

ADMINISTRATIVE PANEL DECISION

Asurion, LLC v. Whois Privacy, Private by Design, LLC / Greek God
Case No. D2022-2742

1. The Parties

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

Respondent is Whois Privacy, Private by Design, LLC, United States / Greek God, United States.

2. The Domain Name and Registrar

The Disputed Domain Name <asurion-ss0.com> is registered with Porkbun LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 26, 2022. On July 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 27, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on August 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 1, 2022.

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 Respondent of the Complaint, and the proceedings commenced on August 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on August 30, 2022.

The Center appointed Richard W. Page as the sole panelist in this matter on September 12, 2022. 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 the owner and proprietor of the registered ASURION mark (the “ASURION Mark”). Complainant offers insurance, technology, mobile phone replacement, configuration, technical support, IT consultation, and related products and services under the ASURION Mark. Complainant has been active since at least as early as 1994 and has used the ASURION Mark since as least as early as 2001. Complainant advertises and sells its products and services through its “www.asurion.com” website and related websites, as well as through print media and other advertising and promotional means. Complainant’s services are made available by retailers worldwide, including some of the largest retailers in the United States. Complainant has fourteen locations in North and South America, two locations in Europe, two locations in Australia, and ten locations in Asia, including China, Japan, Israel, Malaysia, the Philippines, Singapore, and Thailand.

Since its first use of the ASURION Mark at least as early as 2001, Complainant has promoted the ASURION Mark continuously and extensively. Complainant spends millions of dollars every year promoting the ASURION Mark and the products and services sold under the ASURION Mark. Complainant’s website at “www.asurion.com” receives over 7.9 million visits annually and Complainant’s website at “www.phoneclaim.com” (which also prominently displays the ASURION Mark) receives approximately 40 million visitors per year. Complainant maintains an active social media presence, with more than one million Facebook “likes” and nearly 27,000 Twitter followers.

Complainant owns valid and subsisting registrations for the ASURION Mark in the following countries among others: Argentina, Australia, Brazil, Canada, Chile, China, Colombia, Costa Rica, Cuba, Ecuador, United Kingdom, and the United States. Complainant’s United States registrations for ASURION include the following: Registration No. 2,698,459, March 18, 2003; Registration No. 4,179,272, July 24, 2012; and Registration No. 4,314,110, April 2, 2013. All of these registrations pre-date the registration of the Disputed Domain Name. Complainant and its licensees own many domain names incorporating the ASURION Mark, including but not limited to, the following: <asurion.biz>, <asurion.co>, <asurion.com>, and <asurion.net>.

The Disputed Domain Name was registered on July 24, 2022.

5. Parties’ Contentions

A. Complainant

Complainant contends that the dominant and most distinctive element in the Disputed Domain Name is the ASURION Mark in its entirety. In addition, the letters “sso” do not prevent the Disputed Domain Name from being confusingly similar to the ASURION Mark. The letters “sso” are a common abbreviation of the generic phrase “single sign-on”, which is an identification method that enable users to log into multiple applications and websites with one set of credentials.

Complainant alleges that “ASURION SSO” is not Respondent’s name, and to Complainant’s knowledge, Respondent is not and has never been commonly known as “ASURION SSO”. Respondent is not and has never been a licensee or franchisee of Complainant. Furthermore, Respondent has never been authorized by Complainant to register or use the ASURION Mark or to apply for or use any domain name incorporating the ASURION Mark.

Complainant further alleges that Respondent is not using the Disputed Domain Name in connection with a *bona fide* offering of good or services, or in a legitimate noncommercial or fair manner. As of the date of the Amended Complaint, the Disputed Domain Name did not direct to an active website. One day prior to the filing of the original Complaint, Respondent was using the Dispute Domain Name in furtherance of a type of phishing attack, namely “smishing”, in which Respondent sent text messages to Complainant’s employees prompting them to visit the website of the Disputed Domain Name, where the employees would then be asked to enter their employee login information and download a remote desktop application to their devices. Complainant further asserts that the use of a Disputed Domain Name in furtherance of unlawful activity, such as a smishing attack, cannot confer rights or legitimate interest on Respondent.

Complainant further alleges that, without authorization from Complainant, no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Name could reasonably be claimed by Respondent, as the ASURION Mark was famous at the time of registration of the Disputed Domain Name, and due to Complainant’s extensive use and promotion of the ASURION Mark throughout the world for more than 20 years.

Complainant asserts that the Disputed Domain Name was registered and is being used in bad faith. Given the global trademark registrations for the ASURION Mark, Complainant’s numerous domain names incorporating the ASURION Mark, Complainant’s fame and international reputation, and the fact that ASURION is a coined and highly distinctive mark universally associated with Complainant, it is not plausible that Respondent could have been unaware of Complainant at the time of registration of the Disputed Domain Name.

Complainant further asserts that Respondent is using the Disputed Domain Name in furtherance of an unlawful smishing scheme, with the intention of gaining access to Complainant’s secure system. Such unlawful use of the Disputed Domain Name demonstrates clear bad faith on the part of Respondent. See section 3.1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) (use of domain name for *per se* illegitimate activity such as phishing [and smishing] is manifestly considered evidence of bad faith).

Complainant further asserts that the fact that the Disputed Domain Name does not currently resolve to an active website does not negate Respondent’s bad faith. Complainant further asserts that “passive holding” does not prevent a finding of bad faith, and a panel must look at the totality of the circumstances to determine whether Respondent is acting in bad faith.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Even though Respondent has failed to file a Response or to contest Complainant’s assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the [WIPO Overview 3.0](#).

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following:

i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to the ASURION Mark in which Complainant has rights; and,

- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and,
- iii) that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Section 1.2.1 of the [WIPO Overview 3.0](#) states that registration of a trademark is *prima facie* evidence of Complainant having enforceable rights in the ASURION Mark.

Complainant's United States registrations for ASURION include the following: Registration No. 2,698,459, March 18, 2003; Registration No. 4,179,272, July 24, 2012; and Registration No. 4,314,110, April 2, 2013.

Respondent has not contested these registrations. Therefore, the Panel finds that Complainant has enforceable rights in the ASURION Mark for purposes of this proceeding.

Section 1.7 of the [WIPO Overview 3.0](#) says that inclusion of the entire trademark in a domain name will be considered confusingly similar. Section 1.8 of the [WIPO Overview 3.0](#) instructs that the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity. Section 1.11.1 of the [WIPO Overview 3.0](#) instructs that Top-Level Domains ("gTLDs") such as (".com") may be disregarded for purposes of assessing confusing similarity.

The Panel finds that the entirety of the ASURION Mark is contained in the Disputed Domain Name and that the letters "sso" do not prevent the Complainant's ASURION Mark from being recognizable in the Disputed Domain Name.

Therefore, Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant alleges that Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

Section 2.1 of the [WIPO Overview 3.0](#) states that once Complainant makes a *prima facie* case in respect of the lack of rights or legitimate interests of Respondent, then Respondent carries the burden of demonstrating it has rights or legitimate interests in the Disputed Domain Name. Where Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed 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 Disputed 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 Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the ASURION Mark.

Complainant further alleges that Respondent is not using the Disputed Domain Name in connection with a *bona fide* offering of good or services, or in a legitimate noncommercial or fair manner. As of the date of the Amended Complaint, the Disputed Domain Name did not direct to an active website. One day prior to the filing of the original Complaint, Respondent was using the Dispute Domain Name in furtherance of a type of phishing attack, namely "smishing", in which Respondent sent text messages to Complainant's employees

prompting them to visit the website of the Disputed Domain Name, where the employees would then be asked to enter their employee login information and download a remote desktop application to their devices. Complainant further asserts that the use of a Disputed Domain Name in furtherance of unlawful activity, such as a smishing attack, cannot confer rights or legitimate interest on Respondent.

Complainant further alleges that, without authorization from Complainant, no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Name could reasonable be claimed by Respondent, as the ASURION Mark was famous at the time of registration of the Disputed Domain Name, and due to Complainant's extensive use and promotion of the ASURION Mark throughout the world for more than 20 years.

The Panel finds that Complainant has made a *prima facie* case which has not been refuted by Respondent.

Therefore, Complainant has satisfied the elements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant contends that Respondent registered and is using the Disputed Domain Name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of domain names:

- (i) circumstances indicating that you [Respondent] have registered or you have acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to Complainant who is the owner of the ASURION Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or
- (ii) you [Respondent] have registered the Disputed Domain Name in order to prevent Complainant from reflecting the ASURION Mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the Disputed Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the ASURION Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

The criteria set forth in paragraph 4(b) of the Policy are nonexclusive. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In addition to paragraph 4(b), other factors alone or in combination can support a finding of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#) (use of domain name for *per se* illegitimate activity such as phishing [and smishing] is manifestly considered evidence of bad faith); section 3.2.2 WIPO of the Overview 3.0 (should have known of Complainant's rights); and section 3.2.3 of the [WIPO Overview 3.0](#) (willful blindness to Complainant's rights).

The Panel finds that each of these factors is present and that Complainant has shown bad faith. The fact that the Disputed Domain Name does not currently resolve to an active website does not mitigate Respondent's bad faith.

Therefore, Complainant has shown the necessary elements of paragraph 4(a)(iii) 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, <asurion-sso.com> be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: September 26, 2022