

ADMINISTRATIVE PANEL DECISION

Macmillan Publishers International Limited v. DOMAIN ADMIN, DOMAIN PRIVACY SERVICE FBO REGISTRANT / Bushra Shoaib
Case No. D2022-1825

1. The Parties

The Complainant is Macmillan Publishers International Limited, United Kingdom (“UK”), represented by Stobbs IP Limited, UK.

The Respondent is DOMAIN ADMIN, DOMAIN PRIVACY SERVICE FBO REGISTRANT, United States of America (“United States”) / Bushra Shoaib, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 20, 2022. On May 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 20, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 23, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed a first and second amended Complaint on May 24, 2022.

The Center verified that the Complaint together with the first and second 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 May 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 15, 2022.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on June 21, 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 following facts are undisputed.

The Complainant is a part of the Macmillan publishing group of companies, owned by Holtzbrinck Publishing Group, with offices in over 41 countries worldwide. In nearly two centuries, the Complainant has grown into an international publishing company in academic and trade books with over 10 imprints, and offices in the UK, India, Australia, South Africa, and the United States.

The Complainant owns a global portfolio of trademark registrations comprising MACMILLAN, including but not limited to, the European Union Trade Mark MACMILLAN (word mark), No. 000066225, and with a registration date of March 18, 1998, for goods and services in classes 9, 16 and 41, and a UK trademark MACMILLAN (word mark), No. UK00900066225, with a registration date of March 18, 1998, for goods and services in classes 9, 16, 41, hereinafter together referred to in singular as the "Trademark".

The Complainant is also the owner of several figurative trademark registrations which contain the word element MACMILLAN with wavy lines above this word, in the color red, including but not limited to, the UK trademark with number UK00002555028, with a registration date of January 6, 2012, for goods and services in classes 9, 16 and 41, hereinafter referred to as the "Logo Trademark".

The Domain Name was registered on November 10, 2021, and resolves to a website (the "Website") about publishing, editing, and ghostwriting of books.

5. Parties' Contentions

A. Complainant

Insofar as relevant for deciding this matter, the Complainant contends the following.

The Domain Name is confusingly similar to the Trademark. The Domain Name incorporates the Trademark in its entirety. The additional term "ghostwriting" at the end of the Trademark is the only differentiator between the Trademark and the Domain Name. The word "writing" is descriptive and would be understood by Internet users in the context of books and publications to refer to a publishing activity where publications can be accessed and/or bought over the Internet. The addition of the "ghostwriting" elements to the Trademark, does not alter the overall impression of the domain name in the eyes of an unsuspecting Internet user. Furthermore, the addition of the generic Top-Level Domain ("gTLD") ".com" "is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test", as stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1. Therefore, the Domain Name is confusingly similar to the Trademark.

The Respondent has no rights or legitimate interest in the Domain Name. Bearing in mind the considerable reputation of the Trademark, there is no believable or realistic reason for registration or use of Domain Name other than to take advantage of the Complainant's rights. The Respondent cannot avail itself to the protections of a reseller, because the Respondent is not an authorized or unauthorized reseller of the Complainant. Furthermore, the Respondent is not a licensee of the Complainant. Moreover, by applying the Trademark on the Website and using a logo which is nearly identical to the Logo Trademark, the Respondent is clearly seeking to financially gain from the deception caused, which cannot constitute a *bona fide* offering of goods or services.

The Domain Name was registered and has been used in bad faith. It is evident that the MACMILLAN brands and the Trademark are well-known and it is highly unlikely that the Respondent was unaware of the Trademark at the time of the registration of the Domain Name, especially considering the Respondent has used the word “macmillan” which is identical to the Trademark and used a mark which is nearly identical with the Logo Trademark. The Domain Name is used for the sole purpose of commercial gain riding on the Complainant’s reputation. Therefore, the Domain Name was registered and has been used in bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Noting the burden of proof on the Complainant, the Respondent’s default (*i.e.*, failure to submit a formal response) would not by itself mean that the Complainant is deemed to have prevailed. The Respondent’s default is not necessarily an admission that the Complainant’s claims are true. See in this regard [WIPO Overview 3.0](#), section 4.3 “In cases involving wholly unsupported and conclusory allegations advanced by the complainant, or where a good faith defense is apparent (*e.g.*, from the content of the website to which a disputed domain name resolves), panels may find that – despite a respondent’s default – a complainant has failed to prove its case. Further to paragraph 14(b) of the UDRP Rules however, panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case *e.g.*, where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent”.

A. Identical or Confusingly Similar

The Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the Domain Name must be shown to be identical or confusingly similar to that mark.

The Complainant has shown that it has rights in the Trademark.

As set out in the [WIPO Overview 3.0](#), section 1.7, the first element functions primarily as a standing requirement. The threshold test for confusing similarity between the Domain Name and the Trademark involves a relatively straightforward comparison.

In light of the foregoing, the Panel finds that the Domain Name is confusingly similar to the Trademark. The Domain Name consists of the Trademark, followed by the word “ghostwriting”. The Panel finds that the Trademark is included in its entirety in the Domain Name and that the additional term does not prevent a finding of confusing similarity. As stated in [WIPO Overview 3.0](#), section 1.11.1, the addition of the gTLD “.com” “is viewed as a standard registration requirement and as such is disregarded und the first element confusing similarity test”.

In light of the foregoing, the Panel finds that the Domain Name is confusingly similar to the Trademark.

Therefore, the Panel is satisfied that the first element of the Policy is met.

B. Rights or Legitimate Interests

The Panel has carefully considered the factual allegations that have been made by the Complainant and are supported by the submitted evidence.

In particular, the Respondent has failed to offer the Panel any of the types of evidence set forth in paragraph 4(c) of the Policy from which the Panel might conclude that the Respondent has rights or legitimate interests in the Domain Name, such as:

- (i) use or preparation to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services prior to notice of the dispute; or
- (ii) being commonly known by the Domain Name (as an individual, business or other organization) even if the Respondent has not acquired any trademark or service mark rights; or
- (iii) making legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant submitted in particular that the Website does not provide a *bona fide* offering of goods and services. After carefully considering the arguments brought forward by the Complainant, including the lack of evidence that the Respondent resides at the address included in the Whois information, and after a review of the Website, the Panel concludes that the Website is a sham website, also creating the false impression of a relationship between the Complainant, its reputation on the one hand, and the services offered on the Website, on the other. Would the Website have provided a *bona fide* offering of goods and services, it would have been unthinkable that the Respondent would not have responded to the Complaint, given all the various attempts of the Center to reach the Respondent.

The Panel refers to *Mike Saredidine v. Registration Private, Domains By Proxy, LLC / Alien Liquids*, WIPO Case No. [D2018-2105](#): “First, the offering will not be *bona fide* if the evidence suggests that the Respondent’s intention in establishing and designing its website has been to confuse Internet users into thinking that it is either the Complainant’s website or a website authorized or operated by him. Nor, second, will the Respondent’s offering be *bona fide* if its intention has been to create a sham website, deliberately intended to make it difficult for the Complainant to secure the disputed domain name through proceedings under the Policy”, and “Third, is the evidence of the Complainant’s repute sufficient to establish that it is likely to have come to the attention of the Respondent”.

The Respondent does not seem to be affiliated with the Complainant in any way. There is also no evidence that “macmillan” is the name of the Respondent or that the Respondent is commonly known under the Domain Name. There is also no evidence that the Respondent is, or has ever been, a licensee of the Complainant, or that the Respondent has ever asked, or has ever been permitted in any way by the Complainant to register or use the Trademark, or to apply for or use any domain name incorporating the Trademark.

The Panel therefore finds that the Website effectively impersonates or suggests endorsement by the Complainant, also given the prominent use on the Website of Trademark and the use of a mark similar to the Logo Trademark, the use of official marketing materials, in addition to the lack of an adequate disclosure of the identity of the provider of the Website.

The above use by the Respondent can anyway not be considered as noncommercial or fair use of the Domain Name.

Therefore, the Panel is satisfied that the second element of the Policy is met.

C. Registered and Used in Bad Faith

The Panel finds that the Domain Name was registered and is being used in bad faith.

The Panel refers to its considerations under section 6.B and adds the following.

The mere registration of the Domain Name, which is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Trademark is clearly famous and/or widely known, given *inter alia* the fact that the Complainant has offices in the UK, India, Australia, South Africa, and the United States. The only explanation for the registration of the Domain Name is to attract Internet users for commercial gain or to disrupt the Complainant's relationship with its customers or potential customers.

Therefore, the Domain Name was registered and is being used in bad faith, in particular as the Website purports to be a website for, or otherwise associated with, the Complainant. The unrebutted facts of the case clearly show that the Complainant was or should have been aware of the Trademark and registered the Domain Name with the purpose to mislead Internet users, and subsequently used the Domain Name, in bad faith. In addition to the above and in accordance with the [WIPO Overview 3.0](#), section 3.6, the Panel considers that the fact that the Respondent hid its identity from the public behind a WhoIs privacy service, is additional evidence of a bad faith registration in these circumstances.

Therefore, the Panel is satisfied that the third element of the Policy is met.

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 Domain Name <macmillanghostwriting.com> be transferred to the Complainant.

/Willem J. H. Leppink/

Willem J. H. Leppink

Sole Panelist

Date: July 3, 2022