

## **ADMINISTRATIVE PANEL DECISION**

Discord Inc. v. Kyle Gue  
Case No. D2024-2671

### **1. The Parties**

The Complainant is Discord Inc., United States of America (“United States”), represented by Abion GmbH, Switzerland.

The Respondent is Kyle Gue, Philippines.

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

The disputed domain name <discordsystem.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 1, 2024. On July 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 3, 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 (Whois Privacy Protection Service by onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 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 July 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 July 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 13, 2024.

The Center appointed Haig Oghigian as the sole panelist in this matter on August 19, 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, Discord Inc., is a free voice, video, and text chat application. Created in 2015, it was originally developed for video game players as a chat app to communicate with friends while playing games online and to have a place to provide running commentary on what was going on, but it has quickly become popular among the general public and it is now used by all kinds of users, from local hiking clubs, to art communities, to study groups. Per Discord Inc.'s website, the application has around 150 million monthly active users, and per the web analytics firm Similarweb is consistently among the top 50 most visited websites on the Internet.

The Complainant is the owner of numerous registered trademarks including the sign “Discord”, alone or combined with another element, registered worldwide including but not limited to the following:

Jurisdiction	Mark	No.	Registration Date
United States	DISCORD	4930980	April 5, 2016
China	DISCORD	17248710	August 28, 2016

In addition to the above trademarks, the Complainant also owns and operates numerous domain names composed of the mark DISCORD, alone or combined with another element. These include <discord.com>, which has been registered since November 6, 2000, and <discordapp.com> which has been registered since February 26, 2015. The Complainant uses these domain names to resolve to its official websites through which it informs Internet users and potential consumers about its DISCORD mark and its products and services

According to the Whois records, the disputed domain name was registered on April 18, 2024.

At the time the Complainant filed their Complaint, the disputed domain name resolves to an inactive site.

Additionally, the disputed domain name has been used, via the email function, in order to send phishing email attempts, impersonating the Complainant.

**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.

The Complainant’s contentions are as follows.

As to whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, the Complainant contends the only difference is the Respondent’s addition of the term “system” directly adjacent to the term “DISCORD”, which is identical to the Complainant’s trademark and official domain name. The Complainant highlights that the attractive and distinctive element of the disputed domain name is the Complainant’s trademark DISCORD since the other element associated with said trademark is a descriptive term.

The Complainant contends that the DISCORD trademark is clearly recognizable within the second level portion of the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), paragraph 1.8 states: "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. The nature of such additional term(s) may however bear on assessment of the second and third elements". The Complainant further provides that the presence of the generic Top-Level Domain ("gTLD") extension ".com" in the first level portion of the disputed domain name is a standard registration requirement and may be disregarded when assessing whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#); *Can Pro Pet Products LTD. v. Matthew Dweck*, WIPO Case No. [D2020-0615](#)).

As a result of the above, the Complainant submits that the disputed domain name is therefore confusingly similar to the Complainant's DISCORD trademark.

As to whether the Respondent has rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Complainant has not licensed or authorized the Respondent to use its trademarks; that the Respondent is not affiliated to the Complainant; and that the Complainant did not authorize the Respondent to register or use the disputed domain name incorporating its respective trademarks nor has the Complainant endorsed or sponsored the Respondent or the Respondent's websites. Simultaneously, the Complainant asserts that there is no evidence that the Respondent is commonly known by the disputed domain name, or that the Respondent owns any trademarks, including any related to the disputed domain name, as in here, "discord system". When searching for the disputed domain name terms using Google's search engine, the returned results point to the Complainant and its services, among others. The Complainant therefore claims that apart from the reference to the disputed domain name, there is no available information on the Respondent being commonly known by the disputed domain name.

Additionally, the Complainant shows that the disputed domain name is not connected to an active website and therefore cannot be in connection with any bona fide offering of goods or services. However, the Complainant also has shown that the disputed domain name has been used in at least one phishing attempt, via the email address "[...]@discordsystem.com". The Complainant asserts that constitutes fraudulent activity and may tremendously disrupt the business operations of the Complainant, its partners, and customers, as victims of such type of phishing attack could and would be misled into believing that they are corresponding with the Complainant and, potentially, unintentionally involved in fraud.

The Complainant alleges that by reading the disputed domain name, Internet users may believe that the disputed domain name is directly connected or authorized by the Complainant and that it will resolve to the Complainant's official website, which is not the case. Citing previous UDRP Panel decisions and as indicated in the [WIPO Overview 3.0](#), section 2.5, "a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner", the Complainant argues that in the present case, the Respondent has aimed at making Internet users believe that the disputed domain name is directly linked to, or operated by, the Complainant. In similar circumstances, it has been held that "the nature of the disputed domain name carries a risk of implied affiliation" (see *Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Murat Sander*, WIPO Case No. [D2021-0526](#)) and therefore that such composition of terms within the structure of the disputed domain name cannot constitute fair use.

The use of the disputed domain name to perpetrate an illegal activity, such as phishing and/or impersonation, as previously held by several UDRP Panels in similar circumstances, "can never confer rights or legitimate interests on a respondent" (See [WIPO Overview 3.0](#), section 2.13.1; *Darden Concepts, Inc. v. LELAND ARCHER*, WIPO Case No. [D2023-0617](#)).

In view of the above, the Complaint states that the Respondent does not have rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

The Complainant contends that the disputed domain name was registered and used in bad faith.

In terms of registration, the Complainant states that their registration of all their trademarks related to this case pre-dates the registration of the disputed domain name, and that no authorization has been given at any time to the Respondent to use the Complainant's distinctive trademark DISCORD. The Complainant has demonstrated that it enjoys a strong online presence, and that by searching the terms "discord systems" in any online search engine, the Respondent would have inevitably learnt about the Complainant, its trademark and business (citing *Teamreager AB v. Muhsin E. Thiebaut, Walid Victor*, WIPO Case No. [D2013-0835](#); *Amundi Asset Management v. 唐晓鸣 (tang xiao ming)*, WIPO Case No. [D2019-2744](#)). Additionally, the Complainant referred to previous WIPO Panels which have recognized that DISCORD is well known in its market, citing *Discord Inc. v. Domain Administrator*, (*Discord Inc. v. Domain Administrator*, See *PrivacyGuardian.org / Maven Pos Service LLP, Tilek Suierkulov*, WIPO Case No. [D2021-0893](#), that "the trademark DISCORD is well-known in the market of messaging and chat services"). Given the notoriety of the trademark, the Complainant concludes that it is inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the disputed domain name. The Complainant asserts that it is very likely that the Respondent registered the disputed domain name incorporating the DISCORD trademark intentionally and consequently that the Respondent has registered the disputed domain name in bad faith.

Finally, as discussed earlier, the disputed domain name has been used in connection with a phishing attempt, which when combined with the aforementioned established reputation of the Complainant and its trademark, clearly shows bad faith use on the part of the Respondent, according to the Complainant.

The Complainant concludes that the aforementioned facts demonstrate that the Respondent has been using the disputed domain name in bad faith, that the overall described circumstances are clear demonstration of the registration and use of the disputed domain name in bad faith and that the Respondent's conduct falls within the meaning of paragraph 4(a)(iii) of the Policy.

## **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 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, "systems," 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.

Panels have held that the use of a domain name for illegal activity here, claimed phishing and impersonation/passing off, 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 deliberately and knowingly impersonated the Complainant in order to seek commercial gain. The Panel finds that such conduct where the Respondent sought or realized commercial gain, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation of the disputed domain name and emails sent using that domain name, clearly indicates the Respondent’s bad faith, as proscribed by the Policy at paragraph 4(b)(iv) and as stated in many previous WIPO UDRP decisions, in particular *SAP SE v. Anuoluwapo Akobi*, WIPO Case No. [D2018-0624](#), supra, where the panel stated that “the use of the disputed domain name in connection with a fraudulent email scheme can only lead to the conclusion that the disputed domain name is being used in bad faith”.

Panels have held that the use of a domain name for illegal activity here, phishing and impersonation/passing off 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.

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 <discordsystem.com> be transferred to the Complainant.

*/Haig Oghigian/*

**Haig Oghigian**

Sole Panelist

Date: September 2, 2024