

ADMINISTRATIVE PANEL DECISION

Lulu Press, Inc. v. Jared Bacher
Case No. D2024-2858

1. The Parties

Complainant is Lulu Press, Inc., United States of America, represented by Smith, Anderson, Blount, Dorsett, Mitchell & Jernigan, LLP, United States of America (“US”)

Respondent is Jared Bacher, US.

2. The Domain Name and Registrar

The disputed domain name <lulupublishers.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 12, 2024. On July 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 15, 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 (LULU PUBLISHERS, Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on July 17, 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 July 17, 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 July 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 12, 2024. Respondent sent an informal email communication to the Center on July 17, 2024. The Center commenced the Panel Appointment process on August 16, 2024.

The Center appointed Phillip V. Marano as the sole panelist in this matter on August 23, 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 operates a self-publishing, print-on-demand, and distribution platform for online books. Complainant offers its services through its official <lulu.com> domain name and website. Complainant owns a valid and subsisting registration for the LULU stylized design trademark in the US (Reg. No. 6,185,768), registered on October 27, 2020, with a first use in commerce of August 23, 2018.

Respondent registered the disputed domain name on June 5, 2023. At the time this Complaint was filed, the disputed domain name resolved to website content that offers “Ghostwriting” “Publication & Printing” “Formatting & Proofreading” “Book Marketing” and “Book Editing” services. It advertises, “Creating Compelling Stories & Building Excellence with Our Ghostwriting Services ... Lulu Publishers staff is dedicated to helping you achieve your goal of becoming a published author ... Online Book Sales. Make money online by selling your books. You can earn up to \$10,000 every month! ... Worldwide Publishing. Your completed book will be available on a variety of sites, including Amazon, Barnes & Noble, Google Books, and others”. The website also prominently features a LULU PUBLISHERS design trademark similar to Complainant’s LULU design trademark depicting an open book laying on its spine with three pages showing.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant asserts ownership of the LULU trademark and has adduced evidence of a trademark registration in the US, with earliest priority dating back to August 23, 2018. The disputed domain name is confusingly similar to Complainant’s LULU trademark, according to Complainant, because: (i) Respondent purports to offer the same print-on-demand and self-publishing services as Complainant; (ii) the disputed domain name is identical to Complainant’s LULU trademark in its entirety with the addition of the word “publishers”, which is representative of Complainant’s line of business; and (iii) the similarities between Complainant’s LULU design trademark and Respondent’s website logo, along with the similarities between Complainant’s and Respondent’s website content, make it clear that the disputed domain name creates a likelihood of confusion amongst Complainant’s patrons.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: (i) the lack of any evidence that Respondent’s use of the disputed domain name is bona fide; (ii) the lack of any evidence Respondent is commonly known by the disputed domain name; (iii) Respondent’s redirection of Internet users away from Complainant and toward Respondent’s website; and (iv) evidence of actual confusion in the form of customer complaints Complainant has received from Internet users who mistakenly thought they were purchasing services from Complainant rather than Respondent.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: (i) Complainant’s exclusive use of the LULU trademark in connection with self-publishing services dating back to August 23, 2018, and national trademark registration on October 27, 2020, predating registration of the disputed domain name by several years; (ii) Complainant’s renown and trusted reputation in the publishing sector in the US; (iii) Respondent’s intent to create a likelihood of confusion with

Complainant's LULU trademark to drive traffic to Respondent's website, offering its own putative self-publishing services in competition with Complainant; (iv) Respondent's misappropriation of Complainant's identical LULU trademark; (v) the false assertion on Respondent's website that Respondent has been endorsed by major media outlets such as The New York Times, NBC, and the BBC; and (vi) Respondent's false claim of association with Complainant by Respondent's online representative.

B. Respondent

The Respondent did not reply to the Complainant's contentions. Respondent sent an informal email communication to the Center on July 17, 2024, stating "hope you doing well i received your email for the domain dispute i am hosting provider company this is my client domain now tell me what can i do for this dispute waiting for your reply regards".

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. The disputed domain name has been registered and is being used in bad faith.

Panels typically treat a respondent's submission of a so-called "informal response" (merely making unsupported conclusory statements and/or failing to specifically address the case merits as they relate to the three UDRP elements, e.g., simply asserting that the case "has no merit" and demanding that it be dismissed) in a similar manner as a respondent default. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), Section 4.3. Indeed, the Panel views Respondent's informal email, asserting it was the "hosting provider company" and "this is my client domain", as akin to a respondent default.

Although Respondent did not formally reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See [WIPO Overview 3.0](#), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

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.

Ownership of a nationally or regionally registered trademark serves as prima facie evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the LULU trademark has been registered in the US with a first use in commerce of August 23, 2018. Thus, the Panel finds that Complainant's rights in the LULU trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's LULU trademark. In this Complaint, the disputed domain name is confusingly similar to Complainant's LULU trademark because, disregarding the ".com" generic Top-Level Domain ("gTLD"), the entirety of the trademark is contained within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regard to gTLDs, such as ".com" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the term "publishing" does not prevent a finding of confusing similarity between Complainant's LULU trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (additional terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element").

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1. As a threshold matter, there is no evidence in the record that Respondent, identified by Whois data for the disputed domain name as "Jared Bacher", is commonly known by the disputed domain name or Complainant's LULU trademark.

Based on the undisputed facts and circumstances in the record before it, the Panel finds that Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services. This is especially the case where a disputed domain name is so obviously connected with a complainant and its services, the very use by a registrant with no connection to a complainant suggests opportunistic bad faith. The Panel concludes from the record that Respondent clearly had Complainant's LULU trademark in mind when registering the disputed domain name, and that Respondent most likely registered domain name in order to exploit and profit from Complainant's trademark rights, which had already been well-established in Complainant's industry for purposes of the Policy, by offering putative self-publishing services in direct competition with Complainant. Indeed, a respondent who knowingly adopted a third party's registered and established mark as a domain name cannot claim the benefit of paragraph 4(c)(i) of the Policy to establish rights to the domain name based on its mere use of the domain name to offer competing goods or services prior to the notice of a dispute. *Scania CV AB v. Leif Westlye*, WIPO Case No. [D2000-0169](#); see also *Drexel University v. David Brouda*, WIPO Case No. [D2001-0067](#) (rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the complainant).

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

Where parties are both located in the US and the complainant has obtained a federal trademark registration pre-dating a respondent's domain name registration, panels have applied the concept of constructive notice, subject to the strength or distinctiveness of the complainant's trademark, or circumstances that corroborate respondent's awareness of the complainant's trademark. [WIPO Overview 3.0](#), section 3.2.2. In this Panel's view, when the disputed domain name was registered on June 5, 2023, Respondent had either constructive or actual knowledge of Complainant's pre-existing rights in Complainant's LULU trademark under United States law. See e.g., *Champion Broadcasting System, Inc. v. Nokta Internet Technologies*, WIPO Case No. [D2006-0128](#) (applying the principle of constructive notice where both parties are located in the United States). Indeed, circumstances in this case corroborate Respondent's awareness of Complainant and Complainant's LULU trademark, including: (i) Respondent's use of Complainant's identical and distinctive LULU trademark in its entirety within the disputed domain name; (ii) Respondent's use of a website logo that is confusingly similar to Complainant's LULU design logo, depicting an open book on its spine with three pages showing; (iii) and the admission of Respondent's customer service representative that, "We are the publishing domain and lulu.com is more focused on printing and distribution for book events", which can be reasonably interpreted as, at best Respondent's acknowledgement of Complainant, or at worst Respondent's fraudulent assertion that it is somehow associated with Complainant.

Furthermore, use of a domain name incorporating Complainant's trademark to redirect Internet users to Respondent's website, where goods or services are offered in competition with Complainant, is strong evidence of bad faith under paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.4 ("Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: ... seeking to cause confusion for respondent's commercial benefit, even if unsuccessful ... the lack of a respondent's own rights to or legitimate interests in a domain name [or] redirecting the domain name to a different respondent-owned website..."). Here, the disputed domain name appears to intentionally target and ultimately misappropriate Complainant's distinctive LULU trademark and resolves to Respondent's website that contains offers for putative self-publishing and related services in direct competition with Complainant. Accordingly, the Panel finds that use of the disputed domain name will divert potential customers from the Complainant's business to the website under the disputed domain name by attracting Internet users who mistakenly believe that the disputed domain name is affiliated with the Complainant, and which may further mistakenly believe that the products offered on this website are authentic products offered by the Complainant, or by an entity affiliated to the Complainant.

In view of the foregoing, the Panel concludes that 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 <lulupublishers.com> be transferred to the Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: September 12, 2024