

ADMINISTRATIVE PANEL DECISION

Jam City, Inc. v. Berg Tony
Case No. D2022-4096

1. The Parties

Complainant is Jam City, Inc., United States of America (“United States” or “U.S.”), represented by Stobbs IP Limited, United Kingdom (“U.K.”).

Respondent is Berg Tony, United States.

2. The Domain Name and Registrar

The disputed domain name <championsio.xyz> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 31, 2022. On November 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on November 1, 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 November 3, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on November 4, 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 Respondent of the Complaint, and the proceedings commenced on November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 29, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on December 8, 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 states in its Complaint and provides evidence in the respective Annexes sufficient to support the following:

Founded in 2010 by former MySpace cofounder and CEO Chris DeWolfe, Complainant is a mobile entertainment company that provides games that appeal to a broad, global audience, and has nine studios located in the United States, Canada, South America, and Europe. Complainant is a partner of choice for Hollywood studios, having developed immersive, narrative-rich mobile games around iconic entertainment brands. Complainant's popular RPG game "Harry Potter: Hogwarts Mystery" was the number one game in more than 40 countries at its launch in April 2018. As of 2021, Complainant's games had 31 million monthly active users and 1.3 billion total downloads.

Complainant's games include a AAA blockchain game developed exclusively for Web3 using the trademark CHAMPIONS ASCENSION (the "CHAMPIONS Mark") based on a player-driven fantasy world where players can collect and create unique NFT Champions, battle other players, and stake a path in a developing token economy. Complainant's CHAMPIONS Mark game is active at websites accessed through Complainant's official domain names which incorporate the CHAMPIONS Mark: <championsascension.com> and <champions.io> registered to Complainant on December 1, 2021, used to promote the game online at "www.championsascension.com" and "www.champions.io" (the "Official CHAMPIONS Mark Websites"). Since its launch in early December 2021, Complainant's game using the CHAMPIONS Mark has also gained a significant following on social media platforms such as Twitter (58, 800 followers) and Instagram (17,900 followers) and built up substantial recognition in the public domain, supported by endorsement on social media and in the press.

Complainant has used the CHAMPIONS Marks for its game and owns multiple trademark registrations which predate the registration of the disputed domain name, including in the including U.K. Trademark Registration No. UK00003752915, CHAMPIONS ASCENSION, registered on May 2, 2022, for downloadable computer game software and online computer games under International Classes 9 and 41; and European Union Trademark Registration 018651294, CHAMPIONS ASCENSION, registered on June 2, 2022, for a range of computer game software products and online computer game services in Classes 9 and 41.

The disputed domain name was registered on September 15, 2022, and originally resolved to a copycat site with content identical to Complainant's Official CHAMPIONS Mark Websites, until Complainant's cease and desist letter resulted in removal of the infringing content from Respondent's Website under Complainant's DMCA Notice. The disputed domain name now resolves to an inactive URL.

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 the requirements for each of the elements listed in paragraph 4(a) of the Policy have been satisfied.

The Panel will address its findings on each of these elements 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 the 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 CHAMPIONS Marks for its computer game software products and online computer game services in its registrations for the CHAMPIONS Marks which predate Respondent’s registration of the disputed domain name. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting trademark registration documents in the name of Complainant and therefore, Complainant has demonstrated it has trademark rights in the CHAMPIONS Marks. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant’s rights in the CHAMPIONS Marks 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 CHAMPIONS Marks. 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 held the fact that a domain name wholly incorporates a complainant’s registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks. [WIPO Overview 3.0](#), section 1.8 (“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”) see also *Wal-Mart Stores, Inc. v. MacLeod d/b/a/ For Sale*, WIPO Case No. [D2000-0662](#).

A side-by-side comparison between the disputed domain name and Complainant’s CHAMPIONS Mark shows the leading and predominant portion of the CHAMPIONS Mark is essentially incorporated in its entirety and serves as the dominant feature of the disputed domain name as well as providing an exact replication of the string that comprises Complainant’s above referenced official domain name <champions.io>, the domain name used to redirect to Complainant’s Official CHAMPIONS Marks Website.

Complainant’s CHAMPIONS Mark as incorporated including the “io” signifier in the disputed domain name has one minor distinction, the removal of the “dot” as compared to the official domain name and the addition of the gTLD “.xyz”. This omitted dot does not significantly affect the appearance or pronunciation of the disputed domain name as compared to the official domain name, nor does the addition of “io” to the CHAMPIONS element of the Complainant’s CHAMPIONS Mark prevent a finding of confusing similarity between the disputed domain name and the CHAMPIONS Mark. The addition of the TLD “.xyz” is irrelevant in determining whether the disputed domain name is confusingly similar. See, *Research in Motion Limited v thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#); [WIPO Overview 3.0](#), section 1.11.

Based on the above, this Panel finds that the addition of the “io” does not prevent a finding of confusing similarity between the disputed domain name and Complainant’s CHAMPIONS Mark, because the leading dominant term of Complainant’s CHAMPIONS Mark is fully recognizable as it is incorporated into the disputed domain name. Accordingly, the Panel finds the disputed domain name confusingly similar to the CHAMPIONS Marks in which Complainant has 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 disputed domain name. If the respondent fails to come forward with such evidence, a complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

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 disputed domain name resolve before Respondent’s first notice of the dispute from Complainant that Respondent operated a copycat website featuring exact copies of unique copyrighted content taken from Complainant’s Official CHAMPIONS Mark Websites, including artwork and a unique stylized skull logo design associated with Complainant and its computer game products and services. Complainant contends Respondent’s copycat site was created to trick Internet users into believing that the disputed domain name would direct them to an official website offering Complainant’s products and services. Complainant also contends that removal of the infringing website’s content post-takedown notice constitutes an admission of intellectual property infringement by Respondent.

Prior UDRP panels have specifically found use of a disputed domain name to resolve to a copycat site attempting to pass itself off as a complainant in furtherance of an illegitimate scheme competing with or capitalizing on Complainant’s trademark does not represent a *bona fide* use of the disputed domain name pursuant to paragraph 4(c)(i) nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii). See *Microsoft Corporation v. Charilaos Chrisochou*, WIPO Case No. [D2004-0186](#); see also *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); [WIPO Overview 3.0](#), section 2.9.

Based on the foregoing decisions and evidence submitted, this Panel finds the disputed domain name is not being used in connection with a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraphs 4(c)(i) or (c)(iii) of the Policy.

Prior UDRP panels have also found that “use which intentionally trades on the fame of another cannot constitute a *bona fide* offering of goods or services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy”. See *In Advance Magazine Publishers, Inc. v. Lisa Whaley*, WIPO Case No. [D2001-0248](#) (finding that “intentionally infringing use should not be viewed as *bona fide* use”). The disputed domain name clearly features unauthorized use of terms that are confusingly similar to Complainant’s CHAMPIONS Marks and its domain name used for the Official CHAMPIONS Marks Website. Thus, Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain.

Complainant also contends that the disputed domain name's configuration, including "io" but omitting the dot reveals an alternate purpose to intentionally create a false association with Complainant. Since 2015, the phrase "IO games" has become a popular reference in relation to online games (particularly in the framework of Web3). Like others, Complainant has utilized the ".IO" extension in domain names to indicate to their target consumers that the website is associated with an IO game: the "IO" element forms one iteration of Complainant's CHAMPIONS brand identity, namely CHAMPIONS IO. Therefore, the addition of the letters "IO" in the domain prefix within the disputed domain name reinforces a connection with Complainant and its CHAMPIONS Mark, also known as ".com aping" the CHAMPIONS IO brand signifier.

In light of the above, and with no Response in this case to rebut Complainant's assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no 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. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do the Hustle, LLC v. Tropic Web, supra*.

Complainant contends that there is no other explanation for Respondent to register the disputed domain name other than to target Complainant. Complainant's registered trademark rights pre-date the registration of the Disputed Domain Name. Furthermore, Respondent's copycat website noted in section 6B. above clearly targeted Complainant's CHAMPIONS Mark by copying Complainant's copyrighted content to have the same look and feel as Complainant's Official CHAMPIONS Mark Websites. Therefore, it is clear that Respondent had Complainant's CHAMPIONS Mark in mind at the time Respondent chose to register the disputed domain name and, thereafter, build its copycat website. Prior UDRP panels have found that where it would be implausible to believe that Respondent selected and was using the disputed domain name for any purpose other than to trade on Complainant's trademark rights and reputation, establishes a fact pattern that repeatedly has been held to constitute bad faith registration. See *Alstom v. Domain Investments LLC*, WIPO Case No. [D2008-0287](#); see also *Houghton Mifflin Co. v. Weathermen, Inc.*, WIPO Case No. [D2001-0211](#).

Prior UDRP panels have also found where a respondent's actions indicate that respondent's primary intent with respect to the disputed domain name is to trade off the value of Complainant's Marks, constitutes bad faith. See *Herbalife International, Inc. v. Surinder S. Farmaha*, WIPO Case No. [D2005-0765](#). The Panel also notes Respondent's registration data as revealed by the concerned Registrar appears to be false considering it has provided a postal address with a zip code of 85014, which is attributed to cities in Maricopa County, Arizona, while the city Respondent gives in its registration is Washington, Alabama. Providing false registration data is an additional factor that prior UDRP panels have used to support an inference of bad faith. [WIPO Overview 3.0](#), section 3.2.1

Given the copycat site, the purpose and use of the disputed domain name has been to cause confusion with Complainant and therefore, the use and registration of the disputed domain name must be considered to be in bad faith. See, *Empresa Brasileira de Telecomunicações S.A. Embratel v. Kevin McCarthy*, WIPO Case No. [D2000-0164](#). See [WIPO Overview 3.0](#), section 3.1.4.

As found by prior UDRP panels, use of the disputed domain name for a copycat website competing with or capitalizing on Complainant's trademark demonstrates an indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its disputed domain name, by creating a likelihood of

confusion with Complainant's CHAMPIONS Mark as to the source, sponsorship, affiliation or endorsement of Respondent, and, therefore is evidence of registration and use of the disputed domain name in bad faith under paragraph 4(b)(iv) of the Policy. See *Association des Centres Distributeurs E. Leclerc - A.C.D Lec v. Milen Radumilo*, WIPO Case No. [D2017-2003](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no formal Response or 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, <championsio.xyz>, be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: December 25, 2022