

ADMINISTRATIVE PANEL DECISION

Universal Remanufacturing Co. LLC d/b/a Phoenix Chassis v. suzan cemal
Case No. D2022-3521

1. The Parties

The Complainant is Universal Remanufacturing Co. LLC d/b/a Phoenix Chassis, United States of America (“United States”), represented by Bodman PLC, United States.

The Respondent is suzan cemal, Türkiye.

2. The Domain Names and Registrar

The disputed domain names <phoenix-chassis.com> and <phoenixchassis.net> are registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 22, 2022. On September 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 24, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 29, 2022 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 October 4, 2022.

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 October 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 31, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on November 4, 2022. 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.

In terms of paragraph 12 of the Rules, the Panel may request, in its sole discretion, further statements or documents from either of the Parties which it may deem necessary to decide the case. In the present case, the Panel wished to receive more information regarding the nature and extent of the Complainant's use of the PHOENIX CHASSIS mark. Accordingly, on December 5, 2022, the Panel issued Procedural Order No. 1 to the Parties. This requested the Complainant to submit evidence of the Complainant's use of PHOENIX CHASSIS as a source identifier of the Complainant's services prior to the Complainant's filing of the UDRP complaint by December 12, 2022. The Respondent was invited to reply to the Complainant's submission by December 19, 2022. The Decision due date was extended to December 26, 2022. On December 12, 2022, the Complainant filed a reply to said Procedural Order. The Respondent did not reply to the Procedural Order.

4. Factual Background

Incorporated in Michigan, United States, on January 5, 2022, the Complainant is a limited liability company that manufactures and sells new, used, refurbished, and remanufactured shipping containers and shipping container chassis. It also provides repair, maintenance, modification, and refurbishing services for shipping container chassis and shipping container trailers. Its services are provided across the United States.

The Complainant owns an application for a United States trademark for the word mark PHOENIX CHASSIS under Serial No. 97/353271, filed on April 8, 2022. Said application has not yet proceeded to grant. It was filed on an "intent to use" basis, which the Complainant states means that the Complainant has a *bona fide* intention to use the mark concerned.

Between April 5, 2022 and April 11, 2022, the Complainant corresponded with a graphic design company with regard to the preparation of a logo corresponding to the PHOENIX CHASSIS mark. Ultimately, the Complainant elected not to proceed with said company's services and intimated its decision to said company on April 11, 2022. The domain name <phoenixchassis.com>, which is not the subject of this proceeding, was registered one day later, on April 12, 2022. On April 14, 2022, the Complainant contacted the registrant of said domain name listed on the corresponding Whois record and was told that the domain name concerned could be purchased for USD 4,550.

The disputed domain names were registered on April 14, 2022, and the Complainant asserts that these registrations were effected within minutes of it contacting the registrant of <phoenixchassis.com>. Little is known regarding the Respondent, other than that it appears to be an individual with an address in Istanbul, Türkiye. The disputed domain names have been offered for sale on an aftermarket website in the sum of USD 25,000 each.

On April 25, 2022, the Complainant's representatives wrote to the Respondent asserting that the disputed domain names were registered with a bad faith intent to profit from the Complainant's rights. No response was received to said communication.

5. Parties' Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

Under United States law, the filing of an application to register a mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, provided the mark identified in the application ultimately registers. The Complainant is the sole owner of a United States federal application to register the PHOENIX CHASSIS mark filed on April 8, 2022, establishing the date on which it would have priority against subsequent users.

The disputed domain names incorporate the Complainant's exact mark in its entirety. They are each identical thereto. The timing of the Complainant's application for the trademark and that of the registration of the disputed domain names indicates that the Respondent registered them upon publication of said trademark application as part of a cybersquatting scheme to register domain names identical to the mark for the purpose of profiting in excess of the cost of said domain names. The Complainant believes that the logo designer with which it was corresponding had informed the Respondent of the Complainant's intentions with regard to the trademark application as this had been disclosed during the Complainant's discussion with the logo designer. The disputed domain names were registered soon after the Complainant's relationship with the logo designer was terminated.

Rights or legitimate interests

There is no indication that the Respondent has rights or legitimate interests in the disputed domain names. The Complainant has granted no license or otherwise permitted the Respondent to use its mark. There is no evidence of any corresponding *bona fide* offering of goods and services. There is no evidence that the Respondent has been commonly known by the disputed domain names and the Respondent is using a privacy service to shield its identity. There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names. The Respondent registered the disputed domain names only six days after the Complainant's trademark application was filed and the available evidence demonstrates that the Respondent purchased the disputed domain names precisely because it believed that it could profit from use of the Complainant's mark therein. The disputed domain names are offered for sale at an amount that is significantly in excess of any plausible costs related to their registration.

Registered and used in bad faith

The suspicious timing of the registration of the disputed domain names indicates the Respondent's awareness of the Complainant's rights in the mark and demonstrates the Respondent's bad faith. The disputed domain names were registered six days after the Complainant filed its trademark application, shortly after the said application became public knowledge, and in connection with the Complainant's disclosure to its logo designer. At the time of registration of the disputed domain names, the Respondent was fully aware of the Complainant and its claim of rights in the mark. Bad faith may be found where the respondent registered the disputed domain name following the complainant's filing of a trademark application, if the circumstances indicate the respondent intended to unfairly capitalize on the complainant's nascent trademark rights.

The Respondent's conduct follows a pattern that other cybersquatters have employed to profit from trademark abuse and is conduct that panels consistently recognize as bad faith. The disputed domain names have resolved to websites that offer them for sale at costs well beyond the cost of registration. The Respondent had knowledge of the Complainant's rights, it registered the disputed domain names mere minutes after the Complainant had rejected the unreasonable offer to sell a nearly identical domain name for USD 4,550, and has no credible evidence-backed rationale for registering the disputed domain names. Furthermore, the Respondent has concealed its identity by way of a privacy service and failed to respond to the Complainant's letter sent by email on April 25, 2022. The disputed domain names were registered or acquired primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant who is the owner of the trademark or service mark, for valuable consideration in excess of the Respondent's directly related and documented out-of-pocket costs.

Reply to Procedural Order No. 1

The Complainant has been using the PHOENIX CHASSIS mark extensively and continuously on its goods and services throughout the United States since at least as early as November 2021. On June 27, 2022, the Complainant received a World Manufacturer Identifier for its brand of PHOENIX CHASSIS goods indicating its adoption and use of said mark. The Complainant has generated sales of USD 480,000 in 2022 alone. The Complainant has invested around USD 3,500 in advertising in 2022 but has been limited in this activity due to the Respondent's registration of the disputed domain names. Consumers have come to know the Complainant under said mark in the industry, and due to the Complainant's strong reputation for quality product and services, consumers continue to request its goods and services under said mark on a regular basis.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied in respect of the disputed domain names:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Notwithstanding the Complainant's contentions regarding the effect of a trademark application under its national law, it is a long-established principle of UDRP jurisprudence that a pending trademark application by itself is insufficient to establish rights in a trademark for the purposes of the first element under the Policy (see, for example, *UBUX Pty Ltd. v. Domains By Proxy, LLC / Jeffrey DeWit, Revasser Ventures LLC*, WIPO Case No. [D2018-2290](#), and section 1.1.4 of the Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Accordingly, the Complainant cannot establish standing on the basis of its pending United States trademark application for the purposes of the present proceeding.

The Complainant has however provided evidence that it has used the mark PHOENIX CHASSIS in commerce in the United States since at least as early as January 2022. Although it did not provide a breakdown of its sales under said mark for the period predating the registration date of the disputed domain names, it must be noted that the Complainant's sales under the mark in 2022 as a whole (USD 480,000) are substantial, given the short period in which it has traded. Further evidence provided by the Complainant shows that the Complainant applies the said mark to its physical goods, in the form of liveried large vehicle trailers/chassis, and that it has supplied goods and services under said mark to consumers across the United States (invoices are supplied in respect of consumers based in Utah, California, and Nevada, United States) from at least as early as January 2022. While the evidence is necessarily limited by the fact that the Complainant has only been trading for a period of months, the Panel determines that it is sufficient for the Complainant to establish a secondary meaning in the term PHOENIX CHASSIS for the purposes of the Policy and thus that it has unregistered trademark rights in this mark (see section 1.3 of the [WIPO Overview 3.0](#) for the relevant criteria typically applied by Panels under the Policy).

Comparing said unregistered trademark to the disputed domain names, the Panel observes that the Top-Level Domain in each case may be disregarded for comparison purposes as required only for technical

reasons. In these circumstances, it may be seen that the disputed domain names are almost identical to said mark, the only differences being the use of a hyphen as a separator in place of a space in the first disputed domain name <phoenix-chassis.com> and the absence of a space in the second disputed domain name <phoenixchassis.net> (spaces not being permitted in domain names for technical reasons). These differences are of no practical consequence and the Panel therefore finds that the disputed domain names are confusingly similar to the Complainant's trademark.

Accordingly, the Complainant has carried its burden in terms of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain names:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (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."

The consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name concerned. Once such *prima facie* case is made out, the burden of production shifts to the respondent to bring forward appropriate allegations and/or evidence demonstrating its rights or legitimate interests in the domain name concerned.

In the present case, the Complainant submits that there is no indication that the Respondent has such rights or legitimate interests, that the Complainant had not permitted the Respondent to use its mark, whether by license or otherwise, that there is no evidence of any *bona fide* offering of goods and services in connection with the disputed domain names, and that there is no evidence of the Respondent being commonly known by the disputed domain names or that it is making a legitimate noncommercial or fair use of the disputed domain names. The Complainant adds that the disputed domain names were registered because the Respondent believed that it could profit from the use of the Complainant's mark, namely by offering them for sale at an amount that is significantly in excess of any plausible registration costs.

The Panel finds that these submissions, taken together, constitute a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of production therefore shifts to the Respondent. However, the Respondent has not engaged with the administrative proceeding and has failed to file any response in this case which might have set out any alleged rights or legitimate interests in the disputed domain name. The Panel notes that the disputed domain names were registered very shortly after the Complainant had decided to dispense with the services of its logo designer and within minutes of the Complainant contacting the registrant of <phoenixchassis.com>. The proximity in time suggests that the Respondent's registration of the disputed domain names is not a coincidence and is in fact connected to the Complainant terminating its arrangement with said logo designer and to the registration of <phoenixchassis.com>. In that context, the Complainant raises a reasonable case for the Respondent to answer, which indicates that the disputed domain names most probably were registered opportunistically by a person connected to the logo designer and/or to the registrant of <phoenixchassis.com> with a view to

selling them to the Complainant at a substantial profit. The Respondent has chosen to remain silent and has not answered the Complainant's case in any respects. As far as the Panel can identify from the record, no rights or legitimate interests appear to have vested in the Respondent.

In all of these circumstances, the Panel finds that the Respondent has failed to rebut the Complainant's *prima facie* case that it has no rights or legitimate interests in the disputed domain names and that the Complainant has carried its burden in terms of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The circumstances of the present case suggest that the disputed domain names have been registered primarily for the purpose of selling them to the Complainant at a value exceeding the Respondent's likely out of pocket costs. For the reasons outlined in the preceding section, the Panel considers that the Respondent appears to be engaged in prototypical cybersquatting that could not be considered to be a good faith activity.

The Respondent has chosen not to answer the Complainant's allegations of bad faith conduct. In the absence of any response, the Panel has not been able to identify any explanation which might indicate an alternative good faith motivation in connection with its registration and use of the disputed domain names, other than a pure coincidence that the Respondent hit upon exactly the same name as the Complainant entirely independently of any knowledge of the Complainant or its business. As discussed above, the proximity in time between the Complainant discontinuing the arrangements for the design of its logo and making contact with the registrant of <phoenixchassis.com>, and the registration of the disputed domain names suggests that these matters are neither unrelated nor coincidental and that on the balance of probabilities the Respondent registered the disputed domain names with knowledge of the Complainant's rights in its PHOENIX CHASSIS unregistered trademark and with intent to target the same.

In these circumstances, the Panel finds on the balance of probabilities that the Respondent has engaged in an act of prototypical cybersquatting which sought to benefit opportunistically from the fact that the Complainant had yet to register the disputed domain names corresponding to said unregistered mark. The fact that the Respondent immediately proceeded to offer the disputed domain names for sale at an amount that likely exceeds its registration costs affirms the view of the Panel that there are circumstances present that constitute evidence of the registration and use of the disputed domain names in bad faith in accordance with paragraph 4(b)(i) of the Policy.

Accordingly, the Panel finds that the Complainant has carried its burden in terms of paragraph 4(a)(iii) of the Policy.

8. 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 names <phoenix-chassis.com> and <phoenixchassis.net> be transferred to the Complainant.

/Andrew D.S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: December 26, 2022