

ADMINISTRATIVE PANEL DECISION

Associated Newspapers Limited v. Matt Drake, Daily Mail
Case No. D2024-4148

1. The Parties

Complainant is Associated Newspapers Limited, United Kingdom, represented by Adlex Solicitors, United Kingdom.

Respondent is Matt Drake, Daily Mail, Australia.

2. The Domain Name and Registrar

The disputed domain name <dailymailnewsuk.com> (the “Domain Name”) is registered with Squarespace Domains II LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 9, 2024. On October 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on October 15, 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 October 16, 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 Respondent of the Complaint, and the proceedings commenced on October 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on November 7, 2024.

The Center appointed John C. McElwaine as the sole panelist in this matter on November 12, 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 is the management company and publisher of a range of publications in the United Kingdom including two national newspapers: the Daily Mail and The Mail on Sunday. Relevant to this matter, Complainant owns the following trademark registrations:

- DAILY MAIL, United Kingdom trademark no. 120766622, registered on November 22, 1983; and
- DAILY MAIL, European Union Reg. No. 193433, registered on November 5, 1999.

Collectively, these registered trademark rights are referred to as the "DAILY MAIL Mark."

The Domain Name was registered on August 30, 2023. There is currently no website available at the Domain Name and no evidence that Respondent has ever used the Domain Name for a website. As of November 2, 2023, MX records had been set up for the Domain to enable email. Following Complainant's communication with the Registrar, Respondent apparently canceled the MX records.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

As background, Complainant asserts that it was incorporated in the United Kingdom on April 1, 1905, and that Complainant publishes a newspaper known as the Daily Mail. Complainant alleges that the Daily Mail's average United Kingdom readership from July 2019 to June 2021 was over 2 million per issue. Complainant contends that its website located at <dailymail.co.uk> is one of the most-visited websites in the world. The website was the most-read online United Kingdom newspaper brand in 2021, with 518 million page views and 4.1 average daily visitors in July 2021.

With respect to the first element of the Policy, Complainant contends that the Domain Name is confusingly similar to its DAILY MAIL Mark as it wholly incorporates the trademark and differs only by the addition of the terms "news" and "UK". Complainant asserts that these terms fail to dispel the connection between the Domain Name and the DAILY MAIL Mark.

With respect to the second element of the Policy, Complainant asserts it has no association with Respondent and has never authorized or licensed Respondent to use its trademark. Complainant further claims that there is no evidence that Respondent has ever used the Domain Name at all.

With respect to the third element of the Policy, Complainant argues that the evidence points to registration of the Domain Name for fraudulent purposes, namely that email MX records were configured for the Domain Name, which is uniquely associated with Complainant's distinctive DAILY MAIL Mark, and that at some point after receiving notification of Complainant's communication to the Registrar, Respondent chose to remove the MX records without providing any explanation.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Even though Respondent has defaulted, paragraph 4(a) of the Policy requires that, in order to succeed in this UDRP proceeding, Complainant must still prove its assertions with evidence demonstrating:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows.

A. Identical or Confusingly Similar

The Panel finds that Complainant has established rights in the DAILY MAIL Mark through its United Kingdom and European Union trademark registrations.

The Domain Name incorporates Complainant's DAILY MAIL Mark in its entirety, with the addition of the terms "UK" and "news". As stated in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

Therefore, the Panel concludes that the Domain Name is confusingly similar to Complainant's DAILY MAIL Mark, and Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name, after which the burden of production shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests. See section 2.1 of the [WIPO Overview 3.0](#).

Here, Complainant has stated that it has not licensed or otherwise authorized Respondent to use its DAILY MAIL Mark or to register domain names incorporating the mark. There is no evidence that Respondent has been commonly known by the Domain Name or that Respondent has acquired any trademark rights in the term "dailymailnewsuk". Respondent has not come forward with an explanation for choosing the Domain Name which consists of Complainant's well-known DAILY MAIL Mark.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Names. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy¹ or otherwise.

Complainant contends that Respondent has failed to make any use of the Domain Name. Complainant points out that Respondent's Domain Name leads to an inactive website, and as such, is not in connection with a bona fide offering of goods or services pursuant to Policy paragraph 4(c)(i). See *Société nationale des télécommunications: Tunisie Telecom v. Ismael Leviste*, WIPO Case No. [D2009-1529](#) (noting that passive holding of a disputed domain name "does not constitute a legitimate use of such a domain name" that would give rise to a legitimate right or interest in the name); *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#) (Respondent had no rights or legitimate interests in the disputed domain name where the disputed domain name resulted to an inactive website); *Philip Morris USA Inc. v. Elijah Etame*, WIPO Case No. [D2016-0968](#) ("the Panel cannot imagine any potentially legitimate interest that Respondent might have in the disputed domain names based on the manner in which the disputed domain names have been used on the inactive websites"). The Panel agrees that the passive holding of a Domain Name consisting of a well-known trademark without any explanation from Respondent concerning its intended use of the Domain Name supports a finding that Respondent is not engaged in a bona fide offering of goods or services.

The Panel notes that the Respondent provided the name "Daily Mail" as part of the registration details for the Domain Name, but the Panel finds that is not sufficient in itself to give rise to rights or legitimate interests in the Domain Name.

Based on the foregoing, Complainant has made a prima facie showing of Respondent's lack of any right or legitimate interest and Respondent has failed to come forward with evidence to rebut that showing. As provided for by paragraph 14 of the Rules, the Panel may draw such inference from Respondent's default as it considers appropriate. The Panel finds that Respondent does not have rights or legitimate interests in the Domain Name and that Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

The registration of a domain name incorporating a well-known trademark, coupled with the configuration of MX records for potential email use, strongly suggests registration in bad faith. As noted in section 3.1.4 of the [WIPO Overview 3.0](#), the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Bad faith registration can also be found where respondents "knew or should have known" of complainant's trademark rights and nevertheless registered a domain name in which they had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#).

The Panel finds particularly concerning that MX records were configured for the Domain Name, particularly noting the composition of the Domain Name, and then removed after Complainant contacted the Registrar.

¹ The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name: "(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

Furthermore, the fact that the Domain Name does not resolve to website and is being passively held does not obviate a finding of bad faith. As outlined in section 3.3 of the [WIPO Overview 3.0](#), factors that support a finding of bad faith in cases of passive holding include: (1) The degree of distinctiveness or reputation of the complainant's mark; (2) The failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; (3) The respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and (4) The implausibility of any good faith use to which the domain name may be put.

All these factors are present here. The DAILY MAIL mark is well-known, Respondent has failed to respond or provide any evidence of good faith use and given the incorporation of Complainant's mark plus terms describing its services, it is difficult to conceive of any plausible good faith use of the Domain Name.

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 Domain Name, <dailymailnewsuk.com>, be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: November 26, 2024