

ADMINISTRATIVE PANEL DECISION

California Newspapers Partnership v. kail dave, ocregister
Case No. D2024-1717

1. The Parties

Complainant is California Newspapers Partnership, United States of America (“United States” or “U.S.”), represented by Lindsay Nakagawa, United States.

Respondent is kail dave, ocregister, United States.

2. The Domain Name and Registrar

The disputed domain name <ocregisterjobs.com> (the “Domain Name”) is registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 24, 2024. On April 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 25, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Privacy Protect LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on April 25, 2024, 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 April 25, 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 Respondent of the Complaint, and the proceedings commenced on April 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 17, 2024.

The Center appointed John C. McElwaine as the sole panelist in this matter on May 30, 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

Complainant is a publisher of newspapers in the state of California. Complainant's publications include the "Orange County Register", first published in 1905 as the "Santa Ana Daily Register", with a subsequent name change to "Orange County Register".

Relevant to this matter, Complainant submits to own the trademark THE ORANGE COUNTY REGISTER with the United States Patent and Trademark Office (USPTO) No. 76093379 in 2002 in International Class 16 for "newspaper for general circulation".¹

On April 4, 2024, Respondent registered the Domain Name. At the time of filing the Complaint, the Domain Name was being used for emails to perpetrate a fraudulent employment scheme.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

With respect to the first element of the Policy, Complainant alleges that it owns a United States trademark registration for ORANGE COUNTY REGISTER. In addition, Complainant asserts that its Orange County Register publication is regularly known by the general public as OC Register. Complainant claims common law trademark ownership of the OC Register tradename through its long-term continued use. In addition, Complainant points out that its parent company, MediaNews Group, Inc., is the registrant of <ocregister.com>, which was registered on May 5, 1995. Complainant contends that since that date, The Orange County Register newspaper has continued to publish daily news content accessible from this domain name. Complainant also asserts use of the trademark OC Register on its social media accounts. Complainant's common law trademark rights are referred to herein as the "OC REGISTER Mark". Complainant alleges that the Domain Name is confusingly similar to its OC REGISTER Mark.

With respect to the second element of the Policy, Complainant asserts that Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks, nor has Complainant ever licensed or otherwise authorized Respondent to apply for or use any domain name incorporating Complainant's trademarks. Complainant further alleges that neither Respondent nor any other individual, business, or other organization has been commonly known by the Domain Name and that Complainant has not come across any evidence of Respondent's use of, or demonstrable preparations to use, the Domain Name. Instead, Complainant asserts Respondent registered the Domain Name to create associated email addresses to solicit sensitive personal information from potential job candidates by posting fake job advertisements.

With respect to the third element of the Policy, Complainant alleges that Respondent created email addresses associated with the Domain Name (such as "[name]@ocregisterjobs.com") and that these email addresses were used to impersonate Complainant and send fake job postings for positions such as "Junior Web Developer". In addition, Complainant claims that job seekers, believing they were applying for jobs associated with Complainant, contacted these email addresses and potentially submitted personal information and Respondent even offered fake employment to some applicants, potentially requesting further personal details.

¹The Panel notes that on May 22, 2024, the trademark was assigned to ORB Publishing, LLC.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Although Respondent defaulted, to succeed in this proceeding, paragraph 4(a) of the Policy requires Complainant to prove its assertions with evidence demonstrating:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); and see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires Complainant show that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights. In this matter, Complainant alleges unregistered trademark rights in OC REGISTER Mark based upon its use of the Domain Name <ocregister.com> and several social media account names that use "OC Register". With respect to common law trademark rights, the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.3 states that "to establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services."

Complainant has established use of OC REGISTER as a trademark and, in addition, Complainant provided evidence that Respondent must have intentionally targeted Complainant by engaging in an employment offer scheme where Respondent used Complainant's registered ORANGE COUNTY REGISTER trademark, its <ocregister.com> domain name and falsely claimed to be representatives of Complainant. See [WIPO Overview 3.0](#), section 1.3 ("The fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier.") On the basis of this intentional targeting of Complainant's name and reputation by Respondent, the Panel finds that Complainant has established unregistered trademark rights in the OC REGISTER Mark. The Panel also finds that this mark is recognizable within the Domain Name. Accordingly, the Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

B. Rights or Legitimate Interests

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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the 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 Domain Name such as those enumerated in the Policy² or otherwise.

As an initial matter, there is no evidence that Respondent is commonly known by the Domain Name. The Panel therefore finds, based on the record and the lack of evidence otherwise, that Respondent is not commonly known by the Domain Name, which was most likely usurped in furtherance of Respondent's fraudulent scheme to impersonate Complainant. See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#) ("the Panel notes that the respondent's name is "Bestinfo" and that it can therefore not be "commonly known by the Domain Name.")

The Panel finds that the purpose of registering the Domain Name was to engage in a fraudulent employment offer scheme, which is not a bona fide offering of goods or services. [WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically 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 also, *Startup Group v. Whois Agent, Domain Protection Services, Inc. / Dominique Geffroy*, WIPO Case No. [D2020-3303](#) (finding an employment offer scam to be an example of use of a domain name for the illegitimate purpose of impersonating the complainant in the furtherance of a fraudulent scheme).

The Panel finds that Respondent does not have rights or legitimate interests in the Domain Name and that Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Here, the evidence demonstrates that Respondent registered the Domain Name to perpetrate a fraudulent scheme. Complainant's OC REGISTER Mark was intentionally chosen when the Domain Name was registered with the intent to impersonate Complainant for the purpose of making fraudulent employment offers. Knowledge of Complainant's business and its OC REGISTER Mark is established by the use of Complainant's ORANGE COUNTY REGISTER publication and its actual domain name in the header of the fake job ads and in signature lines of the fraudulent emails. In light of the evidence proving the fraudulent use of the Domain Name, there could be no other legitimate explanation except that Respondent intentionally registered the Domain Name to cloak its actions and deceive recipients into believing the emails were from Complainant. Such activity constitutes a disruption of Complainant's business and also establishes bad faith registration and use. *Securitas AB v. Whois Privacy Protection Service, Inc. / A. H.*, WIPO Case No. [D2013-0117](#) (finding bad faith based upon the similarity of the disputed domain name and

² The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name: "(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

the complainant's mark, the fact that the complainant is a well-known global security company and the fact that the disputed domain name is being used to perpetrate an email scam.) In addition, registering a domain name with false contact details is commonly held to be bad faith under the Policy. See *Hermes International v. Jack Yong*, WIPO Case No. [D2017-1959](#) ("the fact of a non-existent postal address is difficult to explain"); *TBWA Worldwide, Inc. v. Karim Bendali*, WIPO Case No. [D2019-1932](#) (the postal address revealed by the Registrar was not accurate).

The use of the Domain Name to conduct fraud constitutes a disruption of Complainant's business and also establishes bad faith registration and use pursuant to paragraph 4(b)(iii) of the Policy. *Securitas AB v. Whois Privacy Protection Service, Inc. / A. H.*, WIPO Case No. [D2013-0117](#) (Finding bad faith based upon the similarity of the disputed domain name and the complainant's mark, the fact that the complainant is a well-known global security company, and the fact that the disputed domain name is being used to perpetrate an email scam.) As discussed above, Respondent used several other indicia of Complainant in addition to the Domain Name when communicating with third parties with the fraudulent purpose of misleading such job seekers. In light of the actions undertaken by Respondent, it is inconceivable that Respondent coincidentally selected the Domain Name without any knowledge of Complainant. See e.g., *Arkema France v. Steve Co., Stave Co Ltd.*, WIPO Case No. [D2017-1632](#).

In finding a disputed domain name used only for an email scam was bad faith, the panel in *Kramer Law Firm, P.A. Attorneys and Counselors at Law v. BOA Online, Mark Heuvel*, WIPO Case No. [D2016-0387](#), pointed out that numerous UDRP panels have found such impersonation to constitute bad faith, even if the relevant domain names are used only for email communications. See, e.g., *Terex Corporation v. Williams Sid, Partners Associate*, WIPO Case No. [D2014-1742](#) ("Respondent was using the disputed domain name in conjunction with...an email address for sending scam invitations of employment with Complainant"); and *Olayan Investments Company v. Anthono Maka, Alahaji, Koko, Direct investment future company, ofer bahar*, WIPO Case No. [D2011-0128](#) ("although the disputed domain names have not been used in connection with active web sites, they have been used in email addresses to send scam emails and to solicit a reply to an 'online location'").

For the reasons set forth above, the Panel holds that Complainant has met its burden under paragraph 4(a)(ii) of the Policy and has established that Respondent registered and is using the Domain Name in bad faith.

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 Domain Name <ocregisterjobs.com> be transferred to Complainant.

/John C McElwaine/
John C McElwaine
Sole Panelist
Date: June 13, 2024