

## **ADMINISTRATIVE PANEL DECISION**

Substack, Inc., v. Yoda Yoda  
Case No. D2024-1759

### **1. The Parties**

The Complainant is Substack, Inc., United States of America (“US”), represented by Rosen, Wolfe & Hwang, US.

The Respondent is Yoda Yoda, US.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 26, 2024. On April 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 26, 2024, 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 (PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 30, 2024, 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 May 2, 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 May 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 28, 2024.

The Center appointed Kathryn Lee as the sole panelist in this matter on June 4, 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 operates a subscription media service called “The Substack Platform”. The service was launched in 2017 and hosts more than 35 million combined subscriptions. The Complainant owns trademark registrations for SUBSTACK in the US as follows: US Trademark Registration Numbers 5,554,882 and 7,126,577, registered on September 4, 2018, and August 1, 2023, respectively. The Complainant owns and operates the domain names <substack.com> and <substackinc.com>, and uses the <substackinc.com> domain name for directing email communications to its employees.

The Respondent appears to be an individual with a purported location in Alabama, US.

The disputed domain name was registered on April 19, 2023, and it was allegedly used in connection with a fraudulent email scheme.

#### **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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the SUBSTACK mark in which the Complainant has rights, as it consists of “substack” and simply adds the generic term “inc” to the end of the trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect. The Complainant contends the Respondent sent phishing text messages to its employees, specifically, text messages containing a hyperlink to a page on the <substackinc.org> disputed domain name: “Recent changes to your employment status: “[www.hr/substackinc.org/status/update/view/2042023/Changes/signin/](http://www.hr/substackinc.org/status/update/view/2042023/Changes/signin/)” - Please note that failing to update your employments status during a pending state may result in network access issues.” The Complainant contends that this does not represent legitimate use. The Complainant also contends that the Respondent used a privacy shield and fake contact information, and that this is further evidence of the Respondent’s lack of rights and legitimate interests in the disputed domain name. Specifically, the Complainant contends that while the Whois records give the Respondent’s location as Diork, Alabama in the US, there is no city called “Diork” in the state of Alabama, or elsewhere. The Complainant also contends that the Respondent’s name “Yoda Yoda” is likely fake, and that the Respondent’s email address service Yopmail provides “disposable email addresses” and “temporary and anonymous inboxes.”

Finally, the Complainant contends that the disputed domain name was registered and used in bad faith. The Complainant contends that the Respondent registered the disputed domain name with the knowledge of the Complainant and with the intention of furthering a phishing scam in order to obtain sensitive login information from the Complainant’s employees.

##### **B. Respondent**

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

## **6. Discussion and Findings**

### **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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms – here, “inc” – 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 mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

### **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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Further, panels have held that the use of a domain name for illegal activity – here, claimed phishing – can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

In the present case, the Panel notes that the Respondent sent text messages to the Complainant's employees, inviting them to click on a hyperlink at the disputed domain name, likely to obtain personal confidential information from them for possible illegal purposes. Panels have held that the use of a domain name for illegal activity – here, claimed phishing – constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Further, considering the use of the disputed domain name in perpetuating fraud, it is quite clear that the Respondent registered the disputed domain name with knowledge of the Complainant's trademark and the intent to benefit financially from the disputed domain name and the Complainant's trademark. The Panel also notes that the Complainant owns the almost identical domain name <substackinc.com>.

The disputed domain name does not resolve to any active website, but panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the use of the disputed domain name in a phishing scheme, the distinctiveness of the Complainant's trademark, the lack of any response from the Respondent or to provide any evidence of actual or contemplated good-faith use, the Respondent's use of a privacy service, and the use of false contact registration details by the Respondent, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 <substackinc.org> be transferred to the Complainant.

*/Kathryn Lee/*

**Kathryn Lee**

Sole Panelist

Date: June 18, 2024