

ADMINISTRATIVE PANEL DECISION

**Gannett Co., Inc. v. Privacy Service Provided by Witheld for Privacy ehf /
Sameul Sanders, Sam LCC
Case No. D2022-1233**

1. The Parties

Complainant is Gannett Co., Inc., United States of America (“U.S.”), represented by Rankin, Hill & Clark LLP, U.S.

Respondent is Privacy Service Provided by Witheld for Privacy ehf, Iceland / Sameul Sanders, Sam LCC, U.S.

2. The Domain Name and Registrar

The disputed domain name <gannett-us.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 7, 2022. On April 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 8, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on April 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on April 13, 2022.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on April 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 4, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 5, 2022.

The Center appointed Maxim H. Waldbaum as the sole panelist in this matter on May 12, 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 print and digital mass media and marketing solutions company. As evidenced in the Complaint, it is the largest U.S. newspaper publisher as measured by daily circulation. Complainant owns multiple trademark registrations in the U.S. and many other countries for the mark GANNETT including, but not limited to U.S. Reg. No. 3,012,484 for GANNETT, registered on November 8, 2005, in connection with “Newspapers containing news on topics of general interest”, International Class 16; U.S. Reg. No. 2,915,572 for GANNETT registered on January 5, 2005, in connection with “Dissemination of advertising for others via television, newspapers and the Internet; providing information about merchandise for sale and job listings via television, newspapers and the Internet” in International Class 35; and Reg. No 2,852,723 for GANNETT registered on June 15, 2004, in connection with “Providing entertainment services in the nature of television news programs; providing interactive information in the field of general, local and international news, information on movies, theater, television and radio programs, sporting events, concerts, books, museums, exhibitions and festivals, and information on sights and attractions of interest to travelers, via the Internet” in International Class 41. Complainant operates a website using the domain name <gannett.com>.

The disputed domain name was registered on April 5, 2022. As evidenced in the Complaint, the disputed domain name has been used in connection to an email phishing/spear phishing campaign impersonating an officer of the Complainant.

5. Parties’ Contentions

A. Complainant

Complainant has put forward evidence of its rights in the GANNETT trademark, and contends that the disputed domain name incorporates Complainant’s entire GANNETT trademark.

Furthermore, Complainant contends that Respondent is not a licensee or franchisee of Complainant, has no authorization from Complainant to use the GANNETT trademark or register a domain name incorporating the mark, is not commonly known by the disputed domain name, and is not using the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair manner, but rather in connection to an email phishing/spear phishing campaign impersonating an officer of Complainant.

Lastly, Complainant contends that the disputed domain name was clearly registered and used in bad faith, noting that less than an hour after registration the disputed domain name was used to perpetrate a fraud via an email phishing/spear phishing campaign impersonating an officer of Complainant.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Respondent has incorporated the trademark of Complainant in the disputed domain name with an additional term “-us”. Absent the “-us”, the addition of which does not prevent a finding of confusing similarity, the

disputed domain name is identical to Complainant's trademark. By defaulting Respondent has no position contrary to the allegations and contentions of Complainant's Factual Background above.

Accordingly, the Panel finds that Complainant has satisfied the first element and the disputed domain name is confusingly similar to Complainant's trademark.

B. Rights or Legitimate Interests

By defaulting, Respondent has set forth no recognizable rights or legitimate interests to any mark or domain name that includes "gannett". Complainant, on the other hand, has set forth a long and clearly legitimate set of interests in the use and commercialization of the GANNETT name as a trademark and domain name. Respondent is not, and has never been, a licensee or franchisee of Complainant. Respondent has never been authorized by Complainant to register or use Complainant's trademark GANNETT or to apply for or use any domain name incorporating the trademark. Respondent is not commonly known by the disputed domain name. The term "gannett" is not Respondent's name, and Respondent is not and has never been commonly known as "gannett". Respondent is not using the disputed domain name with a *bona fide* offering of goods or services. Respondent does not use its domain name for any legitimate noncommercial use or in a fair manner. Respondent has no website with respect to the disputed domain name. In fact, Respondent is using the disputed domain name in an email phishing/spear phishing campaign that falsely impersonates an officer of Complainant.

Accordingly, the Panel finds Complainant has satisfied the second element and Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

On April 5, 2022, at 11:42 AM EST, Respondent registered the disputed domain name and 50 minutes later began an email phishing/spear phishing campaign impersonating an officer of the Complainant. As evidenced in the Complaint, these emails were sent by Respondent to third parties for no other purpose than to commit/perpetrate a fraud. This conduct and registration has been found to be an improper bad faith registration and its use is clearly in bad faith. See *Graybar Services, Inc v Graybar Elec, Grayberine Lawrence*, WIPO Case No. [D2009-1017](#).

Accordingly, the Panel finds that the third element is met and Respondent registered and is using the disputed domain name in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraph 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <gannett-us.com> be transferred to Complainant.

/Maxim H. Waldbaum/

Maxim H. Waldbaum

Sole Panelist

Date: May 25, 2022