Decision for dispute CAC-UDRP-102448

Case number	CAC-UDRP-102448
Time of filing	2019-05-14 10:13:47
Domain names	bitmex.guide

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	HDR Global Trading Limited

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Organization	Graphics Empire

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

According to the evidence submitted by Complainant, Complainant is the owner of the following trademark: European Union trademark BITMEX, with registration number 016462327 and a registration date of 14 August 2017.

FACTUAL BACKGROUND

According to the provided information Complainant provides a peer-to-peer crypto-products trading platform offering leveraged contracts bought and sold in Bitcoin.

The disputed domain name, <bitmex.guide>, was registered on 5 July 2018.

The European Union trademark registration of Complainant has been issued prior to the registration of the disputed domain name.

According to Complainant the disputed domain name is identical or confusingly similar to Complainant’s trademark since it fully incorporates the mark BITMEX in the disputed domain name. Also, where the disputed domain name differs from the mark only by the addition of the generic Top-Level Domain (gTLD), “.guide”, the first element of the Policy has been satisfied

as it does not change the overall impression.

According to Complainant, Respondent has no rights or legitimate interest in the disputed domain name. Respondent is not commonly known by the disputed domain name. Complainant submits that the website to which the disputed domain name resolves is a parked page from GoDaddy, including unrelated advertisement links to purchase domain names adjacent to the display of "bitmex.guide" in bold text above a message that the web page is parked FREE, courtesy of GoDaddy and a picture of a "GoDaddy Guide" to advertise its support services. Use of a domain name incorporating a distinctive mark to post parking and landing pages does not in and of itself confer rights or legitimate interests arising from a bona fide offering of goods or services. According to Complainant it appears likely that since registering the disputed domain name Respondent has not made any bona fide or fair use of the disputed domain name in connection with any products or services.

According to Complainant the disputed domain name is registered and is being used in bad faith. Complainant has had a presence on the Internet from well before Respondent registered the disputed domain name. While Complainant was known to club members of the Rotary Club of Hong Kong, who are very prominent in the Hong Kong business world, as early as 2014, it had already appeared in the global media well before the disputed domain name was registered. Especially given there is no dictionary meaning for the mark BITMEX, it certainly seems likely that Respondent had searched top level domain extensions for the domain name "BitMex" before registering the disputed domain name. Moreover, given that the evidence of record shows that Respondent has otherwise passively held the disputed domain name for almost a year and made no preparations supported by relevant evidence for any actual or contemplated good faith use of the disputed domain name prior to receiving Complainant’s cease and desist order, it is only reasonable to conclude based on the totality of the circumstances that Respondent's actions demonstrate bad faith registration and use.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant has, to the satisfaction of the Panel, shown Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Complainant has established that it is the owner of a trademark registration for BITMEX. The disputed domain name, <bitmex.guide>, incorporates the entirety of the BITMEX trademark as its distinctive element. Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant’s trademark where the disputed domain name incorporates a complainant’s trademark in its entirety. The addition of the generic Top-Level Domain (“gTLD”) “.guide” is insufficient to avoid a finding of confusing similarity.

In the opinion of the Panel, Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in

the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use its trademark or to register the disputed domain name incorporating its trademark. Respondent is not making a legitimate non-commercial or fair use of the disputed domain name with intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of Complainant.

The Panel accepts the undisputed submission of Complainant that the disputed domain name resolves to a parking page. The Panel does not consider such use a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name. In addition, the website under the disputed domain name does not accurately and prominently disclose the relationship between Respondent and Complainant as the holder of the BITMEX trademark, in particular as there has never been any business relationship between Complainant and Respondent. Respondent is also not commonly known by the disputed domain name nor has it acquired any trademark or service mark rights.

The Panel finds that the disputed domain name has been registered and is being used in bad faith. Noting the status of the BITMEX mark and the overall circumstances of this case the Panel finds it more likely than not that Respondent knew or should have known of Complainant's mark.

The Panel notes that the disputed domain name incorporating Complainant's mark resolves to a parking page, which indicates, in the circumstances of this case, that Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy. The Panel adds that any passive holding of the disputed domain name and website does not prevent the Panel from finding registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BITMEX.GUIDE**: Transferred

PANELLISTS

Name	**Dinant T.L. Oosterbaan**

DATE OF PANEL DECISION 2019-06-14

Publish the Decision