Decision for dispute CAC-UDRP-102445

Case number	**CAC-UDRP-102445**
Time of filing	**2019-05-14 11:48:44**
Domain names	**bitmex.app**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**HDR Global Trading Limited**

Complainant representative

Organization	**RiskIQ, Inc. c/o Jonathan Matkowsky**

Respondent

Name	**Crushleo Rey**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings concerning the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of EU trade mark for BITMEX registered under number 016462327 which covers a range of financial services in class 36. The trade mark was filed on the 14 March 2017 and registered on the 11 August 2017.

The Respondent is the registered owner of the domain name BITMEX.APP which was registered on 4 May 2018.

FACTUAL BACKGROUND

The Complainant, HDR Global Trading Limited is a private limited company incorporated in the Republic of Seychelles. It operates BitMEX.com a peer to peer platform for trading cryptocurrency. The Complainant is the registered owner of EU trade mark for BITMEX registered under number 016462327 which covers a range of financial services in class 36. The trade mark was filed on the 14 March 2017 and registered on the 11 August 2017.

The Respondent is Crushleo Rey with a business address at BLK B, 13th Floor #01 Fangheng Building, Chaoyang District, Beijing. The Respondent is the registered owner of the disputed domain name BITMEX.APP. The domain name was registered on 4 May 2018.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant asserts that it has registered rights in the EU word mark BITMEX described above. It submits that the disputed domain name is identical or confusingly similar to this trade mark.

The Complainant asserts that a national or regional trade mark or service mark satisfies the threshold for the purposes of filing a UDRP case. It explains that the location of the trade mark, date of first use and the goods or services for which it is registered are irrelevant for the purposes of finding rights in the trade mark in accordance with the findings in Assurances Premium SARL v. Whois Privacy Shield Services / Daisuke Yamaguchi, WIPO Case No. D2016-1425.

It follows, the Complainant contends, that it has proven that it has established rights in BITMEX within the meaning of 4(a) of the Policy. The Complainant notes that this is consistent with the finding set out in HDR Global Trading Limited v. Pamela Ramirez / Crane Tech S. de R.L. de C.V, Claim No. FA1902001829913.

The Complainant notes that panels have found that fully incorporating an identical trade mark into the disputed domain name is sufficient to meet the requirement to show the disputed domain name is identical or confusingly similar to the trade mark. The Complainant refers to Alfred Dunhill, Inc. v. Registration Private, Domains by Proxy, LLC / Abdullah Altubayieb WIPO Case No. D2017-0209 wherein it was found that the addition of “app” or “.app” does not change the overall impression of a mark. In respect of this point, the Complainant also relies on the decisions in Hike Private Limited v. Jared Hanstra, WIPO Case No. D2018-1588 and Tupelo Honey Hospitality Corporation v. King, Reggie, FA 1732247.

The Complainant claims that the Respondent has no rights or legitimate interests in the disputed domain name. It argues that the consensus view (section 2.1 WIPO overview) is that complainants can have the impossible task of “proving a negative” in overcoming the burden of proof required to overcome this leg of the test. As a result, it has been found that once a complainant has proved a prima facie case the burden of proof can be reversed, it then falls to the respondent to demonstrate its right or legitimate interest in the subject domain name by providing relevant information. The Complainant explains that if the respondent fails to provide relevant evidence then the complainant is deemed to have satisfied the second element of the test. The Complainant refers to the decision in TechStars Central, LLC. v. Suspended Domain, Forum Claim Number: FA1904001836857 as a source of what constitutes relevant information which includes the Whois, assertions by a complainant regarding its relationship with a respondent and other evidence in support of these assertions. Relying on Chevron Intellectual Property LLC v. Fred Wallace, FA1506001626022 (Forum July 27, 2015) the Complainant provides the Whois record as evidence that that Respondent is not commonly known by the disputed domain name Further, it refers to the findings in Navistar Intern'l Corp. v. N Rahmany, FA1505001620789 (Forum June 8, 2015) to ground its complaint that it had not authorised, licensed or otherwise permitted the Respondent’s use of the trade mark in the disputed domain name.

The Complainant confirms that in advance of filing this complaint it sent a cease and desist email attaching images of its trade mark to the Respondent on or about 15 April 2019 wherein it requested that the Respondent transfer the disputed domain name. No response was received in respect of this notification which could demonstrate rights or legitimate interest in the disputed domain name. The Complainant explained that it made a number of attempts to contact the Respondent through the online form but after a number of attempts it relied on the registrar to forward the notice to the Respondent.

The Complainant states that the disputed domain name is used to direct traffic to a Sedo Domain Parking Page which is a pay-per-click links page. The Complainant has provided a print-out from a Sedo Domain Parking Page and a print-out which demonstrates that the disputed domain name was occasionally unreachable. It also refers to the fact that the “renew” message which is adjacent to the display of the BITMEX mark is likely to give the impression that the domain name belonging to the Complainant had expired. The Complainant explains that the “consensus view” is that use of the disputed domain name in this manner is not considered bona fide offering of goods per 4(c)(i) of the Policy or from legitimate non-

commercial or fair use per 4(c)(iii) of the Policy. The Complainant relies on the findings in cases Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao, WIPO Case No. D2016-2303 (Jan. 21, 2017) and TechStars Central (citing CDW LLC v. Spencer Askew, 1806931 (Forum Oct. 22, 2018).

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant has provided evidence that it had acquired recognition in the name on the internet from as early as 2015. The Complainant also explained that BitMEX was well known as early as June 2014 to club members at the Rotary Club of Hong Kong who are very prominent in the business world in Hong Kong. The Complainant also provides a print-out of a Google search before the disputed domain name was registered. It claims that it is likely that the Respondent searched top level domain extensions before registering the disputed domain name.

The Complainant relies on the findings in Home Depot Product Authority, LLC v. richard garyson / vanillacc, Claim No. FA 1765644 (FORUM, February 5, 2018) that bad faith registration and use include use of links to third-party websites. Referring to the decision in Focus Do It All Group v. Athanasios Sermbizis, Case No. D2000-0923 (WIPO, December 10, 2000), the Complainant states that bad faith may be found so long as commercial gain is sought by another person or entity who benefits from the subject domain name.

The Complainant states that a finding of bad faith can still be made despite the fact that the links have not been generated by the respondent or the fact that the respondent has not profited directly per section 3.5 of WIPO overview. The Complainant refers to the finding in the Home Depot Product Authority decision (ibid) that the respondent as the owner of the disputed domain name is responsible for the content of its website and the functioning of its domain name regardless of who selects the pay-per-click links. The Complainant further argues that use of a disclaimer does not prevent a finding of bad faith under 4 (a)(iii) of the Policy in accordance with the findings in Continental Airlines, Inc. v. Vartanian, FA 1106528 (Nat. Arb. Forum Dec. 26, 2007).

To support its claim of bad faith registration and use against the Respondent, the Complainant relies on the fact that the Respondent ignored the pre-filing cease and desist email requesting transfer of the disputed domain name. The Claimant refers to finding of “admission-by-silence” as set out in the decision in CIGNA Corp. v. JIT Consulting, eResolution Case No. AF-00174. It also points to the decision in RRI Financial, Inc., v. Ray Chen, WIPO Case No. D2001-1242 which found that ignoring requests to transfer a domain name without providing an explanation supported findings of bad faith and registration. The Complainant argues that it is reasonable to infer that the Respondent registered the disputed domain name for the purpose of exploiting the Complainant’s trade mark by either selling the disputed domain name or for using it to attract internet users who were seeking the Complainant in accordance with State Farm Mutual Automobile Insurance Company v. Jim Malloy, Forum Claim No. FA1904001837227 (Apr. 29, 2019) (citing State Farm Mutual Automobile Insurance Co. v. ReachLocal Hostmaster, FA 1762154 (Forum Jan. 8, 2018)).

The Complainant asserts that even “passive holding” of the disputed domain name will not prevent a finding of bad faith and use per Section 3.2 of WIPO overview. The Complainant explains in the absence of any explanation from the Respondent it is reasonable to infer that the Respondent registered the disputed domain name with the intention of exploiting the Complainant’s trade mark as described in the aforementioned paragraph. The Complainant relies on State Farm Mutual Automobile Insurance Company v. Jim Malloy, Forum Claim No. FA1904001837227 (Apr. 29, 2019) (citing State Farm Mutual Automobile Insurance Co. v. ReachLocal Hostmaster, FA 1762154 (Forum Jan. 8, 2018)) to support this argument.

RESPONDENT:

The Respondent argues that it uses the disputed domain name for non-commercial reasons and for the purpose of helping to raise funding for open source software. It says that the disputed domain name is not used to mislead consumers for commercial gain.

The Respondent relies on the separate definitions it has assigned to the three words that make up the disputed domain

name as a ground for its use. The Respondent explains that the BIT is the software composed of BIT code. Mex means it is mixed with all the software. APP is the abbreviation of software.

It is noted that the Respondent provided a copy of its SSL certificate together with an image of what is assumed to be the Respondent's website. No further information is provided in respect of the Respondent's enterprise.

RIGHTS

The Complainant has established that it owns the BITMEX word mark number 016462327 filed in the European Union Intellectual Property Office (EUIPO) on the 14 March 2017 and registered on the 11 August 2017.

The Complainant's BITMEX mark is wholly contained in the disputed domain name. In fact the disputed domain name is identical to the disputed domain name apart from the addition of ".app" top level domain name root and the Panel does not consider that the ".app" route distinguishes the disputed domain name from the Complainant's BITMEX mark.

Accordingly, the Panel finds that the disputed domain name is identical or confusingly similar to the trade mark for the purposes of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has submitted that it has not authorised, licensed or otherwise permitted the Respondent to use its trade mark in the disputed domain name. It has also submitted that the Respondent is not commonly known by the disputed domain name.

Although the Respondent says that it is making non-commercial use of the disputed domain name, the Panel notes that it resolves to a pay-per-click parking page. There is no evidence that the Respondent has made or is making a bona fide use of the disputed domain name. The Complainant's BITMEX mark is distinctive and the Respondent does not provide any evidence to support its explanation of the meaning of the mark. Certainly BITMEX is not just a common dictionary word that the Respondent chose by chance to incorporate into the disputed domain name. The use of it by the Respondent, in the disputed domain name, to divert Internet users to a Sedo pay-per-click page is not a bona fide non-commercial use as submitted by the Respondent. The Panel notes in this regard that the Respondent has provided no evidence to support its submission that the disputed domain name is being used to help raise funding for open source software.

For these reasons the Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to rebut this case and also for the reasons set out under the "bad faith" section below, the Panel finds that the Complainant succeeds under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has demonstrated that it owns registered trade mark rights in the word mark BITMEX as described above. The disputed domain name was registered on 4 May 2018 sometime after the Complainant's word mark BITMEX was first used online and more than a year after the word mark was filed in the EUIPO on 14 March 2017. Considering the degree of distinctiveness attaching to the BITMEX mark it and the Complainant's on-line presence at <bitmex.com>, it seems to the Panel more likely than not that that the Respondent was aware of the Complainant's mark when it registered the disputed domain name.

The disputed domain name resolves to a Sedo pay-per-click parking website page. Under Paragraph 4(b)(iv) of the Policy it is evidence of registration and use in bad faith to attract internet users intentionally for commercial gain to your web site 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. In this case the

Respondent has used the disputed domain name to divert Internet users to a Sedo parking page that appears to have commercial links and in respect of which the Respondent is likely to earn income. The Respondent says that this is for non-commercial purposes in order to raise funding for open source software but has provided no evidence to support this submission. In these circumstances the Panel is not inclined to accept this submission and notes that the use of a disputed domain name to confuse and divert Internet users to a pay per click parking page is a prima facie commercial use.

The fact that the Respondent ignored the Complainant's pre-filing cease and desist email of the 15 April 2019 and offered no response only serves to reinforce the Panel's view of the Respondent's bad faith in this case.

Accordingly, the Panel finds that the Complainant has demonstrated that the disputed domain name was registered and used in bad faith and the Complainant succeeds under 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

The Complainant owns the registered trade mark BITMEX. The disputed domain name wholly incorporates the registered trade mark and as a result the disputed domain name is identical or confusingly similar to the Complainant's trade mark.

There is no evidence that the Respondent was permitted to use the Complainant's BITMEX trade mark and no evidence that it was making a bona fide or non-commercial use of the disputed domain name by using the disputed domain name to resolve to a pay-per-click parking page. The disputed domain name was registered well after the Complainant's mark and first use of the BITMEX mark and considering the level of distinctiveness of the mark, it is likely that the disputed domain name was registered with prior knowledge of the Complainant's mark. The use of the disputed domain name to resolve to a pay-per-click parking page together with the Respondent's failure to respond to the Complainant's pre-action cease and desist letter supports a finding that the disputed domain name was registered and used 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.APP**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2019-06-25

Publish the Decision