

ADMINISTRATIVE PANEL DECISION

Modernatx, Inc. v. Brandice Henderson
Case No. D2022-1525

1. The Parties

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

Respondent is Brandice Henderson, United States.

2. The Domain Name and Registrar

The disputed domain name <modernatx.com> is registered with Domain.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 27, 2022. On April 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 28, 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 Complainant on April 28, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 29, 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 May 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 23, 2022.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on May 26, 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 is owner of registration for the word trademark MODERNA on the Principal Register of the United States Patent and Trademark Office (USPTO), registration number 4659803, registration dated December 23, 2014, in international class (IC) 1, covering, *inter alia*, biochemicals for research and manufacturing of pharmaceuticals and diagnostic treatments. In addition to the word trademark, Complainant owns registration for the word and design trademark MODERNA at the USPTO, including registration number 4675783, registration dated January 20, 2015, in IC 1. Complainant owns registration of the word and device trademark MODERNA as an International Trademark under the Madrid System, registration number 1293063, registration dated January 7, 2016, in ICs 1, 5, 42, covering various nucleic acids and processes relating thereto. Designations include Australia, Canada, China, the European Union, Japan, Singapore and the United States. Complainant has provided evidence of additional registrations of MODERNA and MODERNA-formative trademarks.

Complainant is a US-based biotechnology company focusing on the development of medicines based on messenger RNA (mRNA). Complainant successfully developed a vaccine for use in the prevention and/or mitigation of infection by SARS-CoV-19 (manifesting as COVID-19). The MODERNA COVID-19 vaccine was and is widely distributed and used in the United States and other countries around the world. Complainant indicates that in 2021 more than 800 million doses of its COVID-19 vaccine were shipped globally.

The Panel takes administrative notice that the MODERNA trademark has become well-known in the United States and globally based on the extensive public reporting associated with the development and distribution of the MODERNA COVID-19 vaccine used to address the COVID-19 pandemic.

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to that verification the disputed domain name was registered on April 4, 2022. There is no indication on the record of this proceeding that any person other than Respondent was or is registrant of the disputed domain name.

The disputed domain name has been and is directed to a webpage indicating that "This site is temporarily unavailable" and linking to information concerning third-party website hosting.

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

5. Parties' Contentions

A. Complainant

Complainant alleges that it owns rights in the MODERNA trademark and that the disputed domain name is confusingly similar to that trademark.

Complainant contends that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Complainant has not authorized Respondent to use its MODERNA trademark or its company name "Modernatx" in the disputed domain name; (2) Respondent does not hold trademark rights in the disputed domain name or in the term "modernatx"; (3) Respondent has not been commonly known by the disputed domain name or Complainant's company name; (4) the disputed domain name has no meaning in

the English language, nor does Complainant's company name; (5) there is no evidence of use or preparations to use the disputed domain name by Respondent for a *bona fide* offering of goods or services; (6) there is no evidence of a legitimate noncommercial or fair use of the disputed domain name by Respondent, and (7) given the appropriation of Complainant's well-known mark in the disputed domain name there is a high risk of association between the disputed domain name and Complainant.

Complainant argues that Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent's registration of the disputed domain name substantially post-dates Complainant's registration of its trademark; (2) given the well-known character of Complainant's trademark, Respondent could not reasonably have been unaware of Complainant's trademark when it registered the disputed domain name; (3) the disputed domain name appears to embody a deliberate misspelling of Complainant's trademark and company name; (4) registration of Complainant's well-known trademark in the disputed domain name creates a presumption of Complainant's bad faith; (5) passive holding of the disputed domain name in circumstances such as those present here constitutes bad faith; (6) Respondent's use of a privacy service may constitute evidence of bad faith, and; (7) Respondent's association of an MX record with the disputed domain name suggests that Respondent may intend to use the disputed domain name to transmit deceptive emails.

Complainant requests the Panel to direct the registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical addresses provided in its record of registration. Courier delivery of the Complaint to Respondent was successfully completed, and there is no indication of difficulties in the transmission to Respondent of email. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant has provided substantial evidence of rights in the trademark MODERNA, including by registration at the USPTO, by registration as an International Trademark, and through use in commerce in the United States and other countries (see Factual Background supra). Respondent has not challenged

Complainant's assertion of trademark rights. The Panel determines that Complainant owns rights in the trademark MODERNA.

The disputed domain name directly and fully incorporates Complainant's MODERNA trademark, except that the letter "r" is repeated. The direct and full incorporation of Complainant's trademark by Respondent in the disputed domain name is sufficient to establish confusing similarity within the meaning of the Policy. Where, as here, a single repeated letter is added, this does not preclude a finding of confusing similarity. The visual impression of the disputed domain name maintains a high level of similarity with Complainant's trademark. The addition in the disputed domain name of the letters "tx" do not prevent a finding of confusing similarity. The Panel determines that the disputed domain name is confusingly similar to Complainant's MODERNA trademark.

Complainant has established that it owns rights in the trademark MODERNA and that the disputed domain names is confusingly similar to that trademark.

B. Rights or Legitimate Interests

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above in section 5.A, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not replied to the Complaint, and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent's use of the disputed domain name to direct Internet users to an inactive webpage does not establish rights or legitimate interests in favor of Respondent. It does not constitute a *bona fide* offering of goods or services or a fair use of the disputed domain name or Complainant's trademark.

Respondent's use of the disputed domain names does not otherwise manifest rights or legitimate interests.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain name "has been registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that "for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith". These include, "(i) circumstances indicating that [the respondent has] registered or [has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; ... or (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location".

Complainant's MODERNA trademark was very well-known in the United States (where Respondent apparently resides) in April 2022 when Respondent registered the disputed domain name. Given that the disputed domain name virtually replicates Complainant's company name, "Modernatx", there is little reason to doubt that Respondent was specifically targeting Complainant and its trademark when it registered the disputed domain name.

The elements listed in paragraph 4(b) of the Policy are illustrative, not exhaustive. There is scant evidence on the record of this proceeding as to why Respondent decided to register the disputed domain name confusingly similar to Complainant's trademark and company name. Respondent had notice and opportunity to present evidence to the Panel regarding its motive for such registration. The possibility that Respondent might have used the disputed domain name in good faith is remote, and the Panel declines to speculate regarding what such a use might be. In light of the prevalence of abuse of domain names confusingly similar to well-known marks for the purpose of undertaking deceptive practices - such as transmitting emails intended to mislead and defraud recipients - the Panel finds that Respondent registered and is using the disputed domain name in bad faith. Respondent has not attempted to justify itself, and the Panel infers from that there is no legitimate justification for its registration and use of the disputed domain name.

The Panel finds that Complainant has demonstrated that Respondent registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(b) 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 <modernatx.com> be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: June 9, 2022