

ADMINISTRATIVE PANEL DECISION

Dash Two Inc. v. James Rogers
Case No. DME2023-0007

1. The Parties

Complainant is Dash Two Inc., United States of America (“United States”), represented by Gino Sesto, United States.

Respondent is James Rogers, United States.

2. The Domain Name and Registrar

The disputed domain name <wildposting.me> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 7, 2023. On June 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 8, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Unknown) and contact information in the Complaint. The Center sent an email to Complainant on June 30, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 3, 2023.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on July 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2023. Two emails were received by the Center from Respondent on June 30, 2023 and July 22, 2023, stating, respectively, “Can you provide me with information that might help me understand what this case is about? I'm in the dark with regards to this correspondence. Thank you!”, and “Hello, Do you have a specific question or request for me? Thx!”

In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2023. However, the automatic Response due extension was granted until August 14, 2023 as requested by Complainant's representative on August 10, 2023. The Response was filed with the Center on August 14, 2023. Accordingly, the Center notified Acknowledgement of Receipt of Response on August 14, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on August 28, 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.

On September 4, 2023, a Supplemental Filing was received from the Complainant by the Center. On September 7, 2023, the Panel issued Procedural Order No. 1, which stated in substance:

"Before the Panel considers whether to accept the Complainant's unsolicited untimely submission, the Panel will allow the Respondent until September 15, 2023 to respond."

On September 15, 2023, in response to Respondent's request for additional time, the Panel extended the foregoing deadline to September 22, 2023.

Respondent did not submit a timely response to Procedural Order No. 1. The Panel decided, in its discretion, to consider Complainant's unsolicited supplemental filing, although that supplemental filing did not add anything to the relevant record that had not already been there.

4. Factual Background

Complainant describes itself as "a well-known 'Outdoor Advertising Agency' based in Los Angeles." Complainant states that it has a "business presence" in various United States cities including New York, San Francisco, Boston, Washington, D.C., Seattle, and Miami, and that its operations are "available" in cities in other countries.

Complainant has owned the domain name <wildposting.com> since 2014, and uses that domain name to host a commercial website offering its services.

Complainant holds a registered trademark for WILD POSTING with the United States Patent and Trademark Office ("USPTO"), Reg. No. 5,432,087, registered on March 27, 2018 in connection with "outdoor advertising" with a March 20, 2017 date of first use in commerce.

Complainant claims that its WILD POSTING trademark is "a famous brand name." Complainant maintains a social media presence, with approximately 1.2 thousand Facebook followers, 760 Instagram followers, 79 Twitter followers, and 130 YouTube subscribers.

Respondent apparently has some connection to a company called Outdoor Media Corp. ("OMC").

The Domain Name was registered on September 9, 2019. The Domain Name resolves to a website where Respondent offers its own outdoor advertising services. The website boasts: "BEST WILDPOSTING IN THE USA." The website also states:

"OMC has executed thousands of poster campaigns in every major city since 1969, including the iconic 'IPOD Silhouettes' campaign."

On June 4, 2023, Complainant's counsel sent Respondent a cease-and-desist letter, asserting Complainant's rights in the trademark WILD POSTING and demanding that Respondent cease using the WILD POSTING mark in a domain name or otherwise. It does not appear from the record that Respondent replied to this cease-and-desist letter. As noted above, the Complaint in this proceeding was filed on June 7, 2023.

On August 10, 2023, Respondent filed with the USPTO a petition to cancel Complainant's WILD POSTING registered trademark with Registration No. 5,432,087, arguing that the mark is generic for the business activity of "wheat pasting". In the USPTO petition, annexed to the Response in this proceeding, Respondent asserts (and uses a Google search for support) that numerous companies in the business of outdoor advertising (which typically involves the spreading of posters, affixed by wheat paste, in a concentrated location for a limited period of time) use the term "wild posting" in a generic sense, and with no reference to Complainant.

In the USPTO petition, Respondent also cites several USPTO applications over the years by firms seeking to register the mark WILDPOSTING, though these applications either have been abandoned or are pending with the USPTO. In each case, the USPTO trademark applications claimed a date of first use in commerce predating the March 20, 2017 date of first use claimed on Complainant's USPTO application.

Respondent also asserts, and alleges in the USPTO petition, that he has been in the business of outdoor advertising since as early as 1980, and he has used the term "wild posting" in a generic sense for many years. According to Respondent, his firm, James Rogers, Inc., merged with a firm called National Promotion & Advertising to form a firm called NPA. On March 23, 2006, the firm NPA filed one of the USPTO trademark applications for WILDPOSTING discussed above (in connection with "advertising services" and with a 1997 claimed date of first use in commerce), but that application was abandoned as of October 29, 2009.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

As discussed above, Respondent asserts that the mark WILD POSTING is generic and hence Respondent has every right to use the term in its generic sense to promote its outdoor advertising services. Respondent also asserts that Complainant has engaged in Reverse Domain Name Hijacking ("RDNH").

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark WILD POSTING through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is identical to that mark. Unlike trademarks, domain names cannot have spaces between words, and hence the Domain Name is for all practical purposes identical to Complainant's mark.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] 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 Panel need not address this element, given its conclusion below in connection with the “bad faith” element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Complainant has failed to prove, on a balance of probabilities, that Respondent has registered and used the Domain Name in bad faith under the Policy. On the record presented, it is difficult to conclude that Respondent more likely than not had Complainant’s WILD POSTING mark in mind and targeted such in bad faith when he registered the Domain Name. Complainant asserts that its mark is “famous” and “well-known,” but there is little support in the record for such a claim. Further, Complainant’s social media following falls somewhat short of remarkable.

Even if Respondent – who offers competing outdoor advertising services – were aware of Complainant and its WILD POSTING trademark, Respondent has made at least a colorable argument that the mark may face questions as to its possible generic meaning. It is not for this Panel to make a finding of genericness, as that decision apparently will be resolved by the USPTO in the pending proceedings. The Panel does note, though, that Respondent has presented some viable evidence of others in the outdoor advertising business using the term “wild posting” in a generic sense, as a synonym for “wheat pasting” or “fly pasting.”

Under these circumstances, the Panel cannot conclude that this is a clear case of cybersquatting, which is the type of case that the UDRP is fundamentally designed to address.

Complainant has not established Policy paragraph 4(a)(iii). The Complaint fails.

D. Reverse Domain Name Hijacking

Respondent asserts that Complainant has committed RDNH by initiating this proceeding. The Panel disagrees. Here, Complainant has (for the time being) a valid registered trademark. The Domain Name is identical to that mark, and resolves to a website offering services in direct competition with Complainant's services. Finally, as far as the record shows, Respondent did not reply to Complainant's cease-and-desist letter (though Complainant filed its Complaint only three days after sending that letter). In short, at the time the Complaint was filed, Complainant seems to have reasonably believed it had a viable case under the UDRP.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: October 10, 2023