

## **ADMINISTRATIVE PANEL DECISION**

Outfront Media LLC v. Law Office of Aaron Herbert  
Case No. D2023-0086

### **1. The Parties**

Complainant is Outfront Media LLC, United States of America (“United States”), represented by Jones Day, United States.

Respondent is Law Office of Aaron Herbert, United States.

### **2. The Domain Names and Registrars**

The disputed domain names <outfrontbillboardssuck.com>, <outfrontmediasucks.com>, <outfrontsucks.com> are registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 7, 2023. On January 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 10, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Registration Private), and contact information in the Complaint. The Center sent an email communication to Complainant on January 11, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on January 16, 2023.

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”).

On January 17, 2023 the Center received an informal communication from Respondent to which the Center acknowledged receipt.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on January 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2023. Respondent did not submit a formal response. Accordingly, the Center notified the Parties of the Commencement of Panel Appointment Process on February 8, 2023.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on February 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**

Complainant is a provider of outdoor advertising under the OUTFRONT and OUTFRONT MEDIA marks, for which it has registered several trademarks, including the following:

- United States Trademark Reg. No. 5834907 for OUTFRONT (word mark), registered on August 13, 2019 for services in class 35;
- United States Trademark Reg. No. 4909495 for OUTFRONT MEDIA (word mark), registered on March 1, 2016 for services in class 35.

Complainant operates business websites at the domain names <outfront.com> and <outfrontmedia.com>.

All three disputed domain names were registered on September 26, 2022. Each disputed domain name resolves to a parking page featuring Pay-Per-Click (“PPC”) links.

The record reflects that Complainant attempted to notify Respondent using the contact form on the Registrar’s website on November 30, 2022.

#### **5. Parties’ Contentions**

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

Complainant’s contentions may be summarized as follows:

Under the first element, Complainant states that it operates one of the largest and most diverse collections of billboard, transit, and mobile advertising assets in North America. Since 2014, Complainant has used and promoted its OUTFRONT and OUTFRONT MEDIA marks in connection with advertising services featuring audio and visual content distributed via billboards, digital billboards, digital posters, and digital outdoor advertising displays, as well as other marketing and promotional services. The disputed domain names encompass Complainant’s marks in their entirety, with the addition of descriptive and pejorative terms.

Under the second element, Complainant states that Respondent is not commonly known by the disputed domain names. Moreover, there is no relationship or affiliation between Complainant and Respondent giving rise to any license, permission, or other right by which Respondent could own or use any domain name incorporating Complainant’s registered marks. Respondent is using the disputed domain names to host PPC links. Respondent is therefore not making legitimate noncommercial use of them to identify a subject of protest as might be indicated by the inclusion of the term “sucks”.

Under the third element, Complainant states that Respondent’s use of the disputed domain names to profit from PPC advertising revenue amounts to bad faith registration of the disputed domain names for commercial gain. Given that the disputed domain names redirect users to third-party sites that have no apparent relationship to Complainant or to the OUTFRONT marks, it may reasonably be inferred that Respondent is redirecting traffic to these third-party websites in exchange for a fee. Additional indicia of bad faith registration and use are the facts that Respondent registered the disputed domain names using a proxy service and that Respondent failed to respond to Complainant’s attempt to contact Respondent.

Complainant requests transfer of the disputed domain names.

## **B. Respondent**

Respondent did not provide a formal reply to Complainant's contentions. In an email dated January 17, 2023, Respondent stated that it does not "own or operate any of the domains mentioned in the complaint".

## **6. Discussion and Findings**

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) Respondent has registered and is using the disputed domain names in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint 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. Identical or Confusingly Similar**

Complainant has provided evidence establishing that it has trademark rights in the OUTFRONT and OUTFRONT MEDIA marks through registrations in the United States. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1.

In comparing Complainant's marks with the disputed domain names, the Panel finds that the disputed domain names are confusingly similar to these marks, as the OUTFRONT mark is clearly recognizable within all three disputed domain names. UDRP panels have consistently held that a domain name consisting of a trademark and a negative or pejorative term is considered confusingly similar to the complainant's trademark for the purpose of satisfying standing under the first element. See [WIPO Overview 3.0](#), section 1.13.

It is the well-established view of UDRP panels that a generic Top-Level Domain such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

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

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, respondent's 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) respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

- (iii) respondent is 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 finds that there is no evidence that Respondent is commonly known by the disputed domain names – which are used for PPC sites, and not for critical content – nor is using the OUTFRONT or OUTFRONT MEDIA marks with the permission of Complainant.

The Panel therefore finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain names.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names.

Respondent has not provided evidence of rights or legitimate interests. There is no evidence that Respondent is commonly known by the disputed domain names, nor that there are any circumstances or activities that would establish Respondent's rights therein. The Panel finds that the nature of the disputed domain names, each of which reflects Complainant's mark in its entirety together with the additional terms "sucks", and "billboards" cannot constitute fair use, because Respondent is not using the disputed domain names for fair use such as noncommercial free speech in the form of legitimate criticism. See [WIPO Overview 3.0](#), section 2.6.3.

Rather, the disputed domain names, which reflect Complainant's mark in its entirety, resolve to parking pages featuring PPC links where some of them refer to or capitalize on the Complainant's reputation and trademark, which does not amount to a *bona fide* offering of goods or services; such PPC use for what would otherwise appear to be a criticism site does not establish rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.9.

Respondent denies ownership of the disputed domain names. Therefore, it would either appear that someone has wrongfully used their contact information or that currently Respondent has no interest in the disputed domain names. While the fact that the street and phone number information provided by the Registrar does not seem to match that on Respondent's website, Respondent did reply to the Center by email. The exact situation as to the currently registration/registrant of the disputed domain names is somewhat unclear but certainly at least currently Respondent has no interest in the disputed domain names given the email communication received from the Respondent.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

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

Pursuant to paragraph 4(b) of the Policy, the Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain names. Complainant's rights in its OUTFRONT and OUTFRONT MEDIA marks predate the registration of the disputed domain names by several years. The disputed domain names reflect Complainant's OUTFRONT or OUTFRONT MEDIA marks followed by the terms "sucks" and "billboards". The disputed domain names are therefore confusingly similar to Complainant's marks. In connection with the fact that the disputed domain names do not resolve to websites containing legitimate criticism, the Panel is unable to find that the disputed domain names were registered in good faith. See [WIPO Overview 3.0](#), section 3.2.1.

UDRP panels have consistently held that the use of disputed domain names to redirect to PPC websites such as the one used by Respondent is evidence of bad faith. The PPC links indicate Respondent is using

the disputed domain names for commercial gain. See [WIPO Overview 3.0](#), section 3.1.4. See also *Shangri-La International Hotel Management Limited v. NetIncome Ventures Inc.*, WIPO Case No. [D2006-1315](#); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#).

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) 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 <outfrontbillboardssuck.com>, <outfrontmediasucks.com> and <outfrontsucks.com> be transferred to Complainant.

*/Ingrīda Kariņa-Bērziņa*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: February 20, 2023