

ADMINISTRATIVE PANEL DECISION

Associated Newspapers Limited v. alvin costa
Case No. D2023-4069

1. The Parties

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

Respondent is alvin costa, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <mailonline.info> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 28, 2023. On September 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 28, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on October 3, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on October 4, 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 Respondent of the Complaint, and the proceedings commenced on October 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on October 31, 2023.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on November 17, 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

Complainant is a company organized under the laws of the United Kingdom that is the management company and the publisher of a range of publications in the United Kingdom, including the national newspapers "Daily Mail", and "The Mail on Sunday". Complainant runs a website at "www.dailymail.co.uk", which is branded "MailOnline" and which is used to offer a free online newspaper.

Complainant has provided evidence that it is the registered owner of the following trademarks relating to its MAILONLINE brand:

- word/device Trade mark MAILONLINE, European Union Intellectual Property Office ("EUIPO"), registration number: 007487366, registration date: February 17, 2010, status: active;
- word Trade mark MAILONLINE, United Kingdom Intellectual Property Office ("UK IPO"), registration number: UK0002430480A, registration date: August 21, 2006, status: active.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of the United States who registered the disputed domain name on February 1, 2023. The latter resolves to a holding website at "www.mailonline.info", displaying the following message:

"Welcome to nginx! If you see this page, the nginx web server is successfully installed and working. Further configuration is required. For online documentation and support please refer to nginx.org. Commercial support is available at nginx.com. Thank you for using nginx."

Complainant has demonstrated that (1) as at July 6, 2023, mail exchanger ("MX") records had been set up at the disputed domain name and that (2) as at July 19, 2023, the status report for the website under the disputed domain name stated that: "The site mailonline.info contains harmful content, including pages that: Try to trick visitors into sharing personal info or downloading software".

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

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

Notably, Complainant contends that its website for the "Daily Mail" and "The Mail on Sunday" at "www.dailymail.co.uk" is the most popular English language news website and one of the most visited websites in the world.

Complainant submits that the disputed domain name is identical to Complainant's MAILONLINE trademark, disregarding the domain name suffix ".info". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Complainant has no association with Respondent and has never authorized or licensed Respondent to use its MAILONLINE trademark, (2) there is no evidence that Respondent has been commonly known by the disputed domain name, and (3) there is no evidence that Respondent has ever used the disputed domain name at all, except that MX records have been set up thereunder indicating that most likely the disputed domain name has been used for phishing,

malware or in some other illegal manner, as confirmed also by the warning notice in the status report for the website under the disputed domain name. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) it is clear from the massive global fame of Complainant's MAILONLINE trademark that Respondent had Complainant and its business in mind when registering and using the disputed domain name, and (2) insofar as the disputed domain name has been actively used, Respondent has registered and used the latter to confuse, attract and profit from Complainant's customers by creating a likelihood of confusion in the minds of the public as to an association between the Parties.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

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

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that 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.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

A. Identical or Confusingly Similar

First, 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 Complainant has shown rights in respect of the MAILONLINE trademark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.2.1).

The Panel also finds the entirety of Complainant's MAILONLINE trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to this trademark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.7).

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

B. Rights or Legitimate Interests

Second, paragraph 4(c) of the Policy provides a list of circumstances in which 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 Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. Respondent appears to be named "alvin costa", as disclosed by the Registrar, which bears no resemblance to the disputed domain name. Moreover, the Panel has well noted that Respondent so far obviously has neither used the disputed domain name for a *bona fide* offering of goods or services nor for a legitimate noncommercial or fair purpose, but rather passively held it instead. UDRP panels, however, have found that the mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase, does not by itself automatically confer rights or legitimate interests therein (see [WIPO Overview 3.0](#), section 2.10.1). Finally, panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see [WIPO Overview 3.0](#), section 2.13.1).

Here, Complainant has demonstrated that as at July 6, 2023, MX records had been set up at the disputed domain name and that as at July 19, 2023, the status report for the website under the disputed domain name stated that this website contains harmful content and tries to trick visitors into sharing personal info or downloading software, which, in turn, allows to conclude that Respondent, if at all, so far used (or intended to use) the disputed domain name for phishing, malware or in some other illegal manner, which gives no rise to any rights or legitimate interests on the part of Respondent in the disputed domain name.

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

C. Registered and Used in Bad Faith

Third, 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.

In the present case, the Panel notes that Respondent so far obviously has neither used the disputed domain name for a *bona fide* offering of goods or services nor for a legitimate noncommercial or fair purpose, but rather passively held it instead, except that as at July 6, 2023, MX records had been set up at the disputed domain name and that as at July 19, 2023, the status report for the website under the disputed domain name stated that this website contains harmful content and tries to trick visitors into sharing personal info or downloading software, which, in turn, allows to conclude that Respondent, if at all, so far used (or intended to use) the disputed domain name for phishing, malware or in some other illegal manner.

In this context, panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put ([WIPO Overview 3.0](#), section 3.3). Having reviewed the record, the Panel notes (1) the undisputed reputation of Complainant's MAILONLINE trademark, (2) the composition of the disputed domain name which is identical to said trademark, as well as (3) the absence of any explanation as to why Respondent needed to rely on Complainant's MAILONLINE trademark in the disputed domain name, if not to

somehow profit from the reputation connected thereto, and, thus, finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Also, panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) constitutes bad faith ([WIPO Overview 3.0](#), section 3.4). As already laid out above, the fact that as at July 6, 2023, MX records had been set up at the disputed domain name and that as at July 19, 2023, the status report for the website under the disputed domain name stated that this website contains harmful content and tries to trick visitors into sharing personal info or downloading software, allows, in turn, to conclude that Respondent, if at all, so far used (or intended to use) the disputed domain name for phishing, malware or in some other illegal manner.

Finally, it carries weight in the eyes of the Panel that Respondent obviously provided false or incomplete contact information in the Whois register for the disputed domain name since, according to the email correspondence between the Center and the postal courier DHL, the Written Notice on the Notification of Complaint dated October 10, 2023 could not be delivered due to a fake address. This fact at least throws a light on Respondent's behavior which supports the Panel's bad faith finding.

Having reviewed the record, the Panel, therefore, holds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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

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, <mailonline.info>, be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: December 1, 2023