

## **ADMINISTRATIVE PANEL DECISION**

### **Schibsted ASA and Schibsted Media AS v. Joseph Samuel Case No. D2024-2688**

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

The Complainants are Schibsted ASA, Norway, and Schibsted Media AS, Norway, represented by Abion GmbH, Switzerland.

The Respondent is Joseph Samuel, Nigeria.

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

The disputed domain name <schibsteds.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 July 3, 2024. On July 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 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 (*Registration Private, Domains By Proxy, LLC*) and contact information in the Complaint. The Center sent an email communication to the Complainants on July 8, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on July 23, 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”).

The Complainants requested a suspension of the proceedings on August 1, 2024. On August 2, 2024, the proceedings were suspended until September 1, 2024. The suspension of the proceedings was extended to September 18, 2024 and on September 19, 2024, the proceedings were reinstated. In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2024. The Respondent sent email communications to the Center on July 13

and July 24, 2024, and on September 20, 2024. The Center informed the Parties about the commencement of panel appointment process on October 11, 2024.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on October 16, 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 Complainants are two Norwegian companies: Schibsted ASA and Schibsted Media AS. Both Complainants were members of the same group of companies, the Schibsted group, founded more than 180 years ago in Norway until the group has been separated in two groups known as “Schibsted Marketplaces” and “Schibsted Media”. Schibsted ASA is the mother company of the former, which has developed marketplaces in mobility, recommerce, real estate and jobs. On the other hand, Schibsted Media AS is the mother company of the Schibsted Media group, which operates media businesses. The Complainant Schibsted Media AS is the owner of the active trademark registrations in the trademark SCHIBSTED, amongst which:

- The European Union trademark SCHIBSTED No. 006476501, registered on October 3, 2008, in classes 9, 16, 35, 38, and 41;
- The Norway trademark SCHIBSTED No. 307790, registered on January 16, 2020, in classes 9, 16, 35, 36, 38, 39, 41, and 42; and
- The International trademark registration SCHIBSTED (figurative) No. 1067476, registered on November 26, 2010, in classes 35, 38, 41, and 42 (hereinafter together, the “SCHIBSTED trademark”).

The Complainant Schibsted Media AS also own numerous domain names incorporating the trademark SCHIBSTED, amongst which <schibsted.com>, <schibsted.global>, and <schibstedmedia.com>.

The Complainant Schibsted ASA has been granted the right to use the SCHIBSTED trademark for a period of two years starting since March 22, 2024.

The disputed domain name was registered on December 23, 2023. According to evidence submitted by the Complainants, the disputed domain name previously resolved to a website that featured the SCHIBSTED trademark and allegedly offered legal services. This website contained information relating to the Schibsted group, such as the Complainants’ shared address, without the Complainants’ authorization. This website also contained contact forms for interested third parties to provide their personal information. Later, the disputed domain name resolved to a parking page displaying pay-per-click (“PPC”) links.

Although one of the Complainants filed a criminal charge in connection with the use of the disputed domain name in Norway, according to the Complainants, notification was received on June 24, 2024, that prosecution had been discontinued. As a result, there are no concurrent proceedings to the UDRP proceedings at the time of this Decision.

#### **5. Parties’ Contentions**

##### **A. Complainants**

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, regarding the first element of the Policy, the Complainants contend that they have rights in the SCHIBSTED trademarks and that the disputed domain name is confusingly similar to this trademark. The Complainants point out that the disputed domain name reproduces the trademark SCHIBSTED in its entirety. Further, the Complainants claim that the disputed domain name merely appends the additional letter “s” to the Complainants’ SCHIBSTED trademark, which does not prevent the finding of confusing similarity. The Complainants also argue that the disputed domain name constitutes a classic case of typosquatting, whereby the Respondent has misspelled the SCHIBSTED trademark deliberately to attract Internet users. Moreover, the Complainants claim that the generic Top-Level Domain (“gTLD”) “.com”, is a standard registration requirement and can be ignored for the purpose of comparison of the disputed domain name to the Complainants’ trademark.

Regarding the second element of the Policy, the Complainants claim that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainants confirm that the Respondent has not been granted any license or authorization from the Complainants to register or use the disputed domain name. Further, the Complainants note that the Respondent used a privacy shield service and that the use of such service shows that the Respondent is intentionally hiding its identity rather than being known by the disputed domain name. Moreover, the Complainants contend that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services nor making a legitimate noncommercial or fair use of the disputed domain name. Instead, the Complainants point out that the Respondent used the disputed domain name to direct Internet users to a website featuring the Complainants’ trademark to falsely lead them to believe that the disputed domain name will resolve to the Complainants’ official websites, as well as using the disputed domain name in connection with at least one fraudulent invoice, incorporating the Complainants’ trademark in the upper right corner of the document and referencing the alleged “law firm” present on the website, in an attempt to trick the receiver into paying a sum of money to the Respondent.

As for the third element of the Policy, the Complainants contend that the Respondent registered and used the disputed domain name in bad faith. The Complainants argued that the Respondent attempted to obtain personal information on the website connected to the disputed domain name since the disputed domain name directed to a website purporting to offer “free consultation” to Internet users who put their personal information on it. This finding of bad faith is compounded by the display of the Complainants’ trademark SCHIBSTED on a fraudulent invoice related to the fictitious consultation as well as on the website such as its tab, its top left-hand corner and footer, which demonstrates that the Respondent knew of the SCHIBSTED trademark at the time of registration of the disputed domain name. Furthermore, the Complainants claim that the Respondent was aware or should have been aware of the Complainants’ SCHIBSTED trademark given its global reputation and that the Complainants never authorized, licensed or otherwise consented to the Respondent’s use and registration of the disputed domain name. The Complainants also highlight that it is a well-established principle that registration of a domain name that is confusingly similar to a well-known trademark by an entity which does not have a relationship with such trademark can amount to sufficient evidence of bad faith registration and use. In addition, the Complainants point out that, given the recent use of the disputed domain name, its current use for a parking page displaying pay-per-click links, may be an additional evidence of bad faith.

## **B. Respondent**

The Respondent did not formally reply to the Complainants’ contentions. However, via an informal communication of July 24, 2024, the Respondent claimed that the Respondent is merely the developer of the website displayed at the disputed domain name and that their alleged client “has refused to attend to this case”. In a further informal communication of September 20, 2024, the Respondent reiterated that they only acted as developer on behalf of a client, stating that they “had no clue schibsted was a trademark”, that the domain name had been taken down and committing not to repeat such activities.

Nevertheless, the Respondent did not submit any evidence supporting the existence of a third-party client on whose behalf the disputed domain name would have been registered and operated. As a result, the Panel cannot reasonably conclude to the legitimacy of the Respondent’s claims and must operate under the

assumption that the Respondent itself registered and operated the disputed domain name on their own behalf.

## **6. Discussion and Findings**

### **A. Preliminary Issue: Consolidation of Multiple Complainants**

The Complainants in this administrative proceeding request consolidation of the two Complainants. In addressing the Complainants' request, the Panel will consider whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1.

As regards common grievance against the Respondent, the Complainants have convincingly demonstrated that Schibsted Media AS is the owner of the SCHIBSTED trademark and Schibsted ASA was granted the right to use that trademark. Further, the Complainants are related businesses, formerly part of the same group of companies which only recently split into two separate entities – whereby both still rely on the same primary SCHIBSTED trademark (see [WIPO Overview 3.0](#), section 1.4.2; *Cantor Fitzgerald Securities, Cantor Index Limited v. Mark Mark, Chen Xian Sheng/Whois Protect*, WIPO Case No. [D2014-0125](#); *Simon Barrère and Laboratoire de l'Abbé Soury SAS v. Annick Lella-Kouassi*, WIPO Case No. [D2024-2682](#)). As such, the Panel finds that they have a specific common grievance against the Respondent. With respect to fairness and equity, since the registration and use of the disputed domain name affects both Complainants and they therefore have a common grievance against the Respondent, the Panel finds that consolidation of the Complainants would be fair and equitable and it would be procedurally efficient under the circumstances of the case to permit the consolidation. Accordingly, the Panel allows the Complainants to proceed jointly with their Complaint.

### **B. 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 3.0](#), section 1.7.

The Complainants have 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 trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the letter "s", does not prevent the Complainant's trademark from being recognizable in the disputed domain name [WIPO Overview 3.0](#), section 1.8.

Finally, as for the applicable gTLD ".com", the Panel holds that this can be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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

### **C. 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.

First, panels have held that the use of a domain name for illegal activity (here, claimed as applicable to this case: the collection of personal data via the contact webform on the disputed domain name with the aim of sending of fraudulent invoices) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. According to the evidence submitted by the Complainants, at least one third party received a fraudulent invoice displaying the SCHIBSTED trademark and referenced the disputed domain name when reporting this to the Complainant. In this regard, the Respondent lacks rights or legitimate interests in the disputed domain name.

In addition, having reviewed the available record, the Panel finds the Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants’ 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 Complainants confirmed that the Respondent is not affiliated with neither of the Complainants in any way nor have the Complainants licensed or authorized the Respondent to register domain names incorporating the Complainants’ trademarks. Noting the composition of the disputed domain name being nearly identical to the Complainant’s trademark, in the circumstances of this case, no actual or contemplated bona fide or legitimate use of the disputed domain names could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)). The Panel also found no evidence that the Respondent has been commonly known by the disputed domain name or owns any registered trademarks in SCHIBSTED. Rather, the addition of the letter “s” indicates an awareness of the Complainant and carries a risk of Internet user confusion (that seemingly being the Respondent’s aim) .

In addition, the Panel finds that the Respondent does not use the disputed domain name in connection with a bona fide offering of goods or services and has neither made a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name currently displays a parking page with PPC links redirecting to a variety of goods and services. It is widely accepted that the use of a disputed domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users ([WIPO Overview 3.0](#), section 2.9). Given that the disputed domain name previously displayed the SCHIBSTED trademark, it is evident that the Respondent had the intent to capitalize on the reputation and goodwill of the Complainants.

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

#### **D. 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.

Panels have held that the use of a domain name for illegal activity here, claimed collection of personal data via the contact webform on the disputed domain name with the subsequent sending of fraudulent invoices, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. As discussed previously, according to the evidence

submitted by the Complainants, the Respondent previously used the disputed domain name to host a website on which it attempted to obtain personal information of Internet users and, in at least one instance, sent a fraudulent invoice reported to be connected to the disputed domain name. On this basis, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Furthermore, it should be noted that 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 also 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. The following other circumstances further support a finding of bad faith.

It is widely accepted that the use of a disputed domain name to host a parked page comprising PPC links may constitute bad faith where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users (*Facebook Inc. v. Yumei Luo*, WIPO Case No. [D2020-2306](#)). Given that the disputed domain name previously displayed the SCHIBSTED trademark and the composition of the disputed domain name, it is evident that the Respondent had the intent to capitalize on the reputation and goodwill of the Complainants.

The Panel finds that the Complainants have 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 <schibsteds.com> be transferred to the Complainant Schibsted Media AS.

*/Benoit Van Asbroeck/*

**Benoit Van Asbroeck**

Sole Panelist

Date: October 30, 2024