

ADMINISTRATIVE PANEL DECISION

uBreakiFix, Co. v. YangZhiChao

Case No. D2023-2569

1. The Parties

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

The Respondent is YangZhiChao, China.

2. The Domain Name and Registrar

The disputed domain name <ubrekifix.com> is registered with 22net, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 14, 2023. On June 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 16, 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 (Not Available) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 16, 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 June 16, 2023.

On June 16, 2023, the Center transmitted another email communication to the Parties in English and Chinese regarding the language of the proceeding. On June 16, 2023, the Complainant confirmed its request that English be the language of the proceeding. 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 proceedings commenced on June 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 20, 2023.

The Center appointed Francine Tan as the sole panelist in this matter on August 11, 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 states that it has since as early as 2009 offered, *inter alia*, repair services for devices such as computers, laptops, tablets, and phones under the UBREAKIFIX trade mark. The Complainant owns the domain name <ubreakifix.com> which it uses to advertise and sell its products and services. The Complainant states that in September 2022 alone, its website received over 1,000,000 visits and that it has served over 6,000,000 customers at over 500 retail stores throughout the U.S., Canada, and the Caribbean.

The Complainant also states that it has an active social media presence, with over 800,000 subscribers on YouTube, over 34,000 Facebook “likes,” over 300,000 Twitter followers, and over 14,000 Instagram followers.

The Complainant is the registered owner of the UBREAKIFIX trade mark in territories which include the U.S., China, and the European Union. Its trade mark registrations include the following:

- U.S. Trade Mark Registration No. 4364495, registered on July 9, 2013;
- U.S. Trade Mark Registration No. 3855288, registered on October 5, 2010;
- Canada Trade Mark Registration No. TMA901622, registered on April 21, 2015;
- Mexico Trade Mark Registration No. 2104673, registered on August 3, 2020;
- Mexico Trade Mark Registration No. 2203934, registered on February 12, 2021; and
- China Trade Mark Registration No. 51353085, registered on July 21, 2021.

The Complainant and its licensees own many other domain names which incorporate the Complainant's UBREAKIFIX trade mark (and variations of the said trade mark). These include: <ubreakifix.us>, <ubreakifix.info>, <ubreakifix.net>, <ubreakifixit.com>, <ubreakifixorlandoacrepair.com>, <ubreakifix.com>, <ubreakifix.com>, <ubreakifixhomeservices.com>, <ubreakifixhome.com>, <ubreakifixacrepair.com>, <ubreakifixhvac.com>, <ubreakifixhvacreapairs.com>, <ubreakitifix.com>, and <ubreakitifixit.com>.

The disputed domain name was registered on September 26, 2022. At the time of the filing of the Complaint, the disputed domain name resolved to a parking page featuring pay-per-click (“PPC”) links. On January 31, 2023, the Complainant's counsel sent the Respondent, via the contact form provided by the Registrar, a cease-and-desist message requesting that the disputed domain name be transferred to the Complainant. The Respondent did not reply to the communication.

5. Parties' Contentions

A. Complainant

- 1) The disputed domain name is identical or confusingly similar to the Complainant's UBREAKIFIX trade mark in which the Complainant has rights. The disputed domain name incorporates the Complainant's UBREAKIFIX mark in its entirety with the omission of the letter “a” which is insufficient to differentiate the disputed domain name from the Complainant's UBREAKIFIX trade mark. This is a case of typosquatting by the Respondent, to take advantage of the fact that a proportion of Internet users will mistype the said trade mark when attempting to locate the Complainant's website at “www.ubreakifix.com”.

- 2) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to register or use the disputed domain name and there is no connection between the Complainant and the Respondent. The Respondent is not and has never been a licensee of the Complainant, nor is it commonly known by the name “Ubrekifix”. The disputed domain name resolves to a parking page with PPC links to third-party websites offering products and/or services of the type that consumers would expect to find on the Complainant’s official website. The disputed domain name is therefore used to divert the Complainant’s customers and potential customers to those third-party websites. Such use of the disputed domain name does not constitute a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name. At the time the disputed domain name was registered, the trade mark UBREAKIFIX was already well known. Hence, no actual or contemplated *bona fide* or legitimate use of the disputed domain name can reasonably be claimed by the Respondent.
- 3) The disputed domain name was registered and is being used in bad faith. The Complainant’s trade mark UBREAKIFIX is highly distinctive and exclusively associated with the Complainant. The Respondent must have been well aware of the Complainant’s rights in the UBREAKIFIX trade mark at the time the Respondent registered the disputed domain name since the services offered by third parties at the said PPC links (*i.e.*, “Screen Fix Near Me”, “Smartphone Repair”, and “iPhone Screen Repair Near Me”) relate to services which compete with those of the Complainant. The Respondent’s knowledge of the Complainant and of its UBREAKIFIX trade mark is also evidenced by the Respondent’s choice of a slight variation in the spelling of the word “break” which features in the Complainant’s UBREAKIFIX trade mark. The Respondent registered and used the disputed domain name with the opportunistic intent to profit from the traffic generated by Internet users looking for the Complainant’s website.
- 4) The Respondent’s bad faith is also demonstrated by the fact that he has been a named respondent in at least 16 other UDRP proceedings and panels in earlier UDRP cases have found that the Respondent is, to quote one of the cases, a “serial cybersquatter” or to have engaged in a pattern of conduct, namely of abusive registrations involving third-party trade marks.

B. Respondent

The Respondent did not submit any response in this administrative proceeding.

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. The Complainant requested that the language of the proceeding be English for the following main reasons:

- (i) the disputed domain name is in Latin characters rather than Chinese characters;
- (ii) the disputed domain name resolves to a website displaying PPC links in the English language; and
- (iii) requiring the Complaint to be translated into Chinese would result in the proceeding being unduly delayed and the Complainant having to incur a disproportionate amount of expense.

The Respondent did not comment on the language of the proceeding.

Paragraph 11(a) of the Rules provides that:

“Unless otherwise agreed by the Parties, or 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.”

Section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) states the following:

“Noting the aim of conducting the proceedings with due expedition, paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. Against this background, panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant’s mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.”

Having considered the relevant factors and interests of the respective Parties, the Panel determines that it would be appropriate for English be the language of the proceeding. The Panel is persuaded that the Respondent would not be prejudiced as he appears to be familiar with and understands the English language. The PPC links on the parked page to which the disputed domain name resolves reflect words in English and notably, nothing in Chinese. The Respondent had, moreover, been notified by the Center, in both Chinese and English, of the commencement of the proceeding, the language of the proceeding, and deadline for filing a Response in Chinese or English. The Respondent therefore had ample opportunity to object to the Complainant’s language request and/or propose to submit his Response in Chinese but did not do so. In the absence of any rebuttal argument or justification therefor by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint into Chinese.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The Complainant has established it has rights in the UBREAKIFIX trade mark. The disputed domain name in essence comprises a misspelt version of the said trade mark with the omission of the letter “a”. The UBREAKIFIX mark is nonetheless identifiable in the disputed domain name. As is stated in section 1.9 of the [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”.

The Panel finds that the disputed domain name, which is a typosquatted domain name revolving around the distinctive and well-established UBREAKIFIX trade mark and which contains merely an omission of the letter “a”, is confusingly similar to the UBREAKIFIX trade mark in which the Complainant has rights. The omission of the letter “a” in the disputed domain name does not remove the confusing similarity with the Complainant’s UBREAKIFIX trade mark.

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 name 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 name. The Complainant's earlier use and registration of the UBREAKIFIX trade mark predates the registration date of the disputed domain name by many years. The Complainant did not license nor authorize the Respondent to use UBREAKIFIX as a trade mark or in a domain name. Neither is there any evidence that the Respondent is commonly known by the disputed domain name. The use of the disputed domain name which incorporates a misspelt version of the Complainant's UBREAKIFIX trade mark in relation to parking pages with PPC links to "Screen Fix Near Me", "Smartphone Repair", or "iPhone Screen Repair Near Me", and so forth, does not constitute a *bona fide* offering of good or services within the meaning of paragraph 4(c)(i) of the Policy nor a legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii) of the Policy. The subject matter reflected on the parked page corresponds to and/or is 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 name. The Respondent did not respond to the cease-and-desist communication sent by the Complainant's counsel nor file a Response to the Complaint. In fact, the Respondent refused to accept delivery of the Written Notice sent by the Center via courier service. The Respondent has therefore failed to show that he has rights or legitimate interests in the disputed domain name and 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

A complainant has the burden of proving that the respondent registered and is using the disputed domain name in bad faith. Paragraph 4(b) of the Policy states that:

"[T]he following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [the respondent has] registered or [the respondent has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] web site or location or of a product or service on [the respondent's] web site or location."

Given the well-established use and fame of the Complainant's UBREAKIFIX trade mark, which has not been disputed by the Respondent, and how the disputed domain name, a deliberate misspelt version of the Complainant's trade mark, is being used by the Respondent, it is evident that the Respondent was well aware of and specifically targeted the Complainant and its UBREAKIFIX trade mark. The Respondent is not a licensee of the Complainant. The PPC links on the website to which the disputed domain name resolves

offer services which compete with those offered by the Complainant. The Complainant's assertions that the Respondent has attempted to pass off his website as being sponsored, affiliated, or endorsed with the Complainant, and to ride off the reputation and goodwill of the Complainant have not been disputed by the Respondent. The Panel is therefore persuaded that the evidence supports a finding that the Respondent has blatantly attempted to confuse and/or mislead Internet users seeking or expecting to find the Complainant at the website to which the disputed domain name resolves.

Additionally, the apparent cybersquatting history of the Respondent and his refusal to accept delivery of the Written Notice sent by the Center in relation to this domain name dispute are factors which the Panel has also taken into consideration and from which it has drawn an adverse inference.

Hence, the Panel concludes that the circumstances of this case demonstrate the Respondent's bad faith registration and use under paragraphs 4(b)(ii) and (iv) of the Policy.

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 name <ubrekifix.com> be transferred to the Complainant.

/Francine Tan/

Francine Tan

Sole Panelist

Date: August 25, 2023