

ADMINISTRATIVE PANEL DECISION

Macmillan Publishers International Limited v. Saqib Nizam
Case No. D2024-2900

1. The Parties

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

The Respondent is Saqib Nizam, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <macmillanebookpublisher.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 17, 2024. On July 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 18, 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 (Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 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 the same day.

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 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 15, 2024.

The Center appointed Eva Fiammenghi as the sole panelist in this matter on August 20, 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 is a globally recognized publishing company. The Complainant specializes in publishing a wide range of books, including academic, educational, and fiction titles. The company has established a significant reputation for its high-quality publications and has a substantial presence in the global publishing industry.

The Complaint is primarily based on the following registered trademarks:

- United Kingdom Trademark MACMILLAN and device Registration (“Reg.”) No. UK00002555028, registered on January 6, 2012 in classes 9, 16, and 41;
- European Union Trademark MACMILLAN Reg. No. 000066225, registered on March 18, 1998, in classes 9, 16, and 41;
- Switzerland Trademark MACMILLAN Reg. No. 401760 registered on May 21, 1993 in classes 9,15,16, and 28.

The Complainant is also the owner of several domain names, including <macmillan.com> and <macmillanlearning.com>, which are central to its online presence and are used for the dissemination of both educational and publishing-related content.

The Disputed Domain Name was registered on June 3, 2024, and is used to redirect visitors to a website offering publishing and writing services, containing the Complainant’s trademark.

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 its longstanding rights to the MACMILLAN trademark, which is registered in various jurisdictions. The trademarks are associated with a wide range of goods and services in the publishing and educational sectors.

The Complainant argues that the disputed domain name is confusingly similar to its registered trademarks and leverages the goodwill and reputation established by the Complainant over many years.

The Complainant further argues that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not known by the name “Macmillan” and has no connection or affiliation with the Complainant. The use of the disputed domain name to redirect users to a website offering publishing and writing services using the Complainant’s trademark undermines any claim of rights or legitimate interests. The Complainant suggests that the Respondent registered the disputed domain name in bad faith, with the intent to misleadingly attract Internet users by exploiting the fame of the MACMILLAN trademark.

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith. Evidence suggests that the Respondent may be using the disputed domain name to profit from the reputation of the Complainant by confusing consumers and diverting traffic intended for the Complainant's official websites.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must prove that:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name was registered and is being used in bad faith.

These elements are discussed in turn below. In considering these elements, paragraph 15(a) of the Rules provides that the Panel shall decide the Complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

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 Panel finds the trademark 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.

The disputed domain name incorporates the Complainant's trademark MACMILLAN in its entirety. The addition of the terms "ebook" and "publisher" does not diminish the recognizability of the MACMILLAN trademark within the disputed domain name. Although the addition of other terms (here, "ebook" and "publisher") 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.

Furthermore, the generic Top-Level Domain ("gTLD") ".com" is typically disregarded in the assessment of confusing similarity under the Policy. [WIPO Overview 3.0](#), section 1.11.

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 Respondent has not provided evidence of (i) any use of the domain name or demonstrable preparations to use it in connection with a bona fide offering of goods or services, (ii) being commonly known by the domain name, or (iii) making a legitimate noncommercial or fair use of the domain name. In the absence of such relevant evidence and the Respondent’s rebuttal, the Complainant has established that the Respondent lacks rights or legitimate interests in the disputed domain name.

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

In this case, the Respondent’s use of the disputed domain name to potentially impersonate the Complainant or to pass off as an affiliate or legitimate part of the Complainant’s operations suggests malicious intent, which precludes any claim of rights or legitimate interests.

Moreover, the nature of the disputed domain name, which incorporates the Complainant’s trademark with additional terms referring to the Complainant’s business, carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

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 dispute domain name, using the well-known MACMILLAN trademark for a website offering writing and publishing services, indicates an attempt to capitalize on the Complainant’s established reputation, potentially as part of a broader pattern of opportunistic domain registrations.

The disputed domain name is being used in a manner that disrupts the Complainant’s business by creating confusion among Internet users. This confusion can divert potential customers away from the Complainant’s official channels, thereby disrupting its business operations.

The Respondent has registered and used the disputed domain name in a way that is likely to confuse consumers into believing that the disputed domain name is associated with the Complainant for its own commercial gain. This confusion could result in the Respondent unfairly benefiting from the Complainant's established reputation and goodwill, which constitutes bad faith under the Policy.

Panels have held that the use of a domain name for illegal activity here, claimed 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 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 <macmillanebookpublisher.com> be transferred to the Complainant.

/Eva Fiammenghi/

Eva Fiammenghi

Sole Panelist

Date: September 3, 2024