

ADMINISTRATIVE PANEL DECISION

ZeniMax Media Inc. v. Nam Hoang
Case No. D2023-4422

1. The Parties

The Complainant is ZeniMax Media Inc., United States of America, represented by Kisch Global Limited, United Kingdom.

The Respondent is Nam Hoang, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <skyrimmerch.com> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2023. On October 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 26, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 26, 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 30, 2023.

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 November 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 22, 2023.

The Center appointed Jonas Gulliksson as the sole panelist in this matter on November 28, 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 is a creator and publisher of interactive entertainment. The company is part of the group of companies affiliated to Microsoft Corporation. Microsoft is a leading developer and provider of personal computer software systems and applications, cloud computing services, video games and other online services, with global operations through its subsidiaries, affiliates and/or licensees.

The Complainant is the proprietor of, *inter alia*, the following trademark/service mark registrations:

- Australian trademark registration SKYRIM (word) No. 1178022, registered on October 8, 2007;
- Australian trademark registration SKYRIM (word) No. 2345282, registered on November 6, 2023;
- Chinese trademark registration SKYRIM (word) No. 8088863, registered on March 21, 2011;
- Chinese trademark registration SKYRIM (word) No. 14020026, registered on March 14, 2015;
- United States of America service mark registration SKYRIM (word) No. 4280859, registered on January 22, 2013; and
- United States of America trademark registration SKYRIM (word) No. 5380829, registered on January 16, 2018.

The Domain Name was registered on April 17, 2023.

The Domain Name resolves to an online shop (the “Domain Name Website”).

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 Domain Name. Notably, the Complainant contends that:

The Domain Name is identical or confusingly similar to the Complainant’s SKYRIM mark.

The Respondent has no rights or legitimate interests in respect of the Domain Name. The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks/service marks or to register a domain name incorporating its SKYRIM trademark/service mark (or a domain name which will be associated with this trademark/service mark). The Respondent is not making a legitimate noncommercial or fair use of the Domain Name. On the contrary, the Respondent’s behavior shows a clear intent to obtain an unfair commercial gain, with a view to misleadingly divert consumers or to tarnish the trademarks/service marks owned by the Complainant. The Respondent is selling unauthorized competing products and/or accessories of other commercial origin branded with the Complainant’s SKYRIM mark and/or official Skyrim content through the Domain Name Website. The offering of goods through the Domain Name Website does not meet the requirements for a *bona fide* offering of goods.

The Domain Name was registered and is being used in bad faith. It is evident from the Respondent's use of the Domain Name that the Respondent knew of the Complainant's SKYRIM mark when registering the Domain Name. The Respondent started offering unauthorized competing products branded with the Complainant's SKYRIM mark and/or Skyrim content immediately after registering the Domain Name. Furthermore, the term "Skyrim" is purely an imaginative term and unique to the Complainant. The term "Skyrim" is not commonly used to refer to video games. It is therefore beyond the realm of reasonable coincidence that the Respondent chose the Domain Name, without the intention of invoking a misleading association with the Complainant.

It is also evident from the Respondent's use of the Domain Name that the Respondent registered and used the Domain Name with the intention to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's registered SKYRIM mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location, which constitutes registration and use in bad faith. By reproducing the Complainant's registered trademark/service mark in the Domain Name and the title of the Domain Name Website, the Respondent is clearly suggesting to any Internet user visiting a website provided under the Domain Name that the Complainant (or an affiliated dealer of the Complainant) is the source of the Domain Name Website, which it is not. This suggestion is further supported by the Respondent's use of the Complainant's official Skyrim content, accompanied by a copyright notice claiming the copyright for Domain Name Website and its contents.

Additionally, the Respondent is using the Complainant's SKYRIM mark for the purposes of offering for sale unauthorized third-party products of other commercial origin branded with the Complainant's SKYRIM mark and/or official Skyrim content. Such abusive use of the Complainant's SKYRIM mark and/or official Skyrim content for purposes of promoting competing products is a clear-cut trademark infringement and constitutes clear evidence of the Respondent's bad faith. The fact that the Respondent is using a privacy protection service to hide its true identity may in itself constitute a factor indicating bad faith.

B. Respondent

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

6. Discussion and Findings

The burden for the Complainant under paragraph 4(a) of the Policy is to prove:

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

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/service mark and the Domain Name, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has established that it holds trademark and service mark rights with respect to SKYRIM.

The Domain Name reproduces the Complainant's SKYRIM mark in its entirety, with the addition of the word "merch" and the generic Top-Level Domain ("gTLD") ".com". According to [WIPO Overview 3.0](#), section 1.8, where the relevant mark 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. Further, it is well established that gTLDs typically are disregarded in the assessment of confusing similarity, see [WIPO Overview 3.0](#), section 1.11.1. Accordingly, the Domain Name is confusingly similar to the Complainant's SKYRIM mark for the purposes of the Policy.

Based on the above, 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 a 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 that 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 evidence presented in the case, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the 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 Domain Name such as those enumerated in the Policy or otherwise. To the contrary, The Panel finds that the Domain Name carries a risk of affiliation with the Complainant ([WIPO Overview 3.0](#), section 2.5.1). The composition of the Domain Name and the content of the Domain Name Website, including the goods supposedly offered through such website prominently using the Complainant's SKYRIM mark, shows that the Respondent intentionally has tried to impersonate the Complainant or give the impression that there exists a sponsorship or affiliation between the Respondent and the Complainant. Such use of the Domain Name cannot confer rights or legitimate interest on the Respondent with respect to the Domain Name.

Based on the above, 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 Complainant has not authorized the Respondent to use its SKYRIM mark. The content of the Domain Name Website clearly reflects the Respondent's awareness of and intent to target the Complainant. The content of the Domain Name Website clearly shows that the Respondent intentionally has tried to attract, for commercial gain, Internet users to the Domain Name Website by creating a likelihood of confusion with the Complainant's SKYRIM mark as to the source, sponsorship, affiliation, or endorsement of the Domain Name Website and the goods supposedly offered on such website. The fact that the Respondent is using a privacy protection service to hide its true identity is also a factor that indicates bad faith. Lastly, it is more likely than not that the Respondent used incomplete or false address information when registering the Domain Name since the courier sent out by the WIPO Center could not be delivered to the Respondent's address.

Based on the above, 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 Domain Name, <skyrimmerch.com>, be transferred to the Complainant.

/Jonas Gulliksson/

Jonas Gulliksson

Sole Panelist

Date: December 12, 2023