

## **ADMINISTRATIVE PANEL DECISION**

Chicago Tribune Company LLC v. Ryuta Mizuhara  
Case No. D2024-0431

### **1. The Parties**

The Complainant is Chicago Tribune Company LLC, United States of America (“United States”), represented by Media News Group, United States.

The Respondent is Ryuta Mizuhara, Japan.

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

The disputed domain name <chicagotribune.cam> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 26, 2024. On January 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 30, 2024, 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 the Complainant on January 31, 2024, 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 February 2, 2024.

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 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 28, 2024.

The Center appointed José Pio Tamassia Santos as the sole panelist in this matter on March 11, 2024. 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 owns the Chicago Tribune, the highest circulated newspaper in the midwestern United States, and one of the top 10 circulated newspapers throughout the United States. The Chicago Tribune, winner of 27 Pulitzer Prizes, was first published in 1847 and has continued to provide innovative investigative reporting since that time through its daily print publication and online website, located at “www.chicagotribune.com”. The Complainant’s parent company has owned its “www.chicagotribune.com” website since 1998.

The Complainant first registered the CHICAGO TRIBUNE trademark (the “Trademark”), Registration No. 771,167, with the United States Patent and Trademark Office (“USPTO”) on June 9, 1964, and has maintained its registered status since that date. The Trademark is registered in International Class 016 for newspaper and newspaper supplements.

The disputed domain name was registered on November 28, 2023, and it resolves to an inactive website. According to the evidence in the Complaint, the disputed domain name has been used for fraudulent email activities whereby the Respondent has impersonated the Complainant with the intent of diverting funds to itself.

#### **5. Parties’ Contentions**

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

The Complainant contends that the disputed domain name is confusingly similar to its CHICAGO TRIBUNE mark, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the Respondent registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

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

##### **B. Respondent**

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

#### **6. Discussion and Findings**

For this Complaint to succeed in relation to the disputed domain names the Complainant must prove that:

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

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.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The generic Top-Level Domain ("gTLD"), in this case specifically ".cam", does not prevent the finding of confusing similarity. As stated in section 1.11.1 of the [WIPO Overview 3.0](#), "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', and '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test."

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights, and 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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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.

The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks, including its CHICAGO TRIBUNE trademark, nor has the Complainant ever licensed or otherwise authorized the Respondent to apply for or use any domain name incorporating the Trademark.

To the best of the Complainant's knowledge, neither the Respondent nor any other individual, business, or other organization has been commonly known by the disputed domain name.

In the sixty (60) years since the Complainant registered its CHICAGO TRIBUNE trademark with the USPTO, the Complainant has not had knowledge of any demonstrable preparations by the Respondent or any other individual, business, or organization to use the disputed domain name or the CHICAGO TRIBUNE trademark in connection with a bona fide offering of goods or services.

The Respondent has not made a legitimate noncommercial or fair use of the disputed domain name. As of the date of this Complaint, the Respondent has not displayed any content on the disputed domain. The Complainant provides evidence that the Respondent set up the disputed domain for the purpose of creating associated email addresses to mislead the Complainant's clients into believing they were communicating with the Complainant for the Respondent's financial gain. Such illegal use can never confer rights or legitimate interests onto a respondent in a domain name. [WIPO Overview 3.0](#), section 2.13.

In the circumstances, the Panel finds that the Respondent does not have any rights or legitimate interests in respect of the disputed domain name and 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.

In the present case, the Panel notes that the Respondent had actual knowledge of the Complainant's ownership of the CHICAGO TRIBUNE trademark for the previous 60 years and intended to capitalize on the goodwill associated with the Complainant's Trademark.

The Complainant alleges that the Respondent obtained the disputed domain for the sole purpose of deceiving the Complainant's customers and vendors and profiting from such deception.

The evidence demonstrates that the Respondent was using the disputed domain name in connection with fraudulent activities. The Complainant has provided evidence indicating that the Respondent is using the disputed domain name to engage in deceptive emails activities, including impersonating the Complainant to divert funds.

The Complainant alleges that the Respondent purchased the disputed domain in bad faith in order to deceive the Complainant's customers and clients into believing they were communicating with the Complainant for the purpose of maliciously diverting funds intended for the Complainant, as has already occurred.

Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <chicagotribune.cam> be transferred to the Complainant.

*/José Pio Tamassia Santos/*

**José Pio Tamassia Santos**

Sole Panelist

Date: March 25, 2024