

ADMINISTRATIVE PANEL DECISION

Universal Services of America, LP d/b/a Allied Universal v.
This Domain May be for Sale at <https://www.networksolutions.com>,
New Ventures Services, Corp
Case No. D2019-0834

1. The Parties

The Complainant is Universal Services of America, LP d/b/a Allied Universal of United States of America (“US”), represented by Cozen O’Connor, US.

The Respondent is This Domain May be for Sale at <https://www.networksolutions.com>, New Ventures Services, Corp, US.

2. The Domain Name and Registrar

The disputed domain name <allieduniversaledge.com> is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 11, 2019. Also on April 11, 2019, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed domain name. Later the same day, 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”), 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 that the proceedings commenced on April 25, 2019. In accordance with the Rules, paragraph 5, the Center set the due date for Response to May 15, 2019. The Respondent did not submit any Response. Accordingly, on May 20, 2019, the Center notified the parties of the Respondent’s default.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on June 3, 2019. 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

As reflected in the registration record for the disputed domain name in the public Whois database (a copy of that record appears in Annex 1 to the Complaint), the disputed domain name was registered on July 19, 2017 and will expire on July 19, 2019.

A. The Complainant's marks

As indicated in the Complaint, the Complainant owns two US trademark registrations for the terms "Allied Universal" both in block letters alone, and in stylized form with an accompanying design element. The Complainant has provided, in Annexes 5 and 6, respectively, to the Complaint, copies of its registration certificates for these registrations. The Complainant also owns three US trademark registrations for the terms "Alliedbarton Edge" both in block letters and in stylized forms, and the term "Edge" in block letters. The Complainant has provided a copy of the registration certificates for these three registrations in Annexes 7-9, respectively, to the Complaint. Pertinent details of these five registrations are as follows:

1. The "ALLIED UNIVERSAL" Marks

- i. ALLIED UNIVERSAL (block letters)
United States Registration No. 5,136,006; registered: February 7, 2017

This service mark is registered for use in connection with: "[j]anitorial services; [i]nstallation and maintenance of security systems for buildings and premises" in international class 37; "[t]raining services in the field of fire prevention, life-saving techniques, and building safety; educational services, namely, conducting classes, seminars, conferences, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; providing on-line training classes, courses, seminars, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; training services in the field of security guard and proper surveillance in connection therewith" in international class 41; "[p]roviding a website featuring non-downloadable software for use in database management, for use as spreadsheet, for word processing, for tracking and reporting documents, information and metrics in the field of security guard services; providing on-line non-downloadable software for use in database management, for use as spreadsheet, for word processing, for tracking and reporting documents, information and metrics in the field of security guard services; computer software consultation" in international class 42; and, "[s]ecurity services in the nature of security guard services; evaluating and assessing on-site security programs for others; [p]roperty surveillance and security protective services, namely, providing executive protection, civil protection, personal security consultation, home security consultation, personal body guarding, control of building environmental access and security systems; security guard services; security guard services, namely, provision of uniformed, unarmed security professionals; security consulting services in the fields of fire and life safety, and emergency and terrorism response; and design and implementation of security programs, including standing, patrol and console security, fire and life safety, and emergency and terrorism response; consultation in the field of data theft and identity theft; fraud and identity theft protection services; monitoring of credit reports, the Internet, and public records to facilitate the detection and prevention of identity theft and fraud; monitoring of security systems for buildings and premises; security consulting services, namely, evaluating and assessing on-site security programs for others; providing property surveillance services, namely, monitoring security systems and security guarding for facilities; security protective services, namely, providing executive protection, personal security consultation, and personal body guarding; concierge services, namely, hotel concierge services, personal concierge services for others comprising making requested personal arrangements and reservations, running errands and providing

customer specific information to meet individual needs, all rendered in business establishments, office buildings, hotels, residential complexes and homes” in international class 45. The registrant claims that both first use and first use in commerce of this mark, when used in conjunction with all these services, commenced as of August 1, 2016.

- ii. ALLIED UNIVERSAL (stylized with design element)
United States Registration No. 5,136,124; registered: February 7, 2017

This service mark is registered for use in connection with: “Janitorial services; Installation and maintenance of security systems for buildings and premises” in international class 37; “[t]raining services in the field of fire prevention, life-saving techniques, and building safety; educational services, namely, conducting classes, seminars, conferences, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; providing on-line training classes, courses, seminars, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; training services in the field of security guard and proper surveillance in connection therewith” in international class 41; “[p]roviding a website featuring non-downloadable software for use in database management, for use as spreadsheet, for word processing, for tracking and reporting documents, information and metrics in the field of security guard services; providing on-line non-downloadable software for use in database management, for use as spreadsheet, for word processing, for tracking and reporting documents, information and metrics in the field of security guard services; computer software consultation” in international class 42; and, “[s]ecurity services in the nature of security guard services; evaluating and assessing on-site security programs for others; and property surveillance and security protective services; namely, providing executive protection, civil protection, personal security consultation, home security consultation, personal body guarding, control of building environmental access and security systems; security guard services; security guard services, namely, provision of uniformed, unarmed security professionals; security consulting services in the fields of fire and life safety, and emergency and terrorism response; and design and implementation of security programs, including standing, patrol and console security, fire and life safety, and emergency and terrorism response; consultation in the field of data theft and identity theft; fraud and identity theft protection services; monitoring of credit reports, the Internet, and public records to facilitate the detection and prevention of identity theft and fraud; monitoring of security systems for buildings and premises; security consulting services, namely, evaluating and assessing on-site security programs for others; providing property surveillance services, namely, monitoring security systems and security guarding for facilities; security protective services, namely, providing executive protection, personal security consultation, and personal body guarding; concierge services, namely, hotel concierge services, personal concierge services for others comprising making requested personal arrangements and reservations, running errands and providing customer specific information to meet individual needs, all rendered in business establishments, office buildings, hotels, residential complexes and homes” in international class 45. The registrant claims that both first use and first use in commerce of this mark, when used in conjunction with all these services, commenced as of August 1, 2016.

2. The “ALLIEDBARTON EDGE” and “EDGE” Marks

- i. ALLIEDBARTON EDGE (block letters)
United States Registration No.3,728,360; registered: December 22, 2009

This service mark is registered for use in connection with: “[e]ducational services, namely, conducting classes, seminars, conferences, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; providing on-line training classes, courses, seminars, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; training services in the field of security guard and proper surveillance in connection therewith” in international class 41; and, “[s]ecurity services in the nature of security guard services; security consulting services, namely, evaluating and assessing on-site security programs for others; providing property surveillance services, namely, monitoring security systems and security guarding for facilities; security protective services, namely, providing executive protection, personal

security consultation, and personal body guarding” in international class 45. The registrant claims that first use and first use in commerce of this mark, when used in conjunction with all these services, commenced as of February 9, 2009, and February 16, 2009, respectively.

- ii. ALLIEDBARTON EDGE (stylized and with additional textual elements)
United States Registration No.3,751,627; registered: February 23, 2010

This service mark is registered for use in connection with: “[e]ducational services, namely, conducting classes, seminars, conferences, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; providing on-line training classes, courses, seminars, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; training services in the field of security guard and proper surveillance in connection therewith” in international class 41; and, “[s]ecurity services in the nature of security guard services; security consulting services, namely, evaluating and assessing on-site security programs for others; providing property surveillance services, namely, monitoring security systems and security guarding for facilities; security protective services, namely, providing executive protection, personal security consultation, and personal body guarding” in international class 45. The registrant claims that first use and first use in commerce of this mark, when used in conjunction with all these services, commenced as of February 9, 2009, and February 16, 2009, respectively.

- iii. EDGE (block letters)
United States Registration No. 3,722,330; registered: December 8, 2009

This service mark is registered for use in connection with: “[e]ducational services, namely, conducting classes, seminars, conferences, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; providing on-line training classes, courses, seminars, workshops, and podcasts in the field of security guard training and proper surveillance and distributing course materials in connection therewith; training services in the field of security guard and proper surveillance in connection therewith” in international class 41; and, “[s]ecurity services in the nature of security guard services; security consulting services, namely, evaluating and assessing on-site security programs for others; providing property surveillance services, namely, monitoring security systems and security guarding for facilities; security protective services, namely, providing executive protection, personal security consultation, and personal body guarding” in international class 45. The registrant claims that first use and first use in commerce of this mark, when used in conjunction with all these services, commenced as of February 9, 2009, and February 16, 2009, respectively.

B. The Parties and their activities

The Complainant is a North American security services company with more than 200,000 employees. It began its business operations in 2016 as a result of a merger between AlliedBarton Security Services, LLC (“AlliedBarton”) and Universal Services of America, LP. A copy of a press release dated August 1, 2016, announcing the merger appears in Annex 4 to the Complaint. Prior to the merger and since 2009, AlliedBurton had been using its ALLIEDBARTON EDGE mark in conjunction with its service offerings. Following the merger and reflective of its then new corporate name, the Complainant started using the mark ALLIED UNIVERSAL EDGE, rather than the mark ALLIEDBURTON EDGE (though the same additional textual elements were carried over from the latter to the former mark; however, for simplicity, those elements will be ignored hereinafter as they are not the predominant features of the marks), in conjunction with the same services for which the latter mark has been registered. The Complainant currently has a trademark application (serial number 88/350480; filed March 21, 2019) pending before the United States Patent and Trademark Office (US PTO) to register the latter mark. A copy of a record for this application, from a publicly accessible database provided by the US PTO, as well as the application itself all appear in Annex 10 to the Complaint.

Additionally, the Complainant owns and has been using its domain name <allieduniversaledge.exceedlms.com> since at least one month prior to the July 19, 2017, date on which the

Respondent registered the disputed domain name. Currently, as shown by the screenshot appearing in Annex 11 to the Complaint, the Complainant's domain name resolves to the homepage of the Complainant's main corporate website.

As of the date of the Complaint, the disputed domain name resolves to a page of third-party links, some of which are to third-party websites which offer services directly competing with those offered by the Complainant.

On December 12, 2018, the Complainant sent the Respondent, by email, a cease and desist letter which also requested the Respondent to transfer the disputed domain name to the Complainant. The Complainant received no response. Later, on December 28, 2018, and again on January 8, 2019, the Complainant sent follow-up email messages to the Respondent attaching the Complainant's December 12, 2018, letter. No response was received to either of the two subsequent messages. A copy of all this correspondence is provided in Annex 14 to the Complaint.

Finally, as shown in the Whois results provided in Annex 1 to the Complaint, the Respondent has listed the disputed domain name for sale at USD 5,777.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its mark ALLIED UNIVERSAL.

Specifically, the disputed domain name contains this mark to which the term "edge" has been appended. The mere addition of this term to the Complainant's mark is insufficient to negate confusing similarity that exists between the disputed domain name and the Complainant's mark.

Moreover, the Complainant contends that the disputed domain name is identical to its mark ALLIED UNIVERSAL EDGE.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, the Respondent is not affiliated with the Complainant. Further, no evidence exists of record to suggest that the Respondent has registered the disputed domain name to advance any legitimate interests or for a *bona fide* offering of goods or services. As to the latter and as of the date of the Complaint, the Respondent uses the disputed domain name to resolve to a page of third party links to websites, some of which offer services directly competing with security services offered by the Complainant.

Further, since the Respondent anonymously registered the disputed domain name to intentionally mask its identity, the Respondent is not and cannot claim to be commonly known by that name, a name for which it has no legitimate rights.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

When the Respondent registered the disputed domain name, it was fully aware of the Complainant and did so to intentionally exploit, for the Respondent's own benefit, the goodwill and reputation the Complainant has in its marks.

Thereafter and as of the date of the present Complaint, the Respondent uses the disputed domain name to confuse Internet users into believing an association, affiliation, or sponsorship exists between the Respondent and the Complainant when, in actuality, no such relationship exists, and benefits from that confusion. Specifically, Internet users, upon entering the disputed domain name into their browsers, are not taken – contrary to their desire – to a website related to the Complainant but instead are diverted to the Respondent's website where they are presented with third-party links. Some of those links resolve to websites through which third-parties offer services directly competing with those offered by the Complainant and through which the Respondent will commercially benefit.

Furthermore, the disputed domain name is currently being offered for sale for USD 5777, which exceeds its out of pocket costs of registration and further reflects bad faith.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's mark ALLIED UNIVERSAL.

From a simple comparison of the disputed domain name to the Complainant's mark ALLIED UNIVERSAL, no doubt exists that the disputed domain name is confusingly similar to it. The disputed domain name consists of this mark to which the common word "edge" has been added to form a composite term and then to which the generic Top-Level Domain ("gTLD") ".com" has been appended, with the addition of the ".com" being irrelevant in this case in assessing confusing similarity under paragraph 4(a)(i) of the Policy and thus ignored. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), sections 1.7, 1.8, and 1.11.

It is now very well-established in prior UDRP cases, including numerous decisions previously rendered by this Panel, that a minor variation to a mark, including a minor addition to it such as a commonly understood word, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to prevent confusing similarity. The Respondent's addition of the word "edge" to the Complainant's mark to form the disputed domain name unquestionably constitutes such a minor variation. See, e.g., *Esure Insurance Limited v. Istvan Mayer*, WIPO Case No. D2019-0681; *Praxis Capital, Inc. v. John C. Martinez*, *The Praxeology Group LLC*, WIPO Case No. D2019-0254; *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case

No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; and *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148.

Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

Consequently, the Panel sees no need to separately assess and opine on whatever exclusive trademark rights the Complainant possesses in its mark ALLIED UNIVERSAL EDGE and whether, based on the evidence of record, those rights alone would suffice to satisfy section 4(a)(i) as any such discussion is now moot.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's mark ALLIED UNIVERSAL in either a domain name or any other use and has no relationship, affiliation, or connection whatsoever with the Respondent.

Further, in view of the Respondent's default, the Panel accepts as uncontested the Complainant's assertions that the Respondent has never actually used the disputed domain name in connection with a *bona fide* offering of goods or services or made any prior demonstrable preparations to do so but rather only uses the disputed domain name to resolve to a page containing links to third-party sites offering services directly competitive with those of the Complainant. Using a domain name that intentionally infringes the exclusive trademark rights of another, let alone as a vehicle through which directly competitive third-party services are offered, fails to qualify as a *bona fide* use. Nor does such a use constitute either a legitimate noncommercial or fair use of the disputed domain name.

Given the Complainant's exclusive rights in its ALLIED UNIVERSAL mark, which predate the date (July 19, 2019) on which the Respondent registered the disputed domain name, and the recognition, reputation and good-will which the Complainant likely developed in its ALLIED UNIVERSAL Marks, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to those of the Complainant — at least for the security and related services provided by the Complainant under any of these marks — without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Praxis Capital, Inc.* (cited *supra*); *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; and *Esure Insurance Limited, Chicago Mercantile Exchange Inc., Cummins Inc. and Staatliche Porzellan-Manufaktur*, all cited *supra*. Consequently, the Respondent is not commonly known by the disputed domain name or any of the Complainant's marks.

Hence, the Respondent does not fall within any of paragraphs 4(c)(i) to 4(c)(iii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Panel infers, from the lack of any Response, that it is quite likely, that the Respondent was well aware of the Complainant and its mark ALLIED UNIVERSAL, and the exclusive rights which the Complainant then had in that mark when the Respondent registered the disputed domain name. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally registered

the disputed domain name for both its potential to cause confusion with the Complainant's mark and the Respondent's ability to commercially benefit therefrom.

In that regard, the Respondent doubtlessly believed that Internet users, who sought the Complainant's website and were familiar with the Complainant's mark ALLIED UNIVERSAL would be confused, upon entering the disputed domain name into their browsers, by the similarity between the disputed domain name and that mark – inasmuch as the disputed domain name incorporated the mark in its entirety followed by the common word “edge” – and would consequently assume that a relationship of some sort exists between the parties, possibly a sponsorship, affiliation, or endorsement of the Respondent's website by the Complainant, when in fact no such relationship exists at all.

Alternatively, as the Complainant began using its mark ALLIED UNIVERSAL EDGE shortly before the Respondent registered the disputed domain name, which is identical to this mark, it is also reasonable for the Panel to infer the Respondent may well have seen that use, discovered that the disputed domain name was not then registered, and then decided to opportunistically and illicitly exploit the reputation in that exact mark through registering and using the disputed domain name in some fashion that would, to its own commercial benefit, potentially causing user confusion and ultimately injuring the Complainant.

The Respondent's actions in currently using the disputed domain name to resolve to a web page of third-party links to services directly competitive to those of the Complainant and also currently offering the disputed domain name for sale at a price that, in all likelihood, will yield a considerable profit confirms the validity of these inferences.

The Respondent obviously is willing to sell the disputed domain name to a third-party purchaser, which being fully cognizant of its inability to legitimately use the disputed domain name due to an absence of any authorization from the Complainant to use its ALLIED UNIVERSAL mark, may well purchase the disputed domain name with a specific intent of benefiting from deliberately exploiting the disputed domain name's marked potential to produce user confusion. Such confusion would cause Internet traffic destined to the Complainant's website (or one affiliated with or related to the Complainant) to be diverted to that purchaser's website (or one affiliated or related to the purchaser) through which services could be offered that directly compete with those then provided by the Complainant. That, in turn, would deprive the Complainant of resulting business and quite possibly injure its reputation to the Complainant's ultimate detriment.

Alternatively, that purchaser, rather than using the disputed domain name itself to cause and exploit ensuing confusion, might hold the disputed domain name for ransom by eventually offering to sell it to the Complainant at an even higher price than that at which the purchaser acquired it, so that the Complainant could forestall any confusion and injury to its own reputation that might otherwise arise from any unauthorized use of the disputed domain name.

In the meantime, pending any such sale of the disputed domain name to the purchaser, the Respondent is using the disputed domain name to resolve to a web page which provides links to third-parties which offer services directly competing with those offered by the Complainant. By doing so, the Respondent is causing confusion of Internet users who mistakenly enter that disputed domain name into their browsers, expecting to reach the Complainant's website but in actuality do not and instead are diverted to the Respondent's web page. Currently, the Respondent is most likely benefiting, in some fashion – though not specified in the record – each time an Internet user interacts with or transacts business through one of those third-party links. This diversion routes business away from the Complainant which, in the absence of confusion, it would otherwise legitimately receive.

The Respondent's conduct patently violates paragraphs 4(b)(i), (iii) and (iv) of the Policy and consequently reflects bad faith use.

Thus, the Panel concludes that the Complainant has provided sufficient evidence of its allegations, with respect to the disputed domain name to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name <allieduniversaledge.com> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: June 9, 2019