

ADMINISTRATIVE PANEL DECISION

Discord Inc. v. Aaron Scherer
Case No. D2022-4316

1. The Parties

Complainant is Discord Inc., United States of America (“United States”), represented by BrandIT GmbH, Switzerland.

Respondent is Aaron Scherer, United States.

2. The Domain Name and Registrar

The disputed domain name <discord.bot> is registered with EnCirca, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2022. On November 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 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 named Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to Complainant on November 16, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. On November 19 and 21, 2022, the Center received several email communications from Respondent. Complainant filed an amended Complaint on November 22, 2022.

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 Respondent of the Complaint, and the proceedings commenced on November 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2022. On November 23, 2022, the Center received an email communication from Respondent, however, apart from informal email communications Respondent did not submit any response. Accordingly, the Center notified the commencement of panel appointment process on December 14, 2022.

The Center appointed Phillip V. Marano as the sole panelist in this matter on December 22, 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

Complainant provides a free voice, video, and text messaging application for people to communicate over the Internet. Complainant informs Internet users and potential customers about its services through its official <discord.com> domain name and associated website.

Complainant owns valid and subsisting registrations for the DISCORD trademark in numerous countries, including the trademark for DISCORD (US Reg. No 4,930,980) in the United States, which was registered on April 5, 2016, with the earliest priority dating back to March 2, 2015.

The disputed domain name was registered on December 5, 2017. Prior to the filing of the Complaint, the disputed domain name resolved to an apparent placeholder website displaying the following message: "Hi OwO *Notices your bulge* what's this?" At the time the Complaint was filed, the domain name no longer resolved to any website content.

5. Parties' Contentions

A. Complainant

Complainant asserts ownership of the DISCORD trademark and has adduced evidence of trademark registrations in numerous countries around the world, including the United States and China, with earliest priority dating back to March 2, 2015. The disputed domain name is confusingly similar to Complainant's DISCORD trademark, according to Complainant, because the identical DISCORD trademark is clearly recognizable within the disputed domain name, and the term "bot" is highly relevant to Complainant's services, including its wide use of artificial intelligence tools called "bots" to execute a wide range of tasks.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: Complainant's registration of the DISCORD trademarks long predating Respondent's registration of the disputed domain name; the lack of any evidence that Respondent is known by the term "discord", and conversely ample search engine results for the term "discord" pointing to Complainant; the lack of any license or authorization between Complainant and Respondent; the lack of any trademark applications filed or registrations owned by Respondent; and deactivation of Respondent's website upon filing the Complaint.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: priority of Complainant's trademark registrations versus registration of the disputed domain name; the strong online presence and well-known nature of Complainant's DISCORD trademark, as recognized by prior panel determinations; Respondent's use of a proxy registration service to block or intentionally delay disclosure of its identity; and Respondent's non-use or passive holding of the disputed domain name in connection with a few strings of text and subsequent non-resolution.

B. Respondent

On November 19 and 21, 2022, the Center received several email communications from Respondent. In relevant part, on November 19, 2022, Respondent wrote "I don't understand what this is?" Then on November 21, 2022, Respondent wrote "Doesn't the domain have to be in *use* to be considered a trademark/service mark infringement? Do they just want to buy the domain from me?"

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. The disputed domain name has been registered and is being used in bad faith.

Panels typically treat a respondent's submission of a so-called "informal response" (merely making unsupported conclusory statements and/or failing to specifically address the case merits as they relate to the three UDRP elements, e.g., simply asserting that the case "has no merit" and demanding that it be dismissed) in a similar manner as a respondent default. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), Section 4.3.

Although Respondent did not formally reply to Complainant's contentions, the Panel takes note of the contents of the Respondent's informal communications, and furthermore notes that the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g., where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See [WIPO Overview 3.0](#), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the DISCORD trademark (US Reg. No 4,930,980) has been registered in the United States since April 5, 2016, with the earliest priority dating back to March 2, 2015. Thus, the Panel finds that Complainant's rights in the DISCORD trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's DISCORD trademark.

In this Complaint, the disputed domain name is confusingly similar to Complainant's DISCORD trademark because, disregarding the ".bot" generic Top-Level Domain ("gTLD"), the identical entirety of the trademark is contained within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".bot" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant has made out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any such relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. See WIPO Overview, section 2.1.

It is evident that Respondent, identified by Whois data for the disputed domain name as “Aaron Scherer”, is not commonly known by the disputed domain name or Complainant’s DISCORD trademark.

Based on the undisputed facts and circumstances in the record before it, the Panel finds that Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. This is especially the case where a disputed domain name is so obviously connected with a complainant and its products, the very use by a registrant with no connection to a complainant suggests opportunistic bad faith.

The Panel concludes from the record that Respondent had Complainant’s DISCORD trademark in mind when registering the disputed domain name, and that Respondent most likely registered the disputed domain name in order to exploit and profit from Complainant’s trademark rights. Indeed, a respondent who knowingly adopted a third party’s well-known mark as a domain name cannot claim the benefit of Paragraph 4(c)(i) of the Policy to establish rights to the domain name based on its mere use of the domain name to offer goods or services prior to the notice of a dispute. *Scania CV AB v. Leif Westlye*, WIPO Case No. [D2000-0169](#); see also *Drexel University v. David Brouda*, WIPO Case No. [D2001-0067](#) (rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the complainant).

In addition, as addressed in further detail below with respect to the third element of the Policy, passively holding a domain name in and of itself does not constitute a *bona fide* offering of goods or services. *Philip Morris USA Inc. v. Gabriel Hall*, WIPO Case No. [D2015-1779](#) (January 22, 2016).

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

Where a complainant's trademark is widely known, including in a particular industry, and a respondent cannot credibly claim to have been unaware of complainant, panels have inferred the respondent knew, or should have known, that their registration would be identical or confusingly similar to a complainant's trademark. Furthermore, where parties are both located in the United States and the complainant has obtained a federal trademark registration pre-dating a respondent's domain name registration, panels have applied the concept of constructive notice, subject to the strength or distinctiveness of the complainant's trademark, or circumstances that corroborate respondent's awareness of the complainant's trademark. [WIPO Overview 3.0](#), section 3.2.2.

In this Panel's view, when the disputed domain name was registered on December 5, 2017, Respondent would have had knowledge of Complainant's pre-existing rights in Complainant's DISCORD trademark under United States law because it had been duly registered in the United States and had been in use in the United States even prior to the registration. See e.g., *Champion Broadcasting System, Inc. v. Nokta Internet Technologies*, WIPO Case No. [D2006-0128](#) (Applying the principle of constructive notice where both parties are located in the United States). The Panel also notes the Respondent's email asking about whether the domain name had to be in use to constitute infringement, and inquiring about selling the disputed domain name; nowhere does the Respondent claim not to have been aware of the Complainant.

Indeed, the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (particularly where no conceivable good faith use could be made). [WIPO Overview 3.0](#), Section 3.1.4. Complainant has adduced evidence of recognition of the DISCORD trademark and cited at least one WIPO panel determination in agreement that Complainant's DISCORD trademark is considered to be "well-known" for purposes of the Policy. See e.g. *Discord Inc. v. Domain Administrator, See PrivacyGuardian.org / Maven Pos Service LLP, Tilek Suierkulov*, WIPO Case No. [D2021-0893](#) (Finding "the trademark DISCORD is well-known in the market of messaging and chat services"). As such, the Panel finds it is unconceivable that Respondent could have registered the disputed domain name in 2017 without knowledge of Complainant's DISCORD trademark, without any intention to benefit from confusion with Complainant's DISCORD trademark.

Moreover, passively holding a domain name does not prevent a finding of bad faith. WIPO Overview, section 3.3. This includes domain names that do not resolve to any website content as well as domain names that are parked with a "coming soon" message or other similar content like "Hi OwO *Notices your bulge* what's this?" Where a domain name is being passively held, as in this case, bad faith registration and use exists based upon: (i) the degree of distinctiveness or reputation of the complainant's mark; (ii) the failure of the respondent to submit any response or offer any credible evidence of rights or legitimate interests; (iii) the respondent's concealing its identity or use of false contact details; and (iv) the implausibility of any good faith use which the domain name may be put. See *id. Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) ("A remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith.")

To that end, the Panel acknowledges the prior panel determination under the Policy cited by Complainant concluding that Complainant's DISCORD trademark is "well-known." In the Panel's view, this same prior panel determination, coupled with Complainant's portfolio of trademark registrations for Complainant's DISCORD trademark, make any good faith use of the disputed domain name relatively implausible. Furthermore, the Panel acknowledges Respondent's failure to offer any credible evidence of rights or legitimate interests. And finally, the Panel acknowledges Respondent's either intentional or default use of a proxy registration service, thus concealing its identity from Complainant.

In view of the foregoing, the Panel concludes that 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 <discord.bot> be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: January 10, 2023