

ADMINISTRATIVE PANEL DECISION

Scholastic Inc. v. Nelson
Case No. D2024-3731

1. The Parties

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

The Respondent is Nelson, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <scholasticpublishers.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2024. On September 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 17, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on September 17, 2024, requesting the Complainant to remedy certain deficiencies in the Complaint and providing the registrant’s contact information disclosed by the Registrar. 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 Christopher J. Pibus as the sole panelist in this matter on October 18, 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 headquartered in New York, United States, and it operates internationally as one of the world's largest publishers and distributors of children's books, in association with the SCHOLASTIC brand. It has protected its intellectual property rights gained through developing and marketing its line of products and services, including books, ebooks, audiobooks, classroom magazines as well as related publishing services. The Complainant has used the SCHOLASTIC mark in commerce for more than 100 years and owns the following registrations among an extensive portfolio:

-SCHOLASTIC, United States Registration No. 1,677,988, dated March 3, 1992, in Class 42; and
-SCHOLASTIC and design, United States Registration No. 1,567,119, dated November 21, 1989, in Class 16.

The Complainant also owns trademark registrations for other SCHOLASTIC-formative marks in the United States, and elsewhere. In addition, the Complainant owns and uses the domain name <scholastic.com> to host its principal commercial website.

The disputed domain name was registered on May 1, 2024, and it resolves to a website purportedly offering book publishing and book marketing services. The website under the disputed domain name has a similar look and feel as the Complainant's website.

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 trademark is well-known due to the longstanding adoption and sales of its products and services. The Complainant relies on compelling evidence of bad faith, establishing the use of a fake website with the look and feel of the Complainant's principal website, promoting competitive products and publishing services. The Complainant has uncovered evidence of customers who have been deceived by the use of the disputed domain name and its associated website and related social media platforms. In the circumstances, the Complainant urges the Panel to find deliberate targeting of the SCHOLASTIC mark for improper purposes.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, the Complainant must establish each of the following elements:

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

- (ii) the 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.

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 SCHOLASTIC mark 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.

Although the addition of other terms, here "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. [WIPO Overview 3.0](#), section 1.8.

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. In particular the Complainant has provided evidence and submissions to the effect that the Respondent has never been affiliated with or licensed by the Complainant to use the SCHOLASTIC mark in any manner including as part of a domain name. The record shows that the Respondent has been using the disputed domain name to host a website, replete with images of the SCHOLASTIC brand in association with children's books and the promotion of publishing services. The Panel finds that the Respondent has used the disputed domain name misleadingly to divert Internet users to a website that had a similar look and feel as the Complainant's website and that purportedly offered the same services as the Complainant, which circumstances cannot give rise to rights or legitimate interests.

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.

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 widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

The Panel views the Respondent's conduct in this case as bad faith, in light of the following circumstances: (1) the deliberate misappropriation of the Complainant's well-known mark to deceive Internet users to believe the disputed domain name was associated with the Complainant; (2) the unauthorized use of the Complainant's trademark and a confusingly similar logo on the Respondent's website, calculated to deceive by copying the look, colours, design and font from the Complainant's website; and (3) the operation of such a website promoting book products and publishing services highly similar to those offered by the Complainant on its website.

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 <scholasticpublishers.com> be transferred to the Complainant.

/Christopher J. Pibus/

Christopher J. Pibus

Sole Panelist

Date: November 1, 2024