

ADMINISTRATIVE PANEL DECISION

Moderna, Inc., ModernaTX, Inc. v. Super Privacy Service LTD c/o Dynadot /
Shawn Wang
Case No. D2022-2125

1. The Parties

The Complainant is Moderna, Inc., ModernaTX, Inc., United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / Shawn Wang, Germany.

2. The Domain Name and Registrar

The disputed domain name <modernatotalrewardssurvy.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 11, 2022. On June 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 14, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 15, 2022, 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 June 16, 2022.

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 June 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 12, 2022.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on July 18, 2022. 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 a public company founded in 2010 with more than 3,000 employees. The Complainant's pioneering COVID-19 vaccine is one of the most widely administered vaccines in the history of medicine. Health authorities in more than 70 countries worldwide have approved the Complainant's COVID-19 vaccine. In 2021, the Complainant manufactured and shipped 800 million doses of the COVID-19 vaccine globally. The Complainant's sales in 2021 were approximately USD 18.5 billion.

The Complainant owns the following trademarks in the United States:

- MODERNA (design), United States Registration No. 4,675,783, registered on January 20, 2015, for goods in classes 1 and 5;
- MODERNA (word), United States Registration No. 4,811,834, registered on September 15, 2015, for services in class 42;
- MODERNA MESSENGER THERAPEUTICS (design), United States Registration No. 4,675,775, for goods in classes 1 and 5;
- MODERNA UNIVERSITY (word), United States Registration No. 5,311,631, registered on October 17, 2017, for services in class 41;
- MODERNA UNIVERSITY (design), United States Registration No. 5,311,632, registered on October 17, 2017, for services in class 42;
- MODERNA MODERNA COVID-19 VACCINE (design), United States Registration No. 6,389,465, registered on June 15, 2021, for goods in class 5.

The Complainant is the owner of the domain name <mondernatx.com>, created on September 7, 2010, used in connection with its primary website.

The Complainant also used the domain name <modernatotalrewardssurvey.com> in connection with communications with its employees. This domain name was registered, with the Complainant's authorization, by one of the Complainant's vendors, on May 20, 2022.

The disputed domain name was registered on May 21, 2021, and leads to a website containing pay-per-click links related to employee's services and awards.

5. Parties' Contentions

A. Complainant

The Complainant maintains that the disputed domain name is confusingly similar to its earlier MODERNA trademark as it incorporates it entirely. The addition of the words "total", "rewards", and "survy" cannot prevent a finding of confusing similarity, being the Complainant's mark still clearly recognizable within the disputed domain name.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain name as the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the MODERNA trademark in any manner. Moreover, to the Complainant's best knowledge, the Respondent has never been commonly known by the disputed domain name and has never acquired any trademark or service mark rights in the disputed domain name. By using the disputed domain name in connection with a pay-per-click page, the Respondent has failed to create a

bona fide offering of goods or services under the Policy. Instead, the Respondent's actions are clearly commercial and therefore the Respondent cannot establish rights or legitimate interests in the disputed domain name.

Finally, the Complainant contends that given its widespread use and worldwide resonance, especially due to the massive COVID-19 vaccine campaign, subject of daily articles in the main newspapers worldwide, the MODERNA trademark has become widely renowned. It is therefore implausible that the Respondent was unaware of the Complainant when it registered the disputed domain name. Because the disputed domain name is so obviously connected with the Complainant, the Respondent's action suggests opportunistic bad faith.

The disputed domain name leads to a webpage containing pay-per-click links. Such use constitutes bad faith as the Respondent is capitalizing on the likelihood of confusion with the Complainant's mark in an attempt to generate a commercial gain.

Furthermore, the disputed domain name was registered only one day after the Complainant's vendor registered the nearly identical domain name <modernatotalrewardssurvey.com>. This close correlation in timing is a further indication of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Consolidation of Complainants

The Panel notes that this UDRP Complaint has been filed by two different entities, Moderna TX, Inc., which is the owner of the MODERNA trademarks cited as a basis of this UDRP, and Moderna, Inc., which is its parent company.

A trademark owner's affiliate such as a subsidiary of a parent or of a holding company is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint (see Paragraph 1.4.1 of the "[WIPO Overview 3.0](#)").

"In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels usually look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation" (Paragraph 4.11.1 of the "[WIPO Overview 3.0](#)").

In the instant case, the Panel finds that both Complainants have common grievance against the Respondent in view of the fact that they belong to the same group of companies, use the same MODERNA trademark and are known by this mark. Hence, the Respondent has engaged in common conduct that has affected both Complainants in a similar fashion. Moreover, allowing the consolidation would not be against the interests of the Respondent and would be procedurally efficient and equitable.

For all the reasons set forth above, the Panel is in favor of the consolidation of the Complainants.

B. Identical or Confusingly Similar

The Complainant has shown that it owns registered rights over the trademark MODERNA that long predate the date of creation of the disputed domain name. The Panel agrees that the disputed domain name is confusingly similar to the Complainant's mark because it reproduces it entirely and is followed by the terms

“total”, “rewards”, and “survy”, which is a typo of the word “survey”. The addition of these three terms cannot prevent a finding of confusing similarity, as the Complainant’s trademark MODERNA remains fully recognizable within the disputed domain name.

Therefore, the Panel agrees that the first condition under the Policy is met.

C. Rights or Legitimate Interests

While the overall burden of proof rests with the complainant, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. As such, where a complainant makes a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

In the case at issue, the Panel finds that the Respondent is not authorized to register and use a domain name confusingly similar to the Complainant’s trademark, and that the Respondent does not appear to have been commonly known by the name “modernatotalrewardssurvey.com”.

The disputed domain name leads to a webpage displaying pay-per-click links referring to “employee surveys”, “employee rewards”, “employee incentive software”, “employee engagement” services, and the like. The Complainant uses the domain name <modernatotalrewardssurvey.com>, which is almost identical to the disputed one, in connection with communications with its employees. An Internet user, when confronted with the disputed domain name, could believe that through this domain name the Complainant provides information referring or addressed to the Complainant’s employees. As such, the disputed domain name carries a risk of implied affiliation to the Complainant.

The pay-per-click links displayed on the webpage associated with the disputed domain name presumably generate an income for the Respondent. In view of all the circumstances of the case, the use of the disputed domain name does not amount to a *bona fide* offering of goods and services, nor to a legitimate noncommercial or fair use of the disputed domain name.

In view of all the above, the Panel finds that the Complainant has discharged its burden of proof that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The burden of production now shifts to the Respondent to demonstrate that it owns rights or legitimate interests in the disputed domain name. The Respondent has omitted to file a Response, and therefore has waived its right to contest the Complainant’s allegations.

In light of all the circumstances mentioned above, the Panel is satisfied that the second condition under the Policy is met.

D. Registered and Used in Bad Faith

The Panel agrees with the Complainant that its MODERNA trademark enjoys substantial reputation, especially due to the massive campaign on the Complainant’s COVID-19 vaccine. The registration of a domain name, confusingly similar to a third party’s well-known trademark, without authorization, or rights or legitimate interests in the domain name, can create a presumption of registration in bad faith by itself. Moreover, the Panel notes that the disputed domain name was registered only one day after the registration of the almost identical domain name <modernatotalrewardssurvey.com> that the Complainant uses to communicate with its employees. Both these circumstances clearly indicate that the Respondent registered the disputed domain name having the Complainant’s trademarks well in mind.

The Respondent uses the disputed domain name to access a webpage containing pay-per-click links referring to employee related services. The Respondent is presumably earning an income from each click on said links. In view of the reputation of the MODERNA trademark and the lack of rights or legitimate interests in the disputed domain name, the Panel finds that by using the disputed domain name, the

Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

Therefore, the Panel is of the opinion that the disputed domain name was registered and has been used in bad faith.

In light of the foregoing, the Panel finds that also the third and last condition under the Policy has been met.

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 <modernatotalrewardssurvey.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: August 1, 2022