



URS FINAL DETERMINATION

ZENIMAX MEDIA INC. v. liu zi liang et al.

Claim Number: FA1912001877105

DOMAIN NAME

<morrowind.online>

PARTIES

Complainant: ZENIMAX MEDIA INC. of ROCKVILLE, Maryland, United States of America.

Complainant's Representative: DLA Piper LLP (US) of Washington, District of Columbia, United States of America.

Respondent: liu ziliang of Nanchang City, Jiangxi Province, China.

REGISTRIES and REGISTRARS

Registries: DotOnline Inc.

Registrars: Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn)

EXAMINER

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Examiner in this proceeding.

David L. Kreider, as Examiner.

PROCEDURAL HISTORY

Complainant submitted: December 30, 2019

Commencement: December 31, 2019

Response Date: January 15, 2020

Having reviewed the communications records, the Examiner finds that the FORUM has discharged its responsibility under URS Procedure Paragraphs 3 and 4 and Rule 4 of the Rules for the Uniform Rapid Suspension System (the "Rules").

RELIEF SOUGHT

Complainant requests that the domain name be suspended for the life of the registration.

STANDARD OF REVIEW

Clear and convincing evidence.

FINDINGS and DISCUSSION

The Complainant, ZENIMAX MEDIA INC., owns the trademarks and service marks related the computer and video game programs titled MORROWIND (collectively, the "MORROWIND Marks"). The MORROWIND Marks are well known throughout the United States and the rest of the world by virtue of their use as the title of the third game in the The Elder Scrolls® franchise, released in 2002, as well as the title of an expansion pack for the massively multiplayer online role playing game ("MMORPG") The Elder Scrolls Online, released in 2017. Since as early as 2002, Complainant has prominently and continuously used the MORROWIND Marks in connection with computer and video game software, and related goods and services.

Complainant registered the MORROWIND Marks mark with the USPTO (Reg. No. 2,643,443, registered October 29, 2002). Past panels have held that registration of a mark with the USPTO is sufficient to establish a registrant's

rights in a mark. *See T-Mobile USA, Inc. dba MetroPCS v. Ryan G Foo / PPA Media Services*, FA 1627542 (Forum Aug. 9, 2015).

The Complainant alleges that, by virtue of the wide renown of the MORROWIND Marks, the distinctive, fanciful nature of the MORROWIND Marks, and the wide geographic availability and extensive sales of Complainant's online computer and video game software, the MORROWIND Marks have become highly distinctive in the minds of the purchasing public.

URS Procedure 1.2.6 requires the Complainant to prove, by clear and convincing evidence, each of the following three elements to obtain an order that a domain name should be suspended.

1.2.6.1. that the registered domain name is identical or confusingly similar to a word mark: (i) for which the Complainant holds a valid national or regional registration and that is in current use; or (ii) that has been validated through court proceedings; or (iii) that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed.

1.2.6.2. that the Registrant has no legitimate right or interest to the domain name; and

1.2.6.3. that the domain was registered and is being used in bad faith.

The Panel finds that the Disputed Domain Name <morrowind.online> is identical to Complainant's registered MORROWIND Marks, as the Complainant's Mark MORROWIND is incorporated in its entirety at the second-level in the domain name. The top-level suffix "online" need not be considered for purposes of the confusing similarity test, as it is a technical requirement of registration. Even if the top-level domain were to be considered, however, the word "online", would

be understood by Internet users as referring to the platform for Complainant's computer and video game software, which is used in connection with an MMORPG where massive numbers of players converge "online" (over the Internet) through Internet Services Providers ("ISP's) the world over.

Complainant has no business relationship whatsoever with Respondent and has not licensed or otherwise permitted Respondent to use the MORROWIND Marks or to apply for any domain name incorporating the MORROWIND Marks.

The Complainant's evidence shows that the Disputed Domain Name does not resolve to a website on the public Internet. This is consistent with the Respondent's allegation that he uses the Disputed Domain Names domain name server ("DNS") to attain "easy access" to his Network-attached Storage ("NAS") and desktop computer. The Respondent's evidence consists of screenshots of DNS logs, purporting to demonstrate the Respondent's "personal" use of the Disputed Domain Name (during the months of November and December 2019 and early January 2020), for file transfer and recovery and network routing purposes.

Even if the Respondent's allegations as taken as true, however, the Response nonetheless does not assert that the Respondent's brief and general use of the Disputed Domain Name to access devices and files on his network could not be similarly achieved via a domain name that did not infringe on the Complainant's Marks, or that the Respondent's alleged use of the Disputed Domain Name DNS provided any advantage over non-infringing domain names in attaining such ease of access.

The Respondent's allegations and evidence fail to show that the Respondent was making a *bona fide* offering of goods and services as might give rise to a legitimate interest in and to the Disputed Domain Name (even if the Disputed

Domain Name may be deemed to have provided some minimal functionality or utility to the Respondent, such as any other domain name might have similarly provided).

The Panel finds that the Respondent registered the Disputed Domain Name for the primary purpose of disrupting the business of a competitor and that the Complainant has presented clear and convincing evidence of the Respondent's bad faith registration and use of the Disputed Domain Name.

DETERMINATION

After reviewing the parties' submissions, the Examiner determines that the Complainant has demonstrated all three elements of the URS by a standard of clear and convincing evidence; the Examiner hereby Orders the following domain names be SUSPENDED for the duration of the registration.

<morrowind.online>



David L. Kreider, Esq.
Panelist

David L. Kreider, Examiner

Dated: January 16, 2020