

ADMINISTRATIVE PANEL DECISION

Decentraland Foundation v. Darrin Cheney

Case No. D2022-0453

1. The Parties

Complainant is Decentraland Foundation, United States of America (“United States” or “U.S.”), represented by Sheppard, Mullin, Richter & Hampton, United States.

Respondent is Darrin Cheney, United States.

2. The Domain Name and Registrar

The disputed domain name <decentraland.org> is registered with Nicenic International Group Co., Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2022. On February 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 2022, the Registrar transmitted by email to the Center its verification response confirming that 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” 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 February 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 17, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 8, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on April 14, 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

Without contest by Respondent, Complainant asserts in its Complaint and its attached Annexes provide evidence sufficient to support that:

Complainant is a Panama-based provider of blockchain centered products and services offered under its trademark DECENTRALAND (the “DECENTRALAND Mark”). Complainant’s services include a decentralized 3D virtual reality platform or “metaverse” 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. Complainant claims notoriety and recognition of its brand based on content featuring its services under the DECENTRALAND Mark in third party crypto focused websites and publications displayed in the Annexes to its Complaint.

Complainant provides access to its virtual reality environment and related blockchain based services under the DECENTRALAND Mark through its official website located at “<https://decentraland.org/>” (the “Official DECENTRALAND Website”) based on its ownership of the domain name <decentraland.org>.

Complainant owns United States Trademark Registration No. 5,682,061, DECENTRALAND, registered with the United States Patent and Trademark Office (“USPTO”) on February 19, 2019, for a range of products and services, including computer games, data transfer and virtual environment entertainment services in international classes 9, 38 and 41 respectively, and claiming a first use date of January 1, 2017, through its predecessor in interest pursuant to an assignment recorded with the USPTO.

The disputed domain name was registered on December 29, 2021, and as of the time the Complaint was filed resolved to a page provided by Respondent’s web hosting service provider flagging Respondent’s website as a phishing site, stating, “WARNING, Suspected Phishing Site Ahead!”. Complainant asserts that prior to the host’s posting of this warning the disputed domain name resolved to “a copycat website, with content impersonating Complainant and using the DECENTRALAND Mark to solicit a wallet connection and the transfer of funds and personal information from deceived consumers”.

5. Parties’ Contentions

A. Complainant

Complainant contends that the disputed domain name is identical or confusingly similar to Complainant’s trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

There are no exceptional circumstances within paragraph 5(e) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint (as amended), notwithstanding the failure of any person to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall “draw such inferences therefrom as it considers appropriate”.

Where no substantive Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied.

Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights and has, therefore, met its burden under paragraph 4(a)(i) of the Policy; and

Complainant has, to the satisfaction of the Panel, shown that Respondent has no rights or legitimate interests in respect of the disputed domain name and has, therefore, met its burden under paragraph 4(a)(ii) of the Policy; and

Complainant has, to the satisfaction of the Panel, shown that the disputed domain name has been registered and is being used in bad faith and has, therefore, met its burden under paragraph 4(a)(iii) of the Policy.

The Panel will address its findings on each of these requirements in more detail below.

The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.2.

A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant claims trademark rights in the word DECENTRALAND for various computer game products, and related data transfer virtual environment entertainment services dating back to 2017. Sufficient evidence has been submitted, in the form of an electronic copy of a USPTO trademark registration certificate, showing a U.S. Trademark Registration for the DECENTRALAND Mark in the name of Complainant. Complainant has through such valid and subsisting trademark registration demonstrated its rights in the DECENTRALAND Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant’s rights in the DECENTRALAND Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant’s DECENTRALAND Mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7. Prior UDRP panels have also held “in 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 to that mark for purposes of UDRP standing”. See, *id.*

A side by side comparison between the disputed domain name and the DECENTRALAND Mark shows the disputed domain name consists of the DECENTRALAND Mark in its entirety and is essentially identical but for a misspelling by removing the letter “r” and adding an extra letter “l”. Complainant contends this misspelling is intentional on the part of Respondent and an obvious attempt to pass off the disputed domain name as Complainant’s <decentraland.org> domain used to access the Official DECENTRALAND Website.

The consensus view among previous UDRP panels is that “a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element”. [WIPO Overview 3.0](#), section 1.9; see also *First American Financial Corporation v. VistaPrint Technologies Ltd*, WIPO Case No. [DCO2016-0008](#).

Finally, prior UDRP panels have found that the applicable Top-Level Domain (“TLD”) is viewed as a standard registration requirement and as such is disregarded under the first element’s confusing similarity test. Accordingly, the TLD “.com” does not avoid a finding of confusing similarity. See, [WIPO Overview 3.0](#), section 1.11; see also *Research in Motion Limited v Thamer Ahmed Alfarshooti*, WIPO Case

No. [D2012-1146](#).

Finally, the Top-Level Domain (“TLD”) in a domain name (e.g., “.com”, “.org”, “.club”) is viewed as a standard registration requirement; as such, it is disregarded under the paragraph 4(a)(i) analysis. Accordingly, the TLD of the disputed domain name here, “.org”, does not avoid a finding of confusing similarity. See, [WIPO Overview 3.0](#), section 1.11; see also *Research in Motion Limited v Thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#).

In light of the above, the Panel finds the disputed domain name confusingly similar to the DECENTRALAND Mark in which Complainant possesses rights and Complainant has thus satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, the complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, upon which the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the dispute domain name. If the respondent fails to come forward with such evidence, a complainant is generally deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also, *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under paragraph 4(c)(i), is where “before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services”. Here, the annex to the Complaint shows the Respondent is using the disputed domain name to resolve to a website operated as a “phishing site” as flagged by the third party service provider responsible for hosting Respondent’s website. Complainant has asserted, and Respondent has not refuted, that prior to the current web page, the disputed domain name resolved to “a copycat website, with content impersonating Complainant and using the DECENTRALAND Mark to solicit a wallet connection and the transfer of funds and personal information from deceived consumers”. Complainant submits into evidence, however, only a screenshot of the hosting provider’s current phishing site warning, which users encounter when attempting to access Respondent’s website.

Prior UDRP Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1; see also, *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#). Respondent has filed no Response, nor has it made any other submission in this case. Based on the available evidence, the Panel concludes that Respondent is using the disputed domain name as part of a phishing scheme to seek financial or other confidential information from those diverted Internet users who are trying to reach Complainant but, due to the confusing similarity of the disputed domain name with Complainant’s DECENTRALAND Mark, would end up at Respondent’s phishing site and but for the host’s warning, be subjected to Respondent’s phishing scam. Such activity is not a *bona fide* offering of goods or services and so it does not afford Respondent any rights or legitimate interests in the disputed domain name.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant states that “Respondent has not received authorization or a license to use any of the Decentraland Marks, [. . .] has not in any other way been permitted by Decentraland to use its trademarks, or to register any domain names incorporating the Decentraland Marks”. Complainant has submitted a copy of the Whois record for the disputed domain name and this only identifies the Registrant

Organization of the disputed domain name as “Derrin Cheney”. Thus, there is no evidence in this case to suggest that Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use Complainant’s trademark, or that it has acquired any trademark rights relevant thereto. As such, this sub-section of the Policy is of no help to Respondent.

It is generally regarded as *prima facie* evidence of no rights or legitimate interests if a complainant shows that the disputed domain name is identical or confusingly similar to the complainant’s trademark, that the respondent is not commonly known by the disputed domain name, and that the complainant has not authorized the respondent to use its mark (or an expression which is confusingly similar to its mark), whether in the disputed domain name or otherwise. See, *Roust Trading Limited v. AMG LLC*, WIPO Case No. [D2007-1857](#).

As to the third and final example under paragraph 4(c)(iii) of the Policy, there is no evidence that Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish Complainant’s trademark. As the disputed domain name resolves to a website flagged as part of a phishing scheme, this does not rebut Complainant’s assertion that its use is not fair as Respondent’s activity appears to be clearly intended for its illegitimate commercial gain and does not fit into any accepted category of fair use such as news reporting, commentary, political speech, education, nominative or generic use, etc. See *CMA CGM supra* (phishing scam cannot be considered legitimate noncommercial or fair use); see also, *Springer Nature Limited v. Registration Private, Domains By Proxy, LLC / Collections Springer Nature*, WIPO Case No. [D2020-0955](#).

In addition, the Panel notes that the composition of the disputed domain name carries a risk of implied affiliation with Complainant. [WIPO Overview 3.0](#), section 2.5.1.

In light of the above, and with no Response or other submission in this case to rebut Complainant’s assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent does not have any rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#). Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent, including:

- (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’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 the registrant’s website or location or of a product or service on the registrant’s website or location.

Complainant first contends that given the notoriety and brand recognition and almost five years of use by Complainant of the DECENTRALAND Mark before registration of the disputed domain name, Respondent had actual knowledge of Complainant’s rights when it registered the disputed domain name, which knowledge proves bad faith registration. Complainant also relies upon its assertion that before being flagged as a phishing scam as shown in a Complaint annex, the disputed domain name resolved to a copycat website that impersonated the Official DECENTRALAND Website and used the DECENTRALAND Mark.

Prior UDRP panels have held that actual and constructive knowledge of a complainant’s rights at the time of registration of a domain name constitutes strong evidence of bad faith. See [WIPO Overview 3.0](#), section 3.2.2. See also *eBay Inc. v. Sunho Hong*, WIPO Case No. [D2000-1633](#) (“actual or constructive

knowledge of Complainant's rights in the Trademarks is a factor supporting bad faith").

Complainant has submitted as annexes copies of its above-mentioned trademark registration, a screenshot of its "https://decentraland.org/" Official DECENTRALAND Website home page, a cryptocurrency web page and an article explaining the operation of its virtual environment platform, all of which clearly exhibit rights in its claimed trademark. However, this limited evidence, alone, does not adequately speak to the reputation that the trademark may have achieved with the relevant segment of the public. Neither is there any evidence of the copycat site Complainant claims pre-dated the current phishing site warning page.

Nevertheless, in spite of these evidentiary weaknesses requiring substantial inferences, the facts that are well supported appear sufficient to find bad faith registration. Prior UDRP panels have held that a respondent's selection of a disputed domain name that comprises the complainant's mark in its entirety demonstrates a respondent's actual knowledge to support a finding of bad faith in registering and using the domain. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v. Mark Lott*, WIPO Case No. [D2000-1487](#).

Complainant's DECENTRALAND Mark is somewhat distinctive, the disputed domain name incorporates the mark in its entirety and is essentially identical to both Complainant's Mark and its <decentraland.org> domain name, except for a two-letter alteration representing an intentional misspelling. With no explanation or submission from Respondent to dispute Complainant's assertions or the presented facts of this case, and the somewhat narrow field of decentralized blockchain metaverse services in which Complainant operates, this Panel finds it reasonable to conclude that it is more likely than not that Respondent registered the disputed domain name with actual knowledge of Complainant's trademark rights.

The Panel finds that Respondent's registration of the disputed domain name with awareness of Complainant and the DECENTRALAND Mark, and with the absence of its own rights or legitimate interests, amounts to registration in bad faith by Respondent. See *Royds Worthy King LLP v. Help Tobuy*, WIPO Case No. [D2019-0624](#).

Complainant also contends under this element of the Policy that Respondent's two letter alteration amounts to typosquatting, the practice of registering a domain name in an attempt to take advantage of internet users' typographical errors. Previous UDRP panels have found that if a respondent has engaged in typosquatting, that is sufficient to establish registration and use in bad faith. See [WIPO Overview 3.0](#), section 1.9; See also, *Barnes & Noble College Bookstores, Inc. v. Oleg Techino*, WIPO Case No. [D2006-1537](#); and *Humana Inc. v. Cayman Trademark Trust*, WIPO Case No. [D2006-0073](#).

Complainant also contends Respondent's efforts to misappropriate Complainant's DECENTRALAND Mark, capitalize on consumer confusion, and divert unsuspecting Internet users to what is clearly a phishing site, flagged as such by Respondent's own web hosting provider, which undoubtedly constitutes bad-faith registration and use of the contested domain name under paragraph 4(b)(iv) of the Policy.

Panels under the Policy have found the registration and use of a domain name that is confusingly similar to a complainant's trademark to constitute bad faith use pursuant to paragraph 4(b)(iv) of the Policy where, as here, the disputed domain name is used to direct Internet users to a website engaged in illegitimate or malicious conduct such as phishing. See, *CMA CGM, supra*.

The Panel finds Complainant's arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied paragraph 4(a)(iii) 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, <decentalland.org> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: April 28, 2022