

ADMINISTRATIVE PANEL DECISION

Asurion, LLC v. Else Woods

Case No. D2023-4583

1. The Parties

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

The Respondent is Else Woods, Bolivia.

2. The Domain Name and Registrar

The disputed domain name <asurioninc.net> (the "Disputed Domain Name") is registered with Nicenic International Group Co., Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 4, 2023. On November 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 16, 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 (Not Available) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same date, 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 November 20, 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 November 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 13, 2023.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on January 8, 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 United States company founded in 1994 and operating in insurance, technology, mobile phone replacement, configuration, technical support, IT consultation, and related products and services.

The Complainant is the owner of numerous trademarks including the following:

- ASURION, United States word mark registered under No. 2698459 on March 18, 2003, in classes 35, 36 and 37.

The Complainant is the owner of several domain names including <asurion.com> and <asurion.net>.

The Disputed Domain Name was registered on November 3, 2023. According to the Complainant's undated evidence, the Disputed Domain Name resolved to a website displaying a login page mentioning the Complainant's ASURION word mark with the specific font used on the Complainant's official website at the domain name <asurion.com>. The Panel observes that the Disputed Domain Name currently resolves to an inactive webpage labeled as a "Dangerous site" by Google Chrome and "Deceptive Website" by Apple Safari.

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 Disputed Domain Name is identical or confusingly similar to a trademark in which it claims to have rights. According to the Complainant, the Disputed Domain Name includes the Complainant's ASURION trademark and the addition of the term "inc" does not prevent the Disputed Domain Name from being confusingly similar to the Complainant's ASURION mark. The addition of the generic word "inc" in the Domain Name serves, according to the Complainant, to increase the confusing similarity. The Complainant also contends that the addition of the generic Top-Level Domain ("gTLD") ".net" to the Disputed Domain Name does not impact the analysis because the use of a gTLD is a requirement for a domain name registration.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. To the best of the Complainant's knowledge, "Asurioninc" is not the Respondent's name, and the Respondent is not and has never been commonly known as "Asurioninc". According to the Complainant, the Respondent is not and has never been a licensee or franchisee of the Complainant nor has the Respondent ever been authorized by the Complainant to register or use the Complainant's ASURION mark or to apply for or use any domain name incorporating the mark. The Complainant also claims that the Respondent is not using the Disputed Domain Name in connection with a *bona fide* offering of goods or services, or in a legitimate noncommercial or fair manner because the Respondent was using the Disputed Domain Name in furtherance of a type of phishing attack. Additionally, the Complainant contends that no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Name could reasonably be claimed by the Respondent, as the ASURION mark was famous at the time of registration of the disputed domain name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, because of the Complainant's fame, the fact that ASURION is a coined and highly distinctive mark universally associated with the Complainant, the smishing attack targeting the Complainant and the Complainant's employees, and the fact that the website linked to the Disputed Domain Name displayed the Complainant's official logo, it is not plausible that Respondent could have been unaware of the Complainant at the time of registration. Moreover, according to the Complainant, the fact that the Respondent was using the Disputed Domain Name in furtherance of an unlawful smishing scheme, the Respondent's unauthorized use of the Complainant's trademarks on the website associated with the Disputed Domain Name and the fact that the Respondent appears to have provided a false address in registering the Disputed Domain Name demonstrates clear bad faith on the part of the Respondent.

B. Respondent

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

6. Discussion and Findings

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.

Additionally, the Panel finds that the addition of another term, here, "inc", 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.

It is well established that gTLDs, here ".net", may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

Based on the available record, 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 Panel notes that the Respondent has not apparently been commonly known by the Disputed Domain Name, and that the Respondent does not seem to have acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is "Else Woods". The Respondent's use and registration of the Disputed Domain Name was not authorized by the Complainant.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

The Disputed Domain Name incorporates the Complainant's ASURION trademark and company name in its entirety and merely adds the descriptive term "inc" which is the abbreviation of "incorporated" and is used to indicate that a business is legally established. In the Panel's view, the addition of this term may even increase the risk of affiliation with the Complainant as it is a common addition to a company name. Therefore, the Panel finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, including the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not. [WIPO Overview 3.0](#), section 2.5.2.

The Complainant claims that several of its employees received a text message prompting them to visit a website linked to the Disputed Domain Name that displayed a login page. The Panel notes that the Complainant does not provide any screenshot of the alleged text messages, but only an undated screenshot of a login page which appears to be linked to the Disputed Domain Name.

However, the Respondent had the opportunity to contest the above or demonstrate its rights or legitimate interests but did not do so. By failing to provide a substantive response, the *prima facie* case established by the Complainant has not been rebutted.

Based on the available record, 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, and according to the Complainant's uncontested evidence, the Panel notes that the Disputed Domain Name appeared to resolve to a website mentioning the Complainant's ASURION word mark including the specific font used on the Complainant's official website at the domain name <asurion.com>. In the Panel's view, this indicates that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark. See *Simyo GmbH v. Domain Privacy Service FBO Registrant / Ramazan Kayan*, WIPO Case No. [D2014-2227](#).

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.

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#).

In the present case, the Panel finds that the Respondent must have been aware of the Complainant and its trademark rights when it registered the Disputed Domain Name as:

- the Disputed Domain Name incorporates the Complainant's distinctive trademark and company name with the addition of the common abbreviation "inc", which is a common addition to a company name;
- the website linked to the Disputed Domain Name appeared to display the Complainant's word mark including the specific font used on the Complainant's official website at the domain name <asurion.com>;
- the Complainant's oldest trademark was registered more than 20 years before the registration of the Disputed Domain Name;
- previous UDRP Panels have recognized that the Complainant's ASURION trademark is distinctive and well known (see *Asurion, LLC v. Cindy Willis*, WIPO Case No. [D2018-2643](#) and *Asurion, LLC v. Super Privacy Service LTD c/o Dynadot*, WIPO Case No. [D2019-2326](#)).

The Panel observes that there is currently no active website linked to the Disputed Domain Name. While UDRP panels will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

In the present case, the Panel is of the opinion that all above factors apply in this case:

- the Panel finds that the Complainant's ASURION mark is distinctive;
- the Respondent did not submit any response or provided any evidence of actual or contemplated good-faith use;
- the Respondent used false contact details, which prevented the courier from delivering the Center's Written Notice; and
- given the confusing similarity with the Complainant's company name and registered trademarks, the Panel finds it difficult to conceive of any plausible legitimate future use of the Disputed Domain Name by the Respondent.

Moreover, attempting to access the website at the Disputed Domain Name triggers an Internet browser security warning.

By failing to provide a substantive response to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Based on the available record, 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 <asurioninc.net> be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: January 22, 2024