

## **ADMINISTRATIVE PANEL DECISION**

Midjourney, Inc. v. Taisom Mike  
Case No. D2024-0077

### **1. The Parties**

The Complainant is Midjourney, Inc., United States of America (“United States”), represented by DLA Piper US LLP, United States.

The Respondent is Taisom Mike, Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <midjourney-bot.com> (the “Disputed Domain Name”) is registered with Registrar of Domain Names REG.RU LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 9, 2024. On January 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 22, 2024, the Registrar transmitted by email to the Center its verification response, confirming that the Respondent is listed as the registrant and its contact details.

On January 23, 2024, the Center informed the parties in Russian and English, that the language of the registration agreement for the Disputed Domain Name is Russian. On February 3, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

Upon the Center’s request to rectify certain information in the Complaint, the Complainant filed an amended Complaint on February 8, 2024.

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 February 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 5, 2024.

The Center appointed Mariia Koval as the sole panelist in this matter on March 15, 2024. 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 is an innovative independent research laboratory that uses artificial intelligence (the "AI") software allowing customers to generate images from text prompts. The Complainant started a private beta in early 2022 and quickly garnered a significant user base in the tens of thousands. The Complainant then officially launched the public beta version of its software offerings in July 2022, again quickly earning widespread acclaim and an even larger user base for its text to image offerings. As of the filing of this Complaint, the Complainant's discord server has nearly eighteen million members, with typically well over one million members online at any given time. The Complainant has been featured in a number of news articles and has also been discussed at length on the popular television show "Stephen Colbert".

The Complainant provides a list indicating that in 2022 and 2023 it has filed three applications in the United States for the MIDJOURNEY trademark (the "MIDJOURNEY Trademark"): No. 97597218, filed in respect of services in classes 41, 42 and 45; No. 97597231 filed in respect of services in class 35; No. 97844441, filed in respect of goods and services in classes 9, 16, 25 and 38. None of these applications has been registered at the date of filing of the Complaint.

Based on its general powers articulated inter alia in paragraphs 10 and 12 of the Rules, the Panel conducted additional research to determine that, along with the above pending trademark applications, the Complainant owns several trademarks for MIDJOURNEY (the "MIDJOURNEY Trademark"), e.g. International Trademark Registration No. 1737060 registered on March 17, 2023, based on the pending United States application 97597218.<sup>1</sup>

The Complainant claims that it is operating a domain name <midjourney.com>, consisting of the MIDJOURNEY Trademark.

The registration date of the Disputed Domain Name is April 25, 2023. As at the dates of filing of the Complaint and this Decision, the Disputed Domain Name resolves to an inactive webpage which displays an error message.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

---

<sup>1</sup>Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") section 4.8.

The Complainant contends that it has developed a strong reputation in the United States and around the world for its MIDJOURNEY Trademark. In addition to its above-referenced pending United States MIDJOURNEY Trademark applications, the Complainant owns common law rights and the related goodwill to its MIDJOURNEY Trademark. The Complainant has been using the MIDJOURNEY Trademark in connection with its AI technology offerings since at least as early as early 2022, and in public beta since at least as early as July 2022. There were numerous news articles that discussed the Complainant and its offerings that were published prior to the Respondent's registration of the Disputed Domain Name, and tens thousands of users of the Midjourney AI software offerings also prior the Respondent's registration of the Disputed Domain Name in 2023.

The Complainant asserts that the Disputed Domain Name is confusingly similar to the Complainant's MIDJOURNEY Trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. At the time the Respondent began using the Disputed Domain Name, the Complainant had already been using the MIDJOURNEY Trademark for over a year and had amassed a significant following that viewed the MIDJOURNEY Trademark as a source-identifier. The Respondent has no relationship with the Complainant and no authorization from the Complainant to use the MIDJOURNEY Trademark in the Disputed Domain Name, or to otherwise associate himself and its infringing website with the Complainant. The Respondent is not affiliated with the Complainant in any manner. To the Complainant's knowledge (i) the Respondent has not filed any applications for registration of MIDJOURNEY in any trademark office or jurisdiction worldwide; and (ii) the Respondent is not commonly known by the Disputed Domain Name. The Disputed Domain Name was used to attract Internet users seeking legitimate information about Midjourney AI software.

The Complainant also claims that the Respondent has registered and is using the Disputed Domain Name in bad faith. The Respondent intentionally, and for commercial gain, registered and used the Complainant's company name and the MIDJOURNEY Trademark in the Disputed Domain Name to attract Internet users to its website. Additionally, the Respondent's use of the moniker "Midjourney-bot" is particularly problematic given that the Complainant uses the same language when labeling posts from its service on the website discord. As of the filing of this Complaint, the Disputed Domain Name is not hosting any active content and instead only displays an error message.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant to succeed must satisfy the panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (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.

### **6.1. Preliminary Issue: Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the following:

- the Complainant is based in the United States;
- the Disputed Domain Name fully incorporates the Complainant's English language trademark (and the English word "bot") that suggests that the Respondent is able to understand English for purposes of understanding this Complaint;
- substantial additional expense and delay would likely be incurred if the Complaint has to be submitted in Russian;
- the Respondent did not object to the proceeding continuing in English.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

The Complainant and its representative are United States companies. Accordingly, neither the Complainant nor its representative are able to understand and to communicate in Russian. Forcing the Complainant to translate the Complaint and annexes thereto, would result in unfair additional expenses for the Complainant and would delay this UDRP proceeding. The Panel further notes that the Center notified the Parties in Russian and English of the language of the proceeding as well as notified the Respondent in Russian and English of the Complaint. Furthermore, according to the Respondent's contact details his residence is Canada where the English language is one of the official languages. Moreover, the Respondent did not file any suggestions or objections regarding the language of this proceeding.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

#### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or 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.

Further to the above, the Complainant did not provide evidence of any registered trademark rights at the time of filing the Complaint. Rather, the Complainant submits that it owns common law rights in the MIDJOURNEY Trademark through extensive use of its company name and MIDJOURNEY Trademark in association with the AI generative technology. The Complainant also relies upon its pending applications for the MIDJOURNEY Trademark.

According to the [WIPO Overview 3.0](#), section 1.3, to establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. ... As noted in section 1.1.2, for a number of reasons, including the global nature of the Internet and Domain Name System, the fact that secondary meaning may only exist in a particular geographical area or market niche does not preclude the complainant from establishing trademark rights (and as a result, standing) under the UDRP. Also noting the availability of trademark-like protection under certain national legal doctrines (e.g., unfair competition or passing-off) and considerations of parity, where acquired distinctiveness/secondary meaning is demonstrated in a particular UDRP case, unregistered rights have been found to support standing to proceed with a UDRP case including where the complainant is based

in a civil law jurisdiction. The fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier. Even where a panel finds that a complainant has UDRP standing based on unregistered or common law trademark rights, the strength of the complainant's mark may be considered relevant in evaluating the second and third elements.

In this case the Panel finds that the Complainant has trademark rights in the MIDJOURNEY Trademark by virtue of extensive use and promotion of its unregistered MIDJOURNEY Trademark, its company name, and likeness in association with generative AI software. In particular, the Complainant presented the evidence that currently its discord server has nearly eighteen million members as well as the evidence of reference to Midjourney AI software in a number of news articles. Therefore, the Complainant's rights have been established through extensive evidence of use of the MIDJOURNEY Trademark since 2022. Lastly, given the Panel's above-referenced additional research, the Complainant is the owner of at least one trademark that has matured to registration, illustrating the source-identifying function that the MIDJOURNEY mark has attained with respect the Complainant. Additional arguments regarding the strength of the MIDJOURNEY Trademark will be described under the second and third elements.

The Disputed Domain Name contains the entirety of the Complainant's MIDJOURNEY Trademark, as well as a hyphen, the term "bot", and the generic Top-Level Domain ("gTLD") ".com". The gTLD ".com" should be disregarded under the confusing similarity test as a standard registration requirement. See the [WIPO Overview 3.0](#), section 1.11,1.

Although the addition of the other term, here "bot", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Disputed Domain Name and the MIDJOURNEY Trademark for the purposes of the Policy. Furthermore, the use of the hyphen in the Disputed Domain Name is irrelevant in a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.8.

The Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's MIDJOURNEY Trademark, and that the Complainant has established the first condition of paragraph 4(a) of the Policy.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Based on the evidence filed in this proceeding, the Panel finds that the Complainant has made out a prima facie case with respect to the Respondent's lack of rights and legitimate interests. The Complainant clearly owns rights in the MIDJOURNEY Trademark; the Complainant has used its MIDJOURNEY Trademark since 2022 and has an established reputation in generative AI software.

There is no evidence that the Complainant has licensed or otherwise permitted the Respondent to use its MIDJOURNEY Trademark or to register the Disputed Domain Name which is confusingly similar to the MIDJOURNEY Trademark.

The composition of the Disputed Domain Name carries a risk of implied affiliation with the Complainant (see [WIPO Overview 3.0](#) review 3.0, section 2.5.1). The Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name to misleadingly divert consumers or to tarnish the MIDJOURNEY Trademark of the Complainant. As of the date of this Decision the Disputed Domain Name resolves to an inactive website. The use of the term “bot” within the Disputed Domain Name only enhanced the impression that the Respondent’s website somehow related to the Complainant since the Complainant’s website also contained the “Midjourney bot” tool. Therefore, the Panel cannot consider such use of the Disputed Domain Name as bona fide offering of goods or services, or a legitimate noncommercial or fair use.

With respect to the circumstances of this case, the Panel considers that it is obvious that the Respondent registered the Disputed Domain Name with good awareness of the Complainant and with the sole intention of misleading Internet users by creating a likelihood of confusion with the Complainant’s MIDJOURNEY Trademark.

The fact that the Disputed Domain Name currently resolves to inactive website is further evidence that the Respondent lacks rights or legitimate interests.

The Respondent did not file any response to the Complaint and did not participate in this proceeding, respectively, the Respondent did not present any evidence for supporting any rights or legitimate interests in the Disputed Domain Name.

In light of the above the Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel comes to the conclusion that the Respondent was well aware of the Complainant’s trademark rights in the MIDJOURNEY Trademark when it registered the Disputed Domain Name. This inference is supported by the following factors:

- 1) the Complainant’s MIDJOURNEY Trademark is distinctive for generative AI software and services;
- 2) the Respondent chose to register the Disputed Domain Name that was comprised of the Complainant’s MIDJOURNEY Trademark in its entirety and following the filing of various trademark applications for the MIDJOURNEY Trademark, suggesting an intent to target the Complainant’s nascent (as of yet unregistered) trademark rights;
- 3) the Respondent, having registered and used the Disputed Domain Name that is confusingly similar to the Complainant’s MIDJOURNEY Trademark, intended to take unfair advantage of the Complainant’s reputation given the descriptive addition of “bot” to the Complainant’s MIDJOURNEY Trademark.

Furthermore, while the Disputed Domain Name resolves to an inactive website, it has been established that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Section 3.3 of the [WIPO Overview 3.0](#). Given the Complainant’s well-reported involvement and reputation in the AI software industry, the composition of the disputed domain name, and the Respondent’s apparent provision of false or incomplete contact information given the courier’s inability to deliver the Center’s written communication to the details disclosed by the Registrar for the Respondent, such passive holding does not prevent a finding of use in bad faith.

In view of the absence of any evidence to the contrary and that the Respondent did not file any response to claim otherwise, the Panel concludes that the Respondent has engaged in bad faith conduct with respect the Disputed Domain Name.

The Panel finds that the Complainant has established the third element 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 <midjourney-bot.com> be transferred to the Complainant.

*/Mariia Koval/*

**Mariia Koval**

Sole Panelist

Date: March 29, 2024