

ADMINISTRATIVE PANEL DECISION

Modernatx, Inc. v. Mohamed Shakir
Case No. DAI2024-0068

1. The Parties

The Complainant is Modernatx, Inc., United States of America (“United States”), represented by Domain Name Head, United States.

The Respondent is Mohamed Shakir, United States.

2. The Domain Name and Registrar

The disputed domain name <modernatx.ai> is registered with Hexonet Services Inc / 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 17, 2024. On September 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 19, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 25, 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 amendment to the Complaint on September 30, 2024.

The Center verified that the Complaint [together with the amendment to the Complaint/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 October 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 22, 2024. The Respondent sent email communications to the Center on September 25, November 5, and December 3, 2024. Further to a communication received on October 2, 2024, from Complainant, requesting the suspension of the above-referenced administrative

proceeding, the administrative proceeding was suspended until November 1, 2024, for purposes of settlement discussions concerning the disputed domain name. The proceeding was reinstated on November 5, 2024. The new Response due date was November 25, 2024.

The Center appointed William F. Hamilton as the sole panelist in this matter on December 3, 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 develops mRNA medicines, including a COVID-19 vaccine. The Complainant's COVID-19 vaccine was launched in 2021 and is approved for distribution in more than 70 countries. Sales of the Complainant's COVID-19 vaccine exceed USD 15 billion and 800 million doses.

The Complainant owns a sweeping international portfolio of trademark registrations for MODERNA and other trademarks based on the MODERNA mark, including the trademark MODERNATX. The Complainant owns the domain name <modernatx.com> which has hosted its corporate website for over a decade.

The Complainant's many registrations of the MODERNA mark include United States Registration No. 4,659,803, registered on December 23, 2014; Registration No. 4,675,783, registered on January 20, 2015; Registration No. 4,811,834 registered on September 15, 2015; and Registration No. 5,543,197 dated August 21, 2018. More recently, on June 14, 2022, the Complainant obtained China Registration No. 61415206 for the trademark MODERNATX.

The disputed domain name was registered on May 16, 2023. The disputed domain name resolved to an empty light blue colored page. The Respondent's webpage has multiple metatag scripts, including Google AdSense and a behavioral tracking tool allowing the Respondent to collect data on persons directed to the Respondent's website by the disputed domain name.

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 to the MODERNATX mark. Additionally, the Complainant contends that the disputed domain name is confusingly similar to its United States trademark registrations for MODERNA. The Complainant contends that the Complainant has never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, has never operated a business under the disputed domain name, has not advertised the disputed domain name, and have never engaged in any bona fide commercial activity in connection with the disputed domain name. The Complainant contends that the Respondent has no rights or legitimate interests in the Complainant's trademarks and has registered and used the disputed domain name in bad faith to disrupt the Complainant's business and harvest information regarding visitors who are directed to the Respondent's website by the disputed domain name.

B. Respondent

The Respondent sent informal email communications to the Center on September 25, November 5, and December 3, 2024. On September 25, 2024, the Respondent stated "[w]e in fact purchase this domain with the goal of transfereing this to modernatx.. if the dispute is related to modernatx wanting this domain please

let me know I can contact them". The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

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

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

A. Identical or Confusingly Similar

The Complainant has shown rights in the trademarks for the purposes of the Policy by virtue of the trademarks' subsisting registration in the United States, China, and globally.

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 disputed domain name incorporates the MODERNATX mark in its entirety and is identical to the MODERNATX mark for the purposes of the Policy. Previous UDRP panels have consistently found that merely adding additional terms, such as "tx" in this case, to a registered trademark results in confusing similarity. Accordingly, the Panel finds the disputed domain name is confusingly similar to the Complainant's MODERNA mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. See generally *Modernatx, Inc. v. David Chen*, WIPO Case No. [D2022-3189](#) (transferring <modernabooster.com>).

The Top-Level Domain ("TLD") of the disputed domain name, in this case ".ai" may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1.

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 Respondent's use of an empty webpage without the promotion of products or services while simultaneously collecting visitor data fails to establish any rights or legitimate interests in the disputed domain name.

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

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following non-exhaustive scenarios:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Respondent registered the disputed domain name several years after the Complainant secured its trademark registrations. Given the Complainant's extensive and worldwide use of the MODERNA mark, the Respondent's failure to use the disputed domain name for offering any products or services, the Respondent's lack of response to the Complainant's allegations, the use of a privacy shield to obscure the Respondent's identity, the exploitation of the disputed domain name to collect and harvest data from visitors, the replication of the Complainant's primary business domain name <modernatx.com> in the disputed domain name <modernatx.ai>, and the complete incorporation of the MODERNATX mark as well as the confusing use of the MODERNA mark, the Panel concludes that the Respondent was aware of the Complainant's rights in the MODERNA and MODERNATX marks when registering and using the disputed domain name. Accordingly, the Panel finds that the disputed domain name was registered and used 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 <modernatx.ai> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: December 17, 2024