

ADMINISTRATIVE PANEL DECISION

DS Smith PLC v. Ryan Dunn
Case No. D2024-1120

1. The Parties

The Complainant is DS Smith PLC, United Kingdom, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Ryan Dunn, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <dssmith-packaging.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2024. On March 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 2024, 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.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2024.

The Center appointed John Swinson as the sole panelist in this matter on April 19, 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

The Complainant is a company from the United Kingdom and is listed on the London Stock Exchange. The Complainant was started in the 1940s by the Smith family in East London. It is now a leader in corrugated

packaging with emphasis on state-of-the art packaging design. The Complainant maintains an Internet and retail presence through its primary website at the domain name <dssmith.com>.

The Complainant owns registered trademarks for DS SMITH, including United States Trademark Reg. No. 6406061 that was registered on July 6, 2021.

The disputed domain name was registered on June 28, 2001.

The Complainant was the original owner of the disputed domain name, which was held by the Complainant and its marketing partner, Chalk & Ward Advertising, at least since 2006. The Complainant provided a screenshot from the Wayback Machine showing the Complainant's use of the disputed domain name in 2007 for a packaging related website promoting the Complainant's business. The Complainant inadvertently allowed the disputed domain name to lapse, and the Respondent registered the disputed domain name thereafter in July 2022. According to correspondence from the Respondent, he acquired the disputed domain name via a Godaddy auction for expired domain names.

The disputed domain name currently redirects to a website address at "customstickers.com/products/label-and-packaging-stickers". This website is a commercial website that allows users to design labels and stickers and have them printed. It is unclear who operates this website. In the Terms of Service, it states "This website is operated by faststickersus." In the Privacy Policy, under the heading "Who we are", it states "Our website address is: <https://customstickers.com> previously known as faststickers.com."

The Respondent did not file a Response, so little information is known about the Respondent. According to the Registrar's records, the Respondent is a person with an address in Salem, Utah, United States. From his email correspondence, discussed below, the Respondent has an IT department.

On July 25, 2023, the Complainant sent a cease-and-desist letter to the Respondent. This resulted in a chain of email correspondence between the Parties. The Respondent stated that he was not using the disputed domain name and not using it for "unfair commercial advantage". The Respondent offered to transfer the disputed domain name to the Complainant for USD 600, calculated as USD 20 for the registration fee, USD 80 for the auction, and USD 500 for "my IT support service staff to work on this request." The Complainant agreed to this price, but no transaction or transfer took place.

5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends that where a domain name belonging to a well-known company has inadvertently lapsed and subsequently been registered by an unrelated third-party, this evidences a lack of rights and legitimate interests.

Further, the Complainant contends that the Respondent's use of the disputed domain name constitutes a disruption of the Complainant's business and qualifies as bad faith registration and use under paragraph 4(b)(iii) of the Policy because the disputed domain name is confusingly similar to the Complainant's trademarks, and it redirects to a third-party website offering competing goods and services.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainants must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

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

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the 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

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[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.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "packaging" and a dash) may bear on assessment of the second and third elements, the Panel finds the addition of such term and punctuation 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 provides a list of 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 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.

Using a domain name which includes a trademark to redirect to a website that competes with the trademark owner is not bona fide use of the domain name.

The Respondent (in correspondence with the Complainant) states he is not using the disputed domain name, which suggests that either the Respondent does not realize that a redirection to a website can be use of a domain name or that the Respondent is being dishonest with the Complainant. In any event, the Respondent's statement to the Complainant confirms that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 Respondent registered the disputed domain name in 2022 after the Complainant inadvertently let the disputed domain name lapse, and then redirected the disputed domain name to a website that competes with the Complainant. At this time, the Complainant owned registered trademark rights in the United States (where the Respondent is located) for DS SMITH. The Respondent's actions are evidence of registration and use of the disputed domain name in bad faith within paragraph 4(b)(iii) of 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 <dssmith-packaging.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: May 2, 2024