Decision for dispute CAC-UDRP-102463

Case number	CAC-UDRP-102463
Time of filing	2019-05-07 11:07:10
Domain names	bitmex-airdrop.com, bitmex-blog.com

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	1337 Services LLC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceedings between the parties which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is a Seychelles incorporated company and it is active in the financial services money transfer owning a cryptotrading platform since 2014. The disputed domain names were registered on April 22 2019 as far as <bitmex-Airdrop.com> is concerned and April the 8th 2019 as far as <BITEM-BLOG.com> is concerned. Now the two domain names do not point to any active pages.

The Complainant owns several trademarks for BITMEX also in Canada Reg. No. 1880872 in class 36 with a use in Canada since 2016. The Complainant has indicated many other registrations in different jurisdictions.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

PROCEDURAL

The Complainant has clearly summarize the factual situation and the following are the more crucial information of its

resumè:

On April 22, 2019, the Complainant sent a cease-and-desist letter to the Respondent requesting transfer of the disputed domain name. The Respondent did not reply to the Complainant's letter.

BitMex respectfully requests of the Panel to name the Respondent in the caption of the Amended Complaint as follows: "1337 Services LLC, Host Master" because CAC's online platform technically only allows one to identify the organisation name--not the first and last name of the individual associated with the organisation that registered the disputed domain name as well, which is part of the Respondent's contact information confirmed by the registrar. An example of a recent UDRP case identifying Host Master with 1337 Services LLC is WPX Energy, Inc. v. Host Master, 1337 Services LLC, WIPO Case No. D2018-2438 (Dec. 13, 2018) (<us-wpxenergy.com>).

In both this case and in CAC Case No. 102447, the registrar verification responses disclosed that the disputed domain names, each redacted for privacy by Tucows in the public Whois, were registered by 1337 Services LLC, Host Master of Charlestown, Saint Kitts and Nevis. Cf. As stated in Registrar Verification Response received after the Complaint was submitted to the Provider in this case (collectively, hereinafter, "Registrar Verification Responses").

1337 Services purchases domains for itself in its own name on behalf of its customers through "Njalla.". Respondent is the actual owner of the domains vis-à-vis he "world" for its customers, so while it markets it's not an ownership of proxy as found with other providers, its position vis-à-vis its customers is that it does not have actual ownership of the domain names in relation to its customers on whose behalf it is agreeing to register the domains to shield their identities. Id. Respondent used "whois+bitmex-airdrop.com@njal.la" to register <bitmex-airdrop.com> and "whois+bitmex-blog.com@njal.la" to register <bitmex-blog.com>. See Registrar Verification Responses. Beneath the redacted Whois with Tucows, both of the disputed domain names were registered to 1337 Services to shield its customer's true identity. Id. Paragraph 3.7.7.3 of the ICANN RAA states that as the registered name holder, it accepts liability for any use of the relevant names unless it timely discloses the contact information of any underlying beneficial registrant. Cf. The Hartman Media Company, LLC v. Host Master, 1337 Services LLC, WIPO Case No. D2018-1722 (Sept. 24, 2018) (<jasonhartmanproperties.com>) (same Respondent) (deciding that the decision against Respondent should be construed to apply as well to the person(s) that caused the registration to be effected in the name of Respondent).

The Online portal only allows Complainant to list one of the Registrant e-mail addresses when inserting the Respondent’s known contact information. As a different email address was used to register <bitmex-blog.com>, Complainant requests to insert "whois+bitmex-blog.com@njal.la" as the additional e-mail for Respondent in connection with that domain by way of this request into the section of the Amended Complaint requesting such contact information.

Additional known contact information for Respondent 1337 Services LLC includes messaging Responding through its online submission form available at https://njal.la/ as well as by e-mail at <support@njal.la>.

The disputed domain name <bitmex-blog.com> is subject to CAC Case No. 102447.. The Time of Filing of Case No. 102447 is 2019-05-15 14:46:35. Id. The Time of Filing of this case is 2019-05-07 11:07:10. Id. Accordingly, Case 102447 is the proceeding with a later Time of Filing. The disputed domain name <bitmex-blog.com> has been included in the Amended Complaint in the instant Case. § 4(c) of CAC Supplemental Rule states, in pertinent part: "Any proceeding(s) against a domain name holder with a later Time of Filing with respect to the same domain name(s) shall be suspended pending the outcome of the proceeding initiated by the Complaint with the earliest Time of Filing." Accordingly, Case 102447 will be suspended subject to, and in accordance with § 4(c) of CAC Supplemental Rule with respect to this Case.

The Complainant held that the domain names at issue are confusingly similar to its registered trademarks BITMEX.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the Domain Name. According to the Complainant, the Respondent does not use the Domain Name in connection with any legitimate use but the disputed domain names redirects to a parking page. Also, according to the Complainant, the Respondent has not been commonly known by the Domain Name. Finally, the Complainant considers that the Domain Name was registered and used in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The 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 the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the 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

The 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

First of all from a procedural point of view the Panel accepts the Complainant's requests to comprise in the present case also BITMEX-BLOG.COM which is subject to CAC Case No.102447 which has been suspended because this domain name was also included in the Amended Complaint after the verification assessment. The Complainant has come to know that the identity of the both domain names of the case belong to the same entity. Therefore in light of the ne bis in idem principle it is preferred to have one decision on the same parties for the same asserted BITMEX violation.

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Thus for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

2. The Respondent has no rights or legitimate interests in respect of the domain names; and

3. The domain names have been registered and are being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

Domain Name is identical with the earlier existing rights and confusingly similar to other registered trademark

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since Complainant is the holder of the BITMEX registered trademark in many Jurisdictions and mainly in Canada which is the chosen Jurisdiction it is established that the Complainant owns valid rights where the Registrar is resident.

The Complainant shares the majority opinion that nationally or regionally registered trademark or service mark satisfies the threshold requirement of having trademark rights for purpose of standing to file a UDRP case. The location of the trademark, its date of registration or first use and the goods and services for which is registered are all irrelevant for the purpose of finding rights in a trademark under the first element of the URDP (see Assurances Premium SARL vs Whois Privacy Shield Service Wipo Case No. D2016-1425 of September 6, 2016).

This Panel does not share this view and consider the choice of the Mutual Jurisdiction not only related to the possible appeal before the Court of Justice (that will decide on the present UDRP decision) but also for the UDPR decision itself. There is no point to decide on the basis of a registered trademark in any Jurisdiction but not in the Jurisdiction ruling this case if a possible later Decision of the Court of Justice will annul the URDP decision applying the rules of law of that jurisdiction that has not been applied in the first place.

In the case at issue the Decision could be based on the Canadian Trademark registration BITMEX in the name of the Complainant. The possible appeal before the Competent Court in Canada will not change the ruling based on erred Jurisdiction.

The Domain Names at issue incorporate the Complainant’s BITMEX trademark in its entirety and the adding AIRDROP and BLOG are descriptive in relation to the Complainant's field of activity

Accordingly, the Complainant has made out the first of the three elements that it must establish.

No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that Respondent has no rights or legitimate interests in respect of the domain names.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the Domain Name in order to shift the burden of proof to the Respondent (See: Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 <championinnovation.com>; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 <croatiaairlines.com>; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 <belupo.com>).

The Complainant contends that the disputed domain names, now non active, have been used just to present themselves as the real Complainants' websites.

The Complainant has given evidence of the impersonification of the Complainant's web site with the likely intention to divert users. This behaviour is certainly unauthorised by the legitimate trademark owner. Now the disputed domain names and connected web sites are suspended, so it is an indirect evidence of the abusive conducts that the Respondent has decided not to challenge or justifie. Registrant decided not to file any Response and to rebut the above mentioned arguments the Panel finds that Registrant has no rights or legitimate interests in the disputed domain name per paragraph 4(a)(ii) of the Policy.

The Panel notes that the Respondent has not been commonly known by the domain name and that the Respondent has not acquired trademark or service mark rights. Respondent’s use and registration of the Domain Name was not authorized by the Complainant. There are no indications that a connection between Complainant and Respondent existed.

Furthermore, the disputed domain name points to an inactive website since its registration in which the only message shown on it is related to a possible offer for sale.

Bad faith

Complainant must prove on the balance of probabilities that the Domain Name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

Policy Paragraph 4(b) provides a non-exclusive list of factors, any one of which may demonstrate bad faith registration and use, namely:

(i) circumstances indicating that the domain name is registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name (Policy Paragraph 4(b)(i));

(ii) the registration of a 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 Respondent has engaged in a pattern of such conduct (Policy Paragraph 4(b)(ii));

(iii) the registration of a domain name primarily for the purpose of disrupting the business of a competitor (Policy Paragraph 4(b)(iii)); and

(iv) the use of a domain name for intentionally attempting to attract, for commercial gain, Internet users to a 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 Respondent’s web site or location or of a product or service on Respondent’s web site or location (Policy Paragraph 4(b)(iv)).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant’s trademark rights at the time of registration can evidence bad faith.

Furthermore it is proved ex tabula that the actual respondent knew very well the Complainant’s trademarks having set up its own web sites in the same business field.

Furthermore the Panel notes that the Complainant has filed evidence on the impersonification of its own web site in the web sites connected to the disputed domain names.

It seems therefore that the above four grounds are applicable to the case at issue and to support the Complainant’s arguments of the Registrant’s bad faith.

Specific decisions related to BITMEX FA 1902001829913 and FA 1902001829914 have decided in favour of the actual Complainant, as well as CAC previous decisions such as No.102443 - published on 19 June 2019; No.102439 - published on 27 June 2019; No.102445 - published on 27 June 2019.

Considering the above, the Panel finds that the Complainant has made out the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BITMEX-AIRDROP.COM**: Transferred
2. **BITMEX-BLOG.COM**: Transferred

PANELLISTS

Name	Massimo Cimoli

DATE OF PANEL DECISION 2019-07-02

Publish the Decision