

ADMINISTRATIVE PANEL DECISION

Universal Remanufacturing Co. LLC d/b/a Phoenix Chassis v. Super Privacy Service LTD c/o Dynadot and Domain Sales (expired domain caught by auction winner c/o Dynadot)
Case No. D2022-3700

1. The Parties

Complainant is Universal Remanufacturing Co. LLC d/b/a Phoenix Chassis, United States of America (“United States”), represented by Bodman PLC, United States.

Respondent is Super Privacy Service LTD c/o Dynadot and Domain Sales – (expired domain caught by auction winner c/o Dynadot), United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2022. On October 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 5, 2022, the Registrar transmitted by email to the Center its verification response confirming that 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 Respondent of the Complaint, and the proceedings commenced on October 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 31, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on November 4, 2022. 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 December 5, 2022, the Panel issued Procedural Order No. 1, which stated:

“In exercise of its general powers under paragraph 12 of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), the Panel invites Complainant to make a supplemental filing providing:

- (a) evidence that Complainant has used the PHOENIX CHASSIS mark in commerce up to the filing of the UDRP complaint; and
- (b) any evidence of consumer recognition of the PHOENIX CHASSIS mark.

If Complainant wishes to make a supplemental filing pursuant to this Panel Order, it should file it with the Center (copied to the Respondent) by December 12, 2022.

Respondent may reply to Complainant’s submission by December 19, 2022.”

On December 12, 2022, Complainant submitted a response to Procedural Order No. 1.

Respondent did not reply to Complainant’s last submission.

4. Factual Background

Founded in January 2022, Complainant manufactures and refurbishes shipping containers and shipping container chassis. It also provides maintenance, repair, refurbishing, and modification services for shipping container chassis and shipping container trailers. Complainant sells such products and performs such services throughout the United States.

On April 8, 2022, Complainant filed an “intent to use” trademark application for PHOENIX CHASSIS with the United States Patent and Trademark Office (“USPTO”), Serial No. 97353271, in connection with the goods and services described in the preceding paragraph.

According to a sworn but non-notarized declaration by Complainant president Jay Mason, Complainant began using the PHOENIX CHASSIS mark in commerce as early as January 2022. Attached to Mason’s declaration are a series of invoices to customers who had received Complainant’s services, and these invoices (the earliest being January 27, 2022) prominently show PHOENIX CHASSIS as the source of the services. Also attached to the Mason declaration are several photos of Complainant’s products, which prominently bear the PHOENIX CHASSIS mark. In addition, on June 27, 2022 Complainant received from the United States National Highway Traffic and Safety Administration a World Manufacturer Identifier for PHOENIX CHASSIS.

According to Mason, Complainant’s sales in 2022 have reached USD 480,000.

The Domain Name was registered on April 12, 2022, four days after Complainant’s USPTO application was filed. The Domain Name resolves to a parking page at which the Domain Name is offered for sale for USD 995.

According to a September 23, 2021 article in the *World Trademark Review*, which article was attached to the Complaint, there has been an increasing incidence of cybersquatters targeting trademark applicants’ prospective trademarks by registering domain names shortly after the trademark applications become public.

According to the Complaint, one of Complainant’s officers made contact on April 5, 2022 with an Internet firm (“DAL”) that purportedly designs logos for business. The officer of Complainant conducted several days of

back-and-forth with DAL, and at one point disclosed the PHOENIX CHASSIS brand and Complainant's company name. After an initial design was provided but before any contract was agreed, Complainant backed away from the discussion (memorialized in text messages annexed to the Complaint), and stated that Complainant was no longer interested in using DAL's services. On April 11, 2022, DAL telephoned Complainant's officer, who repeated that Complainant had no desire to do business with DAL.

Within 24 hours of that call, the Domain Name was registered. On April 14, 2022, Complainant emailed the registrant of the Domain Name listed in the Whois database, and asked to buy the Domain Name. The registrant responded, "First come first served", and told Complainant's officer that the Domain Name was available for sale at USD 4,550. Complainant alleges, "upon information and belief", that DAL had disclosed Complainant's business branding plans to Respondent.

On April 25, 2022, Complainant's counsel sent a cease-and-desist letter to Respondent, but received no reply.

5. Parties' Contentions

A. Complainant

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

B. Respondent

Respondent did not reply to Complainant's contentions.

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 PHOENIX CHASSIS.

As noted above, Complainant filed an "intent to use" application with the USPTO. Under United States trademark law, the filing of an intent-to-use trademark application, subject to the mark being registered, constitutes constructive use of the mark and confers priority rights as of the date of the application's filing date. According to Complainant, there are no other users of the mark PHOENIX CHASSIS who could emerge and claim priority rights to that mark. This mark has not yet been registered, and hence the "intent to use" application, by itself, may not be sufficient under the UDRP to recognize Complainant's trademark rights on that basis.

Complainant has, however, also presented evidence that it has used the PHOENIX CHASSIS mark, both on its manufactured products and on its service invoices. Complainant's sales have reached USD 480,000 this far in 2022. Although the evidence presented is thin, the Panel finds it sufficient to recognize Complainant's common law trademark rights in PHOENIX CHASSIS in these circumstances, especially given the relatively low "standing" threshold for trademark rights under the first element of the UDRP.

The Panel also concludes that the Domain Name is identical to the PHOENIX CHASSIS 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 concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. None of the above-quoted “safe harbors” applies here, based on the record presented.

Respondent has not come forward, either in response to Complainant’s cease-and-desist letter or in response to the Complaint filed in this proceeding, to articulate or prove any possible legitimate interest in the Domain Name. Relatedly, Respondent has not come forward to deny the allegations that Respondent was aware of Complainant’s recent trademark application and registered the Domain Name in order to profit from Complainant’s nascent trademark rights.

At a minimum, confronted with the cease-and-desist letter and then the Complaint in this proceeding, one would have expected Respondent to deny any knowledge of Complainant or its PHOENIX CHASSIS trademark application, to deny any affiliation or relationship with the logo designer DAL, to explain why Respondent chose a Domain Name reflecting the unusual combination of two words, Phoenix and Chassis, and to confirm that the close timing of the trademark application and the Domain Name registration is mere coincidence.

In short, there is no basis in the record on which to conclude that Respondent has any rights or legitimate interests in respect of the Domain Name.

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

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 Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section.

Section 3.8.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), under some circumstances bad faith may be found even where a domain name is registered by a respondent before the complainant's trademark rights are established. One example is where the domain name is registered shortly after the announcement of a corporate merger. Another example, more germane to this case, is where the domain name is registered shortly after the complainant files a trademark application.

The timing of the Domain Name registration, a mere four days after the USPTO application was filed, and the fact that the words "phoenix" and "chassis" are an unlikely combination, make the Panel immediately suspicious of Respondent's motives. Respondent's failure to explain itself or deny Complainant's well-pleaded and plausible allegations reinforce the case against Respondent here.

Based on the undisputed record here, the Panel concludes, on a balance of probabilities, that Respondent more likely than not had Complainant's nascent PHOENIX CHASSIS mark in mind when registering the Domain Name. Having made that finding, the Panel has no difficulty concluding that Respondent's attempt to sell the Domain Name to Complainant for USD 4,550 constitutes bad faith use of the Domain Name within the meaning of the above-quoted Policy paragraph 4(b)(i).

Complainant has established Policy 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 Domain Name <phoenixchassis.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: December 23, 2022