

## ADMINISTRATIVE PANEL DECISION

Barnes & Noble Booksellers, Inc. v. Yuvraj dixit  
Case No. DAI2023-0052

### 1. The Parties

The Complainant is Barnes & Noble Booksellers, Inc., United States of America (“United States”), represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Yuvraj dixit, India.

### 2. The Domain Name and Registrar

The disputed domain name <barnesandnoble.ai> is registered with 1API GmbH (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 13, 2023. On December 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 15, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent (Registration Private, Domains by Proxy, LLC) is listed as the registrant and providing the contact details.

The Center verified that 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 January 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Parties of the Respondent’s default on January 25, 2024.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on January 29, 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.

On February 20, 2024, the Panel issued Procedural Order No. 1, instructing the Center to contact the provider of the privacy service, namely GoDaddy.com, LLC, requesting the further disclosure of any additional registrant, technical, administrative, and billing contacts concerning the disputed domain name.

Thereafter, upon the privacy service's anticipated disclosure, the Center was instructed to forward the proceeding's notification documents, initially sent on January 4, 2024, to the additional contact details disclosed, if any. The Panel granted five-days' time for any communication from any registrant(s) concerning their intention to participate in this proceeding.

On February 20, 2024, GoDaddy.com, LLC, transmitted by email to the Center its verification response confirming that the previously named Respondent (Registration Private, Domains By Proxy, LLC) is not listed as the registrant and providing the contact details of the Respondent. On February 22, 2024, the Complainant provided an amended Complaint. On February 22 and 23, 2024, the Respondent sent informal communications to the Center. On February 28, the Center transmitted the amended Complaint to the Respondent, inviting the Respondent to reply by March 4, 2024. The Respondent did not file a Response.

On March 5, 2024, the Respondent sent an email communication indicating a willingness to settle this dispute. On March 12, 2024, the Center informed the Parties of the possibility of settlement under paragraph 17(a) of the Rules. On March 12, 2024, the Complainant replied indicating it did not wish to explore settlement options. On March 12, 2024, in response to the Complainant's communication, the Respondent requested additional time to file a formal Response.

#### **4. Factual Background**

The Complainant is one of the largest booksellers in the United States, operating bookstores in every American state. It established its e-commerce business in 1997 at the domain name <barnesandnoble.com>, which it registered in 1995.

The Complainant is the proprietor of several registrations for its BARNES & NOBLE mark in the United States, European Union, and United Kingdom, including United States Trademark Registration No. 1138704 for BARNES & NOBLE (word mark), registered on August 12, 1980, for services in class 42, claiming a date of first use in March 1975.

The disputed domain name was registered on April 19, 2023. It does not resolve to an active website. The record reflects that it previously resolved to a website featuring pay-per-click ("PPC") links.

The record contains a copy of cease-and-desist letters sent by the Complainant to the Respondent on October 12, 2023, October 23, 2023, and November 2, 2023. The record does not reflect the Respondent's response thereto.

#### **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 history dates to 1917, when William Barnes and G. Clifford Noble established a book business in New York City. The company began its expansion in 1971 and has maintained a strong Internet presence since establishing its e-commerce business in 1997. The Complainant's BARNES & NOBLE brand is well-recognized and has been promoted worldwide. The disputed domain name is identical to this mark, except for the substitution of the word "and" for the ampersand. The Respondent is not authorized to use the Complainant's trademark. The disputed domain

name previously resolved to a website featuring PPC links related to the Complainant's business, including "author" and "used bookstore". The disputed domain name is obviously linked to the Complainant. The Respondent employed a privacy service to conceal its identity and ignored the Complainant's cease-and-desist letters.

The Complainant requests transfer of the disputed domain name.

## **B. Respondent**

The Respondent did not provide a formal Response to the Complainant's contentions.

On February 22, 2024, the Respondent sent the following email: "Can you let me know what is the issue with my domain name as it is under dispute? BARNESANDNOBLE.AI is a totally independent domain name not related to any other name in the world purchased by me almost a year back with me holding the domain with it's full authority."

On February 23, 2024, the Respondent sent a second email stating: "I am Yuvraj, the Owner of Barnesandnoble.ai and regarding domain name Barnesandnoble.ai, it was available for purchase on Godaddy.com and how come there is an ownership issue and a Dispute in the first place? I do not hold the Domain name Barnesandnoble.com and the other one for my personal AI related work."

On March 5, 2024, the Respondent indicated a willingness to settle, which was rejected by the Complainant. Thereafter, on March 12, 2024, the Respondent sent a final email stating: "I was informed for the very first time regarding this issue after receiving the email of the complaint by the centre. I already requested the complainant to explore settlement options so that I could surrender the domain name as I have never used it nor I have any bad intention to harm the reputation of any corporate entity by just purchasing a domain name as I was not aware of Trademark associated with it, but the complainant has denied my request and does not wish to discuss it". In addition, the Respondent requested the Center to provide the Respondent with additional time to file a formal Response.

## **6. Discussion and Findings**

### **6.1 Preliminary Issue - Respondent's Request**

As indicated above, the Respondent requested additional time to file a formal Response after already being afforded five days' time from receipt of the amended Complaint during a supplementary round of notification in connection with these proceedings. Further to the considerations below, the Panel will not grant any further time for a Response. In this determination, the Panel notes that: 1) the Center's "Notification of Complaint and Commencement of Administrative Proceeding" sent on January 4, 2024, included instructions to the Registrar and privacy service to forward the notification to any known underlying registrant (i.e., the Respondent), 2) the Respondent was afforded five days' time from receipt of the amended Complaint to furnish a formal Response, 3) the Respondent utilized the time granted to offer to settle with the Complainant and, after the Complainant's rejection of the settlement, admitted to having "never used" the disputed domain name, 4) after the additional time had expired, as well as an additional seven days from the Complainant's rejection of the settlement, the Respondent for the first time put forth arguments regarding lack of bad faith and the lack of time to formulate a formal Response.

Ultimately, the Panel finds that the Respondent was already afforded a fair opportunity to present its case and did submit informal communications even preceding the second notification period, which the Panel will consider within the context of this Decision. In view of the expedited nature of proceedings under the UDRP and the measures taken by the Panel in Procedural Order No. 1 to provide the Respondent with a fair opportunity to present its case, the Panel will proceed with the Decision.

## 6.2 Substantive Issues

Paragraph 4(a) of the UDRP requires the Complainant to make out all three of the following:

- (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 Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it 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 BARNES & NOBLE mark is recognizable within the disputed domain name, substituting the word “and” for the ampersand. 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 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 Panel notes that, at the time of the Complaint and of this Decision, the disputed domain name did not resolve to an active website. On that basis, the Panel is unable to find that the Respondent is using the domain name in connection with a bona fide offering of goods or services. The evidence does not indicate that the Respondent is commonly known by the disputed domain name or that the Respondent is making legitimate noncommercial or fair use of it.

The disputed domain name, which reflects the dominant elements of the Complainant's trademark, resolved to a site featuring PPC links related to the Complainant's business. Such use does not establish rights or legitimate interests in these circumstances. [WIPO Overview 3.0](#), section 2.9. Moreover, the composition of the disputed domain name is phonetically identical to the Complainant's mark and as such carries a risk of implied affiliation to the Complainant that cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

The Respondent states that he has registered the disputed domain name and that he is the sole holder of it, and that therefore he is entitled to maintain this registration. The Respondent also appears to contradict himself, stating that the disputed domain name is related to his personal AI work, yet he later states that he has never used the disputed domain name. Ultimately, no evidence has been furnished in the Respondent's informal communications attesting to any use or demonstrable preparations to use the disputed domain name and the Panel finds it unlikely that any evidence would support a notion of fair use given the composition of the disputed domain name and the prior use to which it was put.

The Panel notes that, pursuant to Paragraph 4(c) of the Policy, the rights and legitimate interests of a registrant may be found in certain circumstances, including the following:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel finds that the record does not indicate that any of these circumstances are present, nor that there is any other evidence to support a finding that the Respondent has established his rights or legitimate interests in the disputed domain name.

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 finds that the Respondent intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's mark. The disputed domain name was registered more than 40 years after the Complainant registered its BARNES & NOBLE trademark, for which the Complainant has provided sufficient evidence to support a finding that it is a well-known mark. The disputed domain name differs from this mark only by the substitution of the word "and" for the ampersand, which still renders the disputed domain name phonetically identical to the Complainant's mark. Moreover, the disputed domain name is identical to the Complainant's primary domain name <barnesandnoble.com>, in use since 1997. Under these circumstances, the Panel finds that the disputed domain name was registered in bad faith. [WIPO Overview 3.0](#), section 3.1.

UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Further, the Panel finds that the previous use of the disputed domain name to resolve to a website featuring PPC links related to the Complainant's business is an additional indication of bad faith use of the disputed domain name. [WIPO Overview 3.0](#), section 3.5.

The Panel notes that, under the Policy and established UDRP practice, the fact that the disputed domain name was available for registration does not, by itself, prevent a finding of bad faith. In this case, the Panel finds that the disputed domain name is nearly identical to a well-established trademark and that it was therefore registered in bad faith. Further, the Panel finds that the disputed domain name is being passively held in bad faith by the Respondent. The Respondent has provided no evidence that would support a different finding by the Panel. Moreover, given that the secondlevel of the disputed domain name ("barnesandnoble") is identical to that within the Complainant's own domain name ("barnesandnoble"), as well as being phonetically identical to the Complainant's mark, the Panel cannot contemplate any good faith use of the disputed domain name that would not cause confusion with the Complainant.

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 <barnesandnoble.ai> be transferred to the Complainant.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: March 12, 2024