

ADMINISTRATIVE PANEL DECISION

McGraw Hill LLC v. Nanci Nette, Name Management Group
Case No. D2023-0260

1. The Parties

The Complainant is McGraw Hill LLC, United States of America (“United States”), represented by Leason Ellis LLP, United States.

The Respondent is Nanci Nette, Name Management Group, United States.

2. The Domain Name and Registrar

The disputed domain name <boardsandbeyond.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 19, 2023. On January 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 20, 2023, 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 (Dynadot Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 27, 2023 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 January 31, 2023.

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 February 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2023.

The Center appointed Evan D. Brown as the sole panelist in this matter on March 10, 2023. 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.

On April 3, 2023, the Panel issued a Procedural Order that specifically requested the Complainant to provide additional information concerning the assertion that the Respondent acquired the disputed domain name on August 11, 2022. The Complainant submitted additional information (the “Additional Filing”) on the same day.

4. Factual Background

The Complainant is in the business of providing educational services, with an emphasis on publishing and related services. The Complainant owns the mark BOARDS AND BEYOND, which is the subject of United States Reg. No. 5,616,019 (registered on November 27, 2018 and having an alleged date of first use in commerce at least as early as June 1, 2014). According to the Whois information, the disputed domain name was registered on February 15, 2009. The disputed domain name was used to display click through advertisements for study services for the “USMLE,” which is a test for which the Complainant provides study aid services.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant’s trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

The Complainant submitted a copy of the Whois records for the disputed domain name, which shows that the disputed domain name was first registered on February 15, 2009. In the Amended Complaint, the Complainant asserts that the disputed domain name was registered on September 7, 2018. The Complainant later asserts that the disputed domain name was, “upon information and belief . . . registered . . . long after Complainant’s mark was first used and registered, likely when the Whois record was last updated on August 11, 2022.”

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (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.

A. Identical or Confusingly Similar

This first element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the BOARDS AND BEYOND mark by providing evidence of its trademark registrations.

The disputed domain name incorporates this mark in its entirety. This is sufficient for showing confusing similarity under the Policy.

Accordingly, the Panel finds that the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant asserts that the Respondent is not and has never been a representative or licensee of the Complainant, nor is the Respondent authorized by the Complainant to use its trademarks in the disputed domain name.

The Panel finds that the Complainant has made the required *prima facie* showing. The Respondent has not presented evidence to overcome this *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondent's favor.

Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

C. Registered and Used in Bad Faith

The Panel is guided by [WIPO Overview 3.0](#), section 3.8.1, which reads, in relevant part, as follows:

"[W]here a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent.

* * *

Merely because a domain name is initially created by a registrant other than the respondent before a complainant's trademark rights accrue does not however mean that a UDRP respondent cannot be found to have registered the domain name in bad faith. Irrespective of the original creation date, if a respondent acquires a domain name after the complainant's trademark rights accrue, the panel will look to the circumstances at the date the UDRP respondent itself acquired the domain name.

Facts or circumstances supporting an inference that a change in registrant has occurred may typically include a change in the content of the website to which a domain name directs to take advantage of the complainant's mark. [WIPO Overview 3.0](#), section 3.9."

The Complainant asserts that the disputed domain name was, "upon information and belief . . . registered . . . long after Complainant's mark was first used and registered, likely when the Whois record was last updated on August 11, 2022." In its Additional Filing, the Complainant provided information from the Wayback Machine indicating that the content of the website associated with the disputed domain name changed, purportedly in connection with a change of ownership on August 11, 2022. For example, on December 24, 2021, the disputed domain name was offered for sale for USD 10,000. By August 17, 2022, however, the disputed domain name had been put to different use, linking to competitive websites.

In the absence of any explanation by the Respondent as to why and when it selected the disputed domain name, the Panel credits the assertions of the Complainant to conclude that it is more likely than not that the Respondent acquired the disputed domain name in August 2022, subsequent to the establishment of the Complainant's trademark rights.

The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent "[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [the respondent's] website or location."

In the circumstances of this case, it seems that the Respondent was aware of the Complainant and its registered BOARDS AND BEYOND mark when it acquired the disputed domain name. Mere registration of a domain name that is confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith registration of the disputed domain name. *Government Employees Insurance Company v. Joel Rosenzweig, RegC*, WIPO Case No. [D2021-1221](#). The Panel finds that the Respondent has used the disputed domain name in bad faith by using it to provide click through advertisements for study services competitive to those of the Complainant.

For these reasons, the Panel finds that the Complainant has satisfied this third element under the Policy.

7. Decision

For the foregoing reasons, the Panel orders that the disputed domain name <boardsandbeyond.com> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: April 25, 2023