

ADMINISTRATIVE PANEL DECISION

**Out-Back Storage, LLC (Rhode Island (US) Limited Liability Company) v.
Sammy Duprami, 14092 Magyol LLC
Case No. D2022-4623**

1. The Parties

The Complainant is Out-Back Storage, LLC (Rhode Island (US) Limited Liability Company), United States of America (“United States”), represented by Barlow, Josephs & Holmes, Ltd, United States.

The Respondent is Sammy Duprami, 14092 Magyol LLC, Burkina Faso.

2. The Domain Name and Registrar

The disputed domain name <outbackstoragecontainers.net> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 2, 2022. On December 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 2022, 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 (Unknown Registrant and the Registrar) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 6, 2022, 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 December 6, 2022.

The Center verified that the Complaint together with the amendment to 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 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 30, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on January 10, 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

The Complainant was founded in 2004 and is based in Rhode Island, United States.

The Complainant offers for sale and rent a variety of container types, including new shipping containers and refurbished containers in a wide number of configurations.

The Complainant owns the United States Trademark Registration No. 5942864 for the word mark OUTBACK STORAGE, registered since December 24, 2019, for retail store services featuring storage containers and accessories for storage containers as well as for rental of storage containers.

Since February 6, 2012, the Complainant owns the domain name <outbackstoragecontainers.com>, which links to its official website.

The disputed domain name was registered on April 23, 2022, and resolved to a copycat website with fraudulent listings of the Complainant's storage containers for sale at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name, which incorporates the entirety of its OUTBACK STORAGE trademark is confusingly similar to it.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant claims that the Respondent registered the disputed domain name with the specific intent to defraud its customers. The Respondent has copied its entire website content, trademark and copyrighted logos, including original photographs of containers taken from listings from the Complainant's website.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the 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

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant evidenced of having registered rights in the OUTBACK STORAGE trademark and for the purpose of this proceeding the Panel establishes that the United States Trademark Registration No. 5942864 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), 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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc", or in this case ".net") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The disputed domain name incorporates the Complainant's mark in its entirety and is clearly recognizable in the disputed domain name. In view of the Panel, the addition of the term "containers" to the Complainant's trademark does not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name.

The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant's trademark and that the first ground of the Policy is established.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use, the domain name

or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;

- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the OUTBACK STORAGE trademark.

The Complainant has never authorized the Respondent to use its trademark in any way, and its prior rights in the trademark precede the date of registration of the disputed domain name.

According to section 2.1 of the [WIPO Overview 3.0](#), while 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 often impossible 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 the relevant evidence demonstrating its rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Respondent failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

The website to which the disputed domain name resolved effectively copied the Complainant’s website, with the Respondent use of the Complainant’s trademark, copyrighted logos and photographs of containers taken from the Complainant’s website and had fraudulent listings of the Complainant’s storage containers for sale.

UDRP panels have categorically held that use of a domain name for illegal activity, such as impersonation/passing of, or other types of fraud can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant's OUTBACK STORAGE trademark is inherently distinctive for the corresponding services, namely sale and rental of storage containers.

The Respondent reproduced the Complainant's trademark in the disputed domain name and has used the Complainant's signature logo and copyrighted materials at the website under the disputed domain name. Thus, it is clear that the Respondent had full knowledge of the Complainant's trademark and business when it registered the disputed domain name.

The use to which the Respondent has put the disputed domain name in view of the Panel amounts to bad faith registration and use.

The Respondent's replication of the Complainant's entire website content, including its trademark, copyrighted logos and original photographs of containers taken from the Complainant's website in view of the Panel amounts to bad faith conduct within the meaning of paragraph 4(b)(iv) of the Policy.

Furthermore, the Respondent has fraudulently listed the Complainant's storage containers for sale at discounted prices, and the Complainant has received a number of customer calls and inquiries asking if the listings were legitimate. This in view of the Panel evidences that the Respondent has registered and used the disputed domain name with clear intent to defraud the Complainant's customers, which in view of the Panel is compelling evidence of bad faith within the meaning of paragraph 4(b)(iii) of the Policy.

The fact that at the time of rendering of this decision the disputed domain name did not resolve to active website does not alter the Panel's findings (see section 3.3 of the [WIPO Overview 3.0](#)).

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain names in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

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 <outbackstoragecontainers.net> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: January 18, 2023