

## **ADMINISTRATIVE PANEL DECISION**

Outfront Media LLC v. D Hawes

Case No. DCO2022-0016

### **1. The Parties**

The Complainant is Outfront Media LLC, United States of America (United States), represented by Jones Day, United States.

The Respondent is D Hawes, United Kingdom, represented by Withers LLP., United Kingdom.

### **2. The Domain Name and Registrar**

The disputed domain name <outfront.co> is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 25, 2022. On February 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 28, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 3, 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 amendment to the Complaint on March 7, 2022.

The Center verified that the Complaint together with the amendment to 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 March 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2022. The Response was filed with the Center on March 29, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 7, 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.

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

The Complainant is an American company where it provides what may be broadly be described as outdoor advertising services such as billboards, wallsapes, posters, street furniture, metro lights and advertising on public transport vehicles. According to the Complaint, it has been doing so under the trademark "Outfront" since at least 2014.

Amongst other things, it promotes its services from the website to which the domain names <outfront.com> and <outfrontmedia.com> resolve.

The landing page of that website claims that advertising placed by the Complainant is placed in over 70 different markets in the United States and reaches seven out of 10 Americans weekly.

The Complainant is the owner of a number of registered trademarks in the United States including:

- (a) Registered Trademark No. 5,834,907, OUTFRONT, for a range of advertising and promotional services in International Class 35. This trademark was registered in the Principal Register on August 13, 2019 and claims first use in commerce in October 2014; and
- (b) Registered Trademark No. 4, 909,495, OUTFRONT MEDIA, also for a range of advertising and related services in International Class 35 which was registered in the Principal Register on March 1, 2016 and also claims first use in commerce in October 2014.

The Complaint also includes evidence of other OUTFRONT-formative marks registered by the Complainant in the United States.

The Respondent is one of the two directors of a company incorporated in the United Kingdom. The company was originally incorporated under the name Elton Capital Advisors Limited in September 2012. As part of a rebrand, the company changed its corporate name to Outfront Capital Limited on March 4, 2020.

The Respondent's company provides corporate advisory and corporate finance advice for private (non-retail) clients and financing for companies across a number of sectors including "the applied artificial intelligence, data and devices space". It would appear from documents submitted with the Response that this funding is so-called pre-seed and seed capital funding. The Respondent's company has been authorised and regulated by the United Kingdom Financial Conduct Authority to provide these services since April 12, 2013. That authorisation was amended, or re-issued, by the Financial Conduct Authority in the company's re-branded name with effect from March 5, 2020.

The Respondent registered the domain names <outfront.vc>, <outfrontpartners.com> and <outfront.io> in October 2019. The Respondent's company maintains a website promoting its financial services from the <outfront.vc> domain name and the other two domain names registered at that time redirect to that website.

The Respondent registered the disputed domain name in March 2020.

The disputed domain name resolves to a typical parking page with pay-per-click (PPC) advertising links. Many, if not all, of the links connect through to advertisements for outdoor advertising services provided by persons other than the Complainant.

## 5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each 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 disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the 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

Having regard to the Complainant's Registered Trademark No. 5,834,907 and the usual practice under the Policy of disregarding the generic Top-Level Domain component,<sup>1</sup> the Respondent admits that the disputed domain name is identical to the Complainant's trademark.

Accordingly, the first requirement under the Policy is satisfied.

### B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

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<sup>1</sup> See e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it in any way. The Respondent does not dispute either of these points but says such consent is not required.

The Respondent registered the disputed domain name after the Complainant had registered its trademark and also after the Complainant began using its trademark.

The use of the disputed domain name to generate revenue through PPC links does not qualify as a legitimate noncommercial or fair use for the purposes of paragraph 4(c)(iii) of the Policy.

The disputed domain name is not derived from the Respondent's name.

These factors are typically sufficient to establish the required *prima facie* case under this requirement of the Policy.

In the present case and apparently unbeknownst to the Complainant when it filed the Complaint, however, the Respondent is a director of a company which has been known as Outfront Capital Limited since March 4, 2020 (which appears to be just before the Respondent registered the disputed domain name).

The fact that a domain name may be the same as or derived from a corporate name does not necessarily give rise to rights or legitimate interests under the Policy. First, the illustration provided by paragraph 4(c)(ii) – if established – is *prima facie* evidence of a right or legitimate interest only. Secondly, the reason why a person's given name may do so is that it is usually bestowed on the person by his or her parents long before any question of taking advantage of a third person's trademark arises. In the case of a company or business name, however, the name is something which is chosen by the incorporators or persons standing behind the company and, as in this case, may often be adopted around the same time as the domain name. Accordingly, it is often necessary to examine the motivations underlying the adoption and use of the name. See e.g. [WIPO Overview 3.0](#), section 2.3.

In the present case, the Respondent's company had been in existence for some seven or eight years. It operates in the field of investment management including financial advice and capital funding. It does so in the United Kingdom. Both the field of activity, investment management, and its geographical operations are quite remote from the outdoor advertising services provided by the Complainant in the United States.

The Respondent says the company's new name was chosen without any knowledge or awareness of the Complainant or its trademark.

Further, he points out that "out front" is an ordinary English term which was chosen for his company's name to emphasise that its target market are companies with some sort of leading edge over their competitors. Consistently with this, the Panel also notes that it appears the Respondent's company is a very early stage investor in emerging businesses.

Further still, the Respondent says the original round of domain names, particularly <outfront.vc>, were and are used for a website promoting the company's existing venture capital business. The disputed domain name was secured in connection with a planned expansion of the company's business from venture capital funding into an expanded range of private equity and funds management activities. For that broader based business, the company prefers a more "generic" name (that is, something which does not signal "venture capital" through the use of the ".vc" country code domain).

According to the Respondent, he and his company were unaware that the disputed domain name was being used for a PPC parking page which, he says, he has now discovered is standard practice by the Registrar. The Respondent says, having discovered the activity on the filing of the Complaint, it has not been possible to stop it due to the locking down of the account pending the outcome of the dispute.

In support of the claimed plans of business expansion, the Response includes an extract from a Regulatory Business Plan which the Respondent says was submitted to the United Kingdom's Financial Control Authority with, or as part of, a "CIC-178-Notice" and an invoice from a website designer said to relate to the proposed business.

It is well-established under the Policy that use of a domain name for a parking page that comprises PPC links that trade on the reputation or goodwill of a complainant's trademark does not generally qualify as a good faith offering of goods or services under the Policy. See e.g. [WIPO Overview 3.0](#), section 2.9. Typically, a respondent's claim that the registrar or some other third party has put the parking page in place without the respondent's knowledge or approval does not exonerate the respondent.

While that conduct may involve some form of contravention of the Complainant's rights in the United States, the Panel considers it does not preclude the Respondent from having rights or legitimate interests in the disputed domain name under the Policy in the circumstances of this case.

First, the Respondent's company appears to be genuinely carrying on business in the field of investment management and funding in the United Kingdom. Both the nature of the business and its geographical location are remote from the Complainant's business and the place where the Complainant carries on business – the United States. In these circumstances, it is not implausible that the Respondent did not have knowledge of the Complainant or its trademark.

Secondly, the Respondent has provided an explanation for the adoption of the new corporate name and the disputed domain name and has provided some documentary materials in corroboration.

Thirdly, it cannot be said that the conduct of the Respondent's company's business in the United Kingdom under its name would infringe any rights of the Complainant which, on the record in this proceeding, appear to be limited to the United States.

In the present case, therefore, the Panel finds that the Respondent has rebutted the *prima facie* case made out by the Complainant.

Accordingly, the Panel finds the Complainant has not established the second requirement under the Policy.

The Complaint must fail, therefore, as the Complainant cannot establish all three requirements under the Policy.

### **C. Registered and Used in Bad Faith**

As the Complaint must fail, no useful purpose would be served by considering this requirement.

### **D. Reverse Domain Name Hijacking**

The Respondent has sensibly not sought a finding of reverse domain name hijacking under paragraph 15(e) of the Rules. Having regard to the fact that there is nothing obvious associating the Respondent with his company and the use of the disputed domain name to resolve to a parking page with PPC links to businesses competing with the Complainant, the Panel finds this is not an appropriate case for such a finding.

**6. Decision**

For the foregoing reasons, the Complaint is denied.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: April 21, 2022