

ADMINISTRATIVE PANEL DECISION

Lagardere SA v. AMG Digital Agency
Case No. D2023-2027

1. The Parties

The Complainant is Lagardere SA, France, represented by GPI MARQUES, France.

The Respondent is AMG Digital Agency, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <hachettebookpublishing.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 May 5, 2023. On May 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 8, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 12, 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 May 15, 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”).

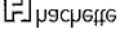
In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 20, 2023.

The Center appointed Knud Wallberg as the sole panelist in this matter on June 26, 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, Lagardère SA, is one of the world's leading companies in the media sector with annual revenue exceeding EUR 6,929 million in 2022. One of the subsidiaries of the Lagardère group of companies is the company HACHETTE BOOK GROUP, which is a leading United States trade publisher.

The Complainant is the owner of a number of trademark registrations of the mark HACHETTE, including but not limited to:

- French trademark No. 1356085, HACHETTE registered on April 25, 1985, and covering goods and services in classes 9, 16, 28, 35 and 41.
- European Union trademark No. 003608551 HACHETTE registered on January 15, 2004, and covering goods and services in classes 9, 16, 28, 35, 38, 41 and 42, and
- International trademark registration No. 1038697,  (H HACHETTE) dated of December 11, 2009, designating United States, Switzerland, China, and Algeria and covering goods and services in classes 9, 16, 28, 35, 38, 41 and 42.

The disputed domain name <hachettebookpublishing.com> was registered on March 27, 2023.

The disputed domain name initially resolved to a website, which purported to be a website for Hachette Book Publishing, *inter alia* by reproducing and imitation of the Complainant's above cited international registration. At the time of filing the disputed domain name resolved to a website, displaying "This Account has been suspended. Contact your hosting provider for more information."

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is highly confusingly similar to the Complainant's trademark HACHETTE, since it reproduces the mark in its entirety. The addition of the terms "book" and "publishing" does not avoid the finding of confusing similarity with the Complainant's trademark. Moreover, this association increases the likelihood of confusion since these terms refer to certain activities of the Complainant and to the service offered under the trademark HACHETTE.

The Complainant further submits that the Respondent has no prior rights or legitimate interests in the disputed domain name, nor is the Respondent affiliated with the Complainant in any way, or has the Respondent been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating said trademark. In addition, the Respondent does not appear to be commonly known by the disputed domain name. The Respondent has no rights or legitimate interests in the disputed domain name since the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy that might demonstrate their rights or legitimate interests in the disputed domain name.

The Complainant finally submits that the disputed domain name was registered and is being used in bad faith. The Complainant thus submits that it is implausible that the Respondent was unaware of the Complainant's reputed mark when it registered the disputed domain name. In addition, the Respondent has used the disputed domain name for scam/phishing purposes since it was used for a fraudulent website that displayed the trademark and logo HACHETTE and with a design that looked an official website. The fact

that the account has been suspended by the hosting provider due to the previous fraudulent use of the disputed domain name supports the Respondent's bad faith use under the UDRP.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the trademark and service mark HECHETTE for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds the mark is recognizable within the disputed domain name, and that the disputed domain name is therefore identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, "book" and "publishing", may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a 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 to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel considers that the record of this case reflects that the Respondent is not 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. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that the Respondent initially used the disputed domain name in an attempt to attract, for commercial gain, Internet users to its websites or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

The fact that the initial website has been suspended and that disputed domain name does not appear to be used actively anymore does not prevent a finding of bad faith in the circumstances of this proceeding. [WIPO Overview 3.0](#), section 3.3.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <hachettebookpublishing.com> be transferred to the Complainant.

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: July 11, 2023