

## **ADMINISTRATIVE PANEL DECISION**

Verizon Trademark Services LLC v. Shilei  
Case No. D2023-1596

### **1. The Parties**

The Complainant is Verizon Trademark Services LLC, United States of America (“United States”), internally represented.

The Respondent is Shilei, China.

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

The disputed domain name <totalbyverizonactivate.com> is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2023. On April 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 13, 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 April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 9, 2023.

The Center appointed Tuukka Airaksinen as the sole panelist in this matter on May 22, 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 established on June 30, 2000 and is one of the world's leading providers of technology and communication products and services. In 2022, it generated revenues of USD 136,8 billion and employs a diverse workforce of approximately 117,100 employees. The Complainant operates in over 150 countries around the world, including in China.

The Complainant is the owner of the trademark VERIZON, registered around the world, including in the United States under No. 2886813 as of September 21, 2004. Since September 21, 2022, the Complainant has also used the mark TOTAL BY VERIZON and has pending applications for this mark in the United States (including the application with United States Serial Number 97358961, with application filing date of April 12, 2022).

The disputed domain name was registered on December 8, 2022 and resolves to a website with pay-per-click ("PPC") links to third party websites.

#### **5. Parties' Contentions**

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

The disputed domain name incorporates the Complainant's trademarks VERIZON and TOTAL BY VERIZON in its entirety and the relevant trademark is recognizable in the disputed domain name. The addition of other terms would not prevent a finding of confusing similarity under the first element of the Policy.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not authorized the Respondent to register or use the disputed domain name and there is no connection between the Complainant and the Respondent. The Respondent is not commonly known by the disputed domain name and has made no legitimate commercial or noncommercial use of the disputed domain name. Directing the disputed domain name to a website containing PPC links does not constitute *bona fide* offering of goods or services.

The Respondent was aware of the Complainant's rights to the VERIZON and TOTAL BY VERIZON trademarks at the time of registration of the disputed domain name. Furthermore, the fact that the disputed domain name is diverted to a PPC website containing links to advertisements for the products and services the Complainant's competitors indicates that the Respondent had knowledge of the Complainant's trademarks and that the Respondent registered and used the disputed domain name with the opportunistic intent to profit unfairly from the traffic generated by confused Internet users seeking the Complainant's website.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

In order to obtain the transfer of a domain name, a complainant must prove the three elements of paragraph 4(a) of the Policy, regardless of whether the respondent files a response to the complaint or not. The first element is that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The second element a complainant must prove is that the respondent has no rights or legitimate interests in respect of the domain name. The third element a complainant must establish is that the domain name has been registered and is being used in bad faith.

## A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that the Complainant establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Consequently, the Complainant must prove that it has rights to a trademark, and that the disputed domain name is identical or confusingly similar to this trademark.

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test".

Section 1.8 of the [WIPO Overview 3.0](#) reads: "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. The nature of such additional term(s) may however bear on assessment of the second and third elements."

The disputed domain name is confusingly similar to the Complainant's trademark VERIZON as it includes the Complainant's trademark entirely with the terms "total", "by" and "activate" in the disputed domain name. This 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 confusingly similar with the Complainant's trademark and hence the first element of the Policy has been fulfilled.

## B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests to the disputed domain names.

It is widely accepted among UDRP panels that once a complainant has made a *prima facie* showing indicating the absence of the respondent's rights or legitimate interests in a disputed domain name the burden of production shifts to the respondent to come forward with evidence of such rights or legitimate interests. If the respondent fails to do so, the complainant is deemed to have satisfied the second element of the Policy. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#), and section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has credibly submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain name, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain name and is not commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

Section 2.9 of the [WIPO Overview 3.0](#) states: "Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users."

Accordingly, the Panel finds that the Complainant has made a *prima facie* case that has not been rebutted by the Respondent. Considering the Panel's findings below, the Panel finds that there are no other circumstances that provide the Respondent with any rights or legitimate interests in the disputed domain name. Therefore, the Panel finds that the second element of the Policy is fulfilled.

### C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy provides that the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(i) circumstances indicating that [the respondent has] registered or has 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 [the respondent’s] documented out-of-pocket costs directly related to the domain name; or
- (ii) [the respondent has] 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 [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business or competitor; or
- (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] 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 [the respondent’s] website or location or of a product or service on [the respondent’s] website or location.”

The disputed domain name resolves to a website that displays various PPC commercial links. According to section 3.5 of the [WIPO Overview 3.0](#) such use can indicate the Respondent’s bad faith. In this specific case, the Respondent combines the generic terms into the disputed domain name to create a likelihood of confusion and to mislead the Internet users for clicks and to gain commercial revenue by the PPC system. The Panel also notes that the Complainant has started using and has filed a trademark application for the trademark TOTAL BY VERIZON. While not yet a registered trademark, this further indicates that the Respondent has specifically targeted the Complainant and its services when registering and using the disputed domain name.

Furthermore, it was consistently found by previous UDRP panels that the mere registration of a domain name that is identical or confusingly similar to a third party’s well-known trademark constitutes by itself, a presumption of bad faith registration for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#). The Panel therefore finds that the disputed domain name was registered and used in bad faith, pursuant to the Policy, paragraph 4(a)(iv).

In conclusion, the Respondent has use the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the Complainant’s trademark.

Therefore, the Panel finds that the third element of the Policy is fulfilled.

### 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 <totalbyverizonactivate.com> be transferred to the Complainant.

*/Tuukka Airaksinen/*

**Tuukka Airaksinen**

Sole Panelist

Date: June 5, 2023