

ADMINISTRATIVE PANEL DECISION

R.R. Donnelley & Sons Company v. Diego Johnson, Sterling Construction Company

Case No. D2024-0411

1. The Parties

The Complainant is R.R. Donnelley & Sons Company, United States of America (“United States”), represented by Loeb & Loeb LLP, United States.

The Respondent is Diego Johnson, Sterling Construction Company, United States.

2. The Domain Name and Registrar

The disputed domain name <rr-donnelley.net> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 29, 2024. On January 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 30, 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 (Redacted for Privacy, Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 7, 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 February 7, 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 February 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 8, 2024.

The Center appointed William F. Hamilton as the sole panelist in this matter on March 15, 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, founded in 1864, is a leading global provider of marketing, packaging, print, and supply chain services and has used the trade name “RR Donnelley” since 1890.

The Complainant currently has over 22,000 clients and 32,000 employees across 28 countries. In 2020, the Complainant’s net sales were USD 4.8 billion.

The Complainant owns the United States Trademark Registration No. 2,842,428, registered on May 18, 2004, for the trademark RR DONNELLEY (the “Mark”), in addition to owning numerous registrations for the Mark in countries around the world.

The disputed domain name was registered on January 7, 2023. The disputed domain name resolves to a website displaying competing pay-per-click links related to publishing and business process 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. The Complainant asserts the disputed domain name is confusingly similar to the Mark because the disputed domain name is identical to the Mark except for placing a hyphen between “r” and “donnelley” where the Mark has a space. The Complainant asserts that the Complainant never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, never operated a business under the disputed domain name, and never engaged in any bona fide commercial activity in connection with the disputed domain name. The Complainant asserts that the Respondent knew of the Mark when registering the disputed domain name and by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (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 was 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 the Mark for the purposes of the Policy by virtue of the Mark's registrations. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name's only deviation from the Mark is the insertion of a hyphen in place of the space between "rr" and "donnelley" in the Mark, which does not prevent a finding of confusing similarity between the disputed domain name and the Mark.

The generic Top-Level Domain ".net" in the disputed domain name is viewed as a standard registration requirement and is disregarded in the analysis under the first element of the confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that 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 evidence submitted by the Complainant indicates that the Respondent's utilization of the disputed domain name involves redirecting visitors through pay-per-click links, thereby diverting Internet users, including potential customers of the Complainant, to a portal that facilitates access to third-party websites. These websites endorse services that compete with the Complainant.

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 Respondent has registered and used the disputed domain name in bad faith to divert Internet users to the Respondent's website for commercial profit. The confusingly similar disputed domain name creates a false impression of the Complainant's sponsorship, affiliation, or endorsement of the Respondent's website. [WIPO Overview 3.0](#), section 3.1. The employment of the disputed domain name, which bears a confusing similarity to the Complainant's trademark, in association with a website that provides links to products that

compete with those of the Complainant demonstrates the Respondent's bad faith registration and use of the disputed domain name.

A simple Internet search, which should normally be undertaken before registering a domain name would have quickly disclosed the Mark. Moreover, the Mark is well known in the packaging and publishing industry. Given the minor differences between the Complainant's unique Mark and the disputed domain name, it strains credulity to believe that the Respondent has innocently and unknowingly registered and used the disputed domain name, especially when the website with pay-per-click links related to services competitive with the Complainant's services.

Finally, even ignoring the above compelling evidence of bad faith use, it is difficult to conceive of any use that the Respondent might make of the disputed domain name without the Complainant's consent that would not involve bad faith. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#) (where the reputation of a complainant in a given mark is significant and the mark bears strong similarities to the disputed domain name, the likelihood of confusion is such that bad faith may be inferred).

The Panel finds the third element of the Policy has been established.

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 <rr-donnelley.net> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: March 29, 2024