

ADMINISTRATIVE PANEL DECISION

Macmillan Publishers International Limited v. Ismail Nakhuda
Case No. D2024-1658

1. The Parties

The Complainant is Macmillan Publishers International Limited, United Kingdom, represented by NORDEMANN DE, Germany.

The Respondent is Ismail Nakhuda, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <macmilanpublishers.com> (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 April 19, 2024. On April 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 19, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 22, 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 April 26, 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 May 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2024. The Respondent sent email communications to the Center on May 3, 2024. The Parties agree to suspend the proceeding, and the Center sent the notification of suspension on May 8, 2024. Email communications were received from the Respondent on May 9 and 11, 2024. The Parties did not reach an agreement and the proceeding was reinstated on May 13, 2024, upon the Complainant’s request.

The Center appointed Nicholas Weston as the sole panelist in this matter on June 3, 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.

Additional email communications were received from the Respondent on June 3, 5, and 12, 2024.

4. Factual Background

The Complainant is incorporated in the United Kingdom and operates a global book publishing business. The Complainant holds registrations for the trademark MACMILLAN and variations of it globally, including, inter alia, Registration No. UK00001102865 for MACMILLAN dated October 12, 1978.

The Complainant operates the domain name <macmillan.com> as its main online retail website.

The Respondent registered the Disputed Domain Name on October 20, 2023. The Disputed Domain Name resolves to a website displaying the MACMILLAN trademark and books and publications published by the Complainant.

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 cites its trademark registrations around the world for the mark MACMILLAN and variations of it, as prima facie evidence of ownership.

The Complainant submits that its rights in that the mark MACMILLAN mark predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name is comprised of a misspelling of the MACMILLAN trademark, with the letter "l" omitted, and that the addition of the word "publishers" is not sufficient to avoid the confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the "the Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the Disputed Domain Name or to seek the registration of any domain name that is confusingly similar to the Complainant's Trademarks. The Respondent is not commonly known by the Disputed Domain Name," and that none of the circumstances set out in paragraph 4(c) of the Policy apply.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to the prior use and well-known nature of the Complainant's trademark, and advances the argument that the use of the Disputed Domain Name to purport to imitate the Complainant's website demonstrates an attempt to mislead the public and is use in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions. Beyond inquiring as to the nature of the emails it was receiving, the Respondent stated that, "we have no issue in transferring the domain to the Complaint, but as per law we purchased the domain, from Namecheap.com as it was available, and there

was no Infringement in this". The Respondent further elaborated that, "WE have legal rights to sell the domain. Though we are taking a good will gesture, That Complaints can purchase the domain from us. if they wish". In its last communications following the appointment of the Panel, the Respondent has raised whether "Pakistan Falls into WIPO or UDRP or whatever?".

6. Discussion and Findings

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

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

6.1 Preliminary Issue: Consent to Remedy

While it seems that the Respondent has seemingly agreed to transfer the disputed domain name to the Complainant and a suspension of the proceeding was issued for purposes of allowing the Parties to pursue settlement negotiations, in line with paragraph 17(a) of the Rules, the Complainant ultimately requested reinstatement of the proceedings due the inability of the Parties to reach a settlement.

Accordingly, in view of the Complainant's request for the reinstatement of the proceedings and the Respondent's apparent disavowal of any bad faith intent, the Panel will proceed with a decision on the substantive merits.

6.2 Preliminary Issue: Applicability of the Policy

In the Respondent's late communications of June 3 and 5, 2024, the Respondent has raised whether Pakistan falls within the scope of the Policy.

The Panel notes that the Respondent's reported location disclosed by the Registrar is in the United States, which raises a question as to the genuine nature of the information reported by the Respondent.

Nevertheless, the Panel notes that the Policy is incorporated into the Respondent's registration agreement for the disputed domain name, as confirmed by the Registrar, and as such, the Respondent is subject to the Policy. There mere availability of a domain name does not entitle a registrant to register a domain name and the Panel notes that paragraph 2 of the Policy includes a representation by a domain name registrant that "the registration of the domain name will not infringe upon or otherwise violate the rights of any third party".

6.3 Substantive Issues:

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 Names. 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. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark MACMILLAN in several countries.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the MACMILLAN trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) the Complainant's trademark MACMILLAN with one letter "l" omitted; (b) followed by the word "publishers"; (c) followed by the generic Top-Level Domain ("gTLD") ".com".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11. The relevant comparison to be made is with the second-level portion of each of the Disputed Domain Name, specifically: "macmilanpublishers".

The Panel finds that the mark is recognizable within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the word "publishers", 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.

A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9.

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.

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 Disputed 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. Rather, the Respondent's emails reflect a general interest in profiting from the resale of the disputed domain name to the Complainant, which does not vest in the Respondent rights or legitimate interests.

The Panel notes the evidence that the Disputed Domain Name resolves to a webpage that imitates the Complainant's main website branding and content and finds that this does not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the evidenced reputation and goodwill

of the Complainant's mark or capacity to otherwise mislead Internet users. Rather, such impersonating use can never confer rights or legitimate interests upon a respondent. [WIPO Overview 3.0](#), section 2.13.

The Panel also notes that the Disputed Domain Name contains the word "publishers", which this Panel accepts the Complainant's submission that this creates the false impression that Respondent's website is related to, authorized by, or affiliated with Complainant, particularly considering the business the Complainant is engaged in.

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

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the well-known nature of the Complainant's trademark, the Panel is satisfied that the Respondent knew of and targetted the Complainant's trademark MACMILLAN when it registered the Disputed Domain Name. The Complainant has held registered rights in the mark for at least 46 years based on details of the trademarks evidenced with the Complaint, and for at least 5 years more, according to its submissions. The Complainant has been in business since 1843. It is a well-known brand.

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name other than to trade off the reputation and goodwill of the Complainant's well-known trademark. [WIPO Overview 3.0](#), section 3.1.4.

On the issue of use, the Complainant's evidence is that the Disputed Domain Name resolves to a website seemingly impersonating the Complainant and where Internet users can supposedly purchase MACMILLAN branded publications.

Panels may take into account particular circumstances in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the Disputed Domain Name such as here where a typo of a widely-known mark is the case, and incorporating an additional term such as a descriptive word "publishers" that corresponds to the Complainant's area of activity, (ii) the chosen Top-Level Domain that also corresponds to the Complainant's area of business activity with its own ".com" website, (iii) the content of the website at the dispute domain name that copies the Complainants own content and branding, and (iv) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name. [WIPO Overview 3.0](#), section 3.2.1. In the circumstances, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

Based on the available record, 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 <macmilanpublishers.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: June 13, 2024