

## **ADMINISTRATIVE PANEL DECISION**

Wastequip, LLC v. Some, Jame  
Case No. D2023-5196

### **1. The Parties**

The Complainant is Wastequip, LLC, United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

The Respondent is Some, Jame, United States.

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

The disputed domain name <containerprosinc.com> is registered with Network Solutions, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 13, 2023. On December 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 18, 2023, the Registrar transmitted by email to the Center its verification response, confirming that the 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 the Respondent of the Complaint, and the proceedings commenced on December 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 16, 2024.

The Center appointed Gregory N. Albright as the sole panelist in this matter on January 29, 2024. 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

Founded in 1989, the Complainant is one of the leading North American manufacturer of waste handling equipment with an international network of manufacturing facilities and the most extensive service network in the industry. The Complainant offers the broadest range of waste equipment, including carts, containers, trucks, and parts, and service and technology for the collection, transport and disposal of waste and recyclables.

Under its ContainerPros brand, the Complainant provides owners and operators with an array of specialized professional waste management services including cart assembly and delivery, maintenance, consulting, marketing and sales, and customer management. Since at least early 2010, the Complainant adopted and has used the CONTAINERPROS trademark in connection with the marketing, advertising, promotion, and provision of the aforementioned services. The Complainant is owner of trademark Registration No. 6,533,956, issued by the United States Patent and Trademark Office on October 26, 2021.

The Complainant also owns the <containerpros.com> domain name, which it registered on April 16, 2010, and has used continuously.

The Respondent registered the disputed domain name on October 19, 2023. The disputed domain name currently resolves to an inactive website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for transfer of the disputed domain name.

Notably, the Complainant contends that it owns common law rights in the CONTAINERPROS mark, and obtained a United States federal trademark registration issued in October 2021. Having established its rights in the mark prior to the Respondent's registration of the disputed domain name in October 2023, the question is whether the disputed domain name is identical or confusingly similar to the Complainant's CONTAINERPROS mark. The disputed domain name incorporates the entirety of the Complainant's mark, and the incorporation of "inc" into the disputed domain name does not prevent a finding of confusing similarity; to the contrary, the inclusion of the commonly-known abbreviation for "corporation" increases confusing similarity between the disputed domain name and the Complainant's mark.

The Respondent has no rights or legitimate interests in the disputed domain name, much less rights prior to the Complainant's rights in its mark. The Respondent is not commonly known by the CONTAINERPROS mark. Moreover, the Complainant has not licensed the mark to the Respondent, or otherwise authorized the Respondent to use it. The Respondent's lack of rights or legitimate interests is further shown by the Respondent's failure to make any *bona fide* use of the disputed domain name, or preparations for such use. And passive holding of a disputed domain name is not a *bona fide* use; instead, passive holding can constitute bad faith use in certain circumstances.

The Respondent's registration of the disputed domain name, which is identical or confusingly similar to the Complainant's mark, in itself can create a presumption of bad faith registration. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), Section 3.1.4. Further, the Respondent knew or should have known of the Complainant's prior existing CONTAINERPROS mark because of the Complainant's registration of the mark in the United States (where both parties are located), and because a simple Google search for "container pros" would have alerted the Respondent to the Complainant's prior existing rights in the mark.

With respect to the Respondent's bad faith use of the disputed domain name, the fact that the disputed domain name does not resolve to an active website, and is being passively held, does not obviate a finding of bad faith. [WIPO Overview 3.0](#), Section 3.3. The following factors demonstrate the Respondent's bad faith: (1) the Complainant has been using its CONTAINERPROS mark in the United States for the past thirteen (13) years since adopting the mark, and the Respondent was at least on constructive notice of the Complainant's trademark rights; (2) the Respondent has made no use of the disputed domain name since registering it; (3) the Respondent failed to respond to the Complainant's cease-and-desist letter; and (4) the Respondent provided false contact information to the Registrar, including a non-existent address.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

It is well accepted that the first element functions primarily as a standing requirement. 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. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. As noted above, the Complainant owns a United States trademark registration for the CONTAINERPROS mark which was issued two years before the Respondent registered the disputed domain name.

The entirety of the mark is reproduced within the disputed domain name. Although the addition of other terms – here, “inc” – may bear on assessment of the second and third elements, the Panel finds the addition of “inc” to the Complainant's CONTAINERPROS mark does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy lists circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant asserts that it has not authorized the Respondent to use the CONTAINERPROS mark. There is no evidence that the Respondent has used or prepared to use the disputed domain name for any *bona fide* offering of goods or services. Further, the Respondent has not rebutted the Complainant's prima facie showing and

has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain name on October 19, 2023, about two years after the Complainant obtained federal registration of the CONTAINERPROS mark in the United States, where the Respondent apparently lives, and thirteen years after the Complainant registered and began using the <containerpros.com> domain name. It may be inferred that the Respondent registered the disputed domain name with knowledge of the Complainant's trademark rights, and registered the disputed domain name for the purpose of attempting to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record in this case, the Panel notes the registration of the Complainant's trademark, the failure of the Respondent to submit any response in this proceeding, and the Respondent's use of false contact details. The Panel finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the 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 name <containerprosinc.com> be transferred to the Complainant.

*/Gregory N. Albright/*

**Gregory N. Albright**

Sole Panelist

Date: February 12, 2024