

ADMINISTRATIVE PANEL DECISION

Scribd, Inc. v. mujeeb ahmad
Case No. D2024-0846

1. The Parties

The Complainant is Scribd, Inc., United States of America (“US” or “United States”), represented by IPLA, US.

The Respondent is mujeeb ahmad, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <scribd downloader.pro> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 27, 2024. On February 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 27, 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 February 28, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

The Respondent sent email communications to the Center on February 28 and 29, 2024, to which the Center acknowledged receipt and notified the Parties about a possible settlement. The Complainant filed an amendment to the Complaint on March 1, 2024, in which it also requested a suspension of the UDRP proceeding. The Center notified the suspension of the administrative proceeding on March 4, 2024, for purposes of settlement discussions concerning the Disputed Domain Name, due until April 3, 2024. The Complainant requested the reinstatement of proceedings on April 5, 2024. The Respondent sent an email communication to the Center on April 6, 2024, to which the Center acknowledged receipt. The Center notified the Parties about the reinstatement of proceeding on April 8, 2024.

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 April 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 29, 2024. The Respondent sent an email communication to the Center on April 17, 2024, to which the Center acknowledged receipt and notified the Parties about a second possible settlement. The Complainant requested the continuation of proceedings on May 2, 2024.

The Center appointed Michael D. Cover as the sole panelist in this matter on May 10, 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 is the proprietor of 40 trademark registrations and 4 pending applications for its SCRIBD trademark worldwide for use in connection with a wide variety of computer, electronic and software related goods. These trademark registrations include:

United States No. 3777227 SCRIBD, registered on April 20, 2010 (claimed first use 2007) in classes 9, 35, 38, and 42.

United States No. 5898302 SCRIBD, registered on October 29, 2019 (claimed first use 2013) Classes 9, 35, and 42.

The Complainant has an official website at “www.scribd.com”.

The Disputed Domain Name was registered on December 11, 2023. According to the evidence presented by the Complainant, the website reachable through the Disputed Domain Name purported to offer a tool for downloading content from the Complainant’s website without subscribing.

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.

Identical or Confusingly Similar

Notably, the Complainant contends that the Disputed Domain Name is nearly identical to the Complainant’s SCRIBD trademarks and the Complainant’s domain name <scribd.com>. The Complainant submits that the Disputed Domain Name is nearly identical or confusingly similar to the Complainant’s registered trademarks, because the Disputed Domain Name incorporates the Complainant’s SCRIBD in its entirety.

The Complainant notes that prior Panels have recognized that the incorporation of a mark in its entirety can be sufficient to establish that a domain name is identical or confusingly similar to a complainant’s registered trademark and cites in support section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0.](#)”)

The Complainant notes that the addition of the descriptive term such as “downloader” does not distinguish the Disputed Domain Name from the Complainant’s SCRIBD trademark and that past Panels found a likelihood of confusion where the mere addition of a descriptive term such as “downloader” to a complainant’s trademark is insufficient to avoid confusion. The Complainant also notes that past Panels have found that adding on terms suggestive of a complainant’s goods and services can enhance the

potential for confusion. Here, the Complainant submits that the addition of the descriptive term “downloader” does nothing to distinguish the Disputed Domain Name and instead further enhances the potential for confusion, because the term is commonly associated with apps such as the Complainant’s.

The Complainant concludes that the Disputed Domain Name is identical and confusingly similar to the Complainant’s SCRIBD trademarks.

Rights or Legitimate Interests

The Complainant notes that the Disputed Domain Name was registered on December 11, 2023, which was well after the Complainant’s first use of the SCRIBD trademarks in 2007. The Complainant also notes that the Disputed Domain Name appears to offer a “Free Scribd Downloader” tool that allows users to download content available on the Complainant’s platform, without subscribing by acting as a proxy and manipulating the URL link. The Complainant further notes that the Disputed Domain Name redirects to a secondary domain containing the SCRIBD trademark, which website contains a functional tool for downloading content of the Complainant, as well as redirecting to pop-up ads. The Complainant submits that this use does not represent a legitimate or bona fide offering of goods and services.

The Complainant continues that the Complainant has never authorized the Respondent to use its SCRIBD trademarks in connection with any goods or services and that nothing suggests that the Respondent is commonly known by the Disputed Domain Name.

The Complainant concludes that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

Registered and Used in Bad Faith

The Complainant notes that its SCRIBD trademark registrations date back to at least as early as 2006 and submits that bad faith can be found where a domain name is so obviously connected with a well-known trademark. The Complainant notes that, upon registering the nearly identical Disputed Domain Name, the Respondent began advertising to users the ability to download SCRIBD documents for free and using the Disputed Domain Name to redirect users to third party websites and pop-up advertisements for its own commercial gain.

The Complainant concludes that the Disputed Domain Name was registered and is being used in bad faith.

Remedy requested by the Complainant

The Complainant requests that the Panel decide and order that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

The Respondent did not reply with a formal Response to the Complainant’s contentions, although the Respondent did send email communications on February 28 and February 29, 2024, stating that the Respondent deleted the Disputed Domain Name, and another on April 6, 2024, in which the Respondent stated that the Disputed Domain Name was now offline.

6. Discussion and Findings

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and that 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 Complainant's trademark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the Complainant's SCRIBD trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, such as "downloader", may bear on assessment of the second and third elements, the Panel finds the addition of such term does 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.

Also, the addition of the generic Top-Level Domain ("gTLD") ".pro" does not prevent a finding of confusing similarity, as the addition of the gTLD is a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.1.

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.

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.

Having reviewed the available 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 such as those enumerated in the Policy or otherwise and there is no evidence that the Complainant has authorized the Respondent to use the Complainant's SCRIBD trademark. Moreover, the composition of the disputed domain name, and its use, reflect the Respondent's intent to target and pass-off as the Complainant, which cannot vest in the Respondent rights or legitimate interests.

The Panel finds the second element of the Policy has been established.

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.

It is a reasonable inference that the Respondent knew of the Complainant's well-known business and trademark SCRIBD and reputation at the time of registration of the Disputed Domain Name, particularly noting that the use of the Disputed Domain Name by the Respondent involves a website that promotes products and services which purport to be those of the Complainant. Such use falls squarely within the non-exhaustive examples of registration and use in bad faith provided within Policy paragraph 4(b), namely, that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site at the disputed domain name.

Having reviewed the record, the Panel finds that the Respondent has registered and is using the Disputed Domain Name in bad faith.

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 <scribdownloader.pro> be transferred to the Complainant.

/Michael D. Cover/

Michael D. Cover

Sole Panelist

Date: May 24, 2024