

## ADMINISTRATIVE PANEL DECISION

Headout Inc. v. “Robert DeNiro”<sup>1</sup>

Case No. DPW2023-0003

### 1. The Parties

Complainant is Headout Inc., United States of America (“US”), represented by Indus Law, India.

Respondent is “Robert DeNiro”, US.

### 2. The Domain Name and Registrar

The disputed domain names <headout-expedition.pw>, <headout-journey.pw>, and <headout-trek.pw> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 21, 2023. On October 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 25, 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 named Respondent and contact information in the Complaint. The Center sent an email

---

<sup>1</sup> Respondent appears to have purposefully used false or fictitious information when registering each of the three disputed domain names. More specifically, Respondent appears to have misappropriated the name of a famous American actor, and Respondent also appears to have misappropriated the physical address and telephone number of a Mexican restaurant in Mitchell, South Dakota. Therefore, the Panel has specifically declined to redact the false or fictitious data used by the Respondent in furtherance of two important interests, namely public notice and accountability. More specifically, publication of Respondent’s false or fictitious data will better facilitate collaboration and cooperation between other organizations or individuals that may have been similarly victimized by Respondent. It will also better facilitate proactive anti-abuse measures by domain name registries and registrars with heightened validation requirements for suspicious or patently false or fictitious registration data. Finally, the Panel considers the instant facts highly distinguishable from those warranting Respondent redaction in *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#) (involving a co-Respondent who “notified the Center that his business had been victim of ‘hijacking’ of their domain name hosting account” and “claimed that he had no involvement with or knowledge of registration of the disputed domain name, which was undertaken by an unknown third party, presumably based on information taken from the hijacked hosting account.”). It was necessary in the instant case for the Center to disclose to the Panel the redacted identity of the Respondent in the related case *Headout Inc. v. Name Redacted*, WIPO Case No. [D2023-3866](#), in order to assess Complainant’s below arguments that Respondent is a habitual cybersquatter. To that end, and in furtherance of the important public policy goals mentioned above, the viewpoint of this Panel is that patently false or fictitious registration data be publicly disclosed and flagged as such whenever possible.

communication to Complainant on November 1, 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 November 4, 2023.

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 November 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 28, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on December 1, 2023.

The Center appointed Phillip V. Marano as the sole panelist in this matter on December 13, 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.

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

Complainant is a Delaware corporation founded in 2014 that provides an online platform for travelers to book tours, excursions, and other travel experiences. Complainant promotes its services through its official <headout.com> domain name and website. Complainant owns valid and subsisting registrations (both in standard character and design) for the HEADOUT trademark in numerous countries, including the trademark for HEADOUT (Reg. No. 4,840,337) in the US, registered on October 27, 2015, with the earliest priority dating back to July 21, 2014.

Respondent registered each of the disputed domain names on August 21, 2023. At the time this Complaint was filed, the disputed domain names all resolved to websites that attempted to impersonate Complainant by misappropriating Complainant's standard character and design HEADOUT trademark as well as the content of Complainant's official website.

#### **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 asserts ownership of the HEADOUT trademark and has adduced evidence of trademark registrations in numerous regions and countries around the world including in the US, with earliest priority dating back to July 21, 2014. Each of the disputed domain names is identical to Complainant's HEADOUT trademark, according to Complainant, because it the added terms "journey, expedition and trek ... are directly related to the goods/services offered by Complainant" and because "domain extensions like '.com' are to be ignored while assessing" confusing similarity. In addition, Complainant argues that confusing similarity is established based upon Respondent's use of the disputed domain names and Respondent's websites to impersonate Complainant by misappropriating Complainant's HEADOUT trademarks as well as other content from Complainant's official website.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any relationship, authorization, or license between Complainant and Respondent; and Respondent's use of the disputed domain names and Respondent's websites to

impersonate Complainant by misappropriating Complainant's HEADOUT trademarks as well as other content from Complainant's official website.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: the "wide and extensive coverage of Complainant's business and services under the HEADOUT marks"; Respondent's habitual cybersquatting, as established by *Headout Inc. v. Name Redacted*, WIPO Case No. [D2023-3866](#); "as an immediate and proactive measure, Complainant had reported the infringing websites hosted under the disputed domain names, and these websites were consequently blocked after being found to be infringing"; and Respondent's use of the disputed domain names and Respondent's websites as part of a phishing or otherwise fraudulent scheme to impersonate Complainant by misappropriating Complainant's HEADOUT trademarks as well as other content from Complainant's official website.

Finally, Complainant asserts that the disputed domain names should be consolidated into a single case because they are subject to common control, as best established by the following facts: (i) the disputed domain names are all "comprise[d] of Complainant's well-known brand and registered trademark, HEADOUT, and follow the same naming pattern;" (ii) the disputed domain names "were all registered on the same date, with the same Registrar, PDR Ltd. d/b/a PublicDomainRegistry.com;" (iii) the "[r]egistrant details provided by the Registrar for all the Disputed domain names are identical;" and (iv) each of the disputed domain names "formerly resolved to websites which [we]re a replication of Complainant's website and are imitating Complainant."

## B. Respondent

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. 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.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

In addition, paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. In view of the above consolidation arguments made by Complainant, the Panel concurs that consolidation of each of the disputed domain names into a single case is appropriate because all evidence supports the conclusion that the same Respondent is responsible for all of the disputed domain names.

## A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the HEADOUT trademark has been registered in numerous jurisdictions with priority dating back to July 21, 2014 (in the US). Thus, the Panel finds that Complainant's rights in the HEADOUT trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether each of the disputed domain names are identical or confusingly similar to Complainant's HEADOUT trademark. In this Complaint, each of the disputed domain names are confusingly similar to Complainant's HEADOUT trademark because, disregarding the .pw country-code Top-Level Domain ("ccTLD"), the entirety of the trademark is contained within each of the disputed domain names. [WIPO Overview 3.0](#), section 1.7 ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to ccTLDs, such as .pw in each of the disputed domain names, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the terms "journey", "expedition", and "trek" do not prevent a finding of confusing similarity between Complainant's HEADOUT trademark and each of the disputed domain names. WIPO Overview, section 1.8 (Additional terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#) ("Each of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant's [ATT trademark]"); *Pfizer Inc. v. Blue Viagra*, WIPO Case No. [D2004-0732](#) (Transferring the <blue-viagra.com> domain name and noting that "[t]he addition of a common term such as 'blue' preceding Complainant's famous and distinctive VIAGRA mark does not create a new or different mark in which the Respondent has rights, and therefore is not sufficient to avoid consumer confusion.") Indeed, the Panel concurs with Complainant that the additional terms "journey", "expedition" and "trek" do not dispel the confusing similarity between Complainant's HEADOUT trademark and each of the disputed domain names.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

## B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain names, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. WIPO Overview, section 2.1.

It is evident that Respondent, most likely falsely identified by Whois data for the disputed domain names as "Robert DeNiro", is not commonly known by the disputed domain name or Complainant's HEADOUT trademark.

Rather, UDRP panels have categorically held that use of a domain name for illegal activity—including the impersonation of the complainant and other types of fraud—can never confer rights or legitimate interests on a respondent. Circumstantial evidence can support a credible claim made by Complainant asserting

Respondent is engaged in such illegal activity, including that Respondent has masked its identity to avoid being contactable, or that Respondent's website has been suspended by its hosting provider.

[WIPO Overview 3.0](#), section 2.13. See e.g. *Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrenge*, WIPO Case No. [D2009-1017](#) ("Respondent has used the domain name to pretend that it is the Complainant and in particular to create false emails pretending that they are genuine emails coming from the Complainant and one of its senior executives"); see also *The Commissioners for HM Revenue and Customs v. Name Redacted*, WIPO Case No. [D2017-0501](#) ("In addition, the disputed domain names ... have had their web hosting suspended as a result of fraudulent activities. This is evidence of bad faith registration and use of the disputed domain names"). In its Complaint, Complainant has submitted persuasive evidence that: Respondent has configured each of the disputed domain names to resolve to website content that intentionally impersonates Complainant by misappropriating Complainant's HEADOUT standard and design trademarks as well as Complainant's official website content; Respondent's websites are part of a larger phishing, fraudulent, or otherwise illegal scheme by Respondent to defraud Complainant's customers; and Complainant has already successfully disabled Respondent's websites with notice and takedown correspondence to Respondent's webhosts. To this end, the second and third elements of the Policy may be assessed together where clear indicia of bad faith suggests that there cannot be any Respondent rights or legitimate interests. [WIPO Overview 3.0](#), section 2.15.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

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

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed 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.

UDRP panels have categorically held that registration and use of a domain name for illegal activity—including impersonation, passing off, and other types of fraud—is manifestly considered evidence of bad faith within paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.3. Use of the disputed domain name by Respondent to pretend that it is Complainant or that it is associated with Complainant "brings the case within the provisions of paragraph 4(b)(iii) of the Policy, for it shows Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor, namely Complainant." Moreover, wrongful use of others' trademarks to extort information from unsuspecting and unwary people, by using the disputed domain name for phishing activity, is considered abusive registration of the disputed domain name under the Policy. See *CareerBuilder, LLC v. Stephen Baker*, WIPO Case No. [D2005-0251](#); *The Boots Company, PLC v. The programmer adviser*, WIPO Case No. [D2009-1383](#). See e.g. *WSI Holdings Ltd. v.*

*WSI House*, Case No. [D2004-1089](#) (“Respondent appears to be engaged in “phishing” for mistaken potential employees of the Complainant ... Respondent (1) has adopted a confusingly similar domain name, (2) it has used the trade dress of the Complainant’s website, and (3) it has sought to attract users to its site by creating confusion between its site and the Complainant’s. It has clearly engaged in activity which fulfils the bad faith requirements of paragraph 4(b)(iv) of the Policy.”). As discussed above with respect to the second element of the Policy, Complainant has proffered strong evidence that: Respondent registered and used each of the disputed domain names to purposefully target and impersonate Complainant in furtherance of Respondent’s illegal website phishing scheme, through which Respondent misappropriated Complainant’s HEADOUT standard and design trademarks as well as proprietary content from Complainant’s official website.

Furthermore, each of Respondent’s websites associated with each of the disputed domain names were deactivated following a takedown request by Complainant absent any attempt by Respondent to explain or justify its use of the disputed domain name. The Panel takes this as corroborating evidence of Respondent’s bad faith. *LEGO Juris A/S v. Ammar Briouel / Brahim Mahjoubi*, WIPO Case No. [D2019-0750](#) (involving website suspension following a takedown request by Complainant).

Prior WIPO panel determinations agree, the use of false registration data in connection with a disputed domain name further supports a finding of bad faith registration and use. See e.g. *Action Instruments, Inc. v. Technology Associates*, WIPO Case No. [D2003-0024](#) (“Providing false contact information violates paragraph 2 of the Policy, which requires a registrant to represent that the statements it ‘made in [its] Registration Agreement are complete and accurate.’ Maintaining that false contact information in the WHOIS records (which can easily be updated at any time) after registration constitutes bad faith use of the domain name because it prevents a putative complainant from identifying the registrant and investigating the legitimacy of the registration.”); *Royal Bank of Scotland Group v. Stealth Commerce*, WIPO Case No. [D2002-0155](#); *Home Director, Inc. v. HomeDirector*, WIPO Case No. [D2000-0111](#) (April 11, 2000). To this end, (and in assessing whether to redact the registration data provided by Respondent on the basis of identity theft), this Panel undertook limited factual research into matters of public record, namely a white pages search for “Robert DeNiro”, as well as a physical address and telephone number lookup, all in Mitchell, South Dakota. All evidence resulting from that limited factual research readily confirmed that Respondent has used false or fictitious domain name registration data: the Panel found no connection between any person named “Robert DeNiro” and Respondent’s putative location, apart from a clear resemblance to the name of the famous American actor “Robert De Niro”; and Respondent’s putative physical address and telephone number instead belong to a Mexican restaurant.

And finally, this Complaint presents a quintessential example where Respondent has engaged in a pattern of bad faith registration and use within paragraph 4(b)(ii) of the Policy. [WIPO Overview 3.0](#), section 3.1.2. (“This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner.”) Complainant has cited Respondent’s habitual cybersquatting, as established by *Headout Inc. v. Name Redacted, supra*. In that case, an individual using the identical false and fictitious registration data was found to have purposefully targeted Complainant by registering and using the <heabout.com>, <heabout.pw>, <heabout-book.pw>, and <heabout-book.online> domain names in bad faith, resulting in a decision against Respondent. It demonstrates that Respondent has repeatedly targeted Complainant’s HEADOUT trademark in bad faith. It also shows that Respondent’s modus operandi is to: hide its true identity through anonymous domain name registration services; further obfuscate its identity through the use of patently false or fictitious domain name registration data; register domain names incorporating Complainant’s HEADOUT trademark; trade-off the goodwill of those marks for commercial gain and/or to perpetrate an illegal phishing scheme by impersonating Complainant; and refuse to participate when the rightful trademark owners file Complaints pursuant to the UDRP.

In view of the foregoing, the Panel concludes 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 names <headout-expedition.pw>, <headout-journey.pw>, and <headout-trek.pw> each be transferred to Complainant.

*/Phillip V. Marano/*

**Phillip V. Marano**

Sole Panelist

Date: January 10, 2024