

ADMINISTRATIVE PANEL DECISION

Moderna, Inc. and ModernaTX, Inc. v. DNS Admin, Buntai LTD
Case No. D2023-0161

1. The Parties

The Complainants are Moderna, Inc. and ModernaTX, Inc., United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is DNS Admin, Buntai LTD, United States.

2. The Domain Name and Registrar

The disputed domain name <hy-veecovidmodernashots.com> (the “Disputed Domain Name”) is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 12, 2023. On January 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 16, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainants on January 17, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on January 17, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on January 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2023. On February 6, 2023, the Respondent requested an extension of the Response due date. An automatic four-day extension of the Response due date was granted until February 11, 2023. The Respondent did not submit a formal Response. On February 14, 2023, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Lynda M. Braun as the sole panelist in this matter on February 23, 2023. 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

The Complainant Moderna Inc., is a public company that was founded in 2010 and employs more than 3,700 individuals. The Complainants' COVID-19 vaccine is one of the most widely administered vaccines in the history of medicine. The Complainants manufactured and shipped 800 million doses globally in 2021 to more than 70 countries worldwide, all of which have approved the Complainants' COVID-19 vaccine. The Complainants and their trademark have become extremely well known worldwide. See *Moderna, Inc. v. Registration Private, Domains By Proxy, LLC / Andrew Chen*, WIPO Case No. [D2022-3189](#) ("Complainant and its trademark are famous throughout the world, especially in light of the COVID-19 pandemic.").

The Complainants own at least 37 trademark registrations in at least 14 jurisdictions worldwide for marks that consist of or incorporate the term "Moderna". Trademark registrations for the MODERNA trademark in the United States include, but are not limited to, the following: MODERNA, United States Registration No. 4,675,783, registered on January 20, 2015, in International Class 1; and MODERNA, United States Registration No. 4,811,834, registered on September 15, 2015, in International Class 42 (hereinafter collectively referred to as the "MODERNA Mark").

The Disputed Domain Name was registered on December 15, 2022, almost 8 years after the Complainants' first registration for the MODERNA Mark, and more than 12 years after the Complainants registered the domain name, <moderatx.com>. The Complaint states that the Respondent was using the Disputed Domain Name in connection with a passive website; however, as of the writing of this Decision, the Disputed Domain Name resolves to a parked landing page containing pay-per-click ("PPC") sponsored hyperlinks.

5. Parties' Contentions

A. Complainants

The following are the Complainants' contentions:

- the Disputed Domain Name is confusingly similar to the Complainants' MODERNA Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- the Disputed Domain Name was registered and is being used in bad faith.

The Complainants seek the transfer of the Disputed Domain Name from the Respondent to the Complainants in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent sent an email communication to the Center on February 6, 2023, requesting an extension of the Response due date. An automatic four-day extension of the Response due date was granted until February 11, 2023. The Respondent did not submit a formal Response.

6. Discussion and Findings

6.1 Primary Issue: Consolidation of the Complainants

There are two Complainants in this administrative proceeding, each of which is a Delaware, United States corporation with a principal place of business in Cambridge, Massachusetts, United States. Complainant ModernaTX, Inc. is a subsidiary of Complainant Moderna, Inc. and owner of the relevant trademarks in this proceeding.

In assessing whether a complaint filed by multiple complainants may be brought against one or more respondents, the appointed panel should consider 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.

Given the legal relationship between the two Complainants, it is appropriate that this Complaint is filed on behalf of both entities because “[a] trademark owner’s affiliate such as a subsidiary of a parent or of a holding company ... is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint”. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.4.1. The Panel therefore submits that consolidation of the Complainants would be appropriate in the present proceeding and would not have any unfair prejudicial effect on the Respondent. Moreover, the Complainants have been the target of common conduct by the Respondent, who has engaged in bad faith registration and use of the Disputed Domain Name.

Therefore, the Panel considers that it is fair and equitable under the circumstances of the case to permit consolidation as the Complainants are not only affiliated companies as parent and subsidiary, but also have common interests.

References to either or both Complainants will hereinafter be referred to as the “Complainant”.

6.2 Substantive Issues

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (i) the Disputed Domain Name is 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 Name; and
- (iii) the Disputed Domain Name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the MODERNA Mark as explained below.

It is uncontroverted that the Complainant has established rights in the MODERNA Mark based on its fame and several years of use as well as its registered trademarks for the MODERNA Mark in the United States and other jurisdictions worldwide. The registration of a mark satisfies the requirement of having trademark rights for purposes of standing to file a UDRP case. As stated in section 1.2.1 of the [WIPO Overview 3.0](#), “[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”. Thus, the Panel finds that the Complainant satisfied the threshold requirement of having rights in the MODERNA Mark.

The Disputed Domain Name consists of the MODERNA Mark in its entirety preceded by the term “hy-vee”, a third party’s trademark used in connection with, *inter alia*, retail pharmacy and grocery store services, and by the term “covid”, followed by the term “shots”, and then followed by the generic Top-Level Domain (“gTLD”) “.com”. Where the trademark is recognizable in the Disputed Domain Name, the addition of terms such as “hy-vee”, “covid” and “shots” does not prevent a finding of confusing similarity. See [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”).

Finally, the addition of a gTLD, such as “.com”, in a domain name is a technical requirement. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant’s MODERNA Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case. Furthermore, the Complainant has not authorized, licensed or otherwise permitted the Respondent to use its MODERNA Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. See Policy, paragraph 4(c).

As explained above, when the Complainant submitted the Complaint, the Disputed Domain Name resolved to an inactive website. However, as of the writing of this Decision, the Disputed Domain Name resolves to a landing page with PPC sponsored hyperlinks. Therefore, the Panel finds that the Respondent was not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name. Rather, the Respondent attempted to use the PPC hyperlinks to monetize the links when Internet users visiting the Disputed Domain Name clicked on the sponsored links. Therefore, the Panel finds that nothing on the record before it would support a finding that the Respondent has any rights or legitimate interests in the Disputed Domain Name.

Moreover, the composition of the Disputed Domain Name, comprising the entirety of the MODERNA Mark, carries a risk of implied affiliation and cannot constitute fair use here, as it effectively suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

In sum, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, the registration of a domain name that is confusingly similar to a trademark by an entity that has no relationship to that mark may be evidence of opportunistic bad faith. See *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#); *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#). Based on the circumstances here, the Respondent registered and used the Disputed Domain Name in bad faith to target the Complainant's MODERNA Mark for commercial gain.

Second, the Panel finds that the Respondent had actual knowledge of the Complainant's MODERNA Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. Based on the widespread use of the MODERNA Mark worldwide, it strains credulity to believe that the Respondent had not known of the Complainant or its MODERNA Mark when registering the Disputed Domain Name. The Respondent's awareness of the Complainant and its MODERNA Mark additionally suggests that the Respondent's decision to register the Disputed Domain Name was intended to cause confusion with the Complainant's MODERNA Mark and to disrupt the Complainant's business. Such conduct indicates that the Respondent registered the Disputed Domain Name in bad faith.

Third, the Panel concludes that the non-use of the Disputed Domain Name at the time of filing the Complaint, does not prevent a finding of bad faith under the doctrine of passive holding. See [WIPO Overview 3.0](#), section 3.3. Moreover, considering the current use of the Disputed Domain Name, the Panel finds that the Respondent registered and used the Disputed Domain Name in bad faith in an attempt to attract Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's MODERNA Mark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name's resolving website. The Respondent's registration and use of the Disputed Domain Name indicates that such registration and use had been done for the specific purpose of trading on the name and reputation of the Complainant and its MODERNA Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Fourth, the Respondent attracts Internet users for commercial gain by displaying third party PPC hyperlinks on the landing page to which the Disputed Domain Name currently resolves. The use of a confusingly similar domain name to display third party sponsored hyperlinks by capitalizing on a complainant's trademark and apparently collecting click-through fees is evidence of bad faith under paragraph 4(b)(iv) of the Policy. Thus, as here, the Panel concludes that such conduct constitutes bad faith. See *Fox News Network, LLC v. Warren Reid*, WIPO Case No. [D2002-1085](#); *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. [D2005-0556](#); *Lewis Black v. Burke Advertising, LLC*, WIPO Case No. [D2006-1128](#).

Finally, the Respondent has been involved in other UDRP cases involving cybersquatting, and in which the disputed domain names in those cases were ordered transferred to the Complainant. Thus, the Panel concludes that the Respondent in this case has engaged in a bad faith pattern of cybersquatting. See [WIPO Overview 3.0](#), section 3.1.2 ("UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration.").

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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 <hy-veecovidmodernashots.com>, be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: March 4, 2023