

## **ADMINISTRATIVE PANEL DECISION**

Nintendo of America Inc. v. Tom James

Case No. DIO2023-0006

### **1. The Parties**

The Complainant is Nintendo of America Inc., United States of America ("United States"), represented by Perkins Coie, LLP, United States.

The Respondent is Tom James, France.

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

The disputed domain name <pokemon-go.io> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 27, 2023. On January 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 27, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 30, 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 January 31, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the "Policy"), the Rules for .IO Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .IO 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 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 24, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on March 1, 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 markets and distributes video game systems, software, and related products. The Complainant's first video game system, the Nintendo Entertainment System, was marketed back in 1985, followed by several video game systems in the following years, currently the Complainant being recognized as one of the best-selling video game system developers in the world.

Also, the Complainant holds rights in POKÉMON, a world-famous brand associated with one of the largest franchises in the world.

The Complainant holds trademark registrations for POKÉMON and POKÉMON GO, such as the following:

- the United States Trademark Registration number 5646122 for the mark POKÉMON GO (stylized), filed on March 3, 2016, and registered on January 8, 2019, covering goods in Nice class 9; and
- the United States Trademark Registration number 5897463 for the mark POKÉMON GO (stylized), filed on March 3, 2016, and registered on October 29, 2019, covering services in Nice class 41.

The disputed domain name was registered on October 13, 2022, and, at the time of filing the Complaint, it resolved to a website used to advertise unauthorised and unlicensed Pokémon digital trading card game, which purportedly involves non-fungible tokens ("NFTs"), also depicting the POKÉMON trademarks and product images.

Further, according to Annex 5 to the Complaint, the files accesible through the disputed domain name were used to infect the users' computers with malware, since Internet users who clicked the "Play on PC" download button reportedly that they downloaded a file that installed a remote access tool that allowed the user's computer to be accessed by the Respondent or an unknown third party.

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

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

The Complainant contends that the disputed domain name is confusingly similar to the POKÉMON and POKÉMON GO trademarks; the Respondent has no rights or legitimate interests in the disputed domain name; and the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name to it.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

In view of the Respondent's default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, the Complainant can only succeed in this administrative proceeding under the Policy if the following circumstances are met:

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

The Panel will further analyze the potential concurrence of the above circumstances.

## A. Identical or Confusingly Similar

The Panel finds that the Complainant holds right in the POKÉMON and POKÉMON GO trademarks.

The disputed domain name reproduces the trademark POKÉMON GO almost exactly (replacing the letter “é” with the letter “e”) with a hyphen added between the two words composing the trademark; and also incorporates the trademark POKÉMON.

However, such addition does not prevent a finding of confusing similarity, as the Complainant’s trademarks are clearly recognizable within the disputed domain name. Numerous UDRP panels have considered that the addition of other terms (whether geographical, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name does not avoid a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)¹.

Further, it is well established in decisions under the UDRP that the country code Top-Level Domain (“ccTLD”) or the generic Top-Level Domain (“gTLD”) (e.g., “.com”, “.site”, “.ro”, “.io”) is typically disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark pursuant to the Policy, paragraph 4(a)(i).

## B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license, or authorization whatsoever to use the its marks POKÉMON and POKÉMON GO; that the Respondent is not commonly known by the disputed domain name; and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods or services.

Under the Policy, “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”. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has put forward a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent has not replied to the Complainant’s contentions and has not come forward with relevant evidence to rebut the Complainant’s *prima facie* case.

There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain name or that the Respondent made a *bona fide* offering of goods or services or a legitimate noncommercial use under the disputed domain name.

According to the evidence provided in Annexes 4 and 5 to the Complaint, the Respondent has used the disputed domain name in connection with a website promoting goods and services related to the Complainant’s Pokémon’s products, reproducing the Complainant’s trademark, and also distributing malware. In this regard, UDRP panels have categorically held that the use of a domain name for illegal activity (such as swindle, fraud, identity theft, phishing and impersonation/passing off) can never confer rights or legitimate interests in a respondent. See section 2.13 of the [WIPO Overview 3.0](#).

In addition, and without prejudice to the above, UDRP panels have found that domain names identical or highly similar to a complainant’s trademark carry a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

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¹ Given the similarities between the ioDRP and the Uniform Domain Name Resolution Policy (“UDRP”), the Panel finds it appropriate to refer to UDRP jurisprudence, including reference to the [WIPO Overview 3.0](#).

For these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

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

The Complainant has held registered trademark rights in POKÉMON and POKÉMON GO since 1996 and the trademark is famous worldwide.

The disputed domain name was created in 2022 and reproduces the Complainant's mark POKÉMON GO exactly. Furthermore, as shown above, the disputed domain name was used in connection to promoting POKÉMON branded goods.

Such conduct leads to infer that the Respondent had previous knowledge of the Complainant, its products and trademarks, and that, at the time of registering the disputed domain name, it targeted the Complainant.

At the time of filing the Complaint, the Respondent was using, without permission, the Complainant's distinctive trademark in order to get traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's trademark POKÉMON GO exactly, and the website operated under the disputed domain name displays the Complainant's trademark and visuals, purportedly offers POKÉMON branded goods, indeed in this Panel's view, the Respondent has intended to attract Internet users who may be confused and believe that the website is held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademark.

Furthermore, according to the evidence provided in the Complaint and unrefuted by the Respondent, the Respondent was using the disputed domain name to distribute malware to the Internet visitors accessing the website under the disputed domain name. This is a classic illegal activity and establishes bad faith registration and use.

For all the above reasons, the Panel finds that the Respondent registered and used the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

### **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 <pokemon-go.io> be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: March 13, 2023