

## **ADMINISTRATIVE PANEL DECISION**

### **Macmillan Publishers International Limited v. Junaid Ahmed Jones Case No. D2024-2505**

#### **1. The Parties**

The Complainant is Macmillan Publishers International Limited, United Kingdom, represented by Nordemann Czychowski & Partner Rechtsanwältinnen und Rechtsanwälte mbB, Germany.

The Respondent is Junaid Ahmed Jones, Pakistan.

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

The disputed domain name <macmillanbookwriters.com> is registered with GoDaddy.com, LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 19, 2024. On June 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 20, 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 (UNKOWN) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 21, 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 amendment to the Complaint on June 26, 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 July 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 25, 2024.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on August 2, 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 was established in 1843, and it is currently part of the Holtzbrinck Publishing Group, a large family-owned media company headquartered in Stuttgart, Germany. The Complainant operates internationally in the field of publishing under the brand MACMILLAN, and offers its products and services offline as well as online, inter alia, at <us.macmillan.com>.

The Complainant owns various trademark registrations for the brand MACMILLAN as well as for a logo consisting of a double letter “M” formed with two wavy lines, including:

- European Union Trademark Registration No. 000066225, MACMILLAN, word, registered on March 18, 1998, in Classes 9, 16, and 41;
- United Kingdom Trademark Registration No. UK00002555028, MACMILLAN, figurative, registered on January 6, 2012, in Classes 9, 16, and 41, with the following representation:



- European Union Trademark Registration No. 000066167, device, registered on March 18, 1998, in Classes 9, 16, and 41, for the following logo:



(hereinafter referred as the “MACMILLAN mark” and the MACMILLAN logo”, respectively).

Prior decisions under the Policy have recognized the reputation of the MACMILLAN mark in the publishing industry. <sup>1</sup>

The Complainant and its group further owns various domain names corresponding to its MACMILLAN brand, including <macmillan.com> (registered on August 11, 1994), <macmillanlearning.com> (registered on June 4, 2015) and <panmacmillan.com> (registered on April 17, 1997), which resolve to the Complainant’s corporate websites.

The disputed domain name was registered on June 2, 2023, and it resolves to a website, in English language, that purportedly offers book-writing services, including ghostwriting, book editing, book publishing, and book marketing. This website displays at its heading the term “Macmillan” in black, accompanied by a logo consisting of two wavy lines in red color, and behind the term “Macmillan”, in smaller red color letters, the terms “book writers”. The favicon of this website reproduces the same logo included at its heading, consisting of two red wavy lines. The “Terms & Conditions” and “Privacy Policy” sections of this website include no content, and redirect to the home page. This website displays a telephone number, an address in California, United States of America (“United States”), and a contact form. The website does not refer to the owner of the site or that of the disputed domain name, and it does not indicate its lack of relationship with the Complainant.

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<sup>1</sup>See, among others, *HM Publishers Holdings Limited v. Webserve LLC*, WIPO Case No. [D2005-0741](#); *HM Publishers Holdings Ltd v. Domainproxyagent.com / Compsys Domain Solutions Private Limited*, WIPO Case No. [D2008-1620](#); *HM Publishers Holdings Ltd v. Marcus Costa Camargo Peres Limited*, WIPO Case No. [D2013-1597](#); *Macmillan Publishers International Limited v. DOMAIN ADMIN, DOMAIN PRIVACY SERVICE FBO REGISTRANT / Bushra Shoaib*, WIPO Case No. [D2022-1825](#); and *Macmillan Publishers International Limited v. Privacy Service Provided by Withheld for Privacy ehf / Mary Fortenbaugh, PubHub*, WIPO Case No. [D2022-1826](#).

## 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 contends that the disputed domain name is confusingly similar to the MACMILLAN mark, as it incorporates this trademark in its entirety with the addition of the descriptive terms "book writers". The disputed domain name creates a false impression of affiliation to or endorsement by the Complainant, enhanced by the content of the Respondent's website that reproduces the Complainant's trademark as well as a very similar logo, the Complainant's brand image, the same color combination (red, white and black) and the general design of the Complainant's website at "us.macmillan.com".

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by and has no trademark rights for the term "Macmillan", he has not been authorized to use the Complainant's trademarks and has no relationship with the Complainant or its group of affiliated companies. The requirements indicated in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) are not met, as the Respondent's website includes no clear statement indicating its lack of relationship with the Complainant. The use of the disputed domain name in connection to a website that reproduces the Complainant's trademarks and brand image cannot be considered a bona fide offering of goods or services under the Policy. Such use generates confusion, mislead Internet users, and constitutes an attempt of impersonation or passing off that can never confer rights or legitimate interests.

The disputed domain name was registered and is being used in bad faith. The disputed domain name was registered with the purpose of fraudulently misleading consumers in order to obtain unfair advantage from the MACMILLAN mark's reputation. The Respondent's website imitates the Complainant's trademarks, its logo, trade name and general brand image, in an obvious intention to create confusion to generate traffic to this site.

### B. Respondent

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

## 6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, inter alia, in paragraph 10 of the Rules.

### 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 MACMILLAN mark is reproduced within the disputed domain name with the addition of the terms "book writers". The mark is recognizable within the disputed domain name, and the generic

Top-Level-Domain (“gTLD”), “.com”, does not prevent a finding of confusing similarity under the Policy. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7., and 1.11.

Although the addition of other terms here, the terms “book writers”, may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

Therefore, 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.

The Panel finds no evidence in the record that may suggest the Respondent has rights or legitimate interests in respect of the disputed domain name.

The Panel notes the term “Macmillan” is a Scottish surname, and it does not share any similarities with the Respondent’s name revealed by the Registrar verification. The Panel, under its general powers, has further corroborated, with a search over the Global Brand Database, that, as the Complainant’s alleges, the Respondent owns no trademark rights over the term “Macmillan” or the terms “Macmillan book writers”.

The Panel finds the composition of the disputed domain name indicates targeting of the Complainant, and generates confusion with the Complainant, its trademarks, and its publishing business. The disputed domain name gives the impression of being owned by or referring to the Complainant’s business in the publishing industry, as another part of its services related to this industry, or as the website of an affiliated company in the Complainant’s group. [WIPO Overview 3.0](#), section 2.5.1.

The Panel further finds the use of the disputed domain name corroborates the targeting and the intention to generate confusion or affiliation with the Complainant, its trademarks and its business. The Respondent’s website reproduces the MACMILLAN mark, imitates the Complainant’s double “M” registered logo, and the general design, brand image, color combination, and look and feel of the Complainant’s corporate website at <us.macmillan.com>.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Therefore, the Panel 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 MACMILLAN mark is internationally used, sufficiently distinctive, and widely known in the publishing industry. Prior decisions under the Policy have recognized the international reputation of the MACMILLAN mark.<sup>2</sup>

The Panel further notes nothing in the record indicates the Respondent has rights or legitimate interests in respect of the disputed domain name, and the term “Macmillan” shares no similarities with the Respondent’s name.

The use of the disputed domain name corroborates the Respondent’s bad faith, as the Respondent’s website reproduces and imitates the Complainant’s trademark, its logo, and its general brand image, as well as the look and feel of the Complainant’s corporate website at <us.macmillan.com>, and this mimic site refers to the same or related services provided by the Complainant.

Panels have held that the use of a domain name for illegal activity here, impersonation/passing off, or other types of fraud, 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 further considers the nature of the disputed domain name, which is confusingly similar to the MACMILLAN mark and incorporates terms related to the same industry where this trademark is reputed, reflects the purposeful composition of the disputed domain name targeting the Complainant and its trademark to generate confusion and create a misleading domain name. See [WIPO Overview 3.0](#), sections 3.1.4 and 3.2.1.

Accordingly, based on the evidence presented, the Panel finds the Respondent registered and is using the disputed domain name in bad faith to create confusion and mislead Internet users with the intention to generate traffic to the Respondent’s website, which constitutes bad faith under the paragraph 4(b)(iv) of the Policy.

Therefore, 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 <macmillanbookwriters.com> be transferred to the Complainant.

*/Reyes Campello Estebarez/*

**Reyes Campello Estebarez**

Sole Panelist

Date: August 9, 2024

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<sup>2</sup>See Footnote No. 1, *supra*.