

ADMINISTRATIVE PANEL DECISION

Verizon Trademark Services LLC v. Vladislav Bartolomey
Case No. D2022-3655

1. The Parties

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

The Respondent is Vladislav Bartolomey, Poland.

2. The Domain Name and Registrar

The disputed domain name <verizoncloudplatform.com> is registered with NetEarth One Inc. d/b/a NetEarth (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 30, 2022. On October 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 3, 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 (Domain Admin, WHOIS IDCPrivacy Service c/o IDC (BVI) Limited) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 6, 2022, 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 amendment to the Complaint on October 6, 2022.

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 the Respondent in English of the Complaint, and the proceedings commenced on October 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 10, 2022.

The Center appointed Haig Oghigian as the sole panelist in this matter on November 23, 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.

At subparagraph 11(a), the Rules provide that, unless otherwise agreed by the parties or specified otherwise in the registration agreement, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regards to the circumstances of the administrative proceeding. The Complainant submits that to the best of its knowledge, the language of stipulated in the registration agreement is English. The Panel notes that the stipulation of the registration agreement is ambiguous on that question and does not explicitly state that English is the language of such registration agreement. The Registrar confirmed in its verification response that the Language of the Registration Agreement was indeed English. As such, the Panel accepts the submission of the Complainant that the language of the proceedings shall be the English language.

4. Factual Background

The Complainant is an intellectual property holding company and is the owner of numerous trademark registrations and service marks consisting or incorporating VERIZON (the "VERIZON Marks"). It granted an exclusive license to the VERIZON Marks to Verizon Licensing Company which in turn granted a number of sublicenses to various affiliates and third parties, namely to Verizon Communications Inc. and its subsidiaries. Verizon Communications Inc., which was formed on June 30, 2000, is one of the world's leading providers of technology and communications products and services. It offers voice, data, and video services through its own telecommunications network. Verizon operates in over 150 countries and generates revenues of around USD 133,6 billion.

The Complainant claims to be the owner of many trademark registrations. In support of this submission, the Complainant refers the Panel to the following examples:

- VERIZON, United States Registration No. 2,866,813, registered on September 21, 2004, covering goods and services in classes 9, 16, 35, 36, 37, 38, 41, 42 related to telecommunications products and services;
- VERIZON and design, United States Registration No. 2,789,802, registered on March 31, 2004, covering goods and services in classes 9, 16, 35, 36, 37, 38, 41, 42 related mainly to telecommunications products and services;
- VERIZON, United Kingdom ("UK") Registration No. 2363110, registered on October 7, 2005, covering goods and services in classes 9, 16, 35, 36, 37, 38, 41, 42 related mainly to telecommunications products and services;
- VERIZON, UK Registration No. 2435887, registered on December 19, 2008, covering goods and services in classes 9, 16, 35, 36, 37, 38, 42, 45 related mainly to telecommunications products and services.

According to the Whois records, the Disputed Domain Name was registered on April 20, 2022.

At the time the Complaint was filed, and to this day, the Disputed Domain Name resolves to an inactive website (Annex H to the Complaint).

5. Parties' Contentions

A. Complainant

Put briefly, the Complainant contends as follows.

The Disputed Domain Name is confusingly similar to the Complainant's Verizon Marks. The Complainant submits that the Disputed Domain Name incorporates the Complainant's famous VERIZON marks and appended the words "cloud platform" and the generic Top-Level Domain ".com". On that last point, the Complainant submits that this element is a standard registration requirement which must be disregarded, and refers the Panel to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.

The Complainant submits that incorporating a trademark in its entirety is generally sufficient to establish that a domain name is identical or confusingly similar to a complainant's mark(s). It further submits that, in light of the fame of the VERIZON Marks, it has a tendency to reinforce the impression that a genuine connection exists between the Disputed Domain Name and the Complainant. Finally, the Complainant submits that where the relevant trademark is recognizable within the Disputed Domain Name, the addition of other terms, whether descriptive or otherwise, would not prevent a finding of confusing similarity: according to the Complainant, the words "cloud" and "platform" are suggestive of Verizon's cloud storage services.

The Complainant further submits that the Respondent has no rights or legitimate interests in the Disputed Domain Name because (1) 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 and (2) there is no evidence that the Respondent intends to make a *bona fide* offering of goods and services in connection with the Disputed Domain Name because it does not resolve to an active website.

Finally, the Complainant submits that the Disputed Domain Name was registered in bad faith. It claims that because the Respondent registered the Disputed Domain Name with prior knowledge of the Verizon Marks, which became famous prior to the Respondent's registration of the Disputed Domain Name, and that the registration and use of a domain name that is confusingly similar to a well-known mark is indicative of opportunistic bad faith. In support of that last submission, the Complainant refers the Panel to the following decisions as examples: *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#), and *Costco Wholesake Membership Inc. v. Almantas Kakareka*, WIPO Case No. [D2007-1833](#). As additional evidence on this point, the Complainant submits that registration of the Disputed Domain Name was clearly done in bad faith because the Disputed Domain Name is so "obviously indicative" of the VERIZON Marks that the Respondent's use of the Disputed Domain Name would "inevitably lead to confusion of some sort" and thus intentionally created a likelihood of confusion with the VERIZON Marks to attract, for commercial gain, Internet users to the Respondent's website.

B. Respondent

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

6. Discussion and Findings

Despite the absence of a response by the Respondent, the Complainant, according to paragraph 4(a) of the Policy, must prove each of the following elements, *prima facie*, namely that:

- i. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and

iii. The Disputed Domain Name has been registered and is being used in bad faith.

The Panel will address each of these elements in turn.

A. Identical or Confusingly Similar

The Complainant has established its rights in the VERIZON trademark.

The Complainant has shown its rights in the trademarks VERIZON through the two registrations in the United States and the two registrations in the UK for the word mark VERIZON. Evidence of such registrations was sufficient to *prima facie* satisfy the threshold requirement of having trademark rights, according to section 1.2.1 of the [WIPO Overview 3.0](#).

As stated at section 1.7 of the [WIPO Overview 3.0](#), a domain name which incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that trademark. The test for identity or confusing similarity typically involves a side-by-side comparison of the domain name, to assess whether the trademark is recognizable within the domain name.

In this case, the Disputed Domain Name is composed of three elements: (1) the word, “verizon”, (2) the word “cloud” and (3) the word “platform”. The Panel is free to ignore the generic Top-Level Domain “.com”, in accordance with [WIPO Overview 3.0](#), section 1.11. The first element is evidently the trademark of the Complainant. That being said, the VERIZON word mark remains clearly recognizable in the Disputed Domain Name, despite the addition of the two terms “cloud” and “platform”. [WIPO Overview 3.0](#), section 1.8.

Therefore, the Panel finds that the Disputed Domain Name is confusingly similar to the VERIZON trademark and thus the Complainant has established the first element under subparagraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has satisfied the requirement of subparagraph 4(a)(ii) of the Policy, according to which it has to establish that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

Following section 2.1 of the [WIPO Overview 3.0](#), the complainant must demonstrate, *prima facie*, that the respondent has no rights or legitimate interests in the disputed domain name. If the complainant succeeds, and in order to avoid the complainant having to prove that a respondent lacks rights or legitimate interests in a domain name, which may result in the often-impossible task of “proving a negative”, the burden of production of this second element under 4(a)(ii) of the Policy shifts to the respondent. At this point, the respondent must produce relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Such legitimate interests are defined, non-exhaustively at section 2.1 of the [WIPO Overview 3.0](#), as either use of the domain name in connection with a *bona fide* offering of goods or services, the respondent being commonly known by the domain name, or a legitimate noncommercial fair use of the domain name, without misleading the consumers or tarnishing the trademark at issue.

In the present case, the Respondent did not file a response and thus provided no evidence that it holds any such rights or legitimate interests in the Disputed Domain Name, namely that it has used or made preparation to use the Disputed Domain Name in connection with a *bona fide* offering of goods and services.

There is a clear presence of the VERIZON mark in the Disputed Domain Name, and in the absence of evidence from the Respondent to the contrary, this is sufficient for the Panel to agree with the Complainant's submissions that the Complainant did not authorize the Respondent to register or use the Disputed Domain Name, that there is no connection between the Complainant and the Respondent and thus, no conceivable basis upon which the Respondent could possibly claim to have any rights or legitimate interests in respect of the Disputed Domain Name. Moreover, the presence of the well-known VERIZON mark along with terms descriptive of some of the services provided by the Complainant, carries a risk of implied affiliation since it

effectively impersonates or suggests sponsorship or endorsement by the Complainant contrary to the fact. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, the Panel finds that the Respondent does not hold any rights or legitimate interests in the Disputed Domain Name and that the Complainant has established the second element under subparagraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant successfully demonstrated that the Disputed Domain Name has been registered and is being used by the Respondent in bad faith.

Subparagraph 4(a)(iii) of the Policy states this double requirement. According to section 3.1 of the [WIPO Overview 3.0](#), bad faith occurs where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. The same subsection lists non-exhaustive scenarios which could constitute evidence of a respondent's bad faith.

The Panel notes that the only evidence provided to it regarding the Respondent's use or intent to use the Disputed Domain Name is a screen capture of a blank landing page where the Disputed Domain Name resolves (Annex H to the Complaint). As a result, the Panel cannot rely on the face of this evidence to draw any conclusion on the actual, or even eventual, use or of the Disputed Domain Name by the Respondent, in bad faith or otherwise.

After reviewing the authorities on the matter, including those cited by the Complainant, the Panel is convinced that the doctrine of "passive holding" supports the Complainant's position that the Disputed Domain Name was registered and is being used in bad faith by the Respondent, despite the Respondent's apparent lack of actual use of the Disputed Domain Name.

This doctrine states that when reviewing the totality of circumstances, the non-use of a domain name may not necessarily prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3. "While panelists 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". *Id.*

The Panel notes that the Complainant has established that the VERIZON mark became famous and well known prior to the Respondent's registration and use of the Disputed Domain Name. The Complainant stated, and this was not disputed by the Respondent in light of the absence of any response on its part, that the Complainant operates in 150 countries and serving 99% of Fortune 500 corporations. Trademark registrations provided by the Complainant were registered in the mid-2000s, well before the Respondent's registration of the Disputed Domain Name. Finally, the Complainant indicates offering itself services related to cloud backup and storage services for small businesses under the name "Verizon Cloud" (Annex F to the Complaint). The Complainant has thus demonstrated that the VERIZON mark was well known and was well known in association to its products and services.

As stated above, the Complainant also established that the Respondent had no legitimate connection to the Complainant, namely that the Complainant never authorized the Respondent to register and use the Disputed Domain Name. This Panel also concluded above that there were no other conceivable grounds upon which the Complainant could claim a legitimate interest in the Disputed Domain Name. Given the extensive notoriety of the VERIZON mark, the Panel is of the view that the Respondent was necessarily, or at least constructively, aware of the VERIZON mark and their reputation, namely because the Complainant had registered trademarks in the UK for the VERIZON word mark.

Even in the absence of evidence of actual use of the Disputed Domain Name by the Respondent, the Panel cannot conceive of any other purpose for the incorporation of the Complainant's VERIZON mark in the Disputed Domain Name than for the Respondent to use the Disputed Domain Name in a confusingly similar way to trade upon the goodwill of the Complainant to eventually.

Lastly, the Respondent appears to have engaged the use of a privacy service to mask its details at the time of registration of the disputed domain name, which under the circumstances of this proceeding, further support an inference of bad faith.

Therefore, the Panel finds that the Respondent registered and used the Disputed Domain Name in bad faith and that the Complainant has established the third element under subparagraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraph 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <verizoncloudplatform.com> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: December 7, 2022