

ADMINISTRATIVE PANEL DECISION

Telefonaktiebolaget LM Ericsson v. Awais Aslam Case No. D2023-2533

1. The Parties

The Complainant is Telefonaktiebolaget LM Ericsson, Sweden, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Awais Aslam, Pakistan

2. The Domain Names and Registrar

The disputed domain names <ericssontelecom.com>, <globalericsson.com>, <swedenericsson.com>, and <worldericsson.com> (collectively the “Domain Names” and each the “Domain Name”) are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 12, 2023. On June 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On June 13, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 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 on June 19, 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 June 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 19, 2023. The Respondent submitted communications to the Center on June 29, July 4, July 6, and on July 25, 2023. Accordingly, the Center notified the parties that it would proceed to panel appointment on July 25, 2023.

The Center appointed Olga Zalomiy as the sole panelist in this matter on July 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 is the provider of communication technology and services around the world. The Complainant owns numerous trademark registrations for the ERICSSON trademark, such as:

- The Australian trademark ERICSSON No. 322638, registered on October 3, 1978;
- The United States of America trademark ERICSSON, No. 1313196, registered on January 8, 1985;
- The United States of America trademark ERICSSON, No. 2665187, registered on December 24, 2002.

The Respondent registered the Domain Names on October 9, 2022. The Domain Names <swedenericsson.com>, <ericssontelecom.com>, or <globalericsson.com> do not direct to any active websites. The website under the Domain Name <worldericsson.com> contains a link, which takes users to different, unrelated websites, one of which features numerous automatically generated pay-per-click links.

The Respondent sent several emails to the Complainant and the Center offering to sell the Domain Names to the Complainant for USD 8,000 initially and for USD 5,000 later on.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarized as follows:

The Complainant argues that the Domain Names are identical or confusingly similar to the Complainant's trademarks. The Complainant claims that by virtue of its trademark and service mark registrations, the Complainant is the owner of the ERICSSON trademark. The Complainant contends that it is standard practice to disregard the applicable Top Level Domain ("TLD") in a domain name, when comparing the Domain Names to the Complainant's trademarks. The Complainant asserts that the Domain Names are confusingly similar to the Complainant's trademarks because they consist merely of the Complainant's trademark and descriptive terms "Sweden", "telecom", "global", and "world" that closely describe the Complainant's business.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the Domain Names because (i) the Complainant has an exclusive right to use the ERICSSON trademark in commerce in connections with the goods or services for which it is registered; (ii) the Respondent is not sponsored or affiliated with the Complainant; (iii) the Complainant has not given the Respondent permission to use the Complainant's trademark in any manner; and (iv) the Respondent is not commonly known by the Domain Names. The Complainant contends that the Respondent has not demonstrated any attempt to make legitimate use of the Domain Names, because the Respondent is not using the Domain Names <swedenericsson.com>, <ericssontelecom.com>, or <globalericsson.com> to direct to any active websites. The Complainant argues that the Respondent is not using the Domain Name to provide a *bona fide* offering of goods or services because the Respondent is using that Domain Name to profit off of the fame of the Complainant's mark and direct users to an aggregator website that offers products and services primarily unrelated to the Complainant. The Complainant asserts that the Respondent's email makes it clear that he wishes to offer the Domain Names for sale for an amount that far exceeds their out-of-pocket expenses in registering them, which serves as further evidence of the Respondent's lack of rights and legitimate interests.

The Complainant asserts that the Domain Names were registered and are being used in bad faith because the Respondent, who registered several Domain Names comprised of the ERICSSON mark and generic terms, has demonstrated a knowledge of and familiarity with the Complainant's brand and business. The Complainant argues that its well-known ERICSSON mark is so closely connected to the Complainant that the Respondent's use of the mark suggests opportunistic bad faith. The Complainant asserts that the Respondent's passive holding of the Domain Names <swedenericsson.com>, <ericssontelecom.com>, and <globalericsson.com> constitute a factor in finding bad faith registration and use. The Complainant argues that the website under the Domain Name <worldericsson.com> contains a link, which takes users to different, unrelated websites, one of which features numerous automatically generated pay-per-click links and such use of the Domain Name constitutes bad faith registration and use. The Complainant states that all of the Domain Names have active Mail Exchange ("MX") records, which could potentially be used for phishing purposes. The Complainant asserts that the Respondent's registration of four Domain Names comprised of the Complainant's ERICSSON trademark combined with related, generic terms, indicates an intention to hold the Domain Names for some future active use in a way which would be competitive with or otherwise detrimental to the Complainant and demonstrates that the Respondent is engaging in a pattern of cybersquatting, which is evidence of bad faith registration and use. The Complainant alleges that the Respondent, at the time of initial filing of the Complaint, had employed a privacy service to hide his identity, which serves as further evidence of bad faith registration and use. The Complainant argues that the Respondent's emails demonstrate an intent to sell, rent, or otherwise transfer the Domain Names to the Complainant for valuable consideration in excess of their out-of-pocket expenses, which is another evidence of bad faith.

B. Respondent

The Respondent submitted communications to the Center on June 29, July 4, July 6, and on July 25, 2023. In its emails, the Respondent contends the Domain Names are not identical or confusingly similar to the Complainant's marks. In support of this contention, the Respondent points to the fact that the Domain Names contain the words "telecom", "global", "Sweden", and "world" in addition to the term ERICSSON, which makes the Domain Names different from the Complainant's ERICSSON trademark. The Respondent claims that he purchased the Domain Names with the sole purpose of reselling them. Initially, the Respondent sought to sell the Domain Names to the Complainant for USD 8,000, but later lowered the price down to USD 5,000.

6. Discussion and Findings

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to each of the Domain Names:

- (i) the Domain Names are 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 Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must prove that the Domain Names are identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The submitted evidence shows that the Complainant owns several trademark registrations for the ERICSSON trademark. Pursuant to section 1.2.1 of the of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), this satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

The Domain Names consist of the Complainant's ERICSSON trademark, the terms "Sweden", "telecom", "global", and "world" and the generic Top-Level Domain ("gTLD") ".com". The Respondent's assertion that the addition of the terms "Sweden", "telecom", "global", and "world" differentiates the Domain Names from the Complainant's mark is without merit. It is well-established that the addition of such words does not prevent a finding of confusing similarity between the Domain Names and the Complainant's trademarks, where the trademark is recognizable within the Domain Names¹. It is well-established that the applicable TLD should be disregarded under the confusing similarity test as a standard registration requirement."² Therefore, the Domain Names are confusingly similar to the Complainant's ERICSSON trademark.

The Complainant has satisfied the first element of the UDRP.

B. Rights or Legitimate Interests

To succeed under the second UDRP element, the Complainant must make out a *prima facie* case in respect of the lack of rights or legitimate interests of the Respondent.

To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under the UDRP, paragraph 4(c) include the following:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the 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 domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant contends that (i) the Complainant has an exclusive right to use the ERICSSON trademark in commerce in connections with the goods or services for which it is registered; (ii) the Respondent is not sponsored or affiliated with the Complainant; (iii) the Complainant has not given the Respondent permission to use the Complainant's trademark in any manner; and (iv) that the Respondent is not commonly known by the Domain Names.

The Respondent primarily argues that he has purchased the Domain Names "with the sole purpose of reselling them in the future". The Respondent contends that addition of words to the Complainant's mark ERICSSON in each of the Domain Names, made the Domain Names distinguishable from the Complainant's mark, and legitimized the Respondent's rights in the Domain Names.

While it is not per se illegitimate to register domain names comprised dictionary words, which may, in certain circumstances confer rights or legitimate interests on the respondent³, this is not the case here. Here, the Respondent registered the Domain Names comprised the Complainant's trademark and dictionary words (some of them obviously connected to the Complainant, and its business). Such registration did not confer rights or legitimate interests on the Respondent. The Respondent failed to provide any relevant arguments supported by evidence that could give rise to rights or legitimate interests in the Domain Names, and the Panel finds the Complainant's *prima facie* case remains un rebutted.

Therefore, the Complainant has satisfied that the second element of the UDRP.

¹ Section 1.8, [WIPO Overview 3.0](#).

² Section 1.11, [WIPO Overview 3.0](#).

³ Section 2.10, [WIPO Overview 3.0](#).

C. Registered and Used in Bad Faith

Under the third UDRP element, the Complainant is required to prove that the Domain Names were registered and are being used in bad faith.

The Complainant offers a number of arguments in support of its contention that the Respondent registered and used the Domain Names in bad faith. First, the Complainant argues that its well-known ERICSSON mark is so closely connected to the Complainant that the Respondent's use of the mark suggests opportunistic bad faith.

The Panel accepts that the ERICSSON mark is well-known. It is well established that merely registering a domain name that is confusingly similar to a highly distinctive or famous mark, creates a presumption of bad faith.⁴ Therefore, the Respondent's registration of the Domain Names that are confusingly similar to the Complainant's well-known mark creates such presumption, particularly noting the nature of the added terms (with some of the added terms clearly connected to the Complainant's business).

Second, the Respondent's bad faith is further evidenced by the fact that in its emails the Respondent purchased the Domain Names "with the sole purpose of reselling them in the future" and offered them for sale to the Complainant for USD 8,000 and later, for USD 5,000. As a result, it is likely that the Respondent registered the Domain Names to profit from the Complainant's famous mark. This is indicative of bad faith under paragraph 4(b)(i) of the UDRP.

Third, the Complainant argues that the Respondent's bad faith is evidenced by the fact that it registered the Domain Names in the name of a privacy service to conceal its identity. The use of proxy services may be indicative of bad faith if such services are used to hide cybersquatting conduct.⁵ Here, the Respondent simultaneously registered four trademark-abusive Domain Names corresponding to the Complainant's distinct mark. It appears that the Respondent attempted to prevent the Complainant contacting the Respondent until its identity was disclosed by the Registrar. As a result, the Respondent's bad faith is affirmed by the use of the privacy service.

In addition, the Panel finds that the Respondent registered and used the Domain Names in bad faith because the Respondent was involved in a pattern of abuse under paragraph 4(b)(ii) of the UDRP by registering four Domain Names corresponding to the Complainant's well-known mark.

Fourth, the Complainant argues that the website under the Domain Name <worldericsson.com> contains a link, which takes users to different, unrelated websites, one of which features numerous automatically generated pay-per-click links and such use of the Domain Name constitutes bad faith registration and use. Prior panels have held that third-party generated material "automatically" appearing on the website associated with a domain name do not prevent finding bad faith⁶. Coupled with the fact that the Respondent purchased the Domain Name for resale, the Panel finds the registration and use of the Domain Name <worldericsson.com> are in bad faith.

The Complainant has established the third element of the UDRP.

⁴ See, Section 3.1.4, [WIPO Overview 3.0](#).

⁵ Section 3.6, [WIPO Overview 3.0](#).

⁶ Section 3.5, [WIPO Overview 3.0](#).

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 Names, <ericssontelecom.com>, <globalericsson.com>, <swedenericsson.com>, <worldericsson.com> be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: August 8, 2023