

## **ADMINISTRATIVE PANEL DECISION**

Associated Newspapers Limited v. Domain Privacy, Domain Name Privacy Inc

Case No. DCO2024-0026

### **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 <thedailyemail.co> is registered with Communigal Communications Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 4, 2024. On April 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 7, 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 (REDACTED FOR PRIVACY, Domain Name Privacy Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 8, 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 10, 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 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 7, 2024.

The Center appointed Kathryn Lee as the sole panelist in this matter on May 14, 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 is a 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 Daily Mail's average UK newspaper readership from July 2019 to June 2021 was over 2 million per issue, and the Daily Mail's average UK newspaper circulation in September 2021 was approximately 920,000 per issue. The Complainant owns a number of trademark registrations for the trademark DAILY MAIL, including UK Trademark Registration Number UK00001207666, registered on November 22, 1983, and European Union Trademark Registration Number 193433, registered on November 5, 1999.

The Respondent appears to be an individual or entity with an address in Cyprus.

The disputed domain name was registered on July 11, 2023, by a registrant with a concealed identity with an address in Romania. On or around April 3, 2024, the country of the registrant on the WhoIs records – identity still concealed – was changed to Cyprus. As of the filing of the Complaint, the disputed domain name resolves to a website with pay-per-click links to terms such as “Daily Mail Headlines Today”, “Mail Rewards”, and “Do My Paper for Me”.

#### **5. Parties' Contentions**

##### **A. Complainant**

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

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark, since the disputed domain name wholly incorporates the DAILY MAIL mark and differs only by the addition of the generic word “the” which appears before the trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect. The Complainant contends that the disputed domain name resolves to a parking page with commercial links, some of which specifically refer to the Complainant. The Complainant contends that such use does not represent a bona fide offering since the links compete with or capitalize on the reputation and goodwill of the Complainant's mark and otherwise mislead Internet users.

Finally, the Complainant contends that the disputed domain name was registered and used in bad faith. The Complainant contends that the Respondent registered the disputed domain name to disrupt the business of the Complainant by diverting business intended for the Complainant. The Complainant also contends that the Respondent registered and used the disputed domain name to confuse, attract and profit from the Complainant's customers by creating a likelihood of confusion in the minds of the public as to an association between the Respondent and the Complainant. In addition, the Complainant contends that the WhoIs page for the disputed domain name displays an offer to sell the disputed domain name for USD 688 , which is a valuable consideration in excess of the Respondent's out of pocket costs.

##### **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 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, “the” – 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.

Further, a respondent's use of a domain name is not considered “fair” if it falsely suggests affiliation with the trademark owner. See [WIPO Overview 3.0](#), section 2.5.1. Here, the dominant element of the disputed domain name corresponds exactly to the Complainants' trademark DAILY MAIL and the Respondent's use of the disputed domain name for a domain parking page with pay-per-click links relating to the Complainant's business (i.e., “Daily Mail Headlines Today”) that ultimately redirect Internet users to direct competitors of the Complainant does not in the circumstances represent a bona fide offering of goods or services. See [WIPO Overview 3.0](#), section 2.9.

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 first notes that the registration of the disputed domain name, which is confusingly similar to the Complainant's famous DAILY MAIL mark, by the Respondent, who is unaffiliated with the Complainant, creates a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4. Although the disputed domain name is composed of three dictionary words, the "dailymail" portion is identical to the Complainant's trademark, and the top search results for both the "dailymail" portion, and the full disputed domain name "thedailymail" on Google all relate to the Complainant's trademark. Further, the use of the article "the" denotes the disputed domain name as referring to "the Daily Mail" of the Complainant, rather than any mail received on a daily basis, e.g., "a daily mail."

Given the fame of the Complainant's trademark and the inclusion of the article "the", the Panel finds that the Respondent likely had knowledge of the Complainant and the Complainant's trademark and registered the disputed domain name with the intent to either sell it to the Complainant at a profit or intentionally attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark.

In addition, by linking the disputed domain name with a parking page displaying pay-per-click links that not only directly allude to the Complainant's trademark and services but also redirect to the Complainant's direct competitors, the Respondent has created a likelihood of confusion and is benefiting commercially from the confusion of Internet users that visit the site by mistake as per paragraph 4(b)(iv) of the Policy.

Furthermore, the Respondent has concealed its identity and failed to submit any response to the Complaint, which are additional evidence of the Respondent's bad faith.

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 <thedailymail.co> be transferred to the Complainant.

*/Kathryn Lee/*

**Kathryn Lee**

Sole Panelist

Date: May 21, 2024