

## **ADMINISTRATIVE PANEL DECISION**

Meta Platforms, Inc. and Silvergate Capital Corporation v. Privacy Service Provided by Withheld for Privacy ehf / Andris Tukišs and Maija Scokina and Zigis Bergs and Maris Mezs and Mara Sirma and Aigars Kuzmins and Lasma Kalnberza, and Aija Berzina  
Case No. D2022-1690

### **1. The Parties**

The Complainants are Meta Platforms, Inc., United States of America (“USA”) and Silvergate Capital Corporation, USA, represented by Hogan Lovells (Paris) LLP, France.

The Respondents are Provided by Withheld for Privacy ehf, Iceland / Andris Tukišs, Latvia and Maija Scokina, Latvia and Zigis Bergs, Latvia and Maris Mezs, Latvia and Mara Sirma, Latvia and Aigars Kuzmins, Latvia and Lasma Kalnberza, Latvia, and Aija Berzina, Latvia.

### **2. The Domain Names and Registrars**

The disputed domain names <africanovi.com>, <creditnovi.com>, <diem.contact>, <diemprepaidcard.com>, <helpnovi.com>, <novi.africa>, <noviafrica.com>, <noviaustralia.com>, <novibrasil.com>, <novibrazil.com>, <novicanada.com>, <novi-company.com>, <novi.contact>, <novicontact.com>, <novieuropa.com>, <novieurope.com>, <novi.help>, <novihelp.com>, <noviindia.com>, <novijapan.com>, <novimexico.com>, <novinigeria.com>, <noviprepaidcard.com>, <novirusia.com>, <novisupport.com>, <novitransaction.com>, <novi247.com>, <novi777.com>, <novi888.com>, <supportnovi.com>, <walletnovi.com>, <247novi.com>, <365novi.com> are registered with NameCheap, Inc. (“the Registrar No. 1”).

The disputed domain names <bancodiem.com>, <diemaustralia.com>, <diembangladesh.com>, <diembrasil.com>, <diembrazil.com>, <diemcontact.com>, <diemindonesia.com>, <diemmexico.com>, <diemnigeria.com>, <diempakistan.com>, <diemspain.com> are registered with Register SPA (“the Registrar No. 2”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 9, 2022. On May 10, 2022, the Center transmitted by email to the Registrars requests for registrar verification in connection with the disputed domain names. On May 11, 2022, both Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names, which differed from some of the named Respondents and contact information in the Complaint. The

Center sent an email communication to the Complainants on May 12, 2022 providing the registrants and contact information disclosed by the Registrars, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on May 20, 2022.

The Center sent an email communication in English and Italian to the parties on May 12, 2022, regarding the language of the proceeding, as the Complaint has been submitted in English and the language of the registration agreement for the disputed domain names registered with Registrar No. 2 is Italian. The Complainants submitted a request for English to be the language of the proceeding in an amended Complaint on May 20, 2022. The Respondents did not comment on the language of the proceeding.

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 Respondents of the Complaint in both English and Italian, and the proceedings commenced on May 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on June 13, 2022. Afterwards, one of the Respondents, Andris Tukišs, sent the Center an informal communication email on June 13, 2022 asking for an extension for filing a response. On June 16, 2022, this same Respondent filed a late response.

The Center appointed Edoardo Fano as the sole panelist in this matter on June 20, 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.

The Panel has not received any requests from the Complainants or the Respondents regarding further submissions, waivers, or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules, and the Supplemental Rules and without the benefit of a formal response from the Respondents.

#### **4. Factual Background**

The Complainants are Meta Platforms, Inc., a USA company operating in the social technology field, and Silvergate Capital Corporation, a USA Federal Reserve member bank, respectively owning several trademark registrations for NOVI and DIEM, among which:

- Australian Trademark Registration No. 2091145 for NOVI, registered on May 26, 2020;
- Indian Trademark No. 4510716 for NOVI, registered on May 26, 2020;
- Indian Trademark No. 4510722 for NOVI, registered on May 26, 2020;
- Malaysian Trademark No. TM2020009357 for NOVI, registered on March 30, 2020;
- Mexican Trademark No. 2146684 for NOVI, registered on September 24, 2020;

- International Trademark Registration No. 1614722 for DIEM, registered on December 1, 2020;

- USA Trademark Registration No. 6071012 for DIEM, registered on June 2, 2020.

At the time of registration of the disputed domain names, the Complainants were engaged in a common venture, centered around the Diem cryptocurrency payment network, and they created a perceived association between them.

The Complainants provided evidence in support of the above.

According to the Whois records, the disputed domain names were registered on the following dates:

<creditnovi.com>, <helpnovi.com>, <novi.africa>, <noviafrica.com>, <novi-company.com>, <novihelp.com>, <novisupport.com>, <novi247.com>, <supportnovi.com>, <walletnovi.com>, <247novi.com>, <365novi.com> on May 26, 2020;

<novicontact.com>, <novi.help> on May 28, 2020;

<africanovi.com> on May 30, 2020;

<diemprepaidcard.com> on November 2, 2020;

<bancodiem.com>, <diemaustralia.com>, <diembangladesh.com>, <diembrasil.com>, <diembrazil.com>, <diemcontact.com>, <diemindonesia.com>, <diemmexico.com>, <diemnigeria.com>, <diempakistan.com> on December 2, 2020;

<diemspain.com> on December 4, 2020;

<diem.contact>, <novi.contact> on December 9, 2020;

<noviindia.com>, <novitransaction.com> on September 25, 2021;

<novi777.com>, <novi888.com>, <noviaustralia.com>, <novibrasil.com>, <novibrazil.com>, <novicanada.com>, <novieuropa.com>, <novieurope.com>, <novijapan.com>, <novimexico.com>, <novinigeria.com>, <novirusia.com> on September 29, 2021;

<noviprepaidcard.com> on October 28, 2021.

All the disputed domain names are offered for sale at the domain name sales platform at the <sedo.com>.

On September 29, 2021 an individual named Andris Tukišs, offered for sale to the Complainants all the disputed domain names, referred to as the "NOVI and DIEM domain package", at a price of EUR 60,000. On November 12, 2021, this same individual offered for sale to the Complainants the NOVI domain names at a price of USD 9.999 per domain.

## **5. Parties' Contentions**

### **A. Complainants**

The Complainants state that the disputed domain names are confusingly similar to their trademarks NOVI and DIEM, since the disputed domain names <novi.africa>, <novi.contact>, <novi.help>, <diem.contact> are identical to their trademarks, while all the other disputed domain names fully incorporate the Complainants' trademarks, together with various descriptive terms, numbers and hyphens.

Further to Section 6.2 below, the Complainants argue that the disputed domain names are under common control and thus address the Respondents in the singular. The Complainants assert that the Respondent has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainants to register the disputed domain names or to use their trademarks within the disputed domain names, it is not commonly known by the disputed domain names and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names; the disputed domain names resolve to webpages offering them for sale.

The Complainants submit that the Respondent has registered the disputed domain names in bad faith, since the Complainants' trademarks NOVI and DIEM are distinctive and known in connection with cryptocurrency services. Therefore, the Respondent targeted the Complainants' trademarks at the time of registration of the disputed domain names, just a few days after both the Complainants' trademarks were registered and the relevant project where the Complainants' trademark are used is launched, and the Complainants contend that the Respondent's unsolicited offers to sell the disputed domain names to the Complainants, as well as the Respondent's redirection of the disputed domain names to <sedo.com> pages where they are listed for sale, support the finding that the Respondent registered the disputed domain names primarily for the purpose of selling them to the Complainants, for valuable consideration in excess of his documented out-of-pocket costs directly related to the disputed domain names, and qualifies as bad faith registration and use.

Moreover, the Complainants assert that the Respondent, by registering 44 disputed domain names, all of them targeting the Complainants, has engaged in a bad faith pattern of conduct, in order to prevent the Complainants from reflecting their trademarks in corresponding domain names.

## B. Respondents

The Respondents have made no formal reply to the Complainants' contentions.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn (see, e.g., *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. [D2000-0441](#); *Microsoft Corporation v. Freak Films Oy*, WIPO Case No. [D2003-0109](#); *SSL INTERNATIONAL PLC v. MARK FREEMAN*, WIPO Case No. [D2000-1080](#); *ALTAVISTA COMPANY v. GRANDTOTAL FINANCES LIMITED et. al.*, WIPO Case No. [D2000-0848](#); *Confédération Nationale du Crédit Mutuel, Caisse Fédérale du Crédit Mutuel Nord Europe v. Marketing Total S.A.*, WIPO Case No. [D2007-0288](#)).

In this case, Andris Tukišs, submitted a late informal response on June 16, 2022, stating the following:

"A domain name in and of itself is not the same thing as a trade mark. A domain name is part of an internet address which locates a specific space on the internet. Unlike trademarks, domain names are global and must be unique - one domain is only available to one user. [...] there are several trademarks registered with name NOVI and DIEM, and the Complaint is not exclusive trade mark owner. Domain names and trade marks can sometimes seem similar, although they are entirely different things. The Complaint's trademarks are not registered in whole world, as it can be seen from database above. Moreover, the database above contains older trademarks than the Complaint's trademarks. I am doing business in Croatia which is the member state of the European Union. Thus Croatian language is one of the official languages of the European Union. In Croatian word 'novi' means 'new' in English language. Thus from my point of view the Complaint's trademark is genericism - generic terms are unregistrable. Thus this trademark is not registered or even filed in Croatian trademark registry bureau. In my domain names with novi I am using Croatian word 'new' to which the claimant is not entitled. The domain names including word diem is abbreviation from Croatian Demokratske Integracije Ekonomski Model (in english democratic integration economic model). [...]"

## 6. Discussion and Findings

### 6.1 Consolidation of Multiple Complainants

The Complainants have requested consolidation of multiple complainants and stated that all the disputed domain names belong to the same person or organization. No objection to this request was made by the Respondents.

Pursuant to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.11.1, “Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation”.

The Panel finds that there is sufficient evidence that the disputed domain names are subject to common control, that they are affecting the Complainants’ legal interests in a similar fashion, and that it would be procedurally efficient, fair and equitable to all Parties to accept the Complainants’ consolidation request. The Panel further notes that the Respondents did not object to the consolidation request. The Panel therefore accepts the Complainants’ consolidation request. Hereinafter, the Panel will refer to the Complainants in the singular, *i.e.*, “the Complainant”.

### 6.2 Consolidation of Multiple Respondents

The Complainant has requested consolidation of multiple respondents and stated that all the disputed domain names belong to the same person or organization. No objection to this request was made by the Respondents.

Pursuant to the [WIPO Overview 3.0](#), section 4.11.2, “Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario”. The Panel may consider a range of factors to determine whether consolidation is appropriate, such as examining relevant registrant contact information, and any naming patterns in the disputed domain names, or other evidence of respondent affiliation that indicate common control of the disputed domain names.

The Panel notes that all the disputed domain names are targeting the Complainant’s trademarks NOVI and DIEM, that they were all offered for sale to the Complainant by Andris Tukišs, and that they are all listed for sale at the same platform, <sedo.com>. The Panel finds that there is sufficient evidence that the disputed domain names are subject to common control, and that it would be procedurally efficient, fair and equitable to all Parties to accept the Complainant’s consolidation request. The Panel further notes that the Respondents did not object to the consolidation request. The Panel therefore accepts the Complainant’s consolidation request. Hereinafter, the Panel will refer to the Respondents in the singular, *i.e.*, “the Respondent”.

### 6.3 Language of Proceeding

According to paragraph 11(a) of the Rules, the Panel decides that the language of the proceeding will be English. The language of the Registration Agreements of the disputed domain names registered with Registrar No. 2 is Italian. The Complainant has requested English to be the language of the proceeding since the Respondent offered the disputed domain names for sale to the Complainant by using the English language. The Panel finds that it would be not only unnecessary but also unfair, both economically and time

wise, to request the Complainant to translate the Complaint. Furthermore, the Respondent did not comment to the Complainant's request to use English and submitted a late informal response in English. See [WIPO Overview 3.0](#), section 4.5.1.

## 6.4 Substantive Issues

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain names are identical or confusingly similar to a trademark 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademarks NOVI and DIEM and that the disputed domain names <novi.africa>, <novi.contact>, <novi.help>, <diem.contact> are identical to its trademarks, while all the other disputed domain names fully incorporate the Complainant's trademarks, together with various terms or numbers and, in one case, a hyphen and the term "company".

The Panel notes that it is now well established that the addition of terms or letters to a domain name does not prevent the confusing similarity between the domain name and a trademark (see, e.g., *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. [D2005-0037](#); *Red Bull GmbH v. Chai Larbthanasub*, WIPO Case No. [D2003-0709](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)). The addition of the terms "africa", "banco", "credit", "australia", "bangladesh", "brasil", "brazil", "contact", "indonesia", "mexico", "nigeria", "pakistan", "prepaidcard", "spain", "help", "canada", "company", "europa", "europe", "india", "japan", "russia", "support", "transaction", "wallet", of the numbers "247", "365", "777", "888", and a hyphen in the disputed domain name <novi-company.com> does not therefore prevent the disputed domain names incorporating these terms, numbers or hyphen from being confusingly similar to the Complainant's trademarks. See [WIPO Overview 3.0](#), section 1.8.

It is well accepted that a generic Top-Level Domain ("gTLD"), in this case ".com", ".contact", ".africa", ".help", is typically ignored when assessing the similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant's trademarks, pursuant to the Policy, paragraph 4(a)(i).

### B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain names.

The Respondent may establish a right or legitimate interest in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

"(i) 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; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain names according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is always more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain names in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent is not currently associated with the Complainant in any way, is not commonly known by the disputed domain name and is not making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name: the Respondent, on the websites at the disputed domain names, is offering them for sale, an activity capitalizing on the Complainant’s trademarks and reputation.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain names. However, the Respondent has failed to file a formal response in accordance with the Rules, paragraph 5, and has not rebutted the Complainant’s *prima facie* case. In an informal late email, Andris Tukišs stated that he is doing business in Croatia, where the term “novi” is generic and means “new”, while the acronym “diem” stands for “democratic integration economic model” (an abbreviation from “Croatian Demokratske Integracije Ekonomski Model”). As he seems to be based in Latvia, and since none of the disputed domain names corresponds to a website with content, no reference whatsoever can be found between the disputed domain names and the term “novi” as “new” in the Croatian language or the acronym “diem” standing for “democratic integration economic model” (as an abbreviation from “Croatian Demokratske Integracije Ekonomski Model”). The Panel cannot therefore consider these statements as evidence of any rights or legitimate interests it may have in the disputed domain names, and the Panel is unable to establish any such rights or legitimate interests on the basis of the evidence in front of it.

Moreover, the Panel finds that the composition of the disputed domain names carries a risk of implied affiliation as they effectively impersonate or suggest sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0.](#), section 2.5.1.

Based on the facts of this case, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

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

Paragraph 4(b) of the Policy provides that “for the purposes of paragraph 4(a)(iii) [of the Policy], 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:

- (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 its documented out-of-pocket costs directly related to the domain name; or
- (ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; 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."

Regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant's trademarks NOVI and DIEM in the field of cryptocurrency services is clearly established and the Panel finds that the Respondent likely knew of the Complainant and deliberately registered the disputed domain names, especially because the disputed domain names were offered for sale by the Respondent directly to the Complainant.

The Panel further notes that the disputed domain names are also being used in bad faith since the Respondent has registered the disputed domain names primarily for the purpose of selling them to the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the disputed domain names, in an attempt to capitalize upon the Complainant's reputation and goodwill.

Finally, the Panel considers that the nature of the disputed domain names, which include the Complainant's trademarks in their entirety with the addition of descriptive or geographic terms, and the fact that they have been registered immediately after the launch of the Complainant's project, further support a finding of bad faith. See [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has presented evidence to satisfy its burden of proof with respect to the issue of whether the Respondent has registered and is using the disputed domain names in bad faith.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

## 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 names <africanovi.com>, <creditnovi.com>, <helpnovi.com>, <novi.africa>, <noviafrica.com>, <noviaustralia.com>, <novibrasil.com>, <novibrazil.com>, <novicanada.com>, <novi-company.com>, <novi.contact>, <novicontact.com>, <novieuropa.com>, <novieurope.com>, <novi.help>, <novihelp.com>, <noviindia.com>, <novijapan.com>, <novimexico.com>, <novinigeria.com>, <noviprepaidcard.com>, <novirusia.com>, <novisupport.com>, <novitransaction.com>, <novi247.com>, <novi777.com>, <novi888.com>, <supportnovi.com>, <walletnovi.com>, <247novi.com>, <365novi.com> be transferred to the Complainant Meta Platforms, Inc.



The Panel orders that the disputed domain names <diem.contact>, <diem prepaidcard.com>, <bancodiem.com>, <diemaustralia.com>, <diembangladesh.com>, <diembrasil.com>, <diembrazil.com>, <diemcontact.com>, <diemindonesia.com>, <diemmexico.com>, <diemnigeria.com>, <diempakistan.com>, <diemspain.com> be transferred to the Complainant Silvergate Capital Corporation.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: June 22, 2022