

## ADMINISTRATIVE PANEL DECISION

Scholastic Inc. v. Kanwal Khan

Case No. D2024-3695

### 1. The Parties

The Complainant is Scholastic Inc., United States of America, represented by Frankfurt Kurnit Klein & Selz, PC, United States of America.

The Respondent is Kanwal Khan, United States of America.

### 2. The Domain Name and Registrar

The disputed domain name <scholasticbookpublishers.com> (the “Disputed Domain Name”) 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 September 11, 2024. On September 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 16, 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 Complainant on September 17, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Center sent a further email communication to the Complainant on the same date, requesting that the Complainant remedy certain deficiencies. The Complainant filed an amended Complaint on September 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 September 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 11, 2024.

The Center appointed Douglas M. Isenberg 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 Complainant states that it was founded in 1920 and “has become the world’s largest publisher and distributor of children’s books, including ebooks and audiobooks”; that it “is a leading provider of literacy curricula, professional services, and classroom magazines, and a producer of educational and popular children’s media”; and that it “is currently in 115,000 schools, reaching 3.8 million educators, 54 million students, and 78 million parents/caregivers domestically, all of whom rely on Scholastic to deliver highest quality learning materials.” The Complainant further states, and provides evidence to support, that it is the owner of “dozens” of trademark registrations, including U.S. Reg. Nos. 1,677,988 (registered March 3, 1992) for SCHOLASTIC for use in connection with “providing children’s books to schools for use in book fairs involved in school fundraising programs; mail-order services in the field of educational books and materials”; 1,741,883 for SCHOLASTIC (registered December 22, 1992) for use in connection with “mail-order book-club services, made available to schools, librarians and interested parents, on a variety of topics”; and 2,711,978 for SCHOLASTIC (registered April 29, 2003) for use in connection with “educational services, namely providing on-line tutoring services for students in the fields of math, science, language arts, social studies, geography and history via a global computer network.” These registrations are referred to herein as the “SCHOLASTIC Trademark.”

The Disputed Domain Name was created on June 22, 2024. The Complainant states, and provides a screenshot in support thereof, that the Disputed Domain Name is used in connection with a website that “display[s] egregiously copy-cat material that aped Scholastic’s genuine website, advertising ghost writing services, book editing services, book publishing and book marketing services.” The Complainant also states that the Disputed Domain Name was used to “send fraudulent marketing emails to authors who are contractually related to Scholastic to offer services identical to Scholastic’s services, causing consumer confusion”.

#### **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 SCHOLASTIC Trademark because the Disputed Domain Name “contains Scholastic’s entire and identical Trademark” and “merely add to the Trademark the words ‘book publishers’, which are descriptive in this context.”
- The Respondent has no rights or legitimate interests in the Disputed Domain Name because, inter alia, “Respondent is not commonly known by the Disputed Domain or the Trademark, and has not acquired any legitimate trademark or service mark rights in the Disputed Domain”; “Respondent’s current use of the Disputed Domain for the Website is based on the trademark value of Scholastic’s Trademark”; and “Respondent is profiting from the value of Scholastic’s Trademark by using the Disputed Domain for its commercial gain.”
- The Disputed Domain Name was registered and is being used in bad faith because, inter alia, “[g]iven that the Website clearly mimics Complainant’s legitimate website, Respondent was well aware of Scholastic’s Trademark at the time the Disputed Domain was registered or acquired”; “bad faith of the Respondent is evidenced by (i) use of Scholastic’s identical Trademark in the Disputed Domain, (ii)

prominent use of the Trademark on the top front portion of the Website homepage, and (iii) use of the Disputed Domain for book editing, book publishing and book marketing services, which is identical to the services for which Scholastic has registered and/or used the Trademark”; and “Respondent is clearly seeking to profit from the unauthorized association with Scholastic’s Trademark.”

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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, namely, the SCHOLASTIC Trademark. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the registrations for the SCHOLASTIC Trademark set forth above is reproduced within the Disputed Domain Name, and the SCHOLASTIC Trademark is recognizable in 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.

Although the addition of other terms (here, “book” and “publishers,”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. As set forth in [WIPO Overview 3.0](#), section 1.8: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.” Indeed, previous panels have found that domain names containing a complainant’s trademark plus words that are associated with the trademark (as is the case here, given that “book” and “publishers” describe the services offered by Complainant under the SCHOLASTIC Trademark) does nothing to diminish confusing similarity between the SCHOLASTIC Trademark and the Disputed Domain Name. See, e.g., *Media West-DMR et al. v. Phil Nagy*, WIPO Case No [D2005-1322](#).

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.

The Panel considers that the composition of the Disputed Domain Name carries a risk of implied affiliation with the Complainant, given that the additional terms “book” and “publishers” describe the services offered by the Complainant under the SCHOLASTIC Trademark. [WIPO Overview 3.0](#), section 2.5.1.

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 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 Respondent has used the Disputed Domain Name in connection with a website that identifies itself as “Scholastic Book Publishers” and offers “ghostwriters for books” via such services as “ghostwriting, editing, publishing, and marketing.” While it is unclear from the Complainant whether the Complainant offers ghostwriting services, the Complainant has stated that it is “the world’s largest publisher and distributor of children’s books,” and the SCHOLASTIC Trademark is used in connection with books and book services – which are clearly related to the services advertised on the website using the Disputed Domain Name.

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 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.

“Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.” [WIPO Overview 3.0](#), section 3.1.4. Here, the Panel finds that the SCHOLASTIC Trademark is famous or widely known, given that it is protected by multiple registrations and used by a company that was founded in 1920, is “the world’s largest publisher and distributor of children’s books,” and “is currently in 115,000 schools, reaching 3.8 million educators, 54 million students, and 78 million parents/caregivers domestically.” Plus, by using the inherently misleading Disputed Domain Name in connection with a website that offers services related to the SCHOLASTIC Trademark, the Respondent is clearly “creating a likelihood of confusion” under paragraph 4(b)(iv) of the Policy. 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 <scholasticbookpublishers.com> be transferred to the Complainant.

*/Douglas M. Isenberg/*

**Douglas M. Isenberg**

Sole Panelist

Date: October 30, 2024