ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

# ADMINISTRATIVE PANEL DECISION
DigiCert Inc v. Master Tom
Case No. D2025-1254

## 1. The Parties

Complainant is DigiCert Inc, United States of America ("U.S."), represented by Taylor Wessing LLP, United Kingdom ("U.K.").

Respondent is Master Tom, U.S.

## 2. The Domain Names and Registrar

The disputed domain names <digicertchina.com>, and <digicertcn.com> (the "Domain Names") are registered with NameSilo, LLC (the "Registrar").

## 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 27, 2025. On March 27, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On March 27, 2025, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (redacted for privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on March 27, 2025, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 31, 2025.

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 Respondent of the Complaint, and the proceedings commenced on April 3, 2025. In accordance with the Rules, paragraph 5, the due date for Response was April 23, 2025. A party apparently or possibly responding on behalf of Respondent sent an email communication to the Center on March 28, 2025. The Center responded on March 29, 2025, indicating that the Complaint was filed against Respondent, and requested the sender to clarify its

relationship with Respondent and evidence thereof. On March 29, 2025, Respondent sent an email communication to the Center. The Response was filed with the Center on April 22, 2025.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on May 1, 2025. 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

Complainant was founded in 2003. Complainant partnered with Microsoft in 2007 to develop the industry's first multi-domain certificate, and in 2013 built the first Certificate Transparency (CT) Log accepted by Google. DigiCert is also one of the market leaders in Internet of Things (IoT) security, digital identification of drones and Public Key Infrastructure (PKI) management.

Complainant owns numerous registered trademarks for the DIGICERT mark, including:

- International Trademark Registration number 1051226 for the DIGICERT word mark, registered on August 3, 2010, designating Australia, China, the European Union, the Russian Federation, Ukraine, and the U.K.;
- International Trademark Registration number 1357093 for the DIGICERT word mark, registered on June 7, 2017, designating Australia, China, Mexico, New Zealand, Norway, and Singapore; and
- Chinese trade mark applications numbers 81933912, 81930728, 81933937, and 81940374 for the DIGICERT word mark, all filed on November 13, 2024.

Complainant is also the owner of numerous domain names, including <digicert.com>, registered on December 2, 1996.

The Domain Names were registered on November 15, 2015. At the time of the filing of the Complaint, the Domain Name <digicertcn.com> redirected to the same website as <digicertchina.com>. The homepage of the website associated with the Domain Names noted that the website was operated by a Chinese company named 芜湖皖易信息技术有限公司 (which may be translated as Wuhu Wanyi Information Technology Co., Ltd.), which indicated that it was the officially authorized distributor of Complainant. The Chinese company, Wuhu Wanyi Information Technology Co., Ltd., has owned two Chinese trademarks 皖易 (WANYI) and 积普 (JIPU), both applied on May 15, 2020.

The website featured the use of Complainant's DIGICERT word mark and logo, with the addition of the words "AUTHORIZED PARTNER" under the mark, as well as images owned and copyrighted by Complainant. It also featured Complainant's products and services. At the end of the home webpage, there was a copyright notice "Copyright © 2024 DigiCertChina.com DigiCert 中国 [China] All Right Reserved" and a disclaimer in English stating that "DigiCert and its logo are registered trademarks of DigiCert, Inc. Symantec and Norton and their logos are trademarks used under license from Symantec Corporation. Other names may be trademarks of their respective owners".

## 5. Parties' Contentions

### A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Names.

Complainant contends that (i) the Domain Names are confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Names; and (iii) Respondent registered and is using the Domain Names in bad faith.

In particular, Complainant contends that it has trademark registrations for DIGICERT, and that Respondent registered and is using the Domain Names with the intention to confuse Internet users looking for bona fide and well-known Digicert products and services.

Complainant notes that it has no affiliation with Respondent, and that Respondent alleges itself on the website at the disputed domain name as the "officially certified distributor of the Complainant, which is false". Respondent offers Complainant's products and services on the website to which the Domain Names resolve. Complainant further contends that Respondent is using the Domain Names as a tool to exploit Complainant's reputation for its own commercial gain, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Names. Further, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Names, when Respondent clearly knew of Complainant's rights.

**B. Respondent**

Respondent acknowledges that the Domain Names incorporate Complainant's DIGICERT trademarks in combination with the geographic identifiers, "china" and "cn".

Respondent, however asserts that it has legitimate rights and interests in the Domain Names, as they were used for the sale and promotion of Complainant's products in China since the registration of the Domain Names in 2015, that the products sold are genuine and the registration and use of the Domain Names predate the establishment of Complainant's subsidiary in China, which was established in 2017. Respondent has never offered the Domain Names for sale; has never attempted to impersonate Complainant's official website; has never conducted activities under Complainant's official name; has never sold competing products or redirected traffic to Complainant's competitors; and has actively protected Complainant's brand image and provided technical support.

Respondent adds that it registered the Domain Names and related domain names in anticipation of SSL certificate demand in the Chinese market. It is Complainant's customer and has received commission credits through official channels, and has communicated with a number of Complainant's account managers regarding the use of his "partner" status and has disclosed the use of the Domain Names to Complainant's account managers. Respondent claims it added "Authorized Partner" label on the website at the Domain Names on the understanding, based on local interpretation and discussions with Complainant's staff, that authorization letters constituted partnership. Partner application required deposits and sales thresholds. After rejection, Respondent was advised to request authorization letters for individual projects. Respondent's intention of registration and use of the Domain Names was to promote and sell Complainant's products in the Chinese market.

Upon receipt of the notice, Respondent has removed content alleged to be "malicious/false" or "confusing", and has also migrated website content to other domain names.

**6. Discussion and Findings**

**6.1. Preliminary Issue: Language of the Proceeding**

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain name, the language of the proceedings shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceedings.

Complainant submitted its original Complaint and amended Complaint in English. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Names is English. Respondent, in its Response dated April 22, 2025, requested that the language of the proceeding be Chinese.

Respondent submits that the Domain Names resolved to a website which contains content primarily in Chinese, as the website targeted mainland Chinese users.

In exercising its discretion to use a language other than that of the Registration Agreement for the Domain Name, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time, and costs. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.5.1.

The Panel notes that Respondent had sent emails and its Response in English, and that the Registration Agreement is in English. The Panel does not find it necessary to change the language of the proceeding into Chinese and/or require the Complainant to translate the Complaint into Chinese. The Panel therefore finds that English being the language of the proceeding would not cause any prejudice to either Party.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding. However, the Panel has also considered the annexes to the Complaint and the Response that were not filed in English when issuing this Decision.

**6.2. Substantive Issues**

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

(i) the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights;

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

(iii) the Domain Names were registered and are being used in bad faith.

To prevail, Complainant has to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence.

**A. Identical or Confusingly Similar**

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See WIPO Overview 3.0, section 1.2.1. Complainant has provided evidence of its rights in the DIGICERT trademarks, as noted above under Section 4. Complainant has therefore proven that it has the requisite rights in the DIGICERT trademarks.

With Complainant's rights in the DIGICERT trademarks established, the remaining question under the first element of the Policy is whether the Domain Names, typically disregarding the generic Top-Level Domain ("gTLD") in which it is registered (in this case, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. D2010-0842.

Here, each of the Domain Names is confusingly similar to Complainant's DIGICERT trademarks. The DIGICERT trademark is recognizable in the Domain Names.

In particular, the Domain Names' inclusion of Complainant's DIGICERT trademark in its entirety, with an addition of the term "china" or "cn", does not prevent a finding of confusing similarity between the Domain Names and the DIGICERT trademarks. See section 1.8 of the WIPO Overview 3.0.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

**B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, a complainant must make a prima facie showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. D2008-1393. Once a complainant makes out such a prima facie showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its DIGICERT trademarks when registering the Domain Names. In addition, Complainant asserts that Respondent is not authorized distributor to promote Complainant's goods or services and is not related to Complainant. Respondent is also not known to be associated with the DIGICERT trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Names.

In addition, Respondent has not used the Domain Name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use. Rather, at the time of the filing of the Complaint, the Domain Name <digicertcn.com> redirected to the website at the Domain Name <digicertchina.com>. The website was operated by a Chinese company named Wuhu Wanyi Information Technology Co., Ltd., which indicated that it was the officially authorized distributor of Complainant, which was denied by Complainant. The website featured the use of Complainant's DIGICERT word mark and logo, with the addition of the words "AUTHORIZED PARTNER" under the mark, as well as images owned and copyrighted by Complainant. It also offered Complainant's products and services for sale.

In particular, the website which the Domain Names resolved to, featured the DIGICERT trademark, a copyright notice "Copyright © 2024 DigiCertChina.com DigiCert 中国 [China] All Right Reserved" and a disclaimer in English stating "DigiCert and its logo are registered trademarks of DigiCert, Inc. Symantec and Norton and their logos are trademarks used under license from Symantec Corporation. Other names may be trademarks of their respective owners" as well as information about and products offered by Complainant, and an email address […]@digicertchina.com was used on the website.

In Oki Data *Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 ("Oki Data"), respondent was a reseller of the complainant's OKIDATA-branded products, and registered the domain name <okidataparts.com>. The panel in Oki Data concluded that the use of a manufacturer's trademark as a domain name by a reseller could be deemed a "bona fide offering of goods or services" within the meaning of the Policy only if the following conditions are satisfied: (1) the respondent must actually be offering the goods or services at issue; (2) the respondent must use the site to sell only the trademarked goods (otherwise, there is the possibility that the respondent is using the trademark in a domain name to bait consumers and then switch them to other goods); (3) the site itself must accurately disclose the respondent's relationship with the trademark owner; and (4) the respondent must not try to "corner the market" in all relevant domain names, thus depriving the trademark owner of the ability to reflect its own mark in a domain name. The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark.

In the present case, Respondent has not accurately and prominently disclosed its relationship with Complainant on the website at the Domain Names. Respondent relies principally on email and Wechat communications to Complainant's employees, both of which occurred years after the registration of the Domain Names. Respondent asserts the use of "AUTHORIZED PARTNER" under Complainant's

DIGICERT trademarks along with “understanding – based on local interpretation and discussions with DigiCert staff – that authorization letters constituted partnership”. In these communications, however, there was no express authorization by Complainant showing that Respondent has been authorized as its official distributor and can use Complainant’s trademarks in any way, particularly, no authorization by Complainant for Respondent to register any domain names with Complainant’s trademark DIGICERT. Therefore, there is no evidence on record showing that Respondent is an official authorized distributor of Complainant. Although the website, at the bottom of its homepage, had a disclaimer indicating “DigiCert and its logo are registered trademarks of DigiCert, Inc.”, there was no information regarding the relationship between Respondent and Complainant. Rather, the website falsely identified itself as DigiCert official authorized distributor. Further, the copyright notice above the disclaimer “Copyright © 2024 DigiCertChina.com DigiCert 中国 [China] All Right Reserved” may mislead Internet users into thinking that the website is somehow sponsored by the Complainant under the circumstances of this case.

The record before this Panel does not reflect Respondent’s use of the Domain Names in connection with a bona fide offering of goods or services. There is no evidence on record showing that Respondent has been commonly known by the Domain Names, or to have acquired trademark or service mark rights in the Domain Names. The Chinse company on the website at the Domain Names applied for registration two Chinese trademarks 皖易 (WANYI) and 积普 (JIPU) on May 15, 2020. However, these marks have nothing to do with the Domain Names. Nor is Respondent making any legitimate noncommercial or fair use of the Domain Names. In short, Respondent has not come forward with evidence of rights or legitimate interests in the Domain Names to rebut Complainant’s prima facie case.

Moreover, the nature of the Domain Names, which includes Complainant’s trademark DIGICERT, with the geographic term “china” following the DIGICERT mark in the Domain Name <digicertchina.com> and the term “cn” (generally known to be an abbreviation of the geographic term “china”) following the DIGICERT mark in the Domain Name <digicertcn.com>, is inherently misleading and carries a risk of implied affiliation. See WIPO Overview 3.0, section 2.5.1.

Accordingly, Complainant has provided evidence supporting its prima facie claim that Respondent lacks any rights or legitimate interests in the Domain Names. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name to rebut Complainant’s prima facie case.

Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Names, and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

**C. Registered and Used in Bad Faith**

The Panel finds that Respondent’s actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website 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."

The Panel finds that Complainant has provided ample evidence to show that the use of the DIGICERT trademarks and some of the registration of the DIGICERT trademarks well predate the registration of the Domain Names. Complainant is also well established and known. Indeed, the record shows that Complainant's DIGICERT trademarks and related products and services are widely known and recognized. In addition, Respondent acknowledged that the Domain Names incorporate Complainant's DIGICERT trademarks in combination with the geographic identifiers "china" and "cn", and that Respondent had been used to establish websites for the sale and promotion of Complainant's products in China.

Therefore, the Panel is of the view that Respondent was aware of the DIGICERT trademarks when it registered the Domain Names. See WIPO Overview 3.0, section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. D2016-1973.

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. D2011-2209; *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. D2001-1070; and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. D2006-0007.

Evidence provided by Respondent shows that it contacted Complainant several years after the registration of the Domain Names regarding trademark use. Therefore, there is no evidence that Respondent obtained any clear or express authorization from Complainant at the time of registration of the Domain Names that it could use Complainant's trademark in any way, particularly in registering a domain name or using it on a website.

In addition, the Domain Names resolved to a website featuring Complainant's DIGICERT information and marks, with a copyright notice "Copyright © 2024 DigiCertChina.com DigiCert 中国 [China] All Right Reserved" and a disclaimer in English that "DigiCert and its logo are registered trademarks of DigiCert, Inc. Symantec and Norton and their logos are trademarks used under license from Symantec Corporation. Other names may be trademarks of their respective owners". Such notice or disclaimer is not sufficiently clear to support a finding that Respondent has undertaken reasonable steps to avoid unfairly passing itself off as related to Complainant, or to otherwise confuse users looking for Complainant's products or services. On the contrary, the website falsely identified itself as DigiCert official authorized distributor. See WIPO Overview 3.0, section 3.7.

Therefore, by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users looking for bona fide and well-known DIGICERT products and services of Complainant or authorized partners of Complainant to Respondent's website by creating a likelihood of confusion with Complainant's DIGICERT mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website. All these actions may result in tarnishing Complainant's reputation and goodwill in the industry.

Accordingly, the Panel finds that Respondent registered and is using the Domain Names in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Names <digicertchina.com> and <digicertcn.com> be transferred to Complainant.

*/Kimberley Chen Nobles/*
**Kimberley Chen Nobles**
Sole Panelist
Date: May 15, 2025