

ADMINISTRATIVE PANEL DECISION

Elsevier BV v. Domain Admin

Case No. DCO2024-0034

1. The Parties

The Complainant is Elsevier BV, Netherlands (Kingdom of the), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States of America (“United States”).

The Respondent is Domain Admin, Panama.

2. The Domain Name and Registrar

The disputed domain name <sciencedirect.co> 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 May 6, 2024. On May 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Redacted for Privacy / Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 9, 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 amended Complaint on May 10, 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 May 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 2, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 5, 2024.

The Center appointed Mihaela Maravela as the sole panelist in this matter on June 11, 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

According to information in the Complaint, the Complainant is a world leading scientific publisher and data analytics company. One of the Complainant's product offerings is the ScienceDirect database of peer-reviewed, full-text scientific, technical and health literature. The ScienceDirect database, which was launched in 1997, hosts over 18 million pieces of content from more than 4,000 academic journals and 30,000 e-books. Since its launch, the Complainant has used its SCIENCEDIRECT trademark in connection with the marketing, advertising, promotion, and provision of the Complainant's ScienceDirect database.

The Complainant is the holder of the United States trademark registration No. 2226808 for SCIENCEDIRECT (word), registered on February 23, 1999, for services in class 42.

The disputed domain name was registered on August 13, 2012. The disputed domain name is hosting a website featuring sponsored pay-per-click ("PPC") advertisements for competing services.

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 identical to the SCIENCEDIRECT mark of the Complainant because it is comprised solely of the SCIENCEDIRECT mark.

As regards the second element, the Complainant argues it has not authorized the Respondent to use the SCIENCEDIRECT mark and the Respondent is not a licensee of the Complainant. The Respondent cannot assert that it has been using the disputed domain name, prior to any notice of the present dispute, in connection with a bona fide offering of goods or services or that it has made demonstrable preparation to do so, in accordance with paragraph 4(c)(i) of the Policy. The disputed domain name resolves to a website featuring PPC sponsored advertisements. In addition, the Respondent has used the disputed domain name to redirect visitors to different websites. The Complainant concludes that the Respondent's sole intent in registering the disputed domain name appears to be to attract visitors to the website at the disputed domain name for the Respondent's own financial gain. In addition, the Complainant submits that the Respondent is not commonly known by the name ScienceDirect.

With respect to the third element, the Complainant argues that the SCIENCEDIRECT mark is a highly distinctive mark that has been in use in commerce by the Complainant exclusively for the past twenty-seven (27) years, making it difficult for the Respondent to offer a credible explanation for registering the disputed domain name other than for specifically targeting the Complainant to trade off the goodwill associated with the SCIENCEDIRECT mark, which amounts to registration of the disputed domain name in bad faith. The Complainant further submits that the use of the disputed domain name to resolve to a PPC website or to redirect visitors to a different website is evidence of registration and use in bad faith.

B. Respondent

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

6. Discussion and Findings

No response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of

probabilities” or “preponderance of the evidence”, and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.2.

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a 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 3.0](#), section 1.7.

The Complainant has shown rights in respect of the SCIENCEDIRECT trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

In addition, the Panel finds that the addition of the country-code Top-Level Domain (“ccTLD”) “.co” to the disputed domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. [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.

There is no evidence that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. Rather, according to the unrebutted evidence put forward by the Complainant, the disputed domain name is used to host a parked page comprising PPC links to competing services. According to section 2.9 of the [WIPO Overview 3.0](#). “Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark

or otherwise mislead Internet users.” In this case, the PPC links are related to the Complainant’s trademark SCIENCEDIRECT and generate search results with competing services to those offered by the Complainant. In this Panel’s view, such use does not confer rights or legitimate interests to the Respondent. Also, there is no evidence that the Respondent is commonly known by the disputed domain name.

Furthermore, the nature of the disputed domain name carries a high risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

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.

The Complainant’s registration and use of the relevant trademarks predate the date at which the Respondent registered the disputed domain name. Given the distinctiveness of the Complainant’s trademark and the identity between the disputed domain name and the Complainant’s trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant’s trademarks, and to target those trademarks.

The disputed domain name is used by the Respondent to direct to a website displaying PPC advertisements related to the Complainant’s services. Given the identity between the SCIENCEDIRECT trademark and the disputed domain name, Internet users would likely be confused into believing that the Complainant is affiliated with the website to which the disputed domain name resolves. Presumably the Respondent intends to benefit from the confusion created: it is likely that the Respondent earns income when Internet users click on the links in search of SCIENCEDIRECT services.

Furthermore, the Respondent has not replied to the Complainant’s contentions in these proceedings and used a privacy service when registering the disputed domain name. The Respondent’s bad faith is reinforced by the Respondent’s use of a fake address to which the courier delivery could not be made. These circumstances are further indications of bad faith. 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 <sciencedirect.co> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: June 25, 2024