

ADMINISTRATIVE PANEL DECISION

Asurion, LLC v. Carolina Rodrigues

Case No. D2023-3304

1. The Parties

The Complainant is Asurion, LLC, United States of America, represented by Adams and Reese LLP, United States of America.

The Respondent is Carolina Rodrigues, Panama.

2. The Domain Name and Registrar

The disputed domain name <gotoasurion.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 August 1, 2023. On August 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 2, 2023, 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 (Redacted for Privacy / Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 4, 2023, 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 August 4, 2023.

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 August 7, 2023. In accordance with the Rules, paragraph 5, the due date for the Response was August 27, 2023. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent’s default on August 28, 2023.

The Center appointed Jon Lang as the sole panelist in this matter on September 7, 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 is the owner of the registered ASURION trademark and offers insurance, technology, mobile phone replacement, configuration, technical support, IT consultation, and related products and services under the ASURION mark. The Complainant has been active since at least as early as 1994 and has used the ASURION trademark since at least as early as 2001, since when it has promoted the mark continuously and extensively. The Complainant owns valid and subsisting registrations for the ASURION trademark in several countries around the world including Argentina, Brazil, Canada, Ecuador, the European Union, Hong Kong, China, Panama, Paraguay, the United Kingdom and the United States of America, including United States trademark No. 2698459 with a Registration Date of March 18, 2003.

The Complainant and its licensees own many domain names incorporating the ASURION trademark, including <assurion.com>, <asurion.org>, <asurioninsurance.com>, <asurion-mobile.com> and <asurionsupport.com>. The Complainant's website at <asurion.com> receives over 7.9 million visits annually, and the Complainant's website at <Phoneclaim.com> (which also prominently displays the ASURION trademark) receives approximately 40 million visitors per year. The Complainant advertises and sells its products and services through its website at <asurion.com> and related websites, as well as through print media and other advertising and promotional campaigns. It has served over 280 million consumers worldwide, and its services are made available by retailers worldwide. The Complainant has 14 locations in North and South America, two locations in Europe, two locations in Australia, and 10 locations in Asia.

The Complainant maintains an active social media presence, with more than one million Facebook "likes" and nearly 27,000 Twitter followers.

The disputed domain name (hereafter the Domain Name) was created on January 10, 2023, which the Complainant discovered shortly thereafter. At that time, it was pointing to a commercial parking page showing pay-per-click links to websites advertising services related to those offered by the Complainant. On January 12, 2023, the Complainant's counsel sent to the Respondent a cease-and-desist letter demanding transfer of the Domain Name to the Complainant. There was no response.

5. Parties' Contentions

A. Complainant

The following is a summary of the main contentions of the Complainant.

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant is the exclusive owner of the coined and famous ASURION trademark. The Complainant spends millions of dollars every year promoting the ASURION trademark and the products and services sold under that mark. Over 20 years of extensive marketing, sales and enforcement, the highly distinctive ASURION trademark has become famous as a source identifier for the Complainant's products and services.

The Domain Name is identical or confusingly similar to the Complainant's ASURION trademark. The Domain Name consists of the ASURION trademark in its entirety, preceded by the generic words "go" and "to". A domain name's incorporation of a registered trademark in its entirety (or a confusingly similar approximation thereof), despite the presence of other terms in the domain name, is sufficient to establish that the domain name is identical or confusingly similar to that mark, particularly where, as here, the mark is the dominant element of the domain name.

The addition of the words "go" and "to", indicating that a user may "go to" Asurion by navigating to the website at the Domain Name, does not prevent the Domain Name from being confusingly similar to the Complainant's ASURION trademark. The mere addition of a generic and/or descriptive word does not prevent a domain name from being confusingly similar to a trademark.

The Complainant's business involves the provision of technical assistance and related services to digital and smart devices, and thus the addition of the terms "go" and "to", which symbolizes the well-known "goto" command in computing implying direct action and immediate engagement, serves to accentuate the confusing similarity rather than differentiate the Domain Name.

The Complainant has rights in the ASURION trademark, as evidenced by its registrations and widespread use, and the Domain Name is identical or confusingly similar because it wholly incorporates the ASURION trademark which is its dominant element. The addition of the words "go" and "to" does not dispel the confusing similarity.

The Respondent has no rights or legitimate interests in respect of the Domain Name

None of the circumstances provided in paragraph 4(c) of the Policy demonstrating that a respondent has rights to and legitimate interests in a domain name is present in this case. The Domain Name is not the Respondent's name and the Respondent is not and has never been commonly known by it. The Respondent is not and has never been a licensee or franchisee of the Complainant, and the Respondent has never been authorized by the Complainant to register or use the Complainant's ASURION trademark or to apply for or use any domain name incorporating the mark.

When the Complainant became aware of the Domain Name, it was pointing to a commercial parking page showing pay-per-click advertising links to websites advertising services, such as insurance, which are related to those offered by the Complainant. No rights or legitimate interests arise from this type of use of another's trademark. "[T]he 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 misleads Internet users" (*Philip Morris USA Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2018-1616](#)).

As at the date of the Amended Complaint, the Domain Name is apparently being used to distribute malware. When the Complainant's counsel attempted to visit the website to which the Domain Name pointed on June 8, 2023, a message prompting visitors to allow a "Security Check" by checking an "I'm not a robot" box was displayed, indicating that the website is likely being used to distribute malware. This type of use does not establish rights or legitimate interests in the Domain Name.

Without authorization from the Complainant, no actual or contemplated *bona fide* or legitimate use of the Domain Name could reasonably be claimed by the Respondent given that the ASURION trademark was famous at the time of registration of the Domain Name as a result of the Complainant's extensive use and promotion of the mark throughout the world for more than 20 years. The Respondent has no rights or legitimate interests in the Domain Name.

The Domain Name was registered and is being used in bad faith

Given the global trademark registrations for the ASURION mark, the Complainant's numerous domain names incorporating the ASURION trademark, the Complainant's fame and international reputation and the fact that ASURION is a coined and highly distinctive mark universally associated with the Complainant, it is not plausible that the Respondent could have been unaware of the Complainant at the time of registration of the Domain Name.

The Respondent is using the Domain Name in bad faith to divert Internet users to commercial parking pages with links related to services offered under the Complainant's trademark. This further supports the assertion that the Respondent had actual knowledge of the Complainant. In using the Domain Name in this manner, the Respondent generates unjustified revenues for each click-through on the sponsored links, thereby illegitimately capitalizing on the Complainant's name and reputation. Such activity constitutes evidence of bad faith registration and use of the Domain Name.

The Respondent's apparent use of the Domain Name to distribute malware constitutes additional evidence of the Respondent's bad faith.

The Respondent's bad faith is further demonstrated by the Respondent's offer to sell the Domain Name. The Domain Name is currently listed for auction at <sedo.com> which demonstrates that the Respondent registered the Domain Name for the purpose of selling it to the Complainant.

The Respondent has also demonstrated a pattern of conduct indicative of bad faith registration and use of domain names incorporating third party trademarks. A reverse Whois search reveals nearly six thousand domain names registered to "Carolina Rodrigues." The search results on the first page alone demonstrate that it is the Respondent's common practice to select domain names incorporating famous trademarks of others.

The Respondent has also been a named respondent in at least 389 other UDRP proceedings, including three cases brought by the Complainant: *Asurion, LLC v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues Fundacion Comercio Electronico*, WIPO Case No. [D2019-2999](#) in which a pattern of bad faith behaviour was found on the part of the Respondent based on the Respondent's history in UDRP proceedings; *Asurion, LLC v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1650](#), in which there was a finding that the Respondent registered eighteen domain names incorporating the ASURION mark in bad faith; and *Asurion, LLC v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-0211](#), in which bad faith was found on the part of the Respondent based on the Respondent's use of a domain name incorporating the ASURION mark in connection with a phishing scheme. Such activity is evidence of bad faith use pursuant to paragraph 4(b)(ii) of the Policy.

The Respondent clearly registered and is using the Domain Name in bad faith. The Respondent's actions are evidence of bad faith use and registration under paragraph 4(b)(i), (ii), and (iv) of the Policy.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove: (i) that a respondent has registered a domain name which is identical or confusingly similar to a trademark or service mark in which a complainant has rights; (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and

(iii), that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

A. Identical or Confusingly Similar

The Complainant is the owner of the ASURION trademark and thus clearly has rights for the purposes of the Policy. Ignoring the genericTop-Level Domain (“gTLD”) “.com” (as the Panel may do for comparison purposes), the Domain Name comprises the ASURION trademark preceded by the words “go” and “to”. Accordingly, the ASURION trademark and Domain Name are not identical and thus the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves “*a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.*” (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). Section 1.7 of the [WIPO Overview 3.0](#) goes on to provide “*...in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.*”.

The ASURION trademark is incorporated in its entirety within the Domain Name. It is clearly recognizable within the Domain Name. The addition of the words “go” and “to” does not prevent a finding of confusing similarity.

The Panel finds that the Domain Name is confusingly similar to the ASURION trademark for the purposes of the Policy and thus paragraph 4(a)(i) of the Policy has been established.

B. Rights or Legitimate Interests

By its allegations, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find, given the *prima facie* case made out by the Complainant, that the Respondent indeed lacks rights or legitimate interests in the Domain Name. Despite the lack of any answer to the Complaint, however, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

A respondent can show it has rights or legitimate interests in a domain name in various ways even where, as is the case here, it is not licensed by or affiliated with a complainant. For instance, it can show that it has been commonly known by the domain name or that it is 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 Respondent here is not commonly known by the Domain Name. Further, given the use to which the Domain Name has been put (at least initially), namely to resolve to a commercial parking page showing pay-per-click advertising links to websites advertising services, such as insurance, which are related to those offered by the Complainant, it would be difficult to conclude that there is anything noncommercial or, given that the Domain Name is confusingly similar to the ASURION trademark, *fair* about the Respondent’s use. As to an absence of an intent to mislead (for commercial gain), the Respondent’s choice of (confusingly similar) Domain Name, the dominant element being the Complainant’s ASURION trademark with the addition of two words preceding the mark which are likely only to increase the risk of confusion (given their natural meaning), suggests the very opposite.

A respondent can also show that it is using a domain name in connection with a *bona fide* offering of goods or services. However, it seems clear that the Respondent set out to acquire a domain name that would create a misleading impression of association with the Complainant, which has then been used to resolve to a commercial parking that features links relating to the Complainant’s field of activity. These circumstances cannot amount to a *bona fide* offering of goods or services for the purposes of the Policy.

The Respondent has sought to create an impression of association with the Complainant and has chosen not to attempt to justify its actions. That, perhaps, is not surprising given that it appears to the Panel that there is very little the Respondent could say to challenge the Complainant's assertion that the Respondent lacks rights or legitimate interests in the Domain Name.

The Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy describes a number of non-exclusive scenarios which evidence a respondent's bad faith. They are as follows:

- “(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”.

A screenshot from January 2023, annexed to the Complaint, shows the commercial parking page to which the Domain Name first pointed, displaying pay-per-click links to websites advertising services related to those offered by the Complainant. The use to which the Domain Name has been put supports a conclusion that the Respondent must have known of the ASURION trademark and appreciated that it was confusingly similar to the Domain Name at the time of its registration, and that it would mislead Internet users into believing that they were accessing a website of the Complainant or a least one that is authorised by them *i.e.* the very circumstances contemplated by paragraph 4(b)(iv) of the Policy set out above.

A later screenshot from June 2023, also annexed to the Complaint, shows the web page to which the Domain name then pointed, which displays the message “Google Chrome Security Check” under which appears the words “Click ‘Allow’ if you are not a robot”. Also appearing on the page is a tick box stating “I’m not a robot”. The Complainant suggests that this indicates the website is likely being used to distribute malware.

The Domain Name is listed for auction at <sedo.com>. Whether the Respondent registered the Domain Name for the primary purpose of selling it to the Complainant or a competitor (as required by paragraph 4(b)(i) of the Policy), is not a matter that can be determined given the other uses to which the Domain Name has been put. However, given those other uses, as well as other circumstances of this Complaint, including the undoubted knowledge by the Respondent of the ASURION trademark and its unique nature, it is clear that the Respondent's intention in registering the Domain Name was to profit in some fashion from, or otherwise exploit the Complainant's trademark. In these circumstances, the Panel finds the <sedo.com> listing to be a further indication of bad faith on the part of the Respondent.

The Respondent is said to have been a named respondent in at least 389 other UDRP proceedings, including three cases brought by the Complainant where there was a finding of bad faith. Paragraph 4(b)(ii) deals with circumstances where the domain name has been registered to prevent the owner of the relevant trademark from reflecting the mark in a corresponding domain name. As can be seen from the extract from paragraph 4(b)(ii) above, a pattern of such conduct is required. [WIPO Overview 3.0](#), provides, at paragraph 3.1.2, that

“...establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner. A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners”. The Panel also finds bad faith on the part of the Respondent under paragraph 4(b)(ii) of the Policy.

Whether or not the Respondent, latterly, was seeking to distribute malware, or had the *primary* intention of selling the Domain Name, the Complainant has made out a case of bad faith under paragraphs 4(b)(ii) and (iv) of the Policy. For the sake of completeness, however, it should be noted that a complainant does not have to demonstrate a precise literal application of any of the paragraph 4(b) scenarios. They are non-exclusive and illustrative only, and as long as there is evidence demonstrating that a respondent is seeking to take unfair advantage of, or to abuse a complainant’s trademark, such behaviour would satisfy the general principle underlying the bad faith requirement of the Policy. In this proceeding, there is no doubt that the Respondent has sought to take unfair advantage of and/or abuse the Complainant’s ASURION trademark.

In all the circumstances, the Panel finds that, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <gotoasurion.com> be transferred to the Complainant.

/Jon Lang/

Jon Lang

Sole Panelist

Date: September 19, 2023