

## **ADMINISTRATIVE PANEL DECISION**

McGraw Hill LLC v. DOMAIN ADMINISTRATOR, Buy this domain on  
Dan.com

Case No. D2023-2241

### **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 DOMAIN ADMINISTRATOR, Buy this domain on Dan.com, United States.

### **2. The Domain Names and Registrar**

The disputed domain names <mcgrawhillemerge.com>, <mcgrawhillsoar.com>, and <mcgrawhillsummit.com> are registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 23, 2023. On May 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 24 and 25, 2023, the Registrar transmitted by emails to the Center its verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Domain Sales c/o Dynadot, and Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 30, 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 Complaint on May 30, 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 June 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 3, 2023.

The Center appointed Angela Fox as the sole panelist in this matter on July 14, 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 long-established publishing company based in the United States. It has carried on its activities under the trademark MCGRAW-HILL since 1909. The Complainant registered the MCGRAW-HILL trademark in 1985, and its use of the mark continues in the form MCGRAW HILL, without a hyphen, in connection with the Complainant's business in the field of educational software, online and digital media education services and publishing services for textbooks and other books.

The Complainant is the owner of the following United States trademark registrations:

- United States Trademark Registration No. 1350345 for MCGRAW-HILL in Class 16, filed on February 1, 1982 and registered on July 23, 1985; and
- United States Trademark Registration No. 4664266 for MCGRAW HILL in Classes 9, 16, 41 and 42, filed on January 25, 2013 and registered on December 30, 2014.

In addition to its MCGRAW-HILL trademarks, the Complainant filed the following trademark applications before the United States Patent and Trademark Office ("USPTO"):

- United States Trademark Application No. 97896570 for MCGRAW HILL EMERGE in Classes 9, 16, 41 and 42, filed on April 19, 2023;
- United States Trademark Application No. 97896582 for MCGRAW HILL SOAR in Classes 9, 16, 41 and 42, filed on April 19, 2023; and
- United States Trademark Application No. 97899058 for MCGRAW HILL SUMMIT in Classes 9, 16, 41 and 42, filed on April 20, 2023.

The disputed domain names were all registered on April 22, 2023. They all resolve to pages advertising the disputed domain names for sale for suggested amounts ranging from USD 1,288 to USD 4,995.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant submits that the disputed domain names are identical or confusingly similar to its registered trademarks. The disputed domain names all incorporate the MCGRAW HILL trademark, with only the removal of the spaces between the words; each individually also incorporates the whole of the MCGRAW HILL EMERGE, MCGRAW HILL SOAR and MCGRAW HILL SUMMIT trademarks, respectively.

The Complainant further submits that the Respondent has no rights or legitimate interests in the disputed domain names. 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 names.

Finally, the Complainant submits that the disputed domain names were registered and have been used in bad faith. The Respondent registered the disputed domain names long after the Complainant's MCGRAW HILL trademark was first used and registered, and within just a few days of the Complainant's United States trademark filings for MCGRAW HILL EMERGE, MCGRAW HILL SOAR and MCGRAW HILL SUMMIT. The Respondent is offering the disputed domain names for sale at inflated prices. The Complainant submits that

the Respondent had the Complainant and its trademarks in mind when registering the disputed domain names and there is no possible good faith use to which the disputed domain names could be put.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions and is in default. No exceptional circumstances explaining the default have been put forward. Therefore, in accordance with paragraphs 14 (a) and (b) of the Rules, the Panel will decide the Complaint and shall draw such inferences as it considers appropriate from the Respondent's default.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

### **A. Identical or Confusingly Similar**

The Complainant has proved that it has registered trademark rights in MCGRAW HILL which pre-date the registration of the disputed domain names.

The disputed domain names include MCGRAW HILL in its entirety, followed only by the words "emerge", "soar" and "summit", respectively, and the generic Top-Level Domain ("gTLD") suffix ".com". As noted in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("the [WIPO Overview 3.0](#)"), at section 1.11.1, the gTLD is a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Under the [WIPO Overview 3.0](#), section 1.7, "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". In this case, the disputed domain names all incorporate the entirety of the Complainant's registered MCGRAW HILL trademark, which is clearly recognizable within the disputed domain names. The addition of the terms "emerge", "soar" and "summit" to the Complainant's MCGRAW HILL trademark does not prevent a finding of confusing similarity according to the [WIPO Overview 3.0](#), section 1.8.

The Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

### **B. Rights or Legitimate Interests**

The burden of proving absence of rights or legitimate interests in a domain name falls on complainants, but UDRP panels have long recognized that the information needed to prove such rights or legitimate interests is normally in the possession of respondents.

In order to avoid requiring complainants to prove a negative, which will often be impossible, UDRP panels

have typically accepted that once a complainant has established a *prima facie* case that a respondent lacks rights or legitimate interests, the respondent carries the burden of proving that it does indeed have such rights or interests (see, *inter alia*, *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#)). In the present case, the Complainant has put forward a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. There is nothing on the record in this case to indicate that the Respondent might have any rights or legitimate interests in them, nor has the Respondent attempted to make out a case that it has. The Complainant has not authorized the Respondent to use the disputed domain names, nor is there any evidence that the Respondent has ever been commonly known by it. The Respondent is not making any commercial or noncommercial use of the disputed domain names, other than to display web pages offering the disputed domain names for sale at prices that far exceed typical domain name registration fees.

Taking all of the above into account, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

### **C. Registered and Used in Bad Faith**

The Complainant has been carrying on business under the MCGRAW HILL mark (initially as MCGRAW-HILL) for over 110 years. The Respondent registered the disputed domain names within just a few days of the Complainant's applications to register MCGRAW HILL EMERGE, MCGRAW HILL SOAR and MCGRAW HILL SUMMIT as trademarks in the United States. The Complainant alleges that the Respondent must have known of the Complainant prior to its registration of the disputed domain names, and that such knowledge prompted the Respondent to register the disputed domain names. The Respondent has made no attempt to rebut this or to provide an explanation for its conduct.

The Panel notes that the Respondent is advertising the disputed domain names for sale for suggested amounts ranging from USD 1,288 to USD 4,995. These sums are far in excess of ordinary domain name registration fees and are likely to significantly exceed the Respondent's out-of-pocket costs in connection with the registration of the disputed domain names.

Under paragraph 4(b)(i) of the Policy, the Panel may find both registration and use in bad faith where the circumstances indicate that the Respondent registered or acquired a domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name.

In addition, under paragraph 4(b)(ii), the Panel may find both registration and use in bad faith where there is evidence that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. Section 3.1.2 of the [WIPO Overview 3.0](#) indicates that a pattern of abuse may be found *inter alia* where a respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners.

Taking into account the Complainant's long-standing use of the MCGRAW HILL trademark, and the Respondent's registration of the three disputed domain names just few days after the Complainant had filed applications to register the trademarks MCGRAW HILL EMERGE, MCGRAW HILL SOAR and MCGRAW HILL SUMMIT, the Panel considers it likely that the Respondent was aware of the Complainant and its trademark, and was targeting the Complainant in registering the disputed domain names. The disputed domain names are inherently confusingly similar to the Complainant's MCGRAW HILL trademark and are, moreover, identical to the Complainant's more recent pending trademark filings for MCGRAW HILL EMERGE, MCGRAW HILL SOAR and MCGRAW HILL SUMMIT. The registration of the disputed domain names appears intended to prevent the Complainant from reflecting its MCGRAW HILL EMERGE, MCGRAW HILL SOAR and MCGRAW HILL SUMMIT marks in corresponding disputed domain names. The Respondent's actions in registering the disputed domain names within just a few days of the Complainant's pending trademark filings, and then offering the disputed domain names for sale at sums likely substantially

exceeding the Respondent's out-of-pocket costs relating to the disputed domain names, appear to be targeted at the Complainant.

The Panel concludes that the Respondent registered and has used the disputed domain names in bad faith under paragraph 4(b)(i) and (ii) 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 names, <mcgrawhillemerge.com>, <mcgrawhillsoar.com>, and <mcgrawhillsummit.com> be transferred to the Complainant.

*/Angela Fox/*

**Angela Fox**

Sole Panelist

Date: August 13, 2023