

ADMINISTRATIVE PANEL DECISION

Verizon Trademark Services LLC v. 徐海民 (Xu Hai Min)

Case No. D2023-0890

1. The Parties

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

The Respondent is 徐海民 (Xu Hai Min), China.

2. The Domain Names and Registrar

The disputed domain names <otalbyverizon.com>, <rotalbyverizon.com>, <toalbyverizon.com>, <toatlbyverizon.com>, <ttotalbyverizon.com>, <toralbyverizon.com>, <totaalbyverizon.com>, <totablyverizon.com>, <totabyverizon.com>, <totakbyverizon.com>, <totalbbyverizon.com>, <totalbtverizon.com>, <totalbuverizon.com>, <totalbverizon.com>, <totalbbyverizon.com>, <totalbyberizon.com>, <totalbycerizon.com>, <totalbyevrizon.com>, <totalbyveeizon.com>, <totalbyveerizon.com>, <totalbyveirizon.com>, <totalbyveriizon.com>, <totalbyverion.com>, <totalbyveriozn.com>, <totalbyverixon.com>, <totalbyverizin.com>, <totalbyverizno.com>, <totalbyverizob.com>, <totalbyverizo.com>, <totalbyverizom.com>, <totalbyverizonn.com>, <totalbyverizoon.com>, <totalbyverizpn.com>, <totalbyverizson.com>, <totalbyverozon.com>, <totalbyverrizon.com>, <totalbyveruzon.com>, <totalbyverzion.com>, <totalbyverzon.com>, <totalbyvetizon.com>, <totalbyvreizon.com>, <totalbyvrizon.com>, <totalbyvrizon.com>, <totalbywerizon.com>, <totalbywrizon.com>, <totalbyyverizon.com>, <totalbbyverizon.com>, <totalnyverizon.com>, <totalvverizon.com>, <totalybverizon.com>, <totalyverizon.com>, <totlabyverizon.com>, <totlbyverizon.com>, <totslbyverizon.com>, <tottalbyverizon.com>, <toyalbyverizon.com>, <tptalbyverizon.com>, <ttotalbyverizon.com>, and <yotalbyverizon.com> are registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 27, 2023. On February 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 2, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (PrivacyProtection.com, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 3, 2023, 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 amended Complaint in English on March 9, 2023.

On March 3, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant requested that English be the language of the proceeding on March 6, 2023. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceeding commenced on March 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 31, 2023.

The Center appointed Sebastian M.W. Hughes as the sole panelist in this matter on April 19, 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

A. Complainant

The Complainant is a company incorporated in the State of Delaware in the United States, and the intellectual property holding company for the NASDAQ listed technology and communications company, Verizon Communications Inc., founded in 2000 and headquartered in New York in the United States, with operations in more than 150 countries worldwide.

The Complainant is the owner of numerous registrations for the trade mark VERIZON (the "VERIZON Trade Mark"), including United States registration No. 2,886,813, with a registration date of September 21, 2004.

On September 21, 2022, Verizon Communications Inc. announced the launch of its new trade mark TOTAL BY VERIZON (the "TOTAL BY VERIZON Trade Mark").

On April 12, 2022, in anticipation of the launch, the Complainant filed United States trade mark application Nos. 97358855 and 97358961 for the word and device forms of the TOTAL BY VERIZON Trade Mark. Both of these applications are still pending registration, but have been accepted for registration and published for opposition purposes.

B. Respondent

The Respondent is apparently an individual resident in China.

C. The Disputed Domain Names

Each of the disputed domain names was registered on the same date, September 21, 2022.

D. Use of the Disputed Domain Names

Each of the disputed domain names is resolved to an English language parking page with sponsored links, including links relating to technology and communications (the "Websites").

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to the VERIZON Trade Mark and the TOTAL BY VERIZON Trade Mark (the "Trade Marks"), the Respondent has no rights or legitimate interests in respect of the disputed domain names, and the disputed domain names were registered and are being used in bad faith.

B. Respondent

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

On March 3, 2023, after the date of filing of the Complaint, the Respondent sent an email communication directly to the Complainant (without copying the Center), offering to transfer the disputed domain names to the Complainant for a USD 10,000 fee.

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreements for the disputed domain names is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the Parties, or unless specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Paragraph 11(a) of the Rules allows the Panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the Parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to an undue burden being placed on the Parties and undue delay to the proceeding (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

The Complainant has requested that the language of the proceeding be English for several reasons. The Complainant in particular submits that the Respondent is able to understand and communicate in English, as evidenced by the fact the disputed domain names are English language domain names; the Websites are in the English language; and the Respondent sent an English language communication to the Complainant offering to sell the disputed domain names.

The Respondent did not make any submissions regarding the language of the proceeding, and did not file any response to the Complaint herein.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time, and costs.

In light of the English language content of the Websites, and the Respondent's English language communication with the Complainant, the Panel finds there is sufficient evidence in support of the conclusion that the Respondent is conversant in English.

The Panel is also mindful of the need to ensure the proceeding is conducted in a timely and cost effective manner.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 Substantive Elements of the Policy

The Complainant must prove each of the three elements in paragraph 4(a) of the Policy in order to prevail.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the VERIZON Trade Mark dating from 2000 and acquired through registration and use; and rights in the TOTAL BY VERIZON Trade Mark dating from September 21, 2022, acquired through use.

Although the Complainant's applications for registration of its TOTAL BY VERIZON Trade Mark have not yet proceeded to registration, this is immaterial for the purposes of the first limb under paragraph 4(a) (see [WIPO Overview 3.0](#), section 1.1.3):

"The fact that a domain name may have been registered before a complainant has acquired trade mark rights does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element."

Each of the disputed domain names consists of common, obvious, or intentional misspellings of the TOTAL BY VERIZON Trade Mark (see [WIPO Overview 3.0](#), section 1.9).

In addition, the disputed domain names <totalbyverizon.com>, <totalbyberizon.com>, <totalbycerizon.com>, <totalbyevizon.com>, <totalbyveeizon.com>, <totalbyveerizon.com>, <totalbyveirizon.com>, <totalbyveriizon.com>, <totalbyverion.com>, <totalbyveriozn.com>, <totalbyverixon.com>, <totalbyverizin.com>, <totalbyverizno.com>, <totalbyverizob.com>, <totalbyverizo.com>, <totalbyverizom.com>, <totalbyverizonn.com>, <totalbyverizoon.com>, <totalbyverizpn.com>, <totalbyverizzon.com>, <totalbyverozon.com>, <totalbyverrizon.com>, <totalbyveruzon.com>, <totalbyverzion.com>, <totalbyverzon.com>, <totalbyvetizon.com>, <totalbyvreizon.com>, <totalbyvizon.com>, <totalbyvrrizon.com>, <totalbywverizon.com>, <totalbywvizon.com>, and <totalbywvizon.com> consist of common, obvious, or intentional misspellings of the VERIZON Trade Mark, prefaced by the terms "total by" or common, obvious, or intentional misspellings of the words "total by" comprised in the TOTAL BY VERIZON Trade Mark.

Furthermore, the disputed domain names <otalbyverizon.com>, <rotalbyverizon.com>, <toalbyverizon.com>, <toatlbyverizon.com>, <ttotalbyverizon.com>, <toralbyverizon.com>, <totaalbyverizon.com>, <totablyverizon.com>, <totabyverizon.com>, <totakbyverizon.com>, <totalbbyverizon.com>, <totalbtverizon.com>, <totalbuverizon.com>, <totalbverizon.com>, <totalbywverizon.com>, <totalbyyverizon.com>, <totalbyverizon.com>, <totalnyverizon.com>, <totalwyverizon.com>, <totalybverizon.com>, <totalyverizon.com>, <totlabyverizon.com>, <totlbyverizon.com>, <totslbyverizon.com>, <tottalbyverizon.com>, <toyalbyverizon.com>, <tptalbyverizon.com>, <ttotalbyverizon.com>, and <yotalbyverizon.com> incorporate the entirety of the VERIZON Trade Mark (see [WIPO Overview 3.0](#), section 1.7), prefaced by common, obvious, or intentional misspellings of the words "total by" comprised in the TOTAL BY VERIZON Trade Mark.

Where a relevant trade mark is recognisable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see [WIPO Overview 3.0](#), section 1.8).

The Panel therefore finds that the disputed domain names are confusingly similar to the Trade Marks.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to the respondent of the dispute, the respondent's 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) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name even if the respondent has acquired no trade mark or service mark rights; or
- (iii) the respondent is 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 trade mark or service mark at issue.

The Complainant has not authorised, licensed, or permitted the Respondent to register or use the disputed domain names or to use the Trade Marks. The Panel finds on the record that there is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names, and the burden is thus on the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that he has acquired any trade mark rights in respect of the disputed domain names or that the disputed domain names have been used in connection with a *bona fide* offering of goods or services. To the contrary, (1) the disputed domain names were each registered on the official launch date of the Complainant's TOTAL BY VERIZON Trade Mark; (2) the disputed domain names have been resolved to parking pages with sponsored links, some of which are related to technology and communication services, the services provided by the Complainant since 2000 under the Trade Marks; and (3) the Respondent has offered to sell the disputed domain names to the Complainant for USD 10,000.

There has been no evidence adduced to show that the Respondent has been commonly known by the disputed domain names, and there has been no evidence adduced to show that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names.

The Panel finds that the Respondent has failed to produce any evidence to rebut the Complainant's *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names.

The Panel therefore finds that the Respondent lacks rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

In light of the manner of the use of the disputed domain names and the Respondent's offer to sell the disputed domain names highlighted above, the Panel finds that the requisite element of bad faith has been made out under paragraphs 4(b)(i) and 4(b)(iv) of the Policy.

Although the Complainant has not yet obtained registration of its pending applications for registration of the TOTAL BY VERIZON TRADE MARK, in all the circumstances, the Panel finds that the Respondent's intent in registering the disputed domain names was to unfairly capitalize on the Complainant's nascent (as yet unregistered) rights in respect of its TOTAL BY VERIZON Trade Mark (see [WIPO Overview 3.0](#), section 3.8.2).

For all the foregoing reasons, the Panel concludes that the disputed domain names have been registered and are being used in bad faith.

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 <otalbyverizon.com>, <rotalbyverizon.com>, <toalbyverizon.com>, <toatlbyverizon.com>, <ttotalbyverizon.com>, <toralbyverizon.com>, <totaalbyverizon.com>, <totalbyverizon.com>, <totabyverizon.com>, <totakbyverizon.com>, <totalbbyverizon.com>, <totalbtverizon.com>, <totalbuverizon.com>, <totalbverizon.com>, <totalbyverizon.com>, <totalbyberizon.com>, <totalbycerizon.com>, <totalbyevrizon.com>, <totalbyveeizon.com>, <totalbyveerizon.com>, <totalbyveirizon.com>, <totalbyveriizon.com>, <totalbyverion.com>, <totalbyveriozn.com>, <totalbyverixon.com>, <totalbyverizin.com>, <totalbyverizno.com>, <totalbyverizob.com>, <totalbyverizo.com>, <totalbyverizom.com>, <totalbyverizonn.com>, <totalbyverizoon.com>, <totalbyverizpn.com>, <totalbyverizzon.com>, <totalbyverozon.com>, <totalbyverrizon.com>, <totalbyveruzon.com>, <totalbyverzion.com>, <totalbyverzon.com>, <totalbyvetizon.com>, <totalbyvreizon.com>, <totalbyvrizon.com>, <totalbyvrrizon.com>, <totalbywerizon.com>, <totalbywrizon.com>, <totalbyyverizon.com>, <totalbyverizon.com>, <totalnyverizon.com>, <totalyverizon.com>, <totalybverizon.com>, <totalyverizon.com>, <totlabyverizon.com>, <totlbyverizon.com>, <totslbyverizon.com>, <tottalbyverizon.com>, <toyalybyverizon.com>, <tpalbyverizon.com>, <ttotalbyverizon.com>, and <yotalbyverizon.com> be transferred to the Complainant.

/Sebastian M.W. Hughes/

Sebastian M.W. Hughes

Sole Panelist

Dated: May 3, 2023