

ADMINISTRATIVE PANEL DECISION

Verizon Trademark Services LLC v. Peter James Case No. D2023-2145

1. The Parties

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

Respondent is Peter James, United States.

2. The Domain Name and Registrar

The disputed domain name <verizonllc.com> (the "Domain Name") 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 May 15, 2023. On May 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 16, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Abid Riaz) and contact information in the Complaint. The Center sent an email to Complainant on May 23, 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 June 5, 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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on June 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 26, 2023. Respondent sent an email to the Center on June 26, 2023 requesting a four calendar day extension to the deadline. The Center granted the automatic four calendar day extension for response under paragraph 5(b) of the Rules. The due date for the Response then became June 30, 2023. Respondent sent emails to the Center on July 3, 2023 indicating they were having issues with online

submission of a Response. On July 6, 2023, the Center acknowledged their email and suggested the Respondent submit a Response via email. On July 11, 2023, Respondent submitted a Response.

The Center appointed Robert A. Badgley as the sole panelist in this matter on July 14, 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 corporate affiliate of Verizon Communications Inc. ("VCI"), formed in 2000. Complainant describes VCI as "one of the world's leading providers of technology and communications products and services". VCI operates in more than 150 countries, and employs more than 117,000 people. Its 2022 revenues were USD 136.8 billion.

Complainant owns numerous registered trademarks for VERIZON around the world. For instance, Complainant registered the mark VERIZON with the United States Patent and Trademark Office ("USPTO"), Reg. No. 2,886,813, registered on September 21, 2004 in connection with various telecommunications products and services. Complainant's VERIZON mark has been recognized in at least one prior UDRP case as a "well known" mark which "consists of an invented word." See *Verizon Trademark Services v. Mike Duffy, London Central Communications Ltd*, WIPO Case No. [D2014-1994](#).

VCI's main website is accessible via the domain name <verizon.com>.

The Domain Name was registered on November 6, 2022. As of January 10, 2023, the Domain Name resolved to a website stating, among other things:

"Verizon Business Services LLC is a Converged ICT Service Provider. We are one of a handful of organisations that can truly offer a fully-managed, end-to-end portfolio of services and solutions designed to address customer challenges and support organisations on their journey through digital transformation to digital business."

On January 10, 2023, Complainant sent Respondent a cease-and-desist letter, demanding the cessation of use of the VERIZON mark at Respondent's website and demanding that the Domain Name be transferred to Complainant. There is no evidence in the record that Respondent replied to the cease-and-desist letter. By April 26, 2023, however, Respondent had taken down the content at his website.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply substantively to Complainant's contentions. On July 11, 2023, however, Respondent sent an email to the Center stating:

"I was [...] away from work for a few days, therefore could not view my emails. Please find my response as below."

“First of all when the company named Verizon Business Services was registered with the state, it was the state who approved it. If there was an issue with the name, they should have not approved it and the registration process should not have taken place or they would have at least informed us that there is a trademark issue with the name and thus cannot be registered. Hence it is not our fault. The state organization approved the formation of Verizonllc and in order to register the company took the registration fee as well to register the company.”

“Secondly when the domain was registered with GoDaddy, we had to buy the Domain, workspace and had to pay for each of the email IDs. Since GoDaddy is the authority offering the Domain. They should have told us that this Domain can not be purchased as it would create a trademark name or issue. They simply took their payment cost and sold it to us. Hence it is their fault and action should be taken against them.”

“Responding to their claim, if there was an intention to direct their traffic to our website and gain commercial gains, then we would have had the same Logo as well. Off course the logo and the website domain name was different which in this case was not Verizon and simply was verizonllc.com. This make it a complete different dictionary words. So our name is completely different. It is Verzion Business Services and not Verizon. We were not aware that it was indirectly creating a confusion of some kind and when a request was received the website was brought down, thus eliminating the claim that website was being used to draw traffic and gain financial gains.”

“As per request the company name Verizon Business Services was dissolved and thus this company cannot exist nor the operations can be carried out. As far as the domain is concerned. It will be used to sell Food products and that would be sold in a country where Verizon doesn't operate. Thus not affecting their interest in any means.”

“If Verizon still wants access to the domain then in that case they will have to buy it from us. Otherwise there is no way that we agree to the transfer. In case this is deliberately done, would result in further legal proceeding or actions from our ends. In case they want to settle this outside, they can contact us.”

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark VERIZON through extensive and longstanding registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The entire mark VERIZON is incorporated into the Domain Name, and, despite the additional abbreviation “llc” (a common abbreviation for “limited liability company”), the mark remains recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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 concludes that Respondents lack rights or legitimate interests in respect of the Domain Name. Respondent does not deny having had knowledge of Complainant's fanciful and famous VERIZON trademark at the time he registered the Domain Name. Rather, the gist of Respondent's position appears to be, if registering this Domain Name was improper, the state with whom Respondent registered the business name "Verizonllc" should have told Respondent that adopting such a name was not permitted. Likewise, Respondent asserts that the Registrar should have blocked his registration of the Domain Name if the registration were improper. The foregoing arguments, while not availing on the merits, do not amount to a disclaimer of knowledge of the famous VERIZON mark when registering the Domain Name.

The Panel concludes, on the record presented, that Respondent very likely was well aware of the VERIZON mark when registering the Domain Name. As noted above, the VERIZON mark is a coined word and enjoys widespread renown. Further, Respondent's purported business, as advertised at his website, suggests that he is fairly well acquainted with technology and the types of services offered by Complainant under the VERIZON mark.

The Panel finds, under these circumstances, that Respondent's purported offering of services via the Domain Name and the associated website cannot have been a *bona fide* offering. Rather, the Panel agrees with Complainant's contention that Respondent targeted the VERIZON mark to trade off of the fame of that mark.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes, on this record, that Respondent has registered and used the Domain Name in bad faith under the Policy. The Panel incorporates here its discussion above in the "Rights or Legitimate Interests" section, including the finding that Respondent had Complainant's VERIZON mark in mind when registering the Domain Name, and concludes that Respondent's conduct runs afoul of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <verizonllc.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: July 28, 2023