

## **ADMINISTRATIVE PANEL DECISION**

Clear Channel Outdoor Holdings, Inc., Clear Channel IP, LLC v. Samuel Chan

Case No. D2024-4204

### **1. The Parties**

The Complainants are Clear Channel Outdoor Holdings, Inc. (the “First Complainant”), and Clear Channel IP, LLC (the “Second Complainant”), United States of America (“United States”), represented by Schwegman Lundberg & Woessner, P.A., United States.

The Respondent is Samuel Chan, Hong Kong, China.

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

The disputed domain name <clear-channeltaximedia.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2024. On October 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 14, 2024, 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 contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 2024, 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 amended Complaint on October 24, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on October 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 18, 2024.

The Center appointed Mladen Vukmir as the sole panelist in this matter on December 6, 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 First and the Second Complainants are the United States-based companies. The First Complainant is one of the world's largest outdoor advertising companies, with over 450,000 displays located in 31 countries across Asia, Europe, Latin America, and North America. The First Complainant helps advertisers to create inspiring out-of-home advertising campaigns via traditional and digital display formats in roadside, urban, transit and airport environments, on street furniture and at retail near point of sale. The Second Complainant is a wholly owned subsidiary of the First Complainant.

The Second Complainant is the owner of numerous CLEAR CHANNEL trademarks registered in various jurisdictions, including CLEAR CHANNEL word trademark registered in the United States on September 7, 2004, under the registration number 2882210 for services in class 35 of International Classification ("IC"), and CLEAR CHANNEL word trademark registered in the European Union on December 21, 1999, under the registration number 000911842 for services in classes 35, 38, and 41 of IC ("CLEAR CHANNEL trademark").

The First Complainant is the exclusive licensee of the intellectual property rights held by the Second Complainant.

In this Decision, the First Complainant and the Second Complainant will be referred to as "the Complainant".

The Complainant has established presence on the Internet and owns or controls numerous domain names containing CLEAR CHANNEL trademark, including <clearchanneltaximedia.com> registered on June 3, 2001.

The disputed domain name was registered on August 27, 2024, and resolves to a website that claims to offer taxi advertising solutions.

#### **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:

(i) the Complainant first adopted and used a trademark containing CLEAR CHANNEL in connection with its out-of-home advertising services in 2001. Over the past 23 years since first adopting the CLEAR CHANNEL trademarks, the Complainant has expended significant time, money and effort to establish substantial customer recognition of the CLEAR CHANNEL trademarks as identifying the Complainant as the source of its high-quality advertising services. As a result, the Complainant has built up and owns valuable goodwill in its CLEAR CHANNEL trademarks which have been used extensively and continuously in connection with advertising and promotion of the Complainant's services. As a result, the consuming public recognizes CLEAR CHANNEL trademarks and associates these trademarks with the Complainant and its services;

(ii) the disputed domain name is confusingly similar to the Complainant's CLEAR CHANNEL trademarks. The disputed domain name incorporates CLEAR CHANNEL trademark. The mere addition of a hyphen in

between the two words of the Complainant's well-known CLEAR CHANNEL trademark, and the descriptive wording "taxi media", are insufficient to distinguish the disputed domain name from the Complainant's CLEAR CHANNEL trademarks;

(iii) the disputed domain name is nearly identical to the Complainant's domain name <clearchanneltaximedia.com> which was registered in 2001. The mere addition of the hyphen in between "clear" and "channel" in the disputed domain name results in minor variation from the Complainant's domain name;

(iv) the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to use CLEAR CHANNEL trademarks, and there is no evidence that the Respondent is commonly known by the disputed domain name or has any trademark rights to it. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name;

(v) the disputed domain name was registered and used in bad faith. Registered in 2024, the disputed domain is nearly identical to the Complainant's well-known CLEAR CHANNEL trademarks, which have been in use for over 23 years. The disputed domain resolves to a website that claims to offer taxi advertising solutions, contains inconsistent contact information and registered address linked to phishing and scams. The website's "Advertise" and "Contact" buttons are non-functional, and the contact phone number listed is out of service. Additionally, the Respondent's address in the Whois database does not match the address displayed on the website, and it is linked to known phishing and scam activities.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Procedural Issue - Consolidation of Complainants**

Affiliated companies have standing to file a complaint under the Policy, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)) section 1.4.1.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation. [WIPO Overview 3.0](#), section 4.11.1.

The Complaint was filed by two Complainants. The owner of the CLEAR CHANNEL trademark and other intellectual property rights is the Second Complainant. The First Complainant is the parent company of the Second Complainant and exclusive licensee of intellectual property rights of the Second Complainant. The inclusion of the CLEAR CHANNEL trademark in the disputed domain name directly impacts the rights of both Complainants, who share a common interest and grievance regarding the Respondent's actions.

This Panel finds that the First and the Second Complainant, jointly comprising the Complainant, have a specific common grievance, and it is equitable and procedurally efficient to allow consolidation in circumstances of this case.

## 6.2. Substantive Issues

### 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 CLEAR CHANNEL trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The CLEAR CHANNEL trademark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The disputed domain name consists of the Complainant's CLEAR CHANNEL trademark, a hyphen between the words "clear" and "channel", and the inclusion of the words "taxi" and "media". Where the relevant trademark is recognizable within the disputed domain name, adding other terms (whether descriptive, geographical, meaningless, or otherwise), would not prevent a finding of confusing similarity under the first element. [WIPO Overview 3.0](#), section 1.8.

Regarding the generic Top-Level Domain ("gTLD") ".com" in the disputed domain name, as a standard registration requirement it should be disregarded under the confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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.

The Respondent is not authorized by the Complainant to use CLEAR CHANNEL trademark, and there is no indication that the Respondent is commonly known under the disputed domain name. There is no apparent relation from the records between the Respondent and the Complainant, neither does it arise that the Complainant has ever licensed or otherwise permitted the Respondent to use its trademark, or to apply for or use any domain name incorporating the same trademark.

There is no evidence or otherwise apparent to the Panel that the Respondent has been using the disputed domain name in connection with bona fide offering of goods or services or making a legitimate noncommercial or fair use of the disputed domain name. The Respondent has failed to provide a response to the Complaint, and accordingly failed to rebut the Complainant's prima facie showing that the Respondent has no 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 Panel notes that the Respondent has registered the disputed domain name 23 years after the Complainant first adopted and used CLEAR CHANNEL trademarks, and 23 years after the Complainant registered its <clearchanneltaximedia.com> domain name. The Respondent's disputed domain name is highly similar to the Complainant's <clearchanneltaximedia.com> domain name. The Respondent's addition of the hyphen in between "clear" and "channel" in the disputed domain name results in minor variation from the Complainant's domain name. The Respondent is using the disputed domain name to create a website offering taxi advertising solutions. The Respondent's ongoing unauthorized use of the Complainant's CLEAR CHANNEL trademark in the disputed domain name, and high similarity of the disputed domain name and the Complainant's domain name give an incorrect impression to the visitors of the Respondent's website that the Respondent is connected to the Complainant.

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.

This Panel accepts that the Complainant's CLEAR CHANNEL trademark is well-known within the advertising industry. Taking into consideration all circumstances and evidence presented, the Panel believes that it is more likely than not that the Respondent was aware of the Complainant and its CLEAR CHANNEL trademark when it registered the disputed domain name, particularly when considering the use to which the disputed domain name was put (a website offering taxi advertising solutions).

Incorporation of a well-known trademark in a domain name having no plausible explanation for doing so is in itself an indication of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

The Panel is of opinion that, by registering the disputed domain name that contains the Complainant's CLEAR CHANNEL trademark and using the disputed domain name to offer competing services, the Respondent is attempting to take advantage of the Complainant's reputation, and well-known trademark.

In this Panel's view, the Respondent is, by using CLEAR CHANNEL trademark in the disputed domain name, intentionally attempting to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant and its CLEAR CHANNEL trademarks. It is well established that if a respondent has intentionally attempted to attract for commercial gain by creating a likelihood of confusion with the complainant's trademark it is an indicator of bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes 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 <clear-channeltaximedia.com> be transferred to the Complainant.

*/Mladen Vukmir/*

**Mladen Vukmir**

Sole Panelist

Date: December 20, 2024