

ADMINISTRATIVE PANEL DECISION

ZeniMax Media Inc. v. Marc Hunter
Case No. D2024-1917

1. The Parties

The Complainant is ZeniMax Media Inc., United States of America, represented by Kisch Global Limited, United Kingdom.

The Respondent is Marc Hunter, Canada.

2. The Domain Name and Registrar

The disputed domain name <falloutbase.com> is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 7, 2024. On May 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 9, 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 (FalloutChronicles / FalloutBase) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 10, 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 13, 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 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 19, 2024.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on July 9, 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 ZeniMax Media Inc. is an award-winning creator and worldwide publisher of interactive entertainment, including video games. In September 2020, Microsoft Corporation acquired ownership over all the Complainant and all its subsidiaries, which are now part of the larger Microsoft Gaming division.

ZeniMax Media Inc. studios are best known for developing action and role-playing video games, such as *Fallout* which is a role-playing video game set in a post-apocalyptic, retro-futuristic world of the mid-22nd century. The development of *Fallout* began in early 1994. The first game, *Fallout*, was released in October 1997. Three sequels were published: *Fallout 2* (1998), *Fallout 3* (2008) and *Fallout 4* (2015). Spin-offs have also been published.

To date, the video game series and franchise merchandise *Fallout* has been almost exclusively distributed through the Complainant's official stores and websites and selected authorized distributors and retailers. The Complainant also has a successful third-party licensing scheme.

The Complainant has rights over a number of trademark registrations consisting in FALLOUT:

- International trademark FALLOUT (word) Nos. 905457 and 905457A registered on November 2, 2006;
- International trademark FALLOUT (word) Nos. 1488042 and 1488042A registered on November 2, 2018;
- United States of America trademark FALLOUT (word) No. 88179343 registered on September 19, 2023.

The Complainant is also the owner of the domain name <fallout.com> which redirects to the official *Fallout* website "https://fallout.bethesda.net".

The disputed domain name <falloutbase.com> was registered on April 17, 2024. At the time of its detection, according to screenshots provided by the Complainant, it redirected to a website promoting and offering presale links to cryptocurrency and/or third party NFTs and digital collectables of other commercial origin. This website also contained hyperlinks redirecting to a third-party website offering unauthorized third-party tokens under the trade mark FALLOUT. The webpage hosted by the Respondent made direct references to the universe of Complainant's videogame, in particular through the use of images associated to it. The website also included a disclaimer, in small lettering and available solely at the bottom: "While inspired by the Fallout universe, our cryptocurrency project, Caps, is an independent endeavor. We are not affiliated with the Fallout brand or its creators. Any similarities are coincidental. Invest responsibly".

Currently the domain name resolves to an inactive website.

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 identical or confusingly similar to its registered trademarks FALLOUT. It wholly reproduces the Complainant's registered trademark FALLOUT associated with the non-distinctive and descriptive term "base". The addition of merely generic, descriptive,

or geographical wording to a trademark in a domain name is normally insufficient to avoid a finding of confusing similarity under the first element of the UDRP. According to the Complainant's own words, any Internet user when visiting a website provided under the disputed domain name <falloutbase.com> will reasonably expect to find a website commercially linked to the owner of the trademarks FALLOUT. This unlawful association is exacerbated by the use of the Complainant's official content without the Complainant's authorization.

Second, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register a domain name incorporating its trademarks FALLOUT (or a domain name which could be associated with these trademarks). The Respondent did not make a legitimate noncommercial or fair use of the disputed domain name. On the contrary, in addition to using the Complainant's registered trademark FALLOUT without authorization, the disputed domain name redirected to a website using the Complainant's official content without authorization. Thus, the Respondent's behavior demonstrated a clear intention to obtain an unfair commercial gain, with a view to misleadingly diverting consumers or to tarnish the trademarks owned by the Complainant. The website associated with the disputed domain name was promoting and offering unauthorized third-party tokens and/or NFTs of other commercial origin featuring the Complainant's trademark FALLOUT, whereas the Respondent is not an authorized official and authorized reseller, agent or licensee of the trademark FALLOUT and/or official Fallout Content. This created the illegitimate and false impression of an affiliation with the Complainant, that the website was endorsed by the Complainant, which it was not the case. For a reseller or a distributor to make a bona fide offering of goods or services, the Respondent must comply with the Oki Data test which was not met in the case as the website offered unauthorized products. And a disclaimer positioned at the bottom of the website indicated that this website was inspired by the *Fallout* universe but not affiliated with the trademark FALLOUT and that "similarities were coincidental".

Third, the Complainant indicates that the disputed domain name was registered and used in bad faith. It is evident from the Respondent's use of the disputed domain name that the Respondent knew of the Complainant's trademark FALLOUT. Immediately after registering the disputed domain name, the Respondent started offering unauthorized third-party tokens and/or NFTs of other commercial origin featuring the Complainant's trademark FALLOUT. The term FALLOUT is not commonly used to refer to video games. Therefore, the Respondent's choice of the disputed domain name could not be purely coincidental. By reproducing the Complainant's trademark in the disputed domain name and on the website, the Respondent was clearly suggesting that the Complainant was the source of the website. The Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to the associated website by creating a likelihood of confusion with the Complainant's registered trademarks FALLOUT as to the source, sponsorship, affiliation, or endorsement of its website or location or of the unauthorized third-party tokens and/or NFT's of unknown commercial origin on its website or location.

The Respondent requests the transfer of the disputed domain name.

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.

Although the addition of other terms, here “base”, 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.

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 reserved a domain name reproducing the Complainant’s trademark FALLOUT in order to set up a website offering links for the pre-sale of third-party crypto-currencies and/or NFTs and digital collectibles not authorized by the Complainant. This website also contained hyperlinks redirecting to a third-party website offering unauthorized third-party tokens under the trademark FALLOUT. The website’s graphic universe featured elements of the FALLOUT video games. It is therefore clear that the Respondent had the Complainant’s trademark in mind when registering the disputed domain name and has registered and used this domain name to attract Internet users to the website for commercial gain, by creating a likelihood of confusion with the Complainant’s trademarks, in accordance with paragraph 4(b)(iv) of the Policy, which is evidence of the registration and use of the disputed domain name in bad faith.

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 <falloutbase.com> be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: July 22, 2024