

ADMINISTRATIVE PANEL DECISION

SPG IP Holdings, LLC v. Youcef Hammoudi, Carolina Premium Outlets
Case No. D2024-5180

1. The Parties

The Complainant is SPG IP Holdings, LLC, United States of America ("United States"), represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Youcef Hammoudi, Carolina Premium Outlets, United States.

2. The Domain Name and Registrar

The disputed domain name <carolina-premium-outlets.com> is registered with Automattic Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 16, 2024. On December 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 18, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 December 30, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 19, 2025. The Response was filed with the Center on January 20, 2025.

The Complainant submitted an unsolicited Supplemental Filing to the Center on February 7, 2025. In response, the Respondent submitted an unsolicited Supplemental Filing on February 8, 2025. The Center notified the Panel of such Supplemental Filings, which the Panel reviewed.

The Center appointed Evan D. Brown as the sole panelist in this matter on January 22, 2025. 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 in the business of developing, leasing, and managing retail shopping space. It owns multiple trademark registrations for formatives of the mark PREMIUM OUTLETS, including United States Reg. No. 2,619,883, registered on September 17, 2002. The Complainant also claims common law trademark rights in the mark CAROLINA PREMIUM OUTLETS, which it has used in connection with one of its locations in North Carolina since October 2004.

The Complainant has used the domain name <premiumoutlets.com> since 1996. It also uses a number of other domain names in connection with its various locations in the United States, each incorporating a geographical designator combined with its PREMIUM OUTLETS mark, such as <chicagopremiumoutlets.com> and <lasvegaspremiumoutlets.com>.

According to the Whois records, the disputed domain name was registered on May 13, 2024. The Respondent has used the disputed domain name to host a website that offers for sale goods similar to those offered in the Complainant's retail shopping centers, while, as the Complainant characterizes it, "brandishing the Complainant's PREMIUM OUTLETS trademark all over the website". The record further indicates that the Respondent operates a physical store approximately 55 miles from the Complainant's North Carolina location.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent submitted an untimely, lengthy and, at times, difficult-to-follow Response, raising numerous arguments—some relevant to the dispute, others less so. The Panel seeks to distill the core of the Respondent's position.

The Respondent asserts its right to use the mark "Carolina Premium Outlets" and retain the disputed domain name. It emphasizes that its business name was legally registered in North Carolina and that it operates a legitimate retail store, distinct from the Complainant's real estate and property leasing business. The Respondent states that before commencing operations, it conducted a thorough trademark search, leading to its trademark application in the United States Patent and Trademark Office ("USPTO") on June 5, 2024, which was subsequently accepted. It contends that the Complainant did not file for the same trademark until June 28, 2024, nearly a month later, thereby undermining the Complainant's assertion of prior rights.

The Respondent argues that there is no likelihood of consumer confusion, as its business operates independently and in a different industry. While the Complainant owns and leases shopping malls, the Respondent runs a standalone retail store in Fayetteville, NC, located approximately 60 miles from the Complainant's shopping center in Smithfield, NC. The Respondent further asserts that the phrase "Premium Outlets" is generic, pointing out – without support – that approximately 3,900 active United States trademarks incorporate this term, which, in its view, weakens the Complainant's exclusivity over the term. To mitigate

any potential confusion, the Respondent has posted a disclaimer on its website explicitly stating that it is not affiliated with the Complainant.

The Respondent maintains that both its trademark use and domain registration comply with federal and international laws, citing, among other things, the Lanham Act, UDRP, and the Anti-Cybersquatting Consumer Protection Act (ACPA). It insists that it registered the disputed domain name in good faith, with no intent to mislead consumers or benefit from the Complainant's branding. Instead, it accuses the Complainant of engaging in coercive tactics, claiming that the Complainant repeatedly attempted to purchase the disputed domain name and resorted to legal threats when its offers were refused. The Respondent argues that the Complainant's persistent efforts to force a domain transfer – rather than simply seeking cancellation – suggest bad-faith intentions on the Complainant's part, rather than a legitimate concern over consumer confusion.

Additionally, the Respondent highlights what it perceives as inconsistencies in the Complainant's claims and strategy, questioning why the Complainant failed to register "Carolina Premium Outlets" as a trademark since 1993 and why it did not acquire the domain when it was available for over 30 years. The Respondent further asserts that the Complainant's actions have caused it substantial financial harm, including over USD10,000 in losses and disruptions to business operations. It concludes that its use of the disputed domain name is lawful, while the Complainant's actions constitute Reverse Domain Name Hijacking (RDNH) and procedural abuse.

6. Discussion and Findings

6.1. Supplemental Filings

On February 7, 2025, and on February 8, 2025, the Center received the Supplemental Filings submitted by the Complainant and Respondent respectively.

The Panel notes that the Rules provide for the submission of the Complaint by the Complainant and the Response by the Respondent. No express provision is made for supplemental filings by either Party, except in response to a deficiency notification or if requested by the Center or the Administrative Panel.

Paragraphs 10 and 12 of the Rules in effect grant the Panel discretion to determine the admissibility of supplemental filings (including further statements or documents) received from either Party. Thus, it is in the discretion of the Panel to determine whether to consider and/or admit any supplemental filing in rendering its decision.

The Supplemental Filing submitted by the Complainant consists of an Office Action issued on February 3, 2025 by the United States Patent and Trademark Office (USPTO), that finds the trademark application 9856424 CAROLINA PREMIUM OUTLETS filed by the Respondent, to be confusingly similar to, and therefore likely to cause confusion with, the Complainant's PREMIUM OUTLETS trademarks 2619883 and 3315244. The Complainant claims that this further demonstrate Respondent's attempt to appear legitimate and falsely identify itself as CAROLINA PREMIUM OUTLETS. The Respondent fundamentally claims that the Office Action is not final, and that the previously referred application was suspended on February 4, 2025 by their own request.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. On receipt of a request to submit an unsolicited supplemental filing or the actual receipt of such filing, the WIPO Center will confirm receipt of the request or filing to the parties, and forward such request or filing to the panel for its consideration as to admissibility. In all such cases, panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some "exceptional" circumstance). See [WIPO Overview 3.0](#), section 4.6.

The Panel finds that the Supplemental Filing submitted by the Complainant may be relevant to this case, particularly noting the date on which the USPTO issued the Office Action, which occurred after the filing of the Complaint. For this reason, the Panel has decided to accept the Supplemental Filing submitted by the Complainant. For fairness and completeness, the Panel has also decided to accept the Respondent's Supplemental Filing, submitted in response to the Complainant's unsolicited submission.

6.2. Substantive Matters

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is 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 name, and (iii) the disputed domain name has been registered and is being used in bad faith. The Panel finds that all three of these elements have been met in this case.

A. Identical or Confusingly Similar

This first element functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. *Id.* This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the PREMIUM OUTLETS mark by providing evidence of its trademark registrations, including United States Reg. No. 2,619,883, registered on September 17, 2002. See [WIPO Overview 3.0](#), section 1.2.1. The Complainant has also shown common law trademark rights in the CAROLINA PREMIUM OUTLETS mark based on longstanding commercial use since at least October 2004.

The Respondent's principal new assertion in its unsolicited Supplemental Filing is that the USPTO has suspended an application (Serial No. 98624649) filed by the Complainant to register the mark CAROLINA PREMIUM OUTLETS, citing the Respondent's pending application (Serial No. 98586424) for the same mark. The Panel does not find this new argument to alter the outcome under this element. The Panel observes that although the Complainant's application has been suspended pending the disposition of the Respondent's application, the Respondent's application has in turn been refused registration for reasons that included a likelihood of confusion with the Complainant's prior registrations of the mark PREMIUM OUTLETS (Registration Nos. 2619883 and 3315244). In these circumstances, the Panel does not see the current suspension of the Complainant's application as any reliable indication that the Respondent holds rights to the mark CAROLINA PREMIUM OUTLETS that are senior to those held by the Complainant.

The disputed domain name incorporates the PREMIUM OUTLETS mark in its entirety with the addition of the geographic term "Carolina," which does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8. The PREMIUM OUTLETS mark remains the dominant and recognizable portion of the disputed domain name, satisfying the threshold requirement for confusing similarity under the Policy.

It is standard practice when comparing a disputed domain name to a complainant's trademark to disregard the generic top-level domain ("gTLD"), such as ".com." See [WIPO Overview 3.0](#) at section 1.11.1 ("The applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.").

The Panel has considered the Respondent's arguments under the first element but does not find them persuasive. The Respondent contends that the Complainant lacks trademark rights because it did not file a trademark application for the mark CAROLINA PREMIUM OUTLETS until after the Respondent's own

application for the same mark. However, the UDRP does not require a Complainant to have a registered trademark, only that it has established rights in the mark, which the Complainant has demonstrated through longstanding commercial use which began before the Respondent registered the disputed domain name. In any event, the Panel finds that the disputed domain name is confusingly similar to the Complainant's PREMIUM OUTLETS mark, which is sufficient to support a finding in the Complainant's favor under this element of the Policy.

The Respondent further argues that the term “premium outlets” is a generic term used by many businesses. However, the Complainant has established secondary meaning and brand recognition through its widespread use in commerce for many years, in addition to its rights in its incontestable registration for the PREMIUM OUTLETS mark. Additionally, the Respondent asserts that adding “Carolina” to the name sufficiently distinguishes it from the Complainant's mark, yet the Panel finds that such a geographic term does not eliminate confusing similarity when the dominant portion of the mark remains identical to the Complainant's mark. See also [WIPO Overview 3.0](#) section 2.5.1.

Accordingly, the Panel finds that the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant must establish that the Respondent has no rights or legitimate interests in the disputed domain name. While the ultimate burden of proof remains with the Complainant, once the Complainant makes a prima facie showing that the Respondent lacks rights or legitimate interests, the burden of production shifts to the Respondent to provide evidence demonstrating such rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

In this case, the Complainant asserts the following, among other things, to establish its prima facie case:

- The Respondent is not sponsored by or affiliated with the Complainant in any way.
- The Complainant has not given the Respondent permission to use its trademarks in any manner, including in domain names.
- The Respondent is not commonly known by the disputed domain name. While the Registrar's verification email indicates that the Respondent is identified as “Youcef Hammoudi / Carolina Premium Outlets,” the Complainant asserts that the Respondent falsely identified itself as or associated with the Complainant to lend legitimacy to its registration while also attempting to piggyback on the fame of the Complainant's marks. Notably, the Respondent's physical store, which it promotes via the disputed domain name, changed its name to “Mini Price” following a cease-and-desist notice sent by the Complainant.
- The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services. Instead, the Complainant contends that the Respondent deliberately chose a domain name based on a registered trademark to generate traffic and income through an unauthorized website that offers goods in the same sector as the Complainant, while prominently utilizing the Complainant's PREMIUM OUTLETS trademark.

The Panel finds that the Complainant has made the required prima facie showing. Accordingly, the burden shifts to the Respondent to demonstrate rights or legitimate interests in the disputed domain name.

The Panel has considered the Respondent's arguments under the second element but does not find that the Respondent has demonstrated rights or legitimate interests in the disputed domain name. The Respondent asserts that it legally registered “Carolina Premium Outlets” as a business name in North Carolina and operates a legitimate retail business. However, a respondent must be “commonly known” (as opposed to merely incidentally being known) by the relevant moniker (e.g., a personal name, nickname, corporate identifier), apart from the domain name. See [WIPO Overview 3.0](#), section 2.3. Mere assertions that a respondent is commonly known by the domain name will not suffice; respondents are expected to produce concrete credible evidence. *Id.* The Respondent has not produced such concrete credible evidence and as noted above changed its name to “Mini Price”.

The Respondent further claims that its business is distinct from the Complainant's real estate leasing operations and that its store is physically located 60 miles away. The Panel does not find this argument persuasive. The nature of the parties' businesses is highly similar, as both are involved in the sale of retail goods, and the disputed domain name is being used in a way that trades on the goodwill of the Complainant's well-known PREMIUM OUTLETS brand.

Additionally, the Respondent highlights that it has posted a disclaimer on its website to avoid confusion. However, the disclaimer does not remedy the confusion created by the use of a domain name that is confusingly similar to the Complainant's mark. In these circumstances, a disclaimer cannot and does not create rights or legitimate interests in the disputed domain name.

Accordingly, the Complainant has established this second element under the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name was both registered and used in bad faith. The UDRP sets out non-exhaustive criteria for bad faith registration and use, including circumstances where a respondent has registered a domain name primarily to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website. See [WIPO Overview 3.0](#), section 3.1. The Panel finds bad faith registration and use by the Respondent, based on several factors.

The Panel finds that it is more likely than not that the Respondent knew of and targeted the Complainant's trademark when it registered and began using the disputed domain name. See *Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#) (finding bad faith registration where the respondent more likely than not had the complainant's trademark in mind when registering the disputed domain name). Given the Complainant's longstanding commercial use of the mark PREMIUM OUTLETS, it is highly unlikely that the Respondent was unaware of the Complainant's brand when registering the disputed domain name.

The Respondent registered the disputed domain name incorporating the Complainant's PREMIUM OUTLETS trademark, preceded by the geographic term "Carolina." This structure mirrors the Complainant's branding practices, as evidenced by its use of domain names such as <chicagopremiumoutlets.com> and <lasvegaspremiumoutlets.com>. By following the same naming pattern, the Respondent's registration suggests knowledge of the Complainant's branding strategy and an intentional effort to imitate it. This supports a finding that the Respondent was aware of the Complainant's mark and sought to capitalize on its reputation.

The Respondent has used the disputed domain name to offer goods in the same sector as the Complainant, further demonstrating that the Respondent intentionally registered the disputed domain name to target the Complainant and not for any legitimate or independent purpose. Despite the Respondent's protestations to the contrary, the Panel finds the nature of the goods and services provided by the parties to be similar.

After the Complainant sent a cease-and-desist letter to the Respondent on May 31, 2024, the Respondent filed a USPTO application to register the mark CAROLINA PREMIUM OUTLETS on June 5, 2024. Although the Respondent later promised to withdraw that application, it failed to follow through. This conduct further supports a finding of bad faith, as it indicates an attempt to legitimize its unauthorized use of a mark that closely resembles the Complainant's brand.

At the time of the initial filing of the Complaint, the Respondent had employed a privacy service to hide its identity. While privacy services are not inherently indicative of bad faith, past UDRP panels have found that their use to intentionally delay or obstruct proceedings may serve as additional evidence of bad faith. See *Dr. Ing. H.C. F. Porsche AG v. Domains by Proxy, Inc.*, WIPO Case No. [D2003-0230](#). See also

[WIPO Overview 3.0](#), section 3.6 (noting that a respondent's use of a privacy service to block or delay disclosure of its identity may support an inference of bad faith).

The Respondent asserts that it has not attempted to sell or profit from the domain name and that it refused multiple unsolicited purchase offers from the Complainant. However, bad faith can still be established where the domain name was registered to capitalize on the Complainant's mark in a manner targeted by the Policy, even if the Respondent did not attempt to sell the disputed domain name.

The Respondent also argues that it voluntarily agreed to rename its physical store in an effort to settle the dispute. However, this does not negate the fact that the disputed domain name remains confusingly similar to the Complainant's mark and continues to be used in a manner that creates a likelihood of confusion. The Respondent further highlights that the Complainant failed to register the mark CAROLINA PREMIUM OUTLETS for over 30 years. However, a delay in registration does not affect the Complainant's ability to assert common law rights based on extensive commercial use. Moreover, as discussed above, the disputed domain name is confusingly similar to the Complainant's PREMIUM OUTLETS mark, which has been registered for many years.

Finally, the Respondent claims financial harm resulting from the dispute. However, it must be observed that the Respondent has brought such burden upon itself by selecting a domain name that is confusingly similar to the Complainant's registered mark and using it to offer goods and services similar to those of the Complainant.

Accordingly, the Panel finds that the Complainant has established this third element under the Policy.

D. Reverse Domain Name Hijacking

Having found in favor of the Complainant, the Panel need not consider the Respondent's assertions that the Complainant has engaged in Reverse Domain Name Hijacking.

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 <carolina-premium-outlets.com> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: February 11, 2025