

## **ADMINISTRATIVE PANEL DECISION**

Modernatx, Inc. v. Registration Private, Domains By Proxy, LLC / Andrew Chen

Case No. D2022-3189

### **1. The Parties**

The Complainant is Modernatx, Inc., United States of America (the “United States”), represented by SILKA AB, Sweden.

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Andrew Chen, United States.

### **2. The Domain Name and Registrar**

The disputed domain name, <modernabooster.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 August 29, 2022. On August 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 30, 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 September 2, 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 September 7, 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 September 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 3, 2022.

The Center appointed Dennis A. Foster as the sole panelist in this matter on October 6, 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, a famous company based in the United States, develops and markets worldwide various medical products, including a COVID-19 vaccine. The Complainant conducts its operations under its MODERNA trademark, which has been registered with trademark authorities globally, including with the United States Trademark and Patent Office (“USPTO”) (e.g., Registration No. 4569803; registered on December 23, 2014).

The Respondent owns the disputed domain name, <modernabooster.com>, which was registered on March 16, 2021. The disputed domain name is attached to a passive website that provides a redirection to another website that in turn offers the disputed domain name for sale at a price of USD 10,000.

#### **5. Parties’ Contentions**

##### **A. Complainant**

- The Complainant is a United States company that develops and markets medicines based on messenger DNA. Those medicines include the Complainant’s COVID-19 vaccine, of which more than 800 billion doses were shipped worldwide in 2021. In that year, the Complainant’s total sales were approximately USD 18.5 billion.
- The Complainant operates under its world-famous MODERNA trademark, which has been registered globally, including with the USPTO.
- The disputed domain name is confusingly similar to the Complainant’s MODERNA trademark. Fully incorporated within the disputed domain name, the mark is the first and dominant feature of the disputed domain name. The generic term “booster”, which is clearly related to the Complainant’s vaccine products, creates no meaningful distinction between the disputed domain name and the Complainant’s trademark. Moreover, the additional generic Top-Level Domain (“gTLD”), “.com”, is also irrelevant in this comparison.
- The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not a licensee of the Complainant and has received no consent or permission from the Complainant to use the MODERNA mark in any way. The Respondent has no trademark rights relative to the disputed domain name, and has not been commonly known by that name. The disputed domain name is used in connection with a passive website that suggests a false affiliation with the Complainant and contains a redirect to a sale offer of USD 10,000 for the disputed domain name, all of which fails to comport with a legitimate or fair use of the disputed domain name.
- The Respondent registered and is using the disputed domain name in bad faith. The Respondent was clearly aware of the Complainant’s world-famous MODERNA trademark when registering the disputed domain name. The Respondent most certainly registered the disputed domain name with the intent to sell it in bad faith for USD 10,000, which is far more than the Respondent’s out-of-pocket costs relating to the disputed domain name.

##### **B. Respondent**

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

## 6. Discussion and Findings

Pursuant to Policy paragraphs 4(a)(i) - (iii), the Panel may find for the Complainant and grant it a transfer of the disputed domain name if the Complainant demonstrates that:

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

### A. Identical or Confusingly Similar

The Panel determines that the Complainant's registration of the MODERNA trademark with the USPTO establishes the Complainant's rights in that mark for the purposes of Policy paragraph 4(a)(i). See *LO 337 IP Holding, LLC v. John Williams, J Entertainment ATL / John Williams, J*, WIPO Case No. [D2019-2339](#) ("The Panel concludes that Complainant has rights in the mark WORLD STAR HIP HOP through registration with the USPTO."); and *DIRECTV, LLC v. Net Manager, Xwings Domains*, WIPO Case No. [D2015-0551](#) ("The Panel accepts that a valid USPTO registration for a mark 'establish[es] that the Complainant has sufficient rights in that mark for the purpose of paragraph 4(a)(i) of the Policy.'").

Because the disputed domain name adds the term "booster" to the Complainant's MODERNA trademark, the Panel concludes that the two are not identical under the Policy. However, the Panel believes that the disputed domain name should be considered confusingly similar to the mark, since the MODERNA trademark remains recognizable despite the additional term. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8. The Panel also notes that the added gTLD, ".com", does not affect the determination of confusing similarity as such additions are required of all domain names. See *Pentair Flow Service AG v. Michael Evingham*, WIPO Case No. [D2017-0966](#) (finding <pentairboosterpumps.com>, among other disputed domain names, to be confusingly similar to the PENTAIR mark); and *Fendi Srl v. Ren Fu Rong(任芙蓉)*, WIPO Case No. [D2021-2115](#) ("A gTLD suffix is normally disregarded in the comparison between a disputed domain name and a trademark for the purposes of the first element of the Policy.").

Accordingly, the Panel finds that the Complainant has demonstrated that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

### B. Rights or Legitimate Interests

Though the Policy places on a complainant the burden of proving that a respondent has no rights or legitimate interests in a disputed domain name, the consensus of UDRP decisions is that a complainant need present only a *prima facie* case that the respondent does not have those rights or legitimate interests before the burden of productions shifts to the respondent to produce convincing evidence of such rights or legitimate interests. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.1; and *Colbeck Capital Management, LLC v. Contact Privacy Inc. Customer 1245253802 / Name Redacted*, WIPO Case No. [D2019-2796](#) ("Once such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name.").

The Complainant has demonstrated to the Panel that the disputed domain name is confusingly similar to the MODERNA trademark, and has asserted clearly that the Respondent was not granted consent or permission by the Complainant to use that mark. As a result, the Complainant has met the standard necessary for a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

Because the Respondent has filed no Response, the Panel will determine whether a plausible rebuttal to the

Complainant's *prima facie* case exists based on all reasonable information found within the Complaint while drawing such inferences as may be appropriate. See [WIPO Overview 3.0](#), section 2.1 ("The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed.").

The Complaint provides the Panel with evidence that the disputed domain name is used to host a website that offers no goods or services but does contain a link to another website at which the disputed domain name is offered for sale at a suggested price of USD 10,000. This usage certainly fails to comply with the criteria (*i.e.*, "a *bona fide* offering of goods or services") listed in Policy paragraph 4(c)(i) that might confer rights or legitimate interests on the Respondent. Moreover, the Panel finds it unlikely that the Respondent, Andrew Chen, is commonly known as <modernabooster.com>, which means that Policy paragraph 4(c)(ii) is inapplicable as well. Finally, the Respondent's use does not constitute a "legitimate noncommercial or fair use" of the disputed domain name per Policy paragraph 4(c)(iii). Therefore, not finding pertinent contradictory evidence in the Complaint or in any other portion of the Record in this case, the Panel concludes that the Complainant's *prima facie* case cannot be rebutted. Moreover, considering the composition of the disputed domain name, which combines the distinctive MODERNA mark with the term "booster" descriptive of the "booster shots" provided by the Complainant, the disputed domain name is such to carry a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainant has demonstrated that the Respondent has no rights or legitimate interests in the disputed domain name.

### **C. Registered and Used in Bad Faith**

As noted above, the Panel has determined that the disputed domain name is linked ultimately to a website that solicits a sales price of USD 10,000 for the disputed domain name. Since this price is well in excess of the Respondent's likely out-of-pocket costs necessary to register the disputed domain name, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith pursuant to Policy paragraph 4(b)(i). See *Klarna Bank AB v. Super Privacy Service LTD c/o Dynadot / lin yanxiao*, WIPO Case No. [D2021-2153](#) ("...Respondent's registration of the disputed domain name with intent to profit by exploiting Complainant's trademark and selling the disputed domain name constitutes bad faith registration and use under paragraph 4(b)(i) of the Policy."); and *Audi AG v. Claus Linder*, WIPO Case No. [D2016-1579](#) ("Previous UDRP panels have held that an offer to sell for in excess of out-of-pocket costs supports a finding of bad faith under paragraph 4(b)(i) of the Policy, as appears to be the case here.").

The Panel also notes that the Complainant and its trademark are famous throughout the world, especially in light of the COVID-19 pandemic. That status by itself suggests to the Panel that any entity not affiliated with or licensed by the Complainant that registers and uses a domain name that is confusingly similar to that trademark has done so in bad faith. Several other UDRP panels have reached the same conclusion with respect to bad faith registration and use of disputed domain names relative to the Complainant's mark. See *Moderna, Inc., ModernaTX, Inc. v. Super Privacy Service LTD c/o Dynadot / Shawn Wang*, WIPO Case No. [D2022-2125](#) ("The registration of a domain name, confusingly similar to a third party's well-known trademark, without authorization, or rights or legitimate interests in the domain name, can create a presumption of registration in bad faith by itself."); *Modernatx, Inc. v. Whois Privacy, Private by Design, LLC / hggfdd bchgugugh*, WIPO Case No. [D2022-2111](#) ("The Complainant's MODERNA-formative marks are very well known in the United States and globally, due to the COVID-19 pandemic and the Complainant's successful vaccine."); and *Modernatx, Inc. v. YangZhiChao*, WIPO Case No. [D2022-1552](#). Furthermore, particularly given the construction of the disputed domain name, combining the term "booster" with the Complainant's mark, the Respondent was evidently aware of and intended to target the Complainant when registering the disputed domain name.

Accordingly, the Panel finds that the Complainant has demonstrated that the disputed domain name was registered and is being used in bad faith.

## 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, <modernabooster.com>, be transferred to the Complainant.

*/Dennis A. Foster/*

**Dennis A. Foster**

Sole Panelist

Date: October 20, 2022