

ADMINISTRATIVE PANEL DECISION

Associated Newspapers Limited v. Chaudhry Ahsan
Case No. D2023-1192

1. The Parties

The Complainant is Associated Newspapers Limited, United Kingdom, represented by Adlex Solicitors, United Kingdom.

The Respondent is Chaudhry Ahsan, United States of America.

2. The Domain Name and Registrar

The disputed domain name <dailymailofficial.com> (the “Disputed Domain Name”) is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 16, 2023. On March 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 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 (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 20, 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 amendment to the Complaint on the same day.

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 the Respondent of the Complaint, and the proceedings commenced on March 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 17, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on April 24, 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.

4. Factual Background

The Complainant is a United Kingdom based company incorporated in 1905 that acts as the management company and 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 Complainant holds a number of registrations for the mark DAILY MAIL including, for example, United Kingdom Trademark Registration No. UK00001207666, registered in class 16 on November 22, 1983.

The Complainant owns the domain name <dailymail.co.uk>, which it uses to publish its popular online UK newspapers.

The Disputed Domain Name <dailymailofficial.com> was registered on November 10, 2022. The Disputed Domain Name resolves to a website that publishes news articles and advertisements.

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations for DAILY MAIL, and variations of it, as *prima facie* evidence of ownership.

The Complainant submits that “[b]y virtue of its extensive trading and marketing activities ... and its status as a major UK newspaper,” the Complainant’s trademark DAILY MAIL “has acquired substantial reputation and goodwill” and submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the DAILY MAIL trademark and that the similarity is not removed by the addition of the generic word “official”.

The Complainant contends that the Respondent has no authorised rights or legitimate interests in respect of the Disputed Domain Name and that “[t]he Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its trade marks.” The Complainant also contends that “[t]he Respondent has clearly used the [Disputed] Domain [Name] and the Complainant’s trade marks to attract, confuse and profit from internet users seeking the Complainant” and that “[t]here is no evidence that the Respondent has been commonly known by the name comprised in the [Disputed] Domain [Name]”.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules. It submits that the Respondent’s website “includes the Complainant’s contact details in the privacy policy, and states “Copyright © 2023 Daily Mail” at the bottom of the home page, along with use of the Complainant’s “M” logo as a favicon for the website” which, it submits, evidences registration and use of the Disputed Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark DAILY MAIL. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the DAILY MAIL trademark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant's DAILY MAIL trademark; (b) followed by the word "official"; (c) followed by the generic Top-Level Domain ("gTLD") ".com".

It is well established that the gTLD used as technical part of a domain name may be disregarded. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: "dailymailofficial" (see section 1.11.1 of the [WIPO Overview 3.0](#)).

It is also well-established that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

It has long been held by previous Panels that the addition of the word "official" to a trademark does not preclude a finding of confusing similarity to the Complainant's trademark (see, for example: *National Association for Stock Car Auto Racing, Inc. v. Imaging Solutions*, WIPO Case No. [D2001-0777](#) ("the presence of the word "official" does nothing to distinguish the [Disputed] Domain Name from Complainant's mark")).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden of proof on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it has not licensed, permitted or authorized the Respondent to use the Complainant's trademark or to sell its products and for those reasons, the Respondent is not making a *bona fide* offering of goods or services. The Complainant submits that "[t]he Respondent has clearly used the [Disputed] Domain [Name] and the Complainant's trade marks to attract, confuse and profit from internet users seeking the Complainant" and that "[i]t is clear that the Respondent was out for commercial gain."

This Panel accepts that the Respondent is not an authorised reseller with a legitimate interest in a domain name incorporating the Complainant's mark, and there is no disclaimer on the website the Disputed Domain Name resolve to, therefore it cannot meet the tests set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Nor, alternatively, is the Respondent commonly known by the Disputed Domain Name.

The composition of the Disputed Domain Name consists of the Complainant's trademark and the word "official". In this Panel's view, the conduct indicates an awareness of the Complainant and its mark and intent to take unfair advantage of such, which does not support a finding of any rights or legitimate interests (see [WIPO Overview 3.0](#), section 2.5.1).

This Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it is engaging in an illegitimate commercial use of the Disputed Domain Name by suggesting some association with the Complainant and misleading consumers who are seeking out the Complainant's mark DAILY MAIL to opportunistically divert Internet traffic to its web page.

The Panel finds for the Complainant on the second element of the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy that a complainant must also demonstrate is that the disputed domain name in question has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both.

The evidence that the Respondent has registered and used the Disputed Domain Name in bad faith is clear.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the content of the website it resolves to, the Panel is satisfied that the Respondent knew of the Complainant's trademark DAILY MAIL when it registered the Disputed Domain Name.

In addition, the gap of several years between registration of the Complainant's trademark and the Respondent's registration of the Disputed Domain Name, along with the composition of the Disputed Domain Name (containing an exact reproduction of the Complainant's well-known trademark) in the circumstances of this case is a further indicator of bad faith. (See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#)). In this case, the Complainant's rights in its trademark predate any rights that could possibly flow from the Respondent's registration by approximately 39 years.

On the issue of use, the uncontradicted evidence of record is that the Disputed Domain Name was used to resolve to a website with news articles that, the Complainant submits would compete with those published by the Complainant's online publications. In line with prior UDRP panel decisions, the Panel finds that this misconduct is an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (see [WIPO Overview 3.0](#), section 3.1.4).

This Panel finds that the Respondent has taken the Complainant's trademark DAILY MAIL and, along with the word "official," incorporated it in the Disputed Domain Name without the Complainant's consent or authorization. The Panel finds that the Respondent did so for the purpose of capitalizing on the reputation of the trademark by diverting Internet users for commercial gain to its website which falls into the meaning of bad faith under paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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, <dailymailofficial.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: April 29, 2023