

ADMINISTRATIVE PANEL DECISION

Advance Magazine Publishers Inc. v. Jesse Pui, Ethinkmedia
Case No. D2022-0515

1. The Parties

The Complainant is Advance Magazine Publishers Inc., United States of America (“United States”), represented by Flaster Greenberg P.C., United States.

The Respondent is Jesse Pui, Ethinkmedia, Canada.

2. The Domain Name and Registrar

The disputed domain name <gqbox.com> is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2022. On February 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 16, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the disputed domain name.

The Center verified that the 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 February 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 16, 2022. The Respondent sent informal messages to the Center on March 3, and March 7, 2022. The Center sent a possible settlement email to the Parties on March 7, 2022. The Complainant did not request a suspension of the proceeding for settlement discussions. The Center informed the Parties of its commencement of Panel appointment process on March 18, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on March 23, 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 in the magazine publishing business, in charge (through its unincorporated division, Condé Nast) of the magazines Vogue, Glamour, The New Yorker, Vanity Fair and GQ. GQ was launched in 1957 and is published monthly in the United States, Canada, England, France, Germany, Spain, Brazil, Italy, Republic of Korea, Taiwan Province of China, Japan, Latin America, China, India, South Africa, Portugal and Russian Federation.

In addition to that, the Complainant operates the <gq.com> website which features magazine content, photos, designer profiles, lifestyle and cultural information as well as ads from third parties, receiving over 2 million unique users per month.

The Complainant is the owner, amongst hundreds of others, of the following trademark registrations (Annexes F-1 and F-2 to the Complaint):

- United States trademark registration No. 1298799 for GQ, registered on October 2, 1984, claiming first use in commerce on June 01, 1975, successively renewed, in class 16;
- United States trademark registration No. 1833829 for GQ, registered on May 3, 1994, successively renewed, in class 16;
- Canada trademark registration No. TMA293902 for GQ, registered on August 10, 1984, successively renewed, in class 16; and
- Canada trademark registration No. TMA682278 for GQ, registered on February 23, 2007, successively renewed, in class 41.

The disputed domain name <gqbox.com> was registered on May 31, 2011, and is presently used in connection with a parked webpage displaying pay-per-click ("PPC") links, including links such as "NEW YORK MAGAZINE SUBSCRIPTION" or "NEW YORKER SUBSCRIPTION".

5. Parties' Contentions

A. Complainant

The Complainant asserts to publish the well-known GQ magazine, counting with a global monthly print readership of 10.4 million, a global digital readership of 51.6 million, and 40.5 million social media followers worldwide. In addition to magazines and websites, the Complainant also organizes GQ branded events around the world.

Under the Complainant's view, the Respondent has abusively registered the disputed domain name which consists of the reproduction of the Complainant's well-known GQ trademark with the addition of the descriptive word "box", creating a likelihood of confusion, given that the disputed domain name is being used in connection with a webpage that invites visitors to click links for items entitled "Gift Box," "Dandy Dental Lab" and "Automatic Instagram Post.", offering a variety of different products and services (Annex A.1 to the Complaint).

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (a) the Complainant never granted the Respondent the right to use or register the GQ trademark, either in connection with a domain name registration or a *bona fide* offering of goods and services or for any other reason;
- (b) there is no indication that the term GQ has any relevance to the Respondent's business or that the Respondent has any basis at all relating to the GQ term, not making any valid claim to the GQ trademark; and
- (c) the Respondent is making no legitimate use of the disputed domain name.

As to the registration of the disputed domain name in bad faith, the Complainant asserts that the Respondent registered the disputed domain name for commercial gain and to trade on the Complainant's goodwill and reputation, presently profiting from PPC advertisements. In addition, the Complainant attempted to solve the matter amicably having sent a warning letter to the Respondent on January 25, 2022, not having the Respondent replied, nor denied the facts and allegations made by the Complainant (Annex H to the Complaint).

B. Respondent

The Respondent did not formally reply to the Complaint. In his informal message of March 3, 2022, the Respondent solely stated: "So if they want the domain back, will they pay for it?" and on his message of March 7, 2022, the Respondent wrote: "Just transfer the domain to who? It's not a big deal."

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

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

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has established rights in the GQ trademark duly registered.

The Panel finds that the disputed domain name reproduces the Complainant's mark in its entirety. The addition of the term "box" does not prevent a finding of confusing similarity. 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 the complainant's trademark and the disputed domain name". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's 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) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the Respondent is 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 trademark or service mark at issue.

The Respondent has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent (being the overall burden of proof always with the Complainant, but once the 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).

In that sense, the Complainant indeed states not to have ever granted the Respondent the right to use or register the GQ trademark, either in connection with a domain name registration or a *bona fide* offering of goods and services or for any other reason.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name available at the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Therefore, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name. The second element of the Policy has also been met.

C. Registered and Used in Bad Faith

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain name:

- a) the Complainant's trademark is registered worldwide and is well known;
- b) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by him of the disputed domain name; and
- c) the present use of the disputed domain name in connection with a parked webpage displaying PPC links, along with the Respondent's messages inquiring of payment for the transfer of the disputed domain name to the Complainant, indicates the Respondent's bad faith.

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name.

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 <ggbox.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: March 28, 2022