

ADMINISTRATIVE PANEL DECISION

Outfront Media LLC v. John Brosnan, Digital Express Case No. D2023-0085

1. The Parties

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

Respondent is John Brosnan, Digital Express, United States.

2. The Domain Name and Registrar

The Disputed Domain Name <outfrontmediafilms.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 7, 2023. On January 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 9, 2023, 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 Complainant on January 10, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on January 14, 2023.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on January 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 5, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 7, 2023.

The Center appointed Richard W. Page as the sole panelist in this matter on February 10, 2023. 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.

At the request of Respondent on February 10, 2023, the Panel granted an extension of the deadline to file a Response until March 3, 2023. Respondent did not file any Response.

4. Factual Background

Complainant leverages the power of technology, location, and creativity to connect brands with consumers outside of their homes through a collection of billboard, transit, and mobile assets in the United States.

Complainant is the owner of the OUTFRONT and OUTFRONT MEDIA Marks (collectively referred to as the "OUTFRONT Marks"), which are used in connection with a variety of advertising services including, without limitation, to advertising services featuring audio and visual content distributed via billboards, digital billboards, digital posters, and digital outdoor advertising displays, as well as other marketing and promotional services. Complainant's rights in and to the OUTFRONT Marks are embodied, in part, in United States Service Mark Registration No. 5,834,907 registered on August 13, 2019 and United States Service Mark Registration No 4,909,495 registered on March 1, 2016, as well as three additional United States Service Mark registrations incorporating "OUTFRONT."

Complainant owns the domain names <outfront.com> and <outfrontmedia.com>, at which Complainant operates an interactive Internet website marketing and promoting the advertising services it provides.

The Disputed Domain Name was registered on May 27, 2020. The website associated with the Disputed Domain Name has been used as a pay-per-click landing page.

5. Parties' Contentions

A. Complainant

Complainant contends that the Disputed Domain Name is confusingly similar to the OUTFRONT Marks pursuant to paragraph 4(a)(i) of the Policy because it wholly incorporates the OUTFRONT Marks.

Complainant further contends that appending a descriptive term to the end of a mark does not dispel confusing similarity. Moreover, the applicable Top Level Domain extension in a domain name is viewed as a standard registration requirement and as such is disregarded in the confusing similarity test.

Complainant asserts that the Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy. Complainant further asserts that Respondent is not commonly known by the Disputed Domain Name. Complainant further asserts that there is no relationship or affiliation between Complainant and Respondent giving rise to any license, permission or other right by which Respondent could own or use any domain name incorporating the OUTFRONT Marks.

Complainant further asserts that the Disputed Domain Name incorporates the OUTFRONT Marks in their entirety, without authorization from Complainant. Complainant further asserts that Respondent operated a pay-per-click website to which the Disputed Domain Name resolved, hosting multiple revolving links to third-party websites, from which Respondent presumably collected revenues for each click.

Complainant further asserts that on December 1, 2022, counsel for Complainant requested Respondent cease and desist from its use of the Disputed Domain Name, using the contact form available on the Registrar's website. As of the filing of this Complaint, Respondent has not replied.

Complainant further asserts that Respondent registered the Disputed Domain name through privacy protection to hide his or her identity. Complainant further asserts that, given Respondent's attempt to mask his or her identity, the Panel should presume that Respondent is not commonly known by the Disputed Domain Name.

Complainant further asserts that Respondent has not used 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 used the Disputed Domain Name for any legitimate non-commercial or fair use. Instead, the website associated with the Disputed Domain Name has continuously been used as an illegitimate pay-per-click landing page for Respondent's commercial gain. Complainant further asserts that the use of an infringing domain name as a pay-per-click site has been repeatedly found not to constitute a *bona fide* commercial use or any other legitimate use.

Complainant alleges that Respondent registered, used, and is holding the Disputed Domain Name willfully, in bad faith, and in complete disregard of Complainant's exclusive rights to use the OUTFRONT Marks, pursuant to paragraph 4(a)(iii) of the Policy. Respondent's actions constitute numerous instances of bad faith as set forth in paragraph 4(b) of the Policy.

Complainant further alleges that, since at least as early as October 2014, Complainant has prominently and extensively used, advertised, and promoted its out-of-home advertising and related services using the OUTFRONT Marks, including on its website, social media, and marketing materials. As a result of significant investment in the promotion and marketing of the OUTFRONT Marks, consumers have come to recognize these service marks as uniquely associated with Complainant and as an indication of origin in Complainant. Complainant vigorously protects its right in and to the OUTFRONT Marks.

Complainant further alleges that Respondent's use of the Disputed Domain Name to profit from pay-per-click advertising revenue amounts to bad faith registration of the Disputed Domain Name for commercial gain.

Complainant further alleges that, given that the Disputed Domain Name redirects users to third-party sites that have no apparent relationship to Complainant or to the OUTFRONT Marks, the Panel may reasonably infer that Respondent is redirecting traffic to these third-party websites in exchange for a fee.

Complainant further alleges that the Panel may also consider, as indicia of bad faith registration and use, the facts that Respondent registered the Disputed Domain Name using a proxy service and that Respondent failed to respond to Complainant's attempt to contact Respondent.

B. Respondent

The Panel allowed an extended Response due date to the Respondent via a Panel Order, dated February 27, 2023. Despite this new deadline, Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable."

Even though Respondent has failed to file a Response or to contest Complainant's assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to the OUTFRONT Marks in which Complainant has rights; and,
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and,
- iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Complainant contends that it owns several registrations of the OUTFRONT Marks. Respondent has not contested Complainant's contentions.

Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration of a trademark is *prima facie* evidence of Complainant having enforceable rights in the OUTFRONT Marks.

Therefore, the Panel finds that Complainant has enforceable rights in the OUTFRONT Marks for purposes of this proceeding.

Complainant contends that the Disputed Domain Name is confusingly similar to the OUTFRONT Marks pursuant to paragraph 4(a)(i) of the Policy because it wholly incorporates the OUTFRONT Marks.

Section 1.7 of the [WIPO Overview 3.0](#) says that inclusion of the entire trademark in a domain name will be considered confusingly similar. Section 1.8 of the [WIPO Overview 3.0](#) instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity. Section 1.11.1 of the [WIPO Overview 3.0](#) instructs that generic Top Level-Domains ("gTLD")(s) such as (.com) may be disregarded for purposes of assessing confusing similarity.

The Panel finds that the Disputed Domain Name contains the entirety of the OUTFRONT Marks, plus the additional phrase "films" and the gTLD ".com". The Panel further finds that the addition of the term "films" would not prevent a finding of confusing similarity under the first element.

The applicable gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Therefore, Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant asserts that the Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

Section 2.1 of the [WIPO Overview 3.0](#) states that once Complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of Respondent, Respondent carries the burden of demonstrating it has rights or legitimate interests in the Disputed Domain Name. Where Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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 OUTFRONT Marks.

Complainant asserts that Respondent is not commonly known by the Disputed Domain Name. Complainant further asserts that there is no relationship or affiliation between Complainant and Respondent giving rise to any license, permission or other right by which Respondent could own or use any domain name incorporating the OUTFRONT Marks.

The Disputed Domain Name was created on May 27, 2020 and incorporates the OUTFRONT Marks in their entirety, without authorization from Complainant. Complainant further asserts that Respondent operated a pay-per-click website to which the Disputed Domain Name resolved, hosting multiple revolving links to third-party websites, from which Respondent presumably collected revenues for each click.

Complainant further asserts that, on December 1, 2022, counsel for Complainant requested Respondent cease and desist from its use of the Disputed Domain Name, using the contact form available on the Registrar's website. As of the filing of this Complaint, Respondent has not replied.

Complainant further asserts that Respondent also registered the Disputed Domain name through privacy protection to hide his or her identity. Given Respondent's attempt to mask his or her identity, the Panel should presume that Respondent is not commonly known by the Disputed Domain Name.

Complainant further asserts that Respondent has not used 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 used the Disputed Domain Name for any legitimate non-commercial or fair use. Instead, the website associated with the Disputed Domain Name has continuously been used as an illegitimate pay-per-click landing page for Respondent's commercial gain. The use of an infringing domain name as a pay-per-click site has been repeatedly found not to constitute a *bona fide* commercial use.

The Panel finds that Complainant has set forth a *prima facie* case and that Respondent has not contested these assertions.

Therefore, Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant alleges that Respondent registered and is using the Disputed Domain Name in bad faith in violation of the Policy paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Name:

- (i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to Complainant who is the owner of the OUTFRONT Marks or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or
- (ii) you [Respondent] have registered the Disputed Domain Name in order to prevent the owner of the OUTFRONT Marks from reflecting the marks in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Disputed Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the OUTFRONT Marks as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

Respondent's use of the Disputed Domain Name to profit from pay-per-click advertising revenue amounts to bad faith registration of the Disputed Domain Name for commercial gain.

Given that the Disputed Domain Name redirects users to third-party sites that have no apparent relationship to Complainant or to the OUTFRONT Marks, the Panel may reasonably infer that Respondent is redirecting traffic to these third-party websites in exchange for a fee.

The Panel finds that Complainant has shown the requirements of paragraph 4(b)(iv) of the Policy and hence proven paragraph 4(a)(iii).

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 <outfrontmediafilms.com> be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: March 13, 2023