

ADMINISTRATIVE PANEL DECISION

Verizon Trademark Services LLC v. Licheng Weng Case No. D2023-0737

1. The Parties

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

The Respondent is Licheng Weng, China.

2. The Domain Names and Registrar

The disputed domain names <totalbyverizon.com>, <totalbyveizon.com>, <totalbyverizn.com>, and <wwwtotalbyverizon.com> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 17, 2023. On February 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 21, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 of the Complaint, and the proceedings commenced on February 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2023. The Respondent sent an email in English to the Center on March 17, 2023, to which was attached a document in the Chinese language. The Center notified the Commencement of Panel Appointment Process to the Parties on March 22, 2023.

The Center appointed Francine Tan as the sole panelist in this matter on March 27, 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, Verizon Trademark Services LLC, is the intellectual property holding company for Verizon Communications Inc. (“Verizon”), which is one of the world’s leading providers of technology and communications products and services. Verizon was formed on June 30, 2000, and is headquartered in New York, U.S. Verizon is listed on Nasdaq and generated revenues of USD 136.8 billion in 2022. It has approximately 117,100 employees. Verizon offers voice, data, and video services and solutions on its networks and platforms, delivering on customers’ demand for mobility, reliable network connectivity, security, and control. It was the first company in the world to launch commercial 5G for mobility, fixed wireless, and mobile edge computing. Verizon operates in over 150 countries around the world, including in China, serving 99% of Fortune 500 companies.

The Complainant is the registered owner of the following VERIZON word and figurative trade marks in the U.S. and China:

- U.S. Trade Mark Registration No. 2,886,813 for VERIZON, registered on September 21, 2004;
- U.S. Trade Mark Registration No. 2,879,802 for , registered on August 31, 2004;
- China Trade Mark Registration No. 35963753 for VERIZON, registered on February 7, 2021;
- China Trade Mark Registration No. 35978665 for VERIZON, registered on September 14, 2021;
- China Trade Mark Registration No. 44522087 for VERIZON, registered on November 28, 2020;
- China Trade Mark Registration No. 44527943 for VERIZON, registered on March 14, 2021; and
- China Trade Mark Registration No. 35978665A for VERIZON, registered on September 7, 2020.

The Complainant is also the registered owner of the trade mark TOTAL WIRELESS in the U.S.:

- U.S. Trade Mark Registration No. 4,732,218, registered on May 5, 2015;
- U.S. Trade Mark Registration No. 4,753,409, registered on June 9, 2015; and
- U.S. Trade Mark Registration No. 5,076,114, registered on November 8, 2016.

The Complainant and Verizon shall hereafter be collectively referred to as “the Complainant”.

The Complainant states that it has spent billions of dollars since the year 2000 to advertise and promote VERIZON-branded products and services throughout the world. As a result, the VERIZON trade mark has enjoyed fame and recognition worldwide.

The Complainant filed applications with the United States Patent and Trademark Office on April 12, 2022 for the registration of the marks TOTAL BY VERIZON and TOTAL BY VERIZON (in design form), covering goods and services in Classes 9, 16, 35, 38, and 42 (U.S. Application Nos. 97358855 and 97358961). These applications have been approved for publication for opposition. The Complainant commenced use of the TOTAL BY VERIZON marks in commerce in connection with its wireless telephone communications products and services in the U.S. on September 21, 2022. A press release was published by the Complainant on the same day, announcing the introduction of the TOTAL BY VERIZON products and services. The Complainant states that the press release was widely distributed via the Internet. September 21, 2022 is also the date that the disputed domain names were registered by the Respondent.

The Complainant owns the domain names <verizon.com> (registered since March 6, 2000), and

<totalbyverizon.com> (registered on November 2, 2021), which it uses to advertise and provide information for its products and services.

At the time of the filing of the Complaint, the disputed domain names resolved to parking pages featuring Pay-Per-Click (“PPC”) links.

5. Parties’ Contentions

A. Complainant

- 1) The disputed domain names are confusingly similar to the Complainant’s TOTAL BY VERIZON trade marks in which the Complainant has rights. The disputed domain names each incorporate the Complainant’s TOTAL BY VERIZON mark in its entirety with the addition or omission of certain letters:
 - a. the disputed domain name <totalbyerizon.com> comprises the TOTAL BY VERIZON mark but omits the letter “v”;
 - b. the disputed domain name <totalbyveizon.com> comprises the TOTAL BY VERIZON mark but omits the letter “r”;
 - c. the disputed domain name <totalbyverizn.com> comprises the TOTAL BY VERIZON mark but omits the letter “o”; and
 - d. the disputed domain name <wwwtotalbyverizon.com> comprises the TOTAL BY VERIZON mark, with the addition of the abbreviation “www”.
- 2) The Respondent has no rights or legitimate interests in the disputed domain names. The Complainant has not authorized the Respondent to register or use the disputed domain names and there is no connection between the Complainant and the Respondent. The Respondent has never sought or obtained any trade mark registrations for “Verizon”, “Total Wireless”, or “Total By Verizon”, or any “Total”-formative mark. The Respondent has never received any license, authorization, express, or implied consent to use the VERIZON, the TOTAL WIRELESS, or the TOTAL BY VERIZON marks. The Respondent is not and has not been commonly known by the disputed domain names. The disputed domain names resolve to parked pages designed to intentionally monetize the Complainant’s trade marks. The Respondent’s parked pages feature sponsored links to third-party websites offering products and services of the type that consumers would expect to find on the Complainant’s official “www.totalbyverizon.com” website, thereby diverting the Complainant’s customers and potential customers to those third-party websites. Such an act by the Respondent constitutes neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names.
- 3) The disputed domain names were registered and are being used in bad faith. The Respondent registered and is using the disputed domain names to take advantage of the goodwill and reputation of the Complainant’s VERIZON and VERIZON-formative marks including the TOTAL BY VERIZON mark. The Respondent was well aware of the Complainant’s rights in the famous VERIZON mark at the time the Respondent registered the disputed domain names. The Respondent registered and is using the disputed domain names with the opportunistic intent to profit unfairly from the traffic generated by confused Internet users. The Respondent’s use of the disputed domain names which incorporate the Complainant’s VERIZON marks, the dominant portion of the Complainant’s TOTAL WIRELESS marks, and the TOTAL BY VERIZON marks without the Complainant’s consent to divert Internet users seeking the Complainant’s products and services to a website featuring PPC links to advertisements of competing services are indicative of bad faith registration and use. The disputed domain names consist of obvious misspellings of and/or additions to the Complainant’s TOTAL BY VERIZON trade mark, which constitutes typosquatting and is further evidence of bad faith registration and use.

B. Respondent

The Respondent did not submit a formal response in this administrative proceeding. He did, however, send an email to the Center on March 17, 2023, stating, *inter alia*:

“Why do you think the contents on my website are threats to your clients? [A]ll the contents are from google.com, I do not think that’s a threat.

As I know, these domains are already exciting (*sic.*) for many years. Why did you do nothing in the past years if you think this domain is a threat?

And I think you should catch this domain faster than me if you really care about this domain, not email me after I caught (*sic.*) it.

I have spent a lot of time, effort or money on this domain[.] And I didn’t do anything illegal.

[A]most nobody will visit this domain. I don’t think it is a typo.

And I am running local court proceedings to protect my domain name, details in the attachment.”

The attachment consisted of a document in Chinese, which purports to be a complaint filed against the Complainant regarding the disputed domain names with a court in Suzhou, China. An English translation was not provided.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has established it has rights in the VERIZON trade mark. The disputed domain names in essence comprise misspelt versions of the Complainant’s VERIZON trade mark (save for the disputed domain name <wwwtotalbyverizon.com>) with the addition of the words “totalby” or “wwwtotalby”. The VERIZON mark is recognizable in the disputed domain names. As stated in section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), “[a] domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element”.

In relation to the Complainant’s reliance on the U.S. trade mark applications for TOTAL BY VERIZON as a basis for the Complaint, the Panel notes that the commencement of use of the TOTAL BY VERIZON mark took place on the same day that the disputed domain names were registered. As such, on the face of it, the Complainant did not have pre-existing common law rights in TOTAL BY VERIZON *per se* at the time the disputed domain names were registered which is needed to satisfy the first element of paragraph 4(a)(i) of the Policy. Section 1.1.4 of the [WIPO Overview 3.0](#) states that “[a] pending trademark application would not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i)”. Therefore, in relation to the consideration of the issue of identity or confusing similarity under paragraph 4(a)(i) of the Policy, the Panel has only given consideration to the established rights the Complainant has in the VERIZON trade mark.

The Panel finds that the disputed domain names, which are typosquatted domain names revolving around the distinctive and well-established VERIZON trade mark and which contain the other elements, are confusingly similar to the VERIZON trade mark in which the Complainant has rights. The addition of the terms “totalby” in the disputed domain names <totalbyverizon.com>, <totalbyveizon.com>, and <totalbyverizn.com>, and “wwwtotalby” in the disputed domain name <wwwtotalbyverizon.com> do not prevent a finding of confusing similarity with the Complainant’s famous VERIZON trade mark. The VERIZON mark is recognizable in the disputed domain names.

The generic Top-Level Domain “.com” is a technical requirement for domain name registrations and does not have any impact on the issue of the identity or confusing similarity between the disputed domain names and the Complainant’s trade mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. The Complainant’s earlier use and registration of the VERIZON trade marks predate the registration dates of the disputed domain names by many years. The Complainant did not license nor authorize the Respondent to use VERIZON as a trade mark or in a domain name. Neither is there any evidence showing that the Respondent is commonly known by the disputed domain names. The disputed domain names which incorporate the Complainant’s VERIZON trade mark are used in relation to parking pages with PPC links to “Phone Wireless”, “Internet Phone Systems”, “Prepaid Call Phones”, “Cell Phones”, “Access Wireless”, and so forth, does not constitute a *bona fide* offering of good or services nor a legitimate noncommercial or fair use of the disputed domain names within the meaning of paragraphs 4(c)(i) and 4(c)(iii) of the Policy. The subject matter reflected on the parked pages corresponds to and/or are related to that of the Complainant’s line of business.

Having established a *prima facie* case, the burden of production shifts to the Respondent to show that he has rights or legitimate interests in the disputed domain names. The Respondent sent an email to the Center but did not file a formal response. In this case, the language of the Registration Agreements of the disputed domain names are in English, so English is the appropriate language of this administrative proceeding. The Respondent did not provide an English translation of the document attached to his email. However, for the sake of completeness, the Panel has considered this document which purports to be a complaint prepared by the Respondent against the Complainant regarding the disputed domain names to a court in Suzhou, China. The authenticity of the document has not been verified and neither is there evidence if indeed the complaint was filed with the Chinese court. In any event, even if the Respondent has initiated a court proceeding against the Complainant regarding the disputed domain names, the Panel has the discretion to proceed to a decision according to paragraph 18(a) of the Rules. For the purposes of the instant proceedings under the Policy, the Panel finds that the Respondent has not by his email nor by any supporting evidence shown that he has rights or legitimate interests in the disputed domain names, all of which contain the Complainant’s famous VERIZON trade mark or misspelt versions of that mark. The Respondent has therefore failed to rebut the *prima facie* case established by the Complainant.

The Panel therefore finds that the second element of paragraph 4(a) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

Although the Panel has only taken into consideration the VERIZON trade mark in its consideration of paragraph 4(a)(i) of the Policy, it is of the view that the fact that the Respondent registered the variations of the disputed domain names containing the trade mark TOTAL BY VERIZON on the very day that the Complainant started to use of that mark and issued the aforementioned press release, are clear indicators of bad faith registration. The Panel draws negative inferences from this and in the absence of any explanation from the Respondent, is persuaded that the Respondent targeted the Complainant’s TOTAL BY VERIZON specifically, which features its famous VERIZON trade mark. There is no other reason for the Respondent to have registered the disputed domain names, all being misspelt versions of the TOTAL BY VERIZON mark, on the very same day that the launch of the mark was announced in a press release, except for the sole purpose of riding off the reputation and goodwill in, and creating confusion with, the Complainant’s trade mark:

“If [...] circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such

circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, (iii) a pattern of abusive registrations by the respondent, (iv) website content targeting the complainant's trademark, e.g., through links to the complainant's competitors, [...] (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, [...] Particularly where the domain name at issue is identical or confusingly similar to a highly distinctive or famous mark, panels have tended to view with a degree of skepticism a respondent defense that the domain name was merely registered for legitimate speculation (based for example on any claimed dictionary meaning) as opposed to targeting a specific brand owner." (See section 3.1.1 of the [WIPO Overview 3.0.](#))

The Panel finds that there has been bad faith registration and use. The facts and circumstances which support the finding include the following:

- (i) the high degree of distinctiveness and reputation of the Complainant's VERIZON trade marks;
- (ii) the Respondent's knowledge of the Complainant's rights in the VERIZON trade marks;
- (iii) the timing of the Respondent's registration of the disputed domain names which coincided with the date the TOTAL BY VERIZON mark was first used and publicized;
- (iv) the PPC links on the parking pages to which the disputed domain names resolve, which are related to the type of goods or services provided by the Complainant under the VERIZON trade marks and via its official websites at "www.verizon.com" and "www.totalbyverizon.com";
- (v) the nature of the disputed domain names which wholly incorporate misspelt versions of the TOTAL BY VERIZON mark, and PPC links to third-party competing websites;
- (vi) the Respondent's deliberate and pattern of typosquatting;
- (vii) the failure of the Respondent to show he has rights or legitimate interests in the disputed domain names; and
- (viii) the implausibility of any good faith use to which the disputed domain names may be put.

The Panel believes that the Respondent fully appreciated the value associated with the VERIZON trade marks, which is why he registered the series of disputed domain names which incorporate the VERIZON trade mark and typosquatted versions of the TOTAL BY VERIZON trade mark. He hoped to draw Internet traffic through typographical errors made by Internet users who may be searching for the Complainant's VERIZON and/or TOTAL BY VERIZON products or services. The Panel therefore concludes that the Respondent has registered and is using the disputed domain names in bad faith.

The Panel therefore finds that the third element of paragraph 4(a) of the Policy has been satisfied.

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 names <totalbyverizon.com>, <totalbyveizon.com>, <totalbyverizn.com>, and <wwwtotalbyverizon.com> be transferred to the Complainant.

/Francine Tan/

Francine Tan

Sole Panelist

Date: April 10, 2023