

ADMINISTRATIVE PANEL DECISION

Decentraland Foundation v. Hildegard Gruener

Case No. D2022-0334

1. The Parties

The Complainant is Decentraland Foundation, Panama, represented by Sheppard, Mullin, Richter & Hampton, United States of America (“US”).

The Respondent is Hildegard Gruener, Austria.

2. The Domain Name and Registrar

The disputed domain name <decentraland-com.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 January 29, 2022. On February 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2022, 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, and contact information in the Complaint. The Center sent an email communication to the Complainant on February 3, 2022, 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 amendment to the Complaint on February 4, 2022.

The Center verified that the Complaint together with the amendment to the 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 February 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on March 4, 2022. 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 Decentraland Foundation, is a decentralized 3D virtual reality platform powered by the Ethereum blockchain where users can create virtual structures such as casinos, art galleries, concert halls and theme parks, and charge other players to visit them. Decentraland Foundation is a leading provider of blockchain based products and services, including virtual environment, game, and cryptocurrency offered under its DECENTRALAND and MANA trademarks.

The Complainant holds the US Trademark Registration No. 5682061 for DECENTRALAND (word), registered on February 19, 2019, covering goods and services in International classes 9, 38 and 41.

The Complainant operates its business on the website available at "www.decentraland.org".

The disputed domain name <decentraland-com.com> was registered on March 15, 2021. According to evidence provided as Annex 9 to Complaint, at the time of filing the Complaint, the disputed domain name was not actively used, it only displayed the DECENTRALAND mark and a copyright claim stating "Copyright © 2022 Decentraland. All Rights Reserved."

The Respondent Hildegard Gruener, was involved in at least twelve past UDRP disputes where it was recognized that it is a serial cybersquatter¹. See for example *Trivago N.V. v. Hildegard Gruener*, WIPO Case No. [D2021-4012](#) and cases cited therein.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its trademark DECENTRALAND, the Respondent has no rights or legitimate interests in the disputed domain name, and the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name to it.

B. Respondent

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

6. Discussion and Findings

In view of the absence of a Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

(ii) the respondent has no rights or legitimate interests in the disputed domain name; and

¹ See section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") regarding Panel's powers to conduct limited searches.

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The disputed domain name <decentraland-com.com> reproduces the Complainant's trademark together with the addition of the element "-com". However, such addition does not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether geographical wording, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name is not sufficient to escape a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

Further, it is well established in decisions under the UDRP that the generic Top-Level Domain ("gTLD") (e.g., ".com", ".xyz", ".org") is typically disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that it has given no license or other right to use its trademark to the Respondent, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain names. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP". See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant's contentions to advance a claim to any rights or legitimate interests in the disputed domain name.

Further, there is no evidence before the Panel to suggest that the Respondent has made a *bona fide* use of the disputed domain name, or has been known by this disputed domain name, or is making any legitimate noncommercial or fair use of the disputed domain name.

In fact, at the time of filing the Complaint the disputed domain name was used in connection with a website where the Complainant's mark and a notice of copyright protection for the material presented on such website were displayed, and therefore the Internet users can be misled regarding the relationship between the website corresponding to the disputed domain name and the Complainant and will falsely believe that the website under the disputed domain name belongs to an official, endorsed distributor of the Complainant.

In addition, and without prejudice to the above, UDRP panels have found that domain names identical or highly similar to a complainant's trademark carry a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the

Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds trademark registered rights in DECENTRALAND since 2019.

The disputed domain name was created in 2021 and reproduces the Complainant's trademark together with the element "-com", and is very similar to the corresponding domain name of the Complainant.

From the above, the Panel finds that the disputed domain name was registered in bad faith, with knowledge of the Complainant, its business, and particularly targeting its DECENTRALAND trademark.

According to the case file documents before it, the Panel finds no evidence of actual use of the disputed domain name. From the inception of the UDRP, panels have found that the non-use of a domain name (including a blank or "coming soon" or other similar inactive page) would not prevent a finding of bad faith under the doctrine of passive holding. The Panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith. Examples of what may be relevant circumstances found to be indicative of bad faith include the degree of distinctiveness or reputation of the complainant's mark and the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good faith use. See section 3.3 of the [WIPO Overview 3.0](#). As previously mentioned, the disputed domain name incorporates exactly the Complainant's trademark together with the insignificant element "-com", and the Respondent failed to participate in this proceeding.

As mentioned above under section 6B, the disputed domain name incorporates the Complainant's trademark and the website operated under the disputed domain name displays the Complainant's trademark and claims copyright protection on its content. According to the circumstances listed under paragraph 4(b)(iv) of the Policy, such facts lead the Panel to conclude that the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, very likely for its commercial gain.

Additionally, as mentioned above under section 4, the Respondent has been the subject of adverse decisions in numerous UDRP proceedings where it was recognized that the Respondent is a serial cybersquatter. This falls within the circumstances listed by paragraph 4(b)(ii) of the Policy and demonstrates that the Respondent has engaged in a pattern of bad faith behavior.

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 <decentraland-com.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: March 18, 2022