

## **ADMINISTRATIVE PANEL DECISION**

OpenStack Foundation, d/b/a Open Infrastructure Foundation v. Danny Castonguay  
Case No. DSH2023-0001

### **1. The Parties**

The Complainant is OpenStack Foundation, d/b/a Open Infrastructure Foundation, United States of America ("United States" or "U.S."), represented by Venable, LLP, United States.

The Respondent is Danny Castonguay, United States.

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

The disputed domain name <openstack.sh> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 24, 2023. On August 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 24, 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 (Redacted For Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 25, 2023, 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 August 28, 2023.

The Center verified that the Complaint, together with the amendment to the Complaint, satisfied the formal requirements of the .SH Domain Name Dispute Resolution Policy (the "Policy"), the Rules for .SH Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .SH 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 August 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 19, 2023. The Respondent sent informal email communications on August 26 and 29, 2023. Accordingly, the Center informed the Parties of its commencement of the panel appointment process on September 20, 2023.

The Center appointed Colin T O'Brien as the sole panelist in this matter on September 22, 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.

The Respondent sent a late informal Response on October 3, 2023. The Panel issued an Administrative Procedural Order on October 5, 2023, giving the Complainant the opportunity to submit its comments to the late Response. The Complainant submitted its supplemental filing to the Administrative Procedural Order on October 6, 2023.

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

The Complainant is a non-profit, non-stock foundation registered in Delaware, United States of America. The Complainant's purpose is to develop, support, protect, and promote open-source software projects for building and managing technology infrastructure.

The domain name "www.openstack.org" is owned and operated by the Complainant and was registered on October 10, 2008. The Complainant, through its website, provides access to the most widely deployed open-source cloud software in the world, information regarding various public speaking events, and opportunities for users to receive software related trainings and documentation.

In addition to the registered domain name, the Complainant owns several trademark registrations for OPENSTACK including:

- U.S. Registration Number 4,693,135 in class 35 and 41 registered on February 24, 2015;
- U.S. Registration Number 4,061,024 in class 9, 35, 41 and 42 registered on November 22, 2011;
- U.S. Registration Number 5,200,129 in class 9, 41 and 42 registered on May 9, 2017;
- U.S. Registration Number 6,088,854 in class 35 registered on June 30, 2020;
- U.S. Registration Number 6,137,193 in class 9 registered on August 25 2020;
- European Union Trademark Number 009262148 in classes 9 and 42 registered on October 8, 2012;
- European Union Trademark Number 009936972 in class 35 and 41 registered on August 10, 2011;
- European Union Trademark Number 012119236 in class 9, 41 and 42 registered on January 28, 2014;
- European Union Trademark Number 012167185 in class 9 and 41 registered February 21, 2014;
- European Union Trademark Number 015625932 in class 9, 35, 41 and 42 registered on January 9, 2017;
- European Union Trademark Number 018033478 in class 9 registered on August 1, 2019;
- United Kingdom Trademark Number UK00909262148 in class 9 and 42 registered October 8, 2012;
- United Kingdom Trademark Number UK00912119236 in class 9, 41 and 42 registered January 28, 2014;
- United Kingdom Trademark Number UK00909936972 in class 35 and 41 registered August 10, 2011; and
- United Kingdom Trademark Number UK00918033478 in class 9 registered on August 1, 2019.

The disputed domain name was registered on November 17, 2022, and resolves to a website which allegedly offers for sale similar software as the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

The disputed domain name is identical or confusingly similar to the incontestable trademark in which the Complainant has rights. Without addition or subtractions, the disputed domain name incorporates the Complainant's entire mark. The disputed domain name was registered on November 17, 2022, many years after the Complainant's use and registration of its domain name, in October 2008, and OPENSTACK

trademark registration, in August 2011. The “.sh” country code Top-Level Domain (ccTLD) relates to the geographic territory of Saint Helena, a British Overseas Territory. The Complainant holds valid trademark registration in the United Kingdom. Therefore, where a “.sh” ccTLD has incorporated the entirety of the Complainant’s trademark, the domain name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Respondent has no rights or legitimate interests in respect to the disputed domain name based on the Complainant’s prior domain name and trademark registration. The Respondent does not have any trademark rights, registered or unregistered, or use of the trademark OPENSTACK. Additionally, the Respondent is not making a legitimate, noncommercial, or fair use of the disputed domain name. The Respondent is using the disputed domain name to divert customers to the Respondent’s domain instead of the Complainant’s authentic website. The Respondent also offers consumers “OpenStack” software templates for USD 1.

The Respondent has registered and used the disputed domain name in bad faith. The Respondent is using the disputed domain name to disrupt the Complainant’s business by intentionally confusing consumers into visiting the disputed domain name instead of the Complainant’s authentic website. The Respondent uses the Complainant’s identical trademark without modification and depicts a similar color-scheme, the teal and dark blue/black colors, that the Complainant uses in its trademark.

Furthermore, the Respondent also uses the “.sh” ccTLD in bad faith because “.sh” is a shell script file type commonly used in the Complainant’s software. The Complainant’s software is commonly referred to as “openstack.sh” by developers. The Respondent also refers to itself as the “OpenStack Operational Team” and uses the email “openstackoperationalteam@[...].com”.

## **B. Respondent**

The Respondent sent the following informal response after the deadline to respond:

“I will not fight you. I have better things to do. However, I will honor you with a reply. Openinfra.dev / openstack.org states “we are a non-profit organization providing a neutral, open environment for organizations, developers, and users to build open source infrastructure software together.”

1. We (openstack.sh) gave some of our interns a chance to test an idea of sharing open stacks – we funded this with very little money.
2. We acquired a catchy domain to support this because it’s an open stack shell tool (openinfra.dev / openstack.org is not that).
3. A self-proclaimed open-stack supporter sent us a legal threat before any dialogue.
4. Their legal expenses probably exceed our development costs.

These actions contradict claims of being neutral, open, and collaborative by Openinfra.dev / openstack.org.

It seems to me like our interns might get a kick out of starting a crowdfunding campaign to finance their legal defense. Or you could just be polite?

If I were the CEO of Openinfra.dev, I would be embarrassed by your collective actions.”

## **C. Complainant’s supplemental filing**

As stated under section 4 above, the Panel issued an Administrative Procedural Order on October 5, 2023, and the Complainant submitted the following submission;

“Respondent’s Comments do not address the substance of OpenStack’s Complaint, and fail to dispute that:

- a. OpenStack has exclusive rights to the registered OPENSTACK trademarks;
- b. OpenStack has not given the Respondent any permission to use the OPENSTACK Trademarks;
- c. The disputed domain name was registered on November 17, 2022, many years after OpenStack's use and registration of its domain name "www.openstack.org" (which was registered in October 2008), and many years after OpenStack obtained its first registered trademark for the trademark OPENSTACK in August 2011;
- d. The disputed domain was registered in bad faith using the entirety of OpenStack's OPENSTACK Trademark because, among other evidence, the Respondent's use of .sh is a shell script file type commonly used in Linux software, including within OpenStack's software. Using this terminology, OpenStack's software is commonly referred to by developers as "<openstack.sh>," and
- e. Respondent has taken steps to confuse consumers by referring to itself as the "OpenStack Operational Team" and using the email address openstackoperationalteam@gmail.com in connection with the disputed domain.

Respondent's Comments indicate that the Respondent was made aware of OpenStack's prior rights to the OPENSTACK Trademarks by a "self-proclaimed open-stack supporter," but it continued to use OpenStack's trademarks willfully without authorization.

Respondent's Comments alleging that it "acquired a catchy domain" because "it's an open stack shell tool" does not dispute or contradict OpenStack's evidence that Respondent acquired the disputed domain to the disrupt OpenStack's business and intentionally confuse consumers into visiting the disputed domain name instead of OpenStack's authentic website ("www.openstack.org").

Respondent does not contend or represent that it was unaware of OpenStack and the "www.openstack.org" domain prior to the registration of the disputed domain.

The remainder of Respondent's Comments make irrelevant assumptions concerning OpenStack's "legal expenses," and irrelevant statements concerning crowdfunding legal expenses that have nothing to do with the merits of the proceeding.

As the Respondent has failed to present any evidence contradicting that the disputed domain name is identical or confusingly similar to OpenStack's OPENSTACK

Trademarks; that the Respondent has no rights or legitimate interests in respect to the disputed domain; or that the Respondent has registered and is using the domain name in bad faith, the Panel should rule in favor of the Complainant and transfer the disputed domain to OpenStack."

## **6. Discussion and Findings**

The Panel notes that the .SH Domain Name Dispute Resolution Policy is substantially similar to the Uniform Domain Name Dispute Resolution Policy (the "UDRP"). Where appropriate, therefore, in this Decision, the Panel applies principles established in connection with the UDRP.

For the Complainant to prevail under the Policy, it must be established that (1) the disputed domain name is identical or confusingly similar to the Complainant's OPENSTACK trademarks, (2) the Respondent has no rights or legitimate interests in the disputed domain name, and (3) the disputed domain name was registered or is being used in bad faith. Policy, paragraph 4(a).

## **A. Identical or Confusingly Similar**

The Complainant has demonstrated it owns registered trademark rights in the OPENSTACK trademark in the United States, European Union, and United Kingdom. The OPENSTACK trademark is clearly recognizable in the disputed domain name. The addition of the ccTLD “.sh” does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions Third Edition ([“WIPO Overview 3.0”](#)), section 1.11.

Accordingly, the disputed domain name is identical to a mark in which the Complainant has rights.

## **B. Rights or Legitimate Interests**

The Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The fact that the Respondent obtained the disputed domain name over a decade after the Complainant had been using the trademark and its internationally registered trademark and domain name, indicates the Respondent sought to divert consumers by piggybacking off the Complainant’s trademark and goodwill for illegitimate reasons.

To rebut the Complainant’s *prima facie* case, the Respondent must present evidence demonstrating rights or legitimate interests in the disputed domain name. See, e.g., *Fondation Tasis v. Redacted for privacy, Privacy Service Provided by Withheld for Privacy ehf / Tas Isn* Case No. [DSH2021-0001](#). Here, the Respondent has provided no evidence of any rights or legitimate interests in the disputed domain name, other than claiming that he wanted to provide his interns a chance to test an idea of sharing open stacks. However, this claim is without merit as the disputed domain name reverts to a website that uses the Complainant’s OPENSTACK trademark and seeks investors. It is clear to the Panel that the Respondent was not offering an opportunity for interns to learn about sharing open stacks, but he was instead trying to create an association with the Complainant in order to take advantage of the fame and notoriety of the Complainant’s OPENSTACK mark.

The Panel concludes that the Respondent lacks rights or legitimate interests in the disputed domain name and finds the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

The disputed domain name was registered over ten-years after the Complainant first registered and used its OPENSTACK mark and domain name. The Complainant has provided sufficient evidence of its global registrations of the OPENSTACK mark and its use well before that of the Respondent’s registration of the disputed domain name. This is sufficient to satisfy the Panel that, at the time the disputed domain name was registered, the Respondent undoubtedly knew of the Complainant’s widely-known OPENSTACK mark, and knew it had no rights or legitimate interests in the disputed domain name.

Moreover, previous UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#). Given the identical nature of the disputed domain name as compared to the Complainant’s trademark, it is evident that the Respondent knew of, and purposefully targeted, the Complainant.

The Respondent’s use of the disputed domain name is clearly in bad faith. The Respondent’s claim that the use of the disputed domain name was to create a website for his interns to learn about sharing open stack technology does not withstand scrutiny. The disputed domain name uses the Complainant’s OPENSTACK trademark in both the composition of the disputed domain name and in the content hosted at the website to sell templates and to seek investors.

This fact establishes a deliberate effort by the Respondent to cause confusion for Internet users for commercial gain. Such an impersonation of the Complainant is sufficient to establish the Respondent's bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the disputed domain name was registered and used in bad faith.

## **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, <openstack.sh>, be transferred to the Complainant.

*Colin T O'Brien*

**Colin T O'Brien**

Sole Panelist

Date: October 10, 2023