

ADMINISTRATIVE PANEL DECISION

Asurion, LLC v. Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2023-4243

1. The Parties

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <asuriontradein.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2023. On October 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 12, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 13, 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 October 17, 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 November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 27, 2023.

The Center appointed Gustavo Patricio Giay as the sole panelist in this matter on December 14, 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 company – operating since 1994 – that offers insurance, technology, mobile phone replacement and “trade-ins”, configuration, technical support, IT consultation, and related products and services under the ASURION trademark.

The Complainant has served over 280 million consumers worldwide, and its services are made available by retailers all around the world, including some of the largest retailers in the United States.

Since 2001, the Complainant has promoted ASURION services continuously and extensively, spending millions of dollars and maintaining an active presence in social media with nearly one million Facebook likes and 26,000 X followers.

The Complainant claims to be the owner of the trademark ASURION in many jurisdictions, including Argentina, Australia, Brazil, Canada, Chile, China, Colombia, Costa Rica, Cuba, Ecuador, El Salvador, the European Union, Guatemala, Honduras, Hong Kong, China, India, Indonesia, Israel, Japan, Malaysia, Mexico, New Zealand, Nicaragua, Panama, Paraguay, Peru, the Philippines, Singapore, Republic of Korea, Taiwan Province of China, Thailand, the United Kingdom, the United States, and Uruguay.

The Complainant’s United States Patent and Trademark Office (USPTO) registrations for ASURION include the following: registration No. 2698459 registered on March 18, 2003, for cl. 35,36 and 37; registration No. 85486099 registered on July 24, 2012, for cl. 9, 42 and 45; and registration No. 4997781 registered on July 12, 2016, for cl. 35,36,37 and 42.

The Complainant asserts to own an important domain names portfolio, including, among others, its primary website at <asurion.com> that receives over 7.9 million visits annually.

The Complainant tried to resolve this dispute outside of this administrative proceeding by sending a cease-and-desist message on March 21, 2023, via the form provided by GoDaddy (as proven by Annex 4), but was ignored by the Respondent.

Finally, the disputed domain name was registered on March 14 2023, and resolves to a webpage containing pay-per-click links (PPC) – with active MX servers (as evidenced in Annex 5) - referring to pages that seem to be potential competitors of the Complainant’s business.

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 claims that the disputed domain name is confusingly similar to its trademark ASURION in which the Complainant has prior rights.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names, nor is it related in any way to the Complainant. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark ASURION or apply for registration of the disputed domain name.

More specifically, the Complainant alleged that the Respondent has not used and/or has no demonstrable intention to use the disputed domain name in connection with a *bona fide* offering of goods or services. In fact, the Complainant claims that the Respondent has selected the disputed domain name only to intentionally lead Internet users to believe they are accessing the Complainant's website.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 disputed domain name was registered and is being used in bad faith.

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 mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, such as "tradein", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Even more, it does not seem that the Respondent made nor is making a legitimate noncommercial or fair use of the disputed domain name. In this regard, the Complainant demonstrated that the disputed domain name is parked with PPC links that redirect users to websites that seem to be potential competitors of the Complainant's business. It is clear that the Respondent's sole intention is to misleadingly divert consumers to the website to which the disputed domain name resolves likely for the purpose of gaining commercial profit, unduly taking advantage of the Complainant's reputation and goodwill. Also, the existence of active MX records reinforces this fact.

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 such connection, the Complainant has submitted evidence to support that the trademark ASURION is widely known and was registered and used many years before the Respondent registered the disputed domain name. Further, the term "tradein" included in the disputed domain name is related to the Complainant's business as one of its fundamental activities is to offer trade-in options for phones and other wireless devices.

The Respondent when registering the disputed domain name has targeted the Complainant's trademark ASURION to attract Internet users likely for commercial gain and benefit from the Complainant's reputation under paragraph 4(b)(iv) of the Policy.

Therefore, the Panel is satisfied that the Respondent must have been aware of the Complainant and the Complainant's trademark ASURION when it registered the disputed domain name. Consequently, and in accordance with section 3.1.4 of [WIPO Overview 3.0](#), the Panel considers that the inclusion of the Complainant's ASURION trademark in the disputed domain name creates a presumption that the disputed domain name was registered on a bad faith basis.

Furthermore, the disputed domain name resolves to a PPC parking page with various links. The Panel finds therefore that the Respondent's use of the disputed domain name incorporating the Complainant's distinctive and well-known ASURION trademark is intended to attract and mislead Internet users when searching for the Complainant's website and to redirect them to the links related to the Complainant's potential competitors at the relevant PPC pages from which the Respondent must probably derive commercial revenue.

Besides, the Complainant proved that MX records have been set up for the disputed domain name, which would enable the Respondent to send phishing emails, which only emphasize the Respondent's bad faith in the use and registration of the disputed domain name.

Even more, the Respondent has ignored the cease-and-desist message from the Complainant to try and resolve this matter amicably outside from this administrative proceeding. This further underscores the Respondent's bad faith in both registering and utilizing the disputed domain name.

The disputed domain name is currently listed for auction at "www.sedo.com" with a minimum offer of USD 899. This demonstrates that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's trademark.

Lastly, the fact that the Respondent was involved in 396 previous UDRP proceedings as evidenced by the Complainant in Annex 9, confirms that the Respondent has already engaged in similar illicit behavior in the past.

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 <asuriontradein.com> be transferred to the Complainant.

/Gustavo Patricio Giay/

Gustavo Patricio Giay

Sole Panelist

Date: December 28, 2023.