

## **ADMINISTRATIVE PANEL DECISION**

uBreakiFix, Co. v. Registration private, Domains by Proxy, LLC  
Case No. DAI2023-0038

### **1. The Parties**

The Complainant is uBreakiFix, Co., United States of America (“United States”), represented by Adams and Reese LLP, United States.

The Respondent is Registration private, Domains by Proxy, LLC, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <ubreakifix.ai> is registered with 1API GmbH (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 10, 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 | EU Registrar, Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 24, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Panel notes that the registrant, as disclosed by the Registrar seems to be a privacy or proxy service provider. The Complainant filed an amended Complaint on October 25, 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 October 26, 2023. In this regard, the Panel notes that the notification of the Complaint included instructions for the Registrar/Registry and/or privacy service kindly requesting to forward the notification (and attachments) to any known underlying registrant. In accordance with the Rules, paragraph 5, the due date for Response was November 15, 2023. The Respondent did not

submit any response. Accordingly, the Center notified the Parties of the Respondent's default on November 17, 2023. On November 21, 2023, the Center notified the Respondent that due to an apparent issue with the notification, the Center granted the Respondent additional time until November 26, 2023 to indicate whether it wishes to participate in this Proceeding. The Respondent did not reply to the Center's notification.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on November 29, 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 a Florida corporation that offers technology and repair services for computers, phones, and other devices. It is the proprietor of a number of trademark registrations in several jurisdictions, including United States Trademark No. 3855288 for UBREAKIFIX (word mark), registered on October 5, 2010 for services in class 37, claiming a date of first use of April 1, 2009.

The Complainant operates its primary business website at the domain name <ubreakifix.com>. It has additionally registered numerous other domain names incorporating its UBREAKIFIX mark, including <ubreakifix.us>, <ubreakifix.info>, and <ubreakifix.net.>

The disputed domain name was registered on May 18, 2023. At the time of the of this Decision, it did not resolve to an active website. The record reflects that it previously resolved to a website featuring pay-per-click ("PPC") links related to the Complainant's business. The record reflects that the disputed domain name was listed for sale on a third-party website. On June 21, 2023, the Complainant sent the Respondent a cease-and-desist letter.

There is no information available about the Respondent.

#### **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 the disputed domain name is identical to its well-known UBREAKIFIX mark, which has been in continuous use since 2009 and has been extensively promoted online. In September 2022, the Complainant's website at <ubreakifix.com> received over one million visits. The Complainant has never authorized the Respondent to use this mark. The disputed domain name resolved to parking pages featuring links to websites purportedly offering technology- and repair-related services such as "Hubspot Sms Automation," "Internet Options Available at My Address," "Ifixit," and "Fixit." Such use demonstrates the Respondent's actual knowledge of the Complainant. Additionally, the disputed domain name is listed for sale for USD 35,000, which exceeds the out-of-pocket costs related to it.

##### **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 4(a) of the UDRP requires the Complainant to make out all three of the following:

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

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

### 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.

Based on the available record, the Panel finds 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 Panel finds the entirety of the Complainant’s UBREAKIFIX mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

In particular, the Panel notes that the disputed domain name is identical to the Complainant’s UBREAKIFIX mark. Such a composition carries a high risk of implied affiliation with the Complainant and cannot lead to a finding that the Respondent had rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.5.1.

Consistent with UDRP Panel practice, the use of the disputed domain name to resolve to inactive websites, PPC sites or sites offering the disputed domain names for sale does not constitute use in connection with a *bona fide* offering of goods or services. See [WIPO Overview 3.0](#), section 2.2. The Panel does not find that the record supports a finding that the Respondent is commonly known by the disputed domain name or is making legitimate noncommercial use of it.

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, the Panel finds that the circumstances enumerated in paragraph 4(b)(i) of the Policy are present, namely, the evidence indicates that the Respondent has registered the disputed domain name, which is identical to the Complainant's UBREAKIFIX mark, primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant, for valuable consideration likely in excess of its out-of-pocket costs directly related to the disputed domain name. The evidence does not indicate that the Respondent had any independent right to or legitimate interest in the disputed domain name, which it listed for sale for USD 35,000, an amount that likely exceeds the out-of-pocket costs related to it. See [WIPO Overview 3.0](#), section 3.1.1.

Additionally, the Panel finds that the evidence in the record establishes that the Respondent previously used the disputed domain name to resolve to a website featuring PPC links related to the Complainant's business. Absent any evidence of mitigating factors such as efforts by the Respondent to avoid links that target the Complainant's mark, such use is clearly evidence of bad-faith use of the disputed domain name. See [WIPO Overview 3.0](#), section, 3.5.

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 <ubreakifix.ai> be transferred to the Complainant.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: December 13, 2023