Further, although the addition of other terms “-co-uk” here, 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 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.

The disputed domain name by adding the term “-co-uk” to the Complainant's trademark DAILY MAIL is confusingly similar not only to said mark but also to the Complainant's official domain name <dailymail.co.uk> and thus creates a risk of implied affiliation or associations with the Complainant's mark and website, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

Panels have held that the use of a domain name for illegal activity such as, phishing, distributing malware, impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 the Complainant's claim that Respondent's registration and utilization of the disputed domain name demonstrate bad faith, a claim which the Respondent failed to contest.

Given the widely recognized reputation of the Complainant's trademarks, the confusing similarity between the disputed domain name and the Complainant's trademark and domain name, the Panel finds it evident that the Respondent was aware of the Complainant's mark when registering the disputed domain name. By using the disputed domain name in the abovementioned manner, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark. [WIPO Overview 3.0](#), section 3.1.4.

Panels have held that the use of a domain name for illegal activity here, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitute bad faith under the Policy.

The Panel notes that the disputed domain name no longer resolves to an active website at the time of this Decision. The current non-use of the disputed domain name does not prevent the finding of bad faith under the passive holding doctrine given the totality of the circumstances of the present case.

The Panel finds 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 <dailymail-co-uk.com> be transferred to the Complainant.

*/Meera Chature Sankhari/*

**Meera Chature Sankhari**

Sole Panelist

Date: June 7, 2024