

ADMINISTRATIVE PANEL DECISION

Discord Inc. v. Mikhail Chernobuk

Case No. D2023-4132

1. The Parties

The Complainant is Discord Inc., United States of America, represented by Ryan Morrison, United States of America ("United States").

The Respondent is Mikhail Chernobuk, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <discord.onl> is registered with Dynadot Inc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 4, 2023. On October 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 4, 2023, 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 October 5, 2023, 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 October 10, 2023.

The Center verified that the Complaint and 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 October 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 5, 2023. The Response was filed with the Center on November 5, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on November 20, 2023. 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, or its application, was created in 2015. Initially, the application under the name “Discord” was intended for video game players as a chat application. Since then, however, the application has become very popular amongst the general public.

By 2016, the “Discord” application had 25 million registered user. The Complainant also participated in a USD 20 million capital raising. By June 2020, the “Discord” application had more than 100 million active monthly users. The Complainant’s “Discord” page on X (formerly Twitter) has 4.6 million followers; and its Instagram social media account has 1.9 million followers.

The Complainant holds numerous domain names. Its main channels operate through “www.discord.com”, “www.discordapp.com” (which redirects to “www.discord.com”) and “www.discordmerch.com”.

The Complaint identifies numerous registered trademarks for, or incorporating, DISCORD. For present purposes, it is sufficient to note:

- (a) United States Registered Trademark No. 4,930,980, DISCORD, which was registered on April 5, 2016, in the Principal Register for goods and services in International Classes 9 and 38 (including computer software and communications services);
- (b) European Union Trademark No. 018003521, DISCORD, which was registered on June 22, 2019, with effect from December 20, 2018 in respect of goods and services in International Classes 9 and 38;
- (c) Chinese Registered Trademark Nos 17248709 and 17248710, DISCORD, which have been registered on August 28, 2016, for, respectively, services and goods in International Classes 38 and 9.

According to the WhoIs record, the disputed domain name was registered on August 7, 2020.

When the Complaint was filed, the disputed domain name resolved to a website which was headed “Discord”. Underneath the heading was an image of the Complainant’s logo and, after a 2 line summary description of what “Discord” is, links to download the application. Underneath these is a heading “Features” with descriptions of various features of the “Discord” application running over the equivalent of roughly two and half pages with sub-headings such as “never pay for voice chat again”, “play online with peace of mind”, “Always be connected to your friends” and so on. After the “Features” section, there is a list of “Resources” with titles such as “How to set up Two-Factor Authentication for Discord?” and “How to set up an announcements channel?”

At the very bottom of the “page” is a footer or black band. Inside the band are on the first line a number of links: “Create New Account”, “Create Server”, “Join Server”, “Q&A”, “Blog” and “Privacy Policy”. Under these links, there is a statement:

“Discord is a trademark of Discord, Inc (formally Hammer & Chisel, Inc). We are not affiliated with Discord Inc. in any ways. [sic]

“This is an unofficial site created for general information/educational purpose only. Any content found in this website is our own personal opinion and should not be constructed as official statement, advise or recommendation of Discord, Inc. or any of its affiliates.”

The printout included in Annex 13 of the Complaint does not show any advertising. However, the accessing the active website presents the same page with a number of pay-per-click (PPC) advertisements adjacent to the content just described.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of numerous registered trademarks for DISCORD.

In undertaking the comparison between the proven trademark and the disputed domain name, it is permissible in the present circumstances to disregard the Top Level Domain (TLD) component as a functional aspect of the domain name system. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.11.

Disregarding the “.onl” TLD, the disputed domain name consists solely of the Complainant's registered trademark. Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

The Respondent points out that there are 314 registered sites with “discord” in their name. The Respondent further disputes that the gTLD, “.onl”, is or would be important for the Complainant's business as the TLD “.online” is used by companies to promote their online businesses. The Respondent also distinguishes the content of the site to which the disputed domain name resolves to the content of other sites in which the Complainant has been successful.

These arguments misunderstand the nature of the inquiry at this stage. It is well accepted that the first element functions primarily as a standing requirement. Accordingly, the comparison stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law.

Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, therefore, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

While 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 often impossible 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. 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.

It is not in dispute between the parties that the Respondent registered the disputed domain name after the Complainant began using its trademark and also after the Complainant had registered its trademark.

Further, it is not in dispute between the parties that the Complainant has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent says the website at the disputed domain name was created in 2018 as an informational website on the subject of the “Discord” application. The Respondent contends the website contains useful articles about “Discord”, a “Discord” status page, a list of servers pointing to the Complainant's official

website. According to the Respondent, many schools found the articles on the website helpful during the pandemic. In addition, the Respondent points out that every page on the Respondent's website includes the disclaimer mentioned above.

First, the Respondent's claim that the website started in 2018 is inconsistent with the Whois data showing that the disputed domain name was registered on August 7, 2020. The Respondent's claim is not supported by any corroborating evidence so the Panel would be very reluctant to accept the claim. In any event, the proposed starting date in 2018 is still after the Complainant's application had started and was gaining significant use and exposure.

Secondly, accepting that the Respondent's website includes information about the Complainant's application and the links to download the application redirect to the Complainant's official website, the disputed domain name is identical to the Complainant's trademark and does not contain any additional or distinguishing features. Therefore, it carries a very high risk of implied affiliation which is a very strong consideration in precluding rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), sections 2.5 and 2.7.

There is, as the Respondent contends, a disclaimer of affiliation with the Complainant and a statement that the Respondent's website is an unofficial website for general information. However, the disclaimer is at the very bottom of the page and is in a font which is very much smaller than the other fonts used on the site. As noted above, an Internet user has to scroll down through the equivalent of almost three pages to get to the footer. In these circumstances, the Panel is unable to find that the disclaimer is sufficiently prominent to dispel the risk of (false) implied affiliation arising from the identity of the disputed domain name to the Complainant's trademark.

The Respondent also contends that his website serves to promote and extend awareness of the Complainant's application and so benefits the Complainant. On the other hand, it is also noteworthy that the Respondent's website features PPC advertising and so does not qualify as non commercial. See also [WIPO Overview 3.0](#), section 2.9.

The Respondent's argument based on the 314 other registered domain names which include "discord" does not assist. The issue here is the disputed domain name which, as already noted, is identical to the Complainant's trademark. Although the Respondent argues that the ".online" domain is used by businesses rather than the ".onl" domain, the Panel notes that the landing page for the ".onl" domain available at "https://www.nic.onl" states:

“.ONL IS THE QUICK WAY TO SAY YOU'RE ONLINE!

“.ONL is the top level domain for anything online. From business to personal, .ONL is the universal, affordable, and less restrictive online presence that allows YOU to be online with your name, brand, or idea!

“.ONL is the simple way to stand out from other top level domains. Get .ONL and let the world know you're online.”

The domain does not appear to be attempting to draw the distinction the Respondent contends for. Moreover, the Panel considers it is very doubtful that members of the public who are aware of the Complainant's use of DISCORD would not associate the Complainant with the disputed domain name merely because the domain extension is .onl. The difference between ".online" and ".onl" does not appear to the Panel to be one which precludes or dispels the likelihood of mistaken implied affiliation.

In these circumstances, given the very high risk of implied affiliation, the Panel finds that the Respondent has not rebutted the *prima facie* case established by the Complainant.

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: See e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Given the purpose of the website claimed by the Respondent, it is clear that the Respondent was aware of the Complainant's trademark when registering the disputed domain name.

Given that knowledge, the reasons leading to the finding that the Respondent does not have rights or legitimate interests in the disputed domain name also lead to a finding of registration and use in bad faith.

As noted in section 5B above, the Panel does not accept the Respondent's argument that there is such a difference between the ".online" domain and the ".onl" domain that a member of the public encountering the disputed domain name would not be likely to associate it with the Complainant and its application.

While there is no evidence before the Panel that the Respondent has engaged in a pattern of this conduct, therefore, the Respondent's registration and use of the disputed domain name does prevent the Complainant from reflecting its trademark in the ".onl" domain.

The registration and use of the disputed domain name creates a very high risk of confusion and, at least in the first instance, diversion of people looking for the Complainant to the Respondent's website. Moreover, it does so in circumstances where some element of commercial advantage is being sought through PPC advertisements. Taking advantage of the resemblance of the disputed domain name to the Complainant's trademark in this fashion constitutes bad faith under the Policy.

In these circumstances, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith for the purposes of the Policy.

6. 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, <discord.onl>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: December 4, 2023