

## **ADMINISTRATIVE PANEL DECISION**

Decentraland Foundation v. Domain Admin, Whols Privacy Corp. / Oleksandr Smirnof  
Case No. D2022-0294

### **1. The Parties**

The Complainant is Decentraland Foundation, Panama, represented by Sheppard, Mullin, Richter & Hampton, United States.

The Respondent is Domain Admin, Whols Privacy Corp., Bahamas / Oleksandr Smirnof, Ukraine.

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

The disputed domain name <decentraland-meta.com> (the “Domain Name”), is registered with Internet Domain Service BS Corp (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 28, 2022. On January 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 31, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 2, 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 amendment to the Complaint on February 2, 2022.

The Center verified that the Complaint together with the amendment to the 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 February 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 3, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 4, 2022.

The Center appointed Tony Willoughby as the sole panelist in this matter on March 8, 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. The Respondent used a privacy service when registering the Domain Name. The Respondent's identity was disclosed by the Registrar in response to the Center's registrar verification request. The Center's invitation to the Complainant to amend the Complaint followed on from that disclosure. In response to that invitation the Complainant added the Respondent as an additional respondent to the Complaint. For the purposes of this decision the Panel treats the underlying registrant as the Respondent and all references herein to the "Respondent" are references to Oleksandr Smirnof.

Having read the case papers, the Panel realised that there was a fundamental defect in the Complainant's evidence as to its trade mark rights, prompting the Panel to issue a procedural order on March 29, 2022 giving the Complainant an opportunity to rectify the defect. The Complainant duly did so by way of its response to that order. The Respondent was given an opportunity to object to the filing of the further evidence, but did not do so. The matter is discussed further in section 6B below.

#### **4. Factual Background**

The Complainant is a Panama Private Interest Foundation.

The Complainant operates "Decentraland", a service provided online at "www.decentraland.org". According to the Complainant "Decentraland" is "a decentralized 3D virtual reality platform powered by the Ethereum blockchain where users can create virtual structures such as casinos, art galleries, concert halls and theme parks, and charge other players to visit them".

The Complainant is the registered proprietor of United States Trade Mark Registration No.5,682,061 DECENTRALAND registered on February 19, 2019 with a first use date of January 2017 for various goods and services in classes 9, 38 and 41.

It is evident from the Complainant's evidence comprising screenshots of the website at "www.decentraland.org" and press commentary on the service provided at that website that a significant reputation and goodwill has been established in respect of the name "Decentraland".

The Domain Name was registered on December 13, 2021 and at the date of the Complaint was connected to a website closely resembling the website at "www.decentraland.org". The Panel's attempts to visit the Respondent's website have been met with an error message.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the Domain Name is confusingly similar to its DECENTRALAND registered trade mark, a trade mark in respect of which it also has unregistered trade mark rights; that the Respondent

has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name has been registered and is being used in bad faith.

The Complainant points to the fact that the website connected to the Domain Name replicates to a substantial degree the Complainant's website at "www.decentraland.org" and contends that the Respondent registered the Domain Name with a view to impersonating the Complainant and defrauding visitors to the website.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. General**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

(i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

### **B. Preliminary matter**

The Policy was launched in 1999 to address the unauthorized use of another's trade mark in a domain name. The key feature enabling a complainant under the Policy to get off first base under the Policy is to establish that it has relevant trade mark rights. The next step is to demonstrate that the disputed domain name is identical or confusingly similar to the complainant's trade mark, but first the complainant must prove the existence of trade mark rights.

The easiest way to prove the existence of such rights is to produce a trade mark registration certificate demonstrating registered trade mark rights. Here, the Complainant claimed registered trade mark rights and produced as Annex 7 to the Complaint an extract from the record of the United States Patent and Trademark Office in respect of United States Trademark Registration No.5,682,061 DECENTRALAND registered on February 19, 2019 for various goods and services in classes 9, 38 and 41.

Annex 7 shows that that trade mark registration is held in the name not of the Complainant, Decentraland Foundation, a Panama Private Interest Foundation, but of Metaverse Holdings Ltd, a Cayman Islands limited company with a PO Box address in Grand Cayman, Cayman Islands, Overseas Territory of the United Kingdom. There was nothing in the Complaint to explain the connection (if any) between the Complainant and the Cayman Islands company. The Panel might have been able to infer a connection if the Complainant's postal address was the same as that of the Cayman Islands company, but the only address provided for the Complainant in the Complaint is the United States address of the Complainant's representative, a law firm. Thus, at the outset there was no evidence before the Panel to establish that the Complainant had any relevant registered trade mark rights in respect of DECENTRALAND.

A less straightforward, but equally acceptable, method of proving the existence of trade mark rights is to demonstrate the existence of unregistered or common law trade mark rights. This is done by demonstrating the existence of a reputation and goodwill in respect of the name in question. The reputation and goodwill claimed by the Complainant is that generated through the business conducted via the website at "www.decentraland.org". However, the screenshot evidence relating to that website annexed to the Complaint features no reference to the Complainant. The Panel visited the website and the only reference to a potential owner/operator of the site that the Panel could find was a copyright notice reading "© 2022 Decentraland", which begged the question as to who owned the trade mark rights to "Decentraland". The Complainant might have felt it appropriate to provide details of the registration of the domain name, <decentraland.org>, but elected not to do so. In an endeavour to find a link the Panel conducted a Whois search for <decentraland.org> at "www.internic.net". The result showed that the name of the registrant was "Redacted for Privacy" and held by an individual (not a business) with a mailing address in Iceland. There was nothing there to link that domain name with the Complainant.

With nothing to link the Complainant to any of the potential holders of trade mark rights in respect of the name "Decentraland", the Complaint might have been expected to fail *in limine*, given that by virtue of paragraph 15(a) of the Rules "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." True, the Complaint featured an assertion (i.e. a 'statement') that the Complainant owned the claimed trade mark rights in respect of "Decentraland" and a certification at the end of the Complaint that "the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate", but the latter was so manifestly not borne out by the annexes to the Complaint that the assertion/statement could not sensibly be relied upon.

Nonetheless, panels strive to see that justice is done and the evidence as to the use of the Domain Name was so obviously an attempt to impersonate the operator of the website at "www.decentraland.org" that the Panel felt it right to give the Complainant the opportunity via Procedural Order to rectify the omission.

In its response to the Procedural Order, the Complainant produced evidence of an assignment to the Complainant of United States Trademark Registration No. 5,682,061 DECENTRALAND referred to above. It also mentioned that if the Panel had visited the Complainant's website at "www.decentraland.org" and clicked on the "Terms" link at the bottom of the home page (a link not visible on the annexes to the Complaint), the Panel would have found a relevant reference to the Complainant. It is a high risk approach to rely upon panels going beyond the case file to search websites to that extent. The only safe course is to include the evidence in the Complaint. In further response to the procedural order the Complainant has also produced evidence to show that the domain name, <decentraland.org>, is registered in the name of the Complainant.

Thus, the response to the Procedural Order has corrected the evidential defect. The Panel is now satisfied that the Complainant has the relevant trade mark rights; moreover, the Respondent has not objected to the Complainant's further filing.

For completeness it should be mentioned that recently another panel has issued a decision in favour of the Complainant finding that the Complainant has the necessary trade mark rights in respect of "Decentraland". The Panel can only assume that the evidence in that case did not feature the defect to which the Panel has drawn attention.

### **C. Identical or Confusingly Similar**

The Domain Name comprises the Complainant's trade mark, DECENTRALAND, followed by a hyphen, the

word “meta” and the “.com” generic Top-Level Domain.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition explains the test for identity or confusing similarity under the first element of the Policy and includes the following passage:

“While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

Here, the Complainant’s trade mark is readily recognizable in the Domain Name, rendering the Domain Name confusingly similar to the trade mark for the purposes of paragraph 4(a)(i) of the Policy.

#### **D. Rights or Legitimate Interests**

The Complainant states that it has no connection of any kind with the Respondent and that the Respondent’s use of the Complainant’s DECENTRALAND trade mark in the Domain Name is unauthorised. The Respondent contends that the Respondent’s use of the Domain Name is not a *bona fide* offering of goods and services within the meaning of paragraph 4(c)(i) of the Policy, but is instead a bad faith use intended to deceive visitors to the Respondent’s website to believe that the website is a website of or authorised by the Complainant and with a view to inducing those visitors to part with personal information and money.

As mentioned in section 4 above the Complainant’s evidence amply supports the contention that the website connected to the Domain Name is intended to replicate the “look and feel” of the Complainant’s website and to defraud visitors. The website appears to offer identical services to those provided through the Complainant’s website including a facility enabling visitors to the Respondent’s website to submit personal information including contact and payment details. The Panel is satisfied that the Complainant’s contention is well-founded.

On no basis could such a use of the Domain Name give rise to rights or legitimate interests in respect of the Domain Name in the hands of the Respondent. The Respondent has not sought to contend otherwise. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

#### **E. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances, which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Complainant relies *inter alia* upon sub-paragraph (iv), which provides: “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

As can be seen from section D above, the Panel has found that in registering and using the Domain Name as it has, the Respondent has impersonated the Complainant. It was clearly intentional. The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) 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 Domain Name, <decentraland-meta.com>, be transferred to the Complainant.

*/Tony Willoughby/*  
**Tony Willoughby**  
Sole Panelist  
Date: April 3, 2022