

ADMINISTRATIVE PANEL DECISION

Asurion, LLC v. james wilkerson
Case No. D2022-3999

1. The Parties

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

Respondent is james wilkerson, United States.

2. The Domain Name and Registrar

The disputed domain name <asurion-services.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 October 25, 2022. On October 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 26, 2022, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on October 27, 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 October 27, 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 November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. Respondent sent informal emails on October 27 and November 7, 2022.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on December 9, 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 trademark. 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 1994 and has used the ASURION mark since as early as 2001.

Complainant owns registrations for the ASURION mark in the following jurisdictions: Argentina, Australia, Brazil, Canada, Chile, China, Colombia, Costa Rica, Cuba, Ecuador, El Salvador, the European Union, Guatemala, Honduras, Hong Kong, China, India, Indonesia, Israel, Japan, Malaysia, Mexico, New Zealand, Nicaragua, Panama, Paraguay, Peru, the Philippines, Singapore, South Korea, Taiwan province of China, Thailand, the United Kingdom, the United States, and Uruguay. Complainant has provided evidence of five United States trademark registrations for its ASURION mark, with the earliest applied for on February 21, 2001 and registered on March 18, 2003 (registration no. 2698459).

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. Complainant has served over 280 million consumers worldwide, and its 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, Taiwan province of China, and Thailand.

Complainant operates its principal website at “www.asurion.com”. Complainant’s website 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.

Finally, Complainant and its licensees own many domain names incorporating the ASURION mark, including the following: <asurion.biz>, <asurion.co>, <asurion.com>, <asurion.net>, <asurion.org>, <asurion.repair>, <asurion.support>, <asurioncare.com>, <asurionclaim.com>, <asurioninsurance.com>, <asurion-mobile.com>, <asurionphoneclaim.com>, <asurionphoneclaims.com>, <asurionservices.com>, <asurionsetup.com>, <asurionsupport.com>, <replacementasurion.com>, <myasurionbenefits.com>, and <myasurionlife.com>.

The Domain Name was registered on September 14, 2022 and has been used to resolve to a pay-per-click site and also posting what appears to be a fake form for entering credit card details in an attempted scam.

5. Parties’ Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant states that since its first use of the ASURION mark as early as 2001, Complainant has promoted the mark continuously and extensively. Complainant spends millions of dollars every year promoting the ASURION mark and the products and services sold under the mark. With over 20 years of

marketing, sales and enforcement, Complainant claims the coined and highly distinctive ASURION mark has become famous as a source identifier for Complainant's products and services.

Complainant states the Domain Name is identical or confusingly similar to Complainant's ASURION mark. The Domain Name consists of the ASURION mark in its entirety, followed by a hyphen and the generic word "services". As many WIPO panels have recognized, a domain name's incorporation of a registered trademark in its entirety is sufficient to establish that the domain name is identical or confusingly similar to that mark, particularly where the mark is the dominant element. The addition of the generic word "services" does not prevent the Domain Name from being confusingly similar to Complainant's ASURION mark. In fact, because Complainant's business involves the provision of technical assistance and related services, the addition of the term "services" serves to increase the confusing similarity rather than differentiate the Domain Name.

(ii) Rights or legitimate interests

Complainant states it is the exclusive owner of the coined and famous ASURION mark. None of the circumstances provided in Paragraph 4(c) of the Policy for demonstrating a respondent's rights to and legitimate interests in a domain name are present in this case. To Complainant's knowledge, "ASURION services" is not Respondent's name, and Respondent is not and has never been commonly known as "ASURION-services". 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 Complainant's ASURION mark or to apply for or use any domain name incorporating that mark.

Complainant further contends that Respondent is not using the Domain Name in connection with a *bona fide* offering of goods or services, or in a legitimate noncommercial or fair manner. As of the date of this Complaint, the Domain Name is directing to a parking page showing pay-per click advertising links purportedly offering services identical or related to those of Complainant. In addition, Respondent appears to be using the Domain Name in furtherance of a phishing scam, via a Third-Level Domain associated with the Domain Name that is currently directing to a credit card entry form. The MX records also indicate that Respondent may be using the Domain Name for sending fraudulent emails. Use of a Domain Name in furtherance of unlawful activity, such as a smishing or phishing attack, cannot confer rights or legitimate interest on a respondent.

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

Accordingly, Respondent has no rights or legitimate interests in the Domain Name.

(iii) Registered and used in bad faith

Complainant submits the 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. Respondent's actual knowledge of Complainant is evidenced by the use of the Domain Name in furtherance of a phishing scam, and the fact that the Domain Name is directing to a parking page showing pay-per-click advertising links to websites purportedly offering services identical or related to those of Complainant, such as "Cell Phone Insurance Plans".

Respondent is using the Domain Name in furtherance of an unlawful phishing scam, with the intention of profiting from fraudulently obtained credit card details submitted through the credit card form appearing at a Third-Level Domain associated with the Domain Name. By using the Domain Name in this manner,

Respondent uses the ASURION mark to attract Complainant's customers to Respondent's website, and then encourages those users, who would plausibly assume that Complainant owns or endorses the website, to enter their personal information and credit card numbers in the form. Such unlawful use of the Domain Name demonstrates clear bad faith on the part of Respondent.

Respondent is also using the Domain Name in bad faith to divert Internet users to a commercial parking page with links related to services offered under Complainant's mark. In using the Domain Name in this manner, Respondent generates unjustified revenues for each click-through of the sponsored links, thereby illegitimately capitalizing on Complainant's name and reputation. Such activity constitutes evidence of bad faith registration and use of the Domain Name under paragraph 4(b)(iv) of the Policy.

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

B. Respondent

Respondent did not submit a formal response in this case. In an email dated October 27, 2022, Respondent stated:

"What is this?! Please stop emailing me! Take the domain! I just created it for fun! I am not using it and do not plan to use it!"

In an email dated November 7, 2022, Respondent stated:

"I have canceled the domain. I have no interest in using the name 'asurion-services'. I have canceled the username via godaddy. Please seize proceedings. I have been properly notified and wish that you stop further communication with me."

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. Those elements are as follows:

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

A. Identical or Confusingly Similar

The Panel determines that Complainant has demonstrated well-established rights in its distinctive ASURION trademark, through both extensive registration and widespread use in its global commercial operations. See *Asurion, LLC v. Colours Ltd.*, WIPO Case No. [D2013-0388](#) (finding that "Complainant's trademarks and activities are well-known throughout the world").

The Panel further finds that the Domain Name is confusingly similar to Complainant's ASURION mark. The Domain Name incorporates the ASURION mark in its entirety, with the placement of this mark in the dominant position at the beginning of the relevant Domain Name, followed by a hyphen the word "services". The addition of the word "services" does not prevent a finding of confusing similarity in this case. Numerous UDRP decisions have found that the addition of other terms does not prevent a finding of confusing similarity. See WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7 ("where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of

UDRP standing.”); see also *Asurion Corporation v. SQB*, WIPO Case No. [D2009-0165](#) (finding the addition of “insurance” to the domain <asurion-insurance.com> did not prevent confusing similarity).

In conclusion, the Panel finds that the Domain Name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy. Accordingly, Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, Complainant must prove that Respondent has no rights or legitimate interests in respect of the Domain Name. A complainant is normally required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Here, the Panel finds that Complainant has made out a *prima facie* case. Complainant has indicated that Respondent has no legitimate interest in the confusingly similar Domain Name because it fully incorporates Complainant’s distinctive and well-established ASURION trademark; that this is particularly true given that ASURION is a coined and well-known mark; that Respondent has no legitimate interest when the Domain Name falsely suggests affiliation with the trademark owner; that Complainant has not authorized, licensed, or otherwise permitted Respondent to use the ASURION trademark; that Complainant does not have any type of business relationship with the Respondent; and that Respondent has used the Domain Name to link it to a pay-per-click website and also for fraudulent activity. See *Asurion, LLC v. Colours Ltd.*, WIPO Case No. [D2013-0388](#) (“It is well established that no rights or legitimate interests derive from this type of use of another’s trademark.”); see also *Philip Morris USA Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2018-1616](#) (“[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 mislead Internet users.”); *Asurion, LLC v. Wang Liqun*, WIPO Case No. [D2013-0376](#) (finding no rights or legitimate interests where the respondent was “using the Domain Name for the sole purpose of redirecting Internet users”); *Asurion Corporation v. Digi Real Estate Foundation*, WIPO Case No. [D2006-0765](#) (“Respondent appears not to run any legitimate business associated with the disputed domain name but only uses it in a web site for the purpose of redirecting internet users to the website of other insurance companies which may compete with Complainant. Accordingly, the use of the domain name <asurioninsurance.com> is not considered legitimate use in connection with a *bona fide* offering of goods and services.”); See *Swiss Re Ltd v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2021-1549](#) (finding no rights or legitimate interests where active MX records indicated that the domain at issue could still be used for sending fraudulent emails (*i.e.*, phishing)).

Accordingly, for all of the above reasons, the Panel finds that Complainant has made a *prima facie* showing of Respondent’s lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Names in bad faith. [WIPO Overview 3.0](#), section 3.1, states “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”.

For the reasons discussed under this and the preceding heading, the Panel considers that Respondent’s conduct in this case constitutes bad faith registration and use of the Domain Name within the meaning of paragraph 4(a)(iii) of the Policy. It is evident that Respondent was aware of Complainant and its ASURION trademark, and targeted that mark when registering the Domain Name. See *Asurion, LLC v. Cindy Willis*,

WIPO Case No. [D2018-2643](#) (“The Panel first finds it more likely than not the Respondent had Complainant’s inherently distinctive – and well-known – ASURION mark in mind when registering Domain Name.”); *Asurion, LLC v. Colours Ltd.*, WIPO Case No. [D2013-0388](#) (“[T]he Panel finds that the Complainant’s trademarks and activities are well-known throughout the world [...] [, thus] Respondent must have been aware of the Complainant’s existence and rights when it registered the Domain Name.”).

Moreover, Respondent’s use of the Domain Name constitutes bad faith use. The Domain Name has been linked to a pay-per-click website and used in an apparent fraudulent scheme. In the face of this evidence presented by Complainant, Respondent has merely claimed that Respondent registered the Domain Name “for fun” and that he had not used the Domain Name and had no plans to do so. Respondent provided no evidence in support of such assertions and did not address the contentions in the Complaint, e.g., the clear evidence in the Complaint of the Domain Name being used to host a Third-Level Domain displaying an apparent phishing website seeking sensitive personal and financial information. See *Asurion, LLC v. Cindy Willis*, WIPO Case No. [D2018-2643](#) (finding bad faith pursuant to Paragraph 4(b)(iv) based on Complainant’s plausible allegations that “Respondent derives per-click revenue through the hyperlinks at her website”); *Asurion, LLC v. Colours Ltd.*, WIPO Case No. [D2013-0388](#) (finding bad faith under Paragraph 4(b)(iv) based on the Respondent’s use of the domain to direct users to a pay-per-click site advertising related services). In addition, as stated in [WIPO Overview 3.0](#), section 3.1.4, use of a domain name for per se illegitimate activity such as phishing “is manifestly considered evidence of bad faith”. See *Dm-Drogerie Markt GmbH & Co. KG v. WhoisGuard Protected, WhoisGuard, Inc. / Charlotte Meilleur*, WIPO Case No. [D2018-1248](#) (finding bad faith where respondent’s “only goal [was] to rely on the deception of consumers to obtain their private details for commercial advantage of some sort”); *Elliott Management Corporation v. Smi Game*, WIPO Case No. [D2018-1062](#) (finding bad faith where respondent “aped Complainant’s trademark to create the appearance of legitimacy in the execution of a potential phishing scheme”).

In conclusion, the Panel determines that, for all of the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainant has satisfied 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 Domain Name, <asurion-services.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: December 31, 2022