

ADMINISTRATIVE PANEL DECISION

Discord Inc. v. Audun Hilden
Case No. D2022-1112

1. The Parties

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

The Respondent is Audun Hilden, Norway.

2. The Domain Name and Registrar

The disputed domain name <discord.style> is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 31, 2022. On April 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 4, 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 April 5, 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 amended Complaint on April 6, 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 the Respondent of the Complaint, and the proceedings commenced on April 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 27, 2022. The Response was filed with the Center on April 8, 2022.

The Center appointed Antony Gold as the sole panelist in this matter on April 29, 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.

Both parties have filed supplemental responses which, having regard to its powers and responsibilities under paragraph 10 of the Rules, and to the extent that they are not repetitive of the parties' initial submissions, the Panel has exercised its discretion to consider.

4. Factual Background

The Complainant has designed and distributes a free voice, video, and text chat application. The Complainant's application was first created in 2015, primarily to enable video game players to communicate with each other whilst playing games online. Its uses have since extended and, in 2020, the Complainant had 300 million registered users including more than 14 million daily active users. The Complainant is active on social media and via its websites. Within the platform architecture, chat room and voice chat channels are organized by users into collections known as servers.

The Complainant's application is branded as DISCORD and the Complainant has secured many trade mark registrations to protect this trading style. These include, by way of example only, United States Service Mark, registration number 4930980, for DISCORD, in classes 9 and 38, registered on April 5, 2016. The Complainant also owns many domain names which comprise or include its mark, including <discord.com> and <discordapp.com>, which resolve to a website providing information about the Complainant's products and services and a facility for downloading the Complainant's application.

The disputed domain name was registered on March 11, 2019. As at the date of filing the Complaint, it resolved to a website headed "Welcome to Discord.Style!", underneath which appeared the words "Browse our extensive collection of Discord templates, all for free!". A variety of templates for use in conjunction with the Discord app, which appear to have been created by users of the Respondent's website, have been posted, a typical example of which is "fairycore temp" which is described as "a great way to get along with people through discord!". At the very foot of the webpage was a copyright notice; "© 2021 discord.style All Rights Reserved."

The screen prints of the Respondent's website provided by the Complainant do not contain any "About us" section or other information concerning its owner and operator. An earlier version of the Respondent's website contained, in very small and faint type at the bottom of the webpage, a brief disclaimer which stated: "Not affiliated with Discord". At some point the Respondent's website was updated and these words were removed, possibly through inadvertence. Subsequent to the filing of the Complaint, and in response to it, the Respondent's website was updated to include a second form of disclaimer which stated; "discord.style is not affiliated with Discord.com. We're a platform for Discord users to share their templates". The Respondent's website now features a third form of disclaimer, which appears in small font at the very foot of the home page and which reads: "The project and people involved are not sponsored, affiliated or endorsed by Discord in any way. Be aware, Discord do not endorse the content of this website nor are responsible for this website content". The main greeting on the home page now reads, in large font: "Welcome to Discord.Style! We aim to provide a huge variety of templates to help build your Discord community into the place of your dreams, without all the hassle". The copyright notice appears to have been removed.¹

¹ As explained at section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. The Panel has accordingly visited the website for the disputed domain name in order to establish the use which is presently being made of it.

5. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which it has rights. The Complainant refers to its registered trade and service marks for DISCORD and says that the disputed domain name incorporates the entirety of its mark. Domain names identical to a third party's trade marks create a very high risk of association with the trade mark owner. In a similar decision involving the Complainant, namely *Discord Inc. v. RANK TW, RANKTW*, WIPO Case No. [D2021-4365](#), the panel ordered the domain names in issue to be transferred to the Complainant.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent's offering cannot be considered as a *bona fide* offering of goods and services in that it resolves to a website displaying the Complainant's DISCORD trade marks and offering services bearing those marks, without any authorization from the Complainant, thereby creating a likelihood of confusion between the parties. Nor does the Respondent's use of the disputed domain name constitute a noncommercial or fair use of it. Furthermore, the Complainant has not licensed or authorized the Respondent to register or use the disputed domain name, nor is there any evidence that the Respondent is commonly known by it.

The Complainant says also that the disputed domain name was registered and is being used in bad faith. Registration of the Complainant's trade marks pre-dates the registration of the disputed domain name. The Respondent was plainly aware of the Complainant's mark as at the date of registration of the disputed domain name, given the content of the website to which it resolves, and such registration was accordingly in bad faith. The disputed domain name resolves to a website containing links to servers connected to the Complainant. The fact that the disputed domain name incorporates the Complainant's mark without a disclaimer of affiliation with the Complainant will mislead potential consumers by creating a likelihood of confusion with its mark as to its source, sponsorship or affiliation. This is even more evident considering that the Respondent uses its website to provide customers with paid services exploiting the Complainant's reputation without any authorization.

B. Respondent

The Respondent says that he aims to provide a large variety of templates to help users of his website build their Discord community into the place of their dreams by assisting them in creating and setting up their own servers. If the Complainant believes that has been done in a way that is detrimental to it, he is willing to make changes. The purpose of the Respondent's website is not to divert users from the Complainant's official website, nor is it intended to tarnish or degrade the Complainant's official website by creating a likelihood of confusion with the Complainant's mark, nor to take advantage of the Complainant's reputation. The Respondent's website does not offer any paid services nor does the Respondent have any customers, so he is not exploiting the Complainant's reputation for its own gain. The form and content of the Respondent's website does not create a likelihood of confusion with the Complainant. Nor does his website contain links redirecting Internet users to the Complainant's website, although it does have a link taking Internet users to the Respondent's own Discord server. This is because the relevant page of the Respondent's website is directed to inviting Internet users to make a Discord Application, also known as a "Bot", to a Discord server. The Respondent has now added a disclaimer saying that his website is not to be confused with that of the Complainant.

C. Additional responses of Complainant and Respondent

The Complainant's further response asserts that the fact that the Respondent's website uses bots that generate web traffic is evidence that his website generates commercial revenue and is therefore being used for financial gain. Moreover, contrary to the Respondent's assertion, the home page of its website redirects to the Complainant's website. The Respondent has only added a disclaimer to its website after the filing of the Complaint. The belated addition of a disclaimer was made to create an appearance of legitimacy; see

Discord Inc. v. Legato LLC / Ivan Talypin, WIPO Case No. [D2021-3881](#).

The Respondent's response to the Complainant's further submission asserts that the Respondent does his best to operate his website as non-official. His website was created because he has a special interest in simplifying the process of discovering Discord templates and to facilitate sharing of what other users have created for use with the Complainant's application. The Respondent's website does not contain any bots which generate web traffic and it does not generate money. The only links to the Complainant's website are links to its authentication system. The Respondent had previously had a disclaimer of non-affiliation with the Complainant, but it was inadvertently omitted when his website was updated in April 2021. This mistake has now been corrected.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the 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.

A. Identical or Confusingly Similar

The Complainant has provided details of its trade and service mark registrations for DISCORD an example having been provided above. It has thereby established its rights in this mark.

The generic Top Level Domain ("gTLD"), that is the ".style" component, is disregarded for the purposes of the comparison made under the first element as it is a technical requirement of registration. The disputed domain name features the entirety of the Complainant's mark, with no added content. The Panel therefore finds that it is identical to a service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides, without limitation examples of circumstances whereby a respondent might demonstrate that it has rights or legitimate interests in a domain name. In summary, these are (i) if a respondent has used or prepared to use the domain name in connection with a *bona fide* offering of goods and services, (ii) if a respondent has been commonly known by the domain name, or (iii) if a respondent has made a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark in issue.

Section 2.5 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") specifically considers the question of fair use although the commentary is also helpful when considering the first circumstance set out above, and explains that "Fundamentally, a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner". Section 2.5.1 further explains that: "Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation". The identical nature of the disputed domain name means that it has an inherent propensity to confuse Internet users who, on encountering the Respondent's website, will be predisposed to assume that it is operated by, or with the authority of, the Complainant.

Section 2.5.2 of the [WIPO Overview 3.0](#) sets out a number of factors which earlier UDRP panels have considered in assessing a claim to fair use. A number of these considerations on the surface point in favour

of the Respondent. By way of example, the content of the Respondent's website relates to the Complainant's services rather than to those of a competitor or industry group. Moreover, there is no evidence that the Respondent has engaged in a pattern of registering domain names corresponding to marks held by the Complainant or third parties. Additionally, there is no clear evidence that the Respondent is directly deriving a commercial advantage from his website.

However this may be, significant and determinative factors point in the other direction. First, as outlined above, the fact that the disputed domain name is identical to the Complainant's mark means that Internet users will be apt to assume that any website associated with it will be operated by, or with the authorization of, the Complainant. In this respect, it is helpful to consider sections 2.6.2 and 2.7.2 of [WIPO Overview 3.0](#). These deal with criticism and fan sites respectively, but each of which discusses the position which arises when a party unconnected with a complainant establishes a website using a domain name identical to the complainant's mark. These sections, building on the foundation of section 2.5.1 explain that panels tend to find that any general right to operate such sites does not necessarily extend to registering or using a domain name identical to a complainant's mark because this creates an impermissible risk of user confusion through impersonation. See also *Louis Vuitton Malletier SAS v. Jamey, Wakeen Industries LLC*, WIPO Case No. [D2021-1201](#); "In this case, the disputed domain name is identical to the Complainant's trade mark and, in the Panel's view, it constitutes a misrepresentation to users that any associated website is likely to be connected with the Complainant. While Internet users arriving at such a website will at some point realise that it is not officially associated with the Complainant, e.g., if the Respondent were to use the kind of prominent disclaimer that it claims to propose, the users have nonetheless been attracted to the site on a false premise, effectively a bait-and-switch". The same considerations are applicable in these circumstances.

Second, notwithstanding that Internet users may appreciate that much of the content of the Respondent's website is user-generated, there is nothing, whether in an "About us" section or otherwise, that ensures that visitors to it will readily understand that it is not under the control of or affiliated with the Complainant. Furthermore, the main greeting on the home page, namely, "Welcome to Discord.Style! We aim to provide a huge variety of templates to help build your Discord community into the place of your dreams, without all the hassle", and the copyright notice (albeit this is not currently visible) are both ambiguous and are more likely than not to reinforce the erroneous perception that the Respondent's website is operated by, or with the authority of, the Complainant.

Finally, the position concerning the various disclaimers which have appeared on the Respondent's website is unsatisfactory. The first disclaimer used by the Respondent, was brief and scarcely visible, which suggests that he had no particular desire to draw the attention of visitors to his website of his lack of connection with the Complainant. For a period even that disclaimer was removed. A second form of disclaimer was then placed on the Respondent's website, but only in response to the assertions in the Complaint. The more detailed disclaimer which is presently used appears in small font at the very foot of the home page and therefore cannot be considered as satisfying the requirement of making clear to Internet users visiting it that the Respondent's website is not operated by the Complainant. As the panel found in *Discord Inc. v. Legato LLC / Ivan Talypin (supra)*, which concerned the domain name <discord-servers.com>; "The Panel does not consider that the disclaimer for the lack of relationship between the Parties that was recently included by the Respondent on his website should be taken into account. It appeared only after the Respondent became aware of the Complaint, so it is more likely that its inclusion was made to cover the Respondent's tracks so to speak, and to create an appearance of legitimacy of the Respondent for the purposes of the present proceeding. However, even if this disclaimer is taken into account, its presence (never mind the timing) would not render the Respondent's activities *bona fide* under the Policy. When Internet users have a chance to read the disclaimer they have already been attracted to the Respondent's website, under the impression that it is associated with the Complainant, and would be exposed to its content [...]".

Taking into account the inherent propensity of the disputed domain name to confuse Internet users, coupled with the absence of any content and prominently displayed disclaimer on the Respondent's website that explains to such users that it has no association with the Complainant, there is a significant risk of visitors to the website being misled into believing that it is operated or authorized by the Complainant. The Panel

accordingly finds that the disputed domain name does not vest the Respondent with a legitimate interests.

The Panel accordingly finds that the Complainant has met its burden under this element.

C. Registered and Used in Bad Faith

The only known use of the disputed domain name has been to resolve to a website which contains templates and other software for use in conjunction with the Complainant's applications. It is therefore evident that the Respondent was aware of the Complainant and its marks as at the date of registration of the disputed domain name and that it was registered by the Respondent for the purposes of establishing his website. Previous UDRP panels have found that registration of a domain name that is identical or confusingly similar to widely-known trade mark by a third party can create a presumption of bad faith. See, by way of example, *Facebook, Inc. v. Eduard Vokhmin*, WIPO Case No. [D2021-3464](#). The Panel therefore finds the registration of the disputed domain name to have been in bad faith.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by a panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy is if a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

The use to which the disputed domain name has been put falls broadly within this circumstance in that Internet users are likely to assume from the fact that the disputed domain name is identical to the Complainant's mark, that any website to which it resolves will be owned and operated by the Complainant or with its authorization. Even when Internet users visit the Respondent's website, the size and positioning of the disclaimer and the other website content is such that as to reduce the likelihood of visitors appreciating that it is not approved or authorized by the Complainant. Whilst the Respondent does not appear to be achieving any direct commercial benefit from his website at present, the ambiguity as to its lack of authorization by the Complainant means that he is nonetheless benefiting unfairly from the confusion created by his registration of the disputed domain name and the use to which it is being put. Moreover, notwithstanding that there is no clear evidence that the Respondent is directly deriving a commercial gain, the circumstances at paragraph 4(b) of Policy are without limitation and bad faith can be found in other circumstances where a respondent seeks to take unfair advantage of, or has otherwise engaged in behavior detrimental to a complainant's trade mark; see, for example, *Andrey Ternovskiy dba Chatroulette v. Polina Butenina*, WIPO Case No. [D2018-1499](#).

The Panel therefore finds that the Complainant has met its burden under this element.

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.style> be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: May 19, 2022