

Before the:

NATIONAL ARBITRATION FORUM

Cengage Learning, Inc and
The Gale Group, Inc.

(Complainants)

-- v. --

Marmaduke Robida / Gale Cengage

(Respondent)

Disputed Domain Name:

“GaleCengage-publicdomain.com”

**COMPLAINT IN ACCORDANCE WITH THE
UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

1. This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved by ICANN on October 24, 1999 (the “ICANN Policy”), and the Rules for Uniform Domain Name Dispute Resolution Policy (the “ICANN Rules”), adopted by ICANN on August 26, 1999 and approved by ICANN on October 24, 1999 and updated effective March 1, 2010, and the National Arbitration Forum (NAF) Supplemental Rules (Supp. Rules). ICANN Rule 3(b)(i). See a copy of the ICANN Policy attached hereto as Exhibit A.

2. **COMPLAINANT INFORMATION**

The Complainants’ information is as follows:

Name: Cengage Learning, Inc.
Address: 200 First Stamford Place
Stamford, CT 06902
Telephone: (248) 699-8942
Fax: (248) 699-8074
E-mail: william.sampson@cengage.com

Name: The Gale Group, Inc.
Address: 27500 Drake Road

Farmington Hills, MI 48331
Telephone: (248) 699-8942
Fax: (248) 699-8074
E-mail: william.sampson@cengage.com

The Complainant's authorized representative in this administrative proceeding is:

Name: Alexandre A. Montagu
Address: 1120 Avenue of the Americas
4th Fl
New York, NY 10036
Telephone: (212) 996-1287
Fax: (212) 996-9579
E-mail: trademarks@montagulaw.com

The Complainant's preferred method of communication directed to the Complainant in the administrative proceeding is as follows:

Electronic-only material:

Method: E-mail at "trademarks@montagulaw.com"
Address: 1120 Avenue of the Americas
4th Floor
New York, NY 10036
Contact: Alexandre A. Montagu

Material including hardcopy:

Method: Fax to 212-996-9579
Address: 1120 Avenue of the Americas
4th Floor
New York, NY 10036
Contact: Alexandre A. Montagu

The Complainants choose to have this dispute heard before a single-member administrative panel.

3. **RESPONDENT INFORMATION**

According to Network Solution's Whois database as of January 14, 2013, the Respondent in this administrative proceeding is Marmaduke Robida / Gale Cengage. A printout of the Whois database search listing Marmaduke Robida / Gale Cengage as the registrant of the Infringing Domain is attached as Exhibit B to this Complaint.

All information known to the Complainants regarding how to contact the Respondent is as follows:

Marmaduke Robida
Gale Cengage
marmaduke.robida@aol.co.uk
Johanneshov 121
Stockholm, 1021, SE
phone: +46.938483

4. **DISPUTED DOMAIN NAME**

(a.) The following domain name is the subject of this Complaint: “GaleCengage-publicdomain.com” (the “Infringing Domain.”)

(b.) The Infringing Domain is registered with the following Registrar, and a copy of the applicable policy is attached hereto as Exhibit C:

Vautron Rechenzentrum AG
Obermuensterstr.9
93047 Regensburg
support@vautron.de

(c.) The Complaint is based on the following trademark registrations:

The CENGAGE Trademark

Cengage Learning is a leading provider of innovative teaching, learning and research solutions for the academic, professional and library markets worldwide. The company has annual revenues of approximately \$2 billion, and has over 5,000 employees with operations in more than 20 countries around the world. Cengage Learning owns trademark registrations for the CENGAGE mark in various jurisdictions throughout the world, including the United States, Australia, CTM (EU), and China. A schedule of Cengage Learning’s trademark registrations and a copy of the United States and CTM registration certificates for the CENGAGE mark are attached hereto as Exhibit D. The CENGAGE mark has become extremely famous in the academic, professional and library markets worldwide and is among Complainant’s most valuable assets.

The CENGAGE mark has been used extensively on the Internet, in printed publications and in various other media. Cengage Learning also has spent millions of dollars annually on various types of advertising involving the CENGAGE mark. By reason of the extensive use and advertising of Cengage Learning’s goods and services, the CENGAGE mark has come to be recognized and relied upon by the trade and the public as identifying Cengage Learning and its teaching, learning and research goods and services, and as distinguishing Cengage Learning from others and the goods and services of others.

Cengage Learning has an active presence on the Internet. The principal domain name currently registered and used by Cengage Learning is cengage.com. The cengage.com domain name has been registered since June 15, 2007. Cengage Learning also owns numerous other domain names incorporating the CENGAGE mark, such as cengage.net, and cengagelearning.com.

The GALE Trademark

The Gale Group Inc. (“Gale”)¹ is a leading publisher of research and educational books and materials. Gale has been in business for over fifty years and owns a number of U.S. trademark registrations which incorporate the term “GALE” (the “GALE Trademarks”). A schedule of Gale’s trademark registrations and a copy of the United States registration certificate for the GALE mark are attached hereto as Exhibit E.

Gale is a world leader in e-research and educational publishing for libraries, schools and businesses. Best known for its accurate and authoritative reference content as well as its intelligent organization of full-text magazine and newspaper articles, the company creates and maintains more than 600 databases that are published online, in print, as eBooks and in microform. Gale uses the GALE Trademarks extensively in printed publications, on the Internet, and other media. Gale produces a wide range of print and online information services for colleges, schools and public libraries worldwide. Each year, Gale publishes hundreds of books, CD-ROMs and Internet-delivered products devoted to serving the information needs of students, businesspeople and other researchers. See Articles, Screenshots and Press Releases attached hereto as Exhibit F.

By reason of the extensive use and advertising of GALE, the GALE trademarks have come to be recognized and relied upon by the trade and the public as identifying Gale and its publishing and content-based goods and services, and as distinguishing Gale’s products from the goods and services of others. In fact, the GALE Trademarks are famous in the publishing and education industries and are among Gale’s most valuable assets.

Gale maintains an active presence for the GALE trademarks on the Internet, and owns many domain names that incorporate the GALE trademark, including, www.gale.com, registered on June 4, 1994, www.galenet.com, registered on March 10, 1998, and www.galegroup.com, registered on September 21, 1998.

5. **FACTUAL AND LEGAL GROUNDS**

(a.) Factual Background

The Respondent registered the Infringing Domain Name on November 20, 2012. See a printout of the WHOIS database search attached hereto as Exhibit B.

Respondent operates a website from the Infringing Domain (the “Infringing Website”) on which Respondent attempts to pass itself off as Complainants in an effort to mislead visitors and cause consumer confusion. The Infringing Website is an almost exact replica of Complainants’ website located at www.gdc.gale.com. See Screenshot of Infringing Website attached as Exhibit

¹ Gale is part of Cengage Learning.

G and screenshot of Complainants' website attached as Exhibit H. The Infringing Website is arranged in such a manner, and contains such content, that would lead visitors to conclude that Respondent is the Complainants. For example, "Gale Digital Collections" is displayed prominently on the top of the page, along with the same coloring and design found on Complainants' website. Id. In addition, the Infringing Website features a page entitled "About Gale", on which Respondent affirmatively represents that it is Complainant Gale. This page reads as follows:

Gale®, part of Cengage Learning, is a world leader in e-research and educational publishing for libraries, schools and businesses. With more than 600 databases published online, in print, as eBooks and in microform, Gale is highly regarded for its accurate and authoritative reference content as well as its intelligent organization of full-text magazine and newspaper articles. To see the many ways Gale brings Power to the user™ and how we can help you find what you're searching for, find out more »

See screenshot from the Infringing Website attached hereto as Exhibit I. Notably, this text was copied verbatim from Complainants' website. See Screenshot attached as Exhibit J.

Furthermore, Respondent has even included links to Complainants' website on the Infringing Website under headings such as "About Us" (which links to www.gale.cengage.com/about), and "Terms of Use" (which links to <http://www.gale.cengage.com/policy.htm#terms>). See screenshot attached as Exhibit G.

Respondent also offers a tool for downloading on the Infringing Website that allows users to bypass Complainants' security systems and gain unauthorized access to Complainants' website and download content therefrom without payment of the requisite fees. See screenshot attached as Exhibit G.

On January 9, 2013, Respondent distributed a press release, falsely stating that Complainants were releasing all of their "public domain" content for free on the Internet. See copy of the Press Release attached hereto as Exhibit K. In the press release, Respondent referred to himself as Gale's "Director for Public Domain Content", and encouraged users to visit the Infringing Website to download the allegedly free materials. Id. Respondent also responded to questions posted on a discussion board by individuals who had read the press release and visited the Infringing Website. See Screenshots attached as Exhibit L. In these responses, Respondent continued to hold himself out as an official representative of Gale, and attempted to convince the audience that the Infringing Website was legitimate. Id.

Respondent's registration and misuse of the Infringing Domain led Complainants to send letters to the Registrar and the Host of the Infringing Domain requesting that the Infringing

Website be taken down (the “Demand Letters”). See a copy of the Demand Letters attached hereto as Exhibit M.

Shortly after sending the Demand Letters, Complainants discovered that the Infringing Website had been altered to include the word “Fake” in the upper left corner of the site, and to revise the introductory paragraph on the home page to state that the site is a “spoof”. See Screenshots of the Revised Infringing Website attached as Exhibit N. However, aside from these two slight revisions, the Infringing Website appears to be unaltered, and in particular still features all of the other components referenced above, encompassing the overall look and feel of Complainants’ website, resulting in a near replica of Complainants’ website. Id.

Respondent’s registration and misuse of the Infringing Domain is a flagrant attempt to subvert the purpose of domain name use and registration and to circumvent the authority of the domain name registration system.

(b.) Confusing Similarity

The domain name used by Respondent is confusingly similar to the famous CENGAGE and GALE Trademarks owned by Complainants. The CENGAGE and GALE Trademarks were famous and distinctive at the time the Respondent registered the Infringing Domain. The Infringing Domain—GaleCengage-publicdomain.com—fully incorporates the CENGAGE and GALE Trademarks, and therefore is confusingly similar to Complainants’ trademarks. In addition, it is well established that the addition of a generic term such as “public domain” to a registered trademark does not negate a finding of confusing similarity. See The Royal Bank of Scotland Group plc v. Wild West c/o Wild, Natl. Arb. Forum Case No. 0709001082183 (November 2, 2007). Furthermore, where, as here, the Infringing Domain merely adds a term to the Complainants’ registered trademark which describes or suggests the Complainants’ goods or services, ICANN Panels have consistently found confusing similarity. See Ace Cash Express, Inc. v. Portfolio Brains, Natl. Arb. Forum Case No. 0710001093846 (December 5, 2007); and Am. Int’l Group, Inc. v. Ling Shun Shing, Natl. Arb. Forum Case No. 0310000206399 (December 15, 2003). Here, the Respondent has merely added the term “public domain”, which is a generic term that is intended to refer to some of the goods and services that are offered under Complainants’ trademarks. Because the Infringing Domain fully incorporates the GALE and CENGAGE marks, and only differs by the addition of the generic term “public domain”, it is confusingly similar to Complainants’ marks.

(c.) No Rights or Legitimate Interests

Respondent has no rights or legitimate interests with respect to the Infringing Domain. The Infringing Domain bears no relationship to the business of Respondent. The Respondent is not commonly known by the Infringing Domain and has no relationship with or permission from Complainants for the use of their famous trademarks. Respondent has not been given a license by Complainants to use the trademarks and does not otherwise come within any of the provisions of paragraph 4(c) of the ICANN Policy. See Konica Corporation, Minolta Kabushiki Kaisha aka Minolta Co., Ltd. v. IC, WIPO Case No. D2003-0112 (March 31, 2003). Furthermore, Respondent is not making a legitimate noncommercial or fair use of the Infringing Domain.

Moreover, Respondent has used the Infringing Website to pass itself off as Complainants in a blatant attempt to cause consumer confusion. Respondent has no right or legitimate interest in exploiting the Infringing Domain to pass itself off as Complainants. See Google Inc. v. power sky a/k/a wanglun, Natl. Arb. Forum Case No. FA1109001407268 (October 27, 2011); 3M Innovative Properties Company v. [Redacted], Natl. Arb. Forum Case No. FA0808001220698 (October 9, 2008).

To that extent that Respondent may claim that it is making a legitimate noncommercial or fair use of the Infringing Domain, that argument must fail, where, as here, the Respondent “intentionally imitates the look and feel of the mark owner's site and provides text apparently related to Complainant's programs and content,” thus causing consumer confusion. See Grupo Costamex, SA de C.V. v. Stephen Smith and Oneandone Private Registration / 1&1 Internet Inc., WIPO Case No. D2009-0062 (March 25, 2009)(Panel noted that non-commercial use which is permitted by paragraph 4(c)(iii) must still be “fair” or “legitimate”, and found that a prime consideration in determining whether a non-commercial criticism site is “fair” or “legitimate” is that the site “must not mislead site visitors into thinking that it is the site of the trademark owner, or that it is somehow authorised or endorsed by the trademark owner.”); and Union Square Partnership, Inc., Union Square Partnership District Management Association, Inc. v. unionsquarepartnership.com Private Registrant and unionsquarepartnership.org Private Registrant., WIPO Case No. D2008-1234 (October 22, 2008).

(d.) Bad Faith

The Infringing Domain Name has been registered and used in bad faith by Respondent. Respondent is using Complainants’ famous marks in an effort to attract consumers to Respondent’s website. This alone is sufficient to demonstrate Respondent’s bad faith See Thomson Canada Limited, et. al. v. Joe Hyon-chol, NAF Case No. FA0711001107033 (Jan. 17, 2008)(“Respondent intends to use Complainant’s marks to attract the public to the website without permission from Complainant. This is evidence of registration and use in bad faith.”).

Respondent's efforts to pass itself off as Complainants on the Infringing Website provide further evidence of Respondent's bad faith. See Monsanto Co. v. Decepticons, NAF Case No. FA 101536 (Dec. 18, 2001) (Respondent's use of domain to misrepresent itself as Complainant and to provide misleading information to the public supported a finding of bad faith); Salesforce.com, Inc. v. Mandi Sun / Sun Man di / sunmandi, Natl. Arb. Forum Case No. 1105001389992 (June 27, 2011)(Respondent's use of a domain name pass itself off as Complainant by using Complainant's marks and logos on the resolving website "inherently disrupts Complainant's business as it delays or impedes Complainant's legitimate customers and potential customers from finding Complainant's services and products"). It is clear from even a cursory glance at the Infringing Website that Respondent is attempting to pass itself off as Complainants. Indeed, the website is almost an exact replica of Complainants' website². See Screenshots attached as Exhibits G and H. One need look no further than the home page of the Infringing Website, where the name "Gale Digital Collections" is displayed prominently on the top of the page, along with the same coloring and design found on Complainants' website. Id. Other examples of similarities between the two websites include:

- both home pages are divided into three columns, with the left side of the page featuring a list of topics, such as "Products", "Partners" and "Contact Us", along with links to others pages within the websites, the middle of the page featuring content under the headings of "News" and "Partners", and the right side of the page featuring links to upcoming product releases;
- both websites feature the GALE and CENGAGE trademarks at the bottom of each page inside of a green border, along with links to Complainants' Terms of Use and Privacy Statement.
- both websites feature a green border at the top of each page, along with links entitled "Contact Us" and "About Us" in the upper right-hand corner of the page.

If there was any doubt that Respondent is using the Infringing Domain in a bad faith attempt to pass itself off as Complainants, that doubt is removed by Respondent's direct copying of text from the Complainants' website, including on the "About Gale" page, which copies verbatim the text found on the page of the same name on Complainants' website. See screenshots attached as Exhibits I and J. Based on the foregoing, it is clear that the Infringing Domain was registered and

² Respondent's recent revisions to the Infringing Website described in Section 5 above do not alter or obscure the bad faith demonstrated by the original version of the site. Indeed, Respondent's actions in this regard can only be viewed as an attempt to mask—and escape liability from--his true bad-faith purpose in registering and using the domain. Moreover, the revisions are so minimal that they are not sufficient to dispel the consumer confusion that is likely to occur upon visiting the Infringing Website. In any event, it is well established that the addition of a disclaimer cannot cure bad faith, where bad faith has been established by other factors. See Estee Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna, WIPO Case No. D2000-0869 (September 25, 2000).

is being used to create a misleading and confusing impression as to the source of the Infringing Website and/or Respondent's affiliation with, or endorsement by Complainants.

Furthermore, the Infringing Website also contains one feature that is not on Complainants' official website—a link to a downloadable application entitled “Public Domain Downloader”, which allows users to bypass Complainants' security systems and gain unauthorized access to Complainants' website and download content therefrom without payment of the requisite fees. See screenshot attached as Exhibit G. The link to the downloader application and the accompanying content on the Infringing Website are clearly intended to blend in with the rest of the website in an effort to make it appear official. For example, there is a preview of the application on the home page of the Infringing Website, which prominently displays the “Gale Digital Collections” phrase along with the same design and coloring used by Complainants on their website. Id. In addition, the Infringing Website falsely claims that the application is an official product of the Complainants':

“The Public Domain Downloader is a simple tool developed by Gale-Cengage to let you download easily an entire book or a newspaper issue. First, you need to search the title list(s) in every product page for a document you are interested in. Then, spot the book or issue id and the content set name. Copy-paste them in the appropriate fields of the Public Domain Downloader and click "Download". After a few minutes, enjoy the Public Domain. It is that simple.”

See Screenshot attached as Exhibit O. The use of the Infringing Website to distribute a product that is held out to be legitimate, but is actually intended to cause harm to Complainants provides an additional basis for a finding of bad faith under the Policy. See Louis Vuitton Malletier S.A. v. Thomas Vuitton, Natl. Arb. Forum Case No. 0811001232819 (Dec 17, 2008). Therefore, there can be no doubt that Respondent has registered the domain name primarily for the purpose of disrupting Complainants' business.

In addition, to the extent that Respondent may claim that its revisions to the Infringing Website should allow it to escape a finding of bad faith under a fair use parody/criticism theory, that argument must fail. First, this belated attempt at making the site appear to be a ‘protest’ site does not in any way excuse the bad faith that was already exhibited in the original version of the site. Furthermore, previous Panels have found that bad faith is present even when the disputed domain is used in connection with a non-commercial protest site, where, as here, the Respondent “deliberately creates initial interest confusion, with the intention of attracting increased Internet traffic...to his or her website, and does not comply with the requirements of fairness or legitimacy which UDRP panels have generally considered appropriate.” See Grupo Costamex, SA de C.V. v. Stephen Smith and Oneandone Private Registration / 1&1 Internet Inc., WIPO Case No. D2009-0062 (March 25, 2009); and Union Square Partnership, Inc., supra, WIPO Case No. D2008-1234 (October 22, 2008). As described above, Respondent's actions in registering the

Infringing Domain and attempting to pass itself off as Complainants by creating a replica website are likely to lead to consumer confusion, and Registrant has not taken sufficient action to dispel such confusion (either before or after the revisions to the site were made). See Union Square Partnership, Inc., supra, WIPO Case No. D2008-1234 (October 22, 2008)(parody defense denied where both the disputed domain name and the associated site's content were “chosen to confuse”). In fact, Complainants have discovered evidence of actual consumer confusion arising out of Respondent’s activities, as well as efforts by Respondent to further--rather than dispel--such confusion. See Screenshots attached hereto as Exhibit P. Moreover, Respondent’s continued use of the Infringing Website to distribute a tool allowing unauthorized access to, and ability to download from Complainants’ website, destroys any argument that Respondent may otherwise have been able to assert that the website is being used for a legitimate purpose. Therefore, any attempt by Respondent to take advantage of a fair use defense cannot succeed.

Finally, because of the fame associated with the CENGAGE and GALE Trademarks, the Panel may find that *any* use of the Infringing Domain by the Respondent constitutes bad faith. See Harrods Ltd. V. Harrod’s Closet, WIPO Case No. D2001 – 1027 (Sept. 28, 2001) (Panel found that where a mark is so obviously connected with well-known products, its very use by someone with no connection to these products can evidence opportunistic bad faith). Given the inherent distinctiveness and fame of the CENGAGE and GALE marks, there is no conceivable explanation, let alone a good faith one, for the registration and use of the Infringing Domain by a person with no connection to Complainants. Therefore, Respondent’s registration and use of the domain can only have been done in bad faith. While this alone would be sufficient for a finding of bad faith, Respondent’s attempt to pass itself off as Complainants on the Infringing Website leaves no doubt that Respondent has acted in bad faith.

The unlawful acts of Respondent have caused and are continuing to cause irreparable injury to the goodwill and reputation of Complainants and, unless restrained, will cause further irreparable injury.

6. **REMEDY SOUGHT**

In accordance with the ICANN Policy, and for the reasons described above, Complainants request that the Administrative Panel appointed in this administrative proceeding issue a decision that the contested domain name www.GaleCengage-publicdomain.com be transferred to Complainants.

7. **OTHER LEGAL PROCEEDINGS**

No other legal proceeding has been commenced or terminated in connection with or relating to the domain name that is the subject of the Complaint.

8. **COMPLAINT TRANSMISSION**

The Complainants assert that a copy of this Complaint, together with the cover sheet as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder), in accordance with ICANN Rule 2(b) and to the Registrar(s) of the domain name, in accordance with NAF Supp. Rule 4(e). ICANN Rule 3(b)(xii); NAF Supp. Rule 4(c).

9. **MUTUAL JURISDICTION**

The Complainants will submit, only with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name that is the subject of this Complaint, to the jurisdiction of the courts where the principal office of the Registrar, Vautron Rechenzentrum AG, is located.

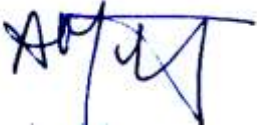
10. **CERTIFICATION**

Complainants agree that their claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waive all such claims and remedies against (a) the National Arbitration Forum and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

Complainants certify that the information contained in this Complaint is to the best of Complainants' knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under the ICANN Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted,

MONTAGULAW, P.C.

A handwritten signature in blue ink, appearing to read 'AMT', written over a horizontal line.

By: Alexandre Montagu

January 29, 2013

[Date]