

ADMINISTRATIVE PANEL DECISION

ArcBest IP Holdings LLC v. Howard Miller

Case No. D2024-4334

1. The Parties

Complainant is ArcBest IP Holdings LLC, United States of America (“United States”), represented by Bryan Cave Leighton Paisner, United States.

Respondent is Howard Miller, United States.

2. The Domain Name and Registrar

The disputed domain name <upackexpressdelivery.com> is registered with Global Domain Group LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 21, 2024. On October 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 22, 2024, 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 (REDACTED FOR PRIVACY, Global Domain Group Privacy Service) and contact information in the Complaint. The Center sent an email communication to Complainant on October 23, 2024, 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 October 28, 2024.

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 Respondent of the Complaint, and the proceedings commenced on October 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 20, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 21, 2024.

The Center appointed Timothy D. Casey as the sole panelist in this matter on December 9, 2024. 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

Complainant is a provider of transportation, relocation and self-moving services, including storage/shipping containers, moving boxes and other supplies and services in the United States and Canada.

Complainant has operated under trademarks including U-PACK since 1992 related to transportation services and holds numerous registrations (the “U-PACK Marks”), including the following:

Mark	Jurisdiction	Class(es)	Registration No.	Registration Date
U-PACK	United States	39	2834028	April 20, 2004
U-PACK	United States	35	4504126	April 1, 2014
U-PACK	Canada	39	TMA630753	January 21, 2005

Complainant is also the owner of the domain name <upack.com> since 1998, and has operated a blog and other informational services for many years.

The disputed domain name was registered August 17, 2024. At the time of filing the Complaint, the disputed domain name resolved to a website that counterfeits Complainant’s own website, including the U-PACK Marks, and includes copies of Complainant’s copyright-protected images and content. Complainant provided evidence indicating that the disputed domain name was utilized in emails and other documentation, including fraudulent invoices on Complainant’s letterhead, impersonating Complainant.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that the disputed domain name is wholly incorporated into the U-PACK Marks and is identical to the U-PACK Marks but for deletion of the hyphen between the letter “u” and the word “pack” and the addition of the descriptive terms “express” and “delivery”. Complainant contends the removal of the hyphen is irrelevant to the identical/confusingly similar analysis, and the addition of the descriptive terms does not prevent a finding of confusing similarity.

Complainant contends that it has made a prima facie showing that Respondent has no rights or legitimate interests in the disputed domain name, based on: Respondent not being authorized by Complainant to use the disputed domain name; Complainant’s U-PACK Marks are known; there is no evidence that Respondent is known under the disputed domain name; the disputed domain name is identical to or confusingly similar to the U-PACK Marks and serves as “bait” to attract customers to Respondent’s website; and the disputed domain name is primarily descriptive of Complainant’s goods and services under the U-PACK Marks. Complainant also notes that it is unclear whether Respondent provides any actual services under the disputed domain name or solely utilizes the disputed domain name for fraudulent purposes, which would not be a legitimate non-commercial use of the same.

Complainant contends that Respondent has used the disputed domain name in attempts to defraud third parties seeking Complainant’s branded services and misrepresented to other that it was a representative of Complainant, issuing invoices for services to unsuspecting customers and seeking payment for the

fraudulent services through the Cash App payment service. Complainant contends that Respondent's registration of the disputed domain name suggests opportunistic bad faith that seeks to create an illegitimate impression of association with Complainant. Complainant contends that Respondent's complete lack of legitimate rights in and to the disputed domain name, or similar names or marks, further demonstrates bad faith in adopting the disputed domain name. Complainant contends that Respondent knew of the U-PACK Marks at the time of registration, which is further evidenced by the content of its website which counterfeits Complainant's own website, but for contact information over which Complainant has no control, and lacks any disclaimer to notify the public that Respondent is not affiliated with Complainant, which all evidence bad faith. Lastly, Complainant contends that Respondent's use of a privacy service for registration of the disputed domain name is further evidence of bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Although the hyphen in the U-PACK Marks between the letter "u" and the word "pack" is missing in the disputed domain name, such a misspelling signals an intention on the part of Respondent to confuse users seeking or expecting Complainant. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, the added terms "express" and "delivery", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity, here, the impersonation/passing off of Complainant through a counterfeit website and other documentation can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that Respondent must have known of the U-PACK Marks at the time of registration given Respondent's use of the U-PACK Marks to counterfeit Complainant's website and Respondent's attempt to fraudulently collect payments from users seeking Complainant's goods and services, thereby disrupting the business of Complainant and intentionally attempting to attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant's marks.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity, here, the impersonation/passing off of Complainant through a counterfeit website and other documentation constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that Complainant has established the third element of the Policy.

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 <upackexpressdelivery.com> be transferred to Complainant.

/Timothy D. Casey/

Timothy D. Casey

Sole Panelist

Date: December 23, 2024