

ADMINISTRATIVE PANEL DECISION

New York Digital Investment Group LLC v. Joshua Ogbemudia
Case No. D2022-0873

1. The Parties

The Complainant is New York Digital Investment Group LLC, United States of America (“United States”), represented by 101domain.com, United States.

The Respondent is Joshua Ogbemudia, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <nydigcompany.com> is registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 12, 2022. On March 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 15, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform 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 March 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 19, 2022.

The Center appointed Antony Gold as the sole panelist in this matter on April 27, 2022. 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 was established in 2017 and has developed a cryptocurrency-related business, which is branded as NYDIG. The Complainant has secured registered trade mark protection for NYDIG, namely United States Service Mark, registration number 5,916,140, registered on November 19, 2019 in classes 36 and 42. The Complainant also owns and operates many domain names which comprise or include its NYDIG mark, including the domain name <nydig.com> which resolves to a website providing information about the Complainant and the services it offers.

The disputed domain name was registered on February 3, 2022. Following registration, it resolved to a website which replicated both the form and content of the Complainant's website. By way of example, the home page of the Respondent's website was branded "NYDIG", beneath which was a section headed "Bitcoin For All", which stated; "We're building an inclusive financial system that makes Bitcoin a universal option for billions of people worldwide. Bitcoin is a resource for human progress, and NYDIG is the gateway". A further section stated; "NYDIG is a bitcoin company that's fusing high tech with institutional-grade finance to usher in a new era of financial products. We make it easy for partners to white label our solutions and create their own products like bitcoin accounts, rewards, and loyalty programs".

The disputed domain name is presently inactive, the Respondent's website having been taken down by the nameserver provider following a complaint by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which it has rights. The disputed domain name includes the entirety of the Complainant's trade mark and, as it was being used to direct consumers to an unaffiliated website of the Complainant for nefarious purposes, is confusingly similar to it.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Whilst the Respondent's website was active, it was being used for phishing purposes and the Respondent was trading on the goodwill the Complainant has established in its NYDIG brand, diverting potential customers away from the Complainant for wrongful profit and for collection of sensitive information from consumers. The Respondent does not appear to have any trade marks for NYDIG, or other rights or legitimate interests in this term, nor is he commonly known by the disputed domain name. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name because he intentionally imitated the Complainant's website.

Lastly, the Complainant says that the Respondent has registered and is using the disputed domain name in bad faith. The Respondent was fraudulently using the disputed domain name to confuse customers into dealing with him rather than with the Complainant. The Respondent's registration of the disputed domain name prevents the Complainant from reflecting its NYDIG trade mark in a corresponding domain name. The only use to which the Respondent has put the disputed domain name is fraudulently to mislead consumers who have been seeking the Complainant and who will have assumed that the services displayed on the Respondent's website were associated with the Complainant, thereby disrupting the Complainant's business.

B. Respondent

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

6. Discussion and Findings

Dealing, first, with the Respondents' failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following three elements in order to succeed in its Complaint:

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

A. Identical or Confusingly Similar

The Complainant has provided details of its service mark registration for NYDIG and has thereby established its rights in this mark.

The Top-Level Domain ("TLD"), that is ".com" in the case of the disputed domain name, is typically disregarded for the purposes of the comparison made under the first element, as it is a technical requirement of registration. The disputed domain name comprises the Complainant's NYDIG mark in full and adds the word "company". This additional term does not prevent the disputed domain name from being found confusingly similar to the Complainant's mark. As explained at section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element".

The Complainant's NYDIG mark is clearly recognizable within the disputed domain name and the Panel therefore finds that the disputed domain name is confusingly similar to a service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides, without limitation, examples of circumstances whereby a respondent might demonstrate that it has rights or legitimate interests in a domain name. In summary, these are if a respondent has used or prepared to use the domain name in connection with a *bona fide* offering of goods and services, if a respondent has been commonly known by the domain name, or if a respondent has made a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark in issue.

The Respondent's website unequivocally purported to be that of the Complainant. Whilst the exact benefit which he sought to derive from his use of a cloned copy of the Complainant's website is unclear, his objective was clearly to confuse Internet users into believing that his website was owned and/or operated by the Complainant. In these circumstances, it is reasonable to infer that the Respondent's objective has been to profit unlawfully from such confusion. Section 2.13.1 of the [WIPO Overview 3.0](#) explains that "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent". See also *Hero MotoCorp Limited v. Domains By Proxy, LLC, DomainsByProxy.com / Moien Ali*, WIPO Case No. [D2018-1744](#). The Respondent's website did not therefore comprise a *bona fide* offering

of goods and services.

There is no evidence that the Respondent has been commonly known by the disputed domain name and the second circumstance under paragraph 4(c) of the Policy is therefore inapplicable. Nor did the Respondent's website comprise a legitimate noncommercial or fair use of the disputed domain name. Lastly, the current inactive use of the disputed domain name comprises neither a *bona fide* offering of goods and services nor a legitimate noncommercial or fair use of it; see, for example, *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / petrov petya*, WIPO Case No. [DCC2020-0003](#).

The Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the burden of production shifts to the Respondent; see section 2.1 of the [WIPO Overview 3.0](#). In the absence of any response from the Respondent to the Complaint, he has failed to satisfy that burden. The Panel accordingly finds that the Respondent has no rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The only known use of the disputed domain name has been to resolve to a website which has been copied wholesale from that of the Complainant and which, self-evidently, purports misleadingly to be owned and/or operated by the Complainant. The fact that such use commenced very shortly after registration of the disputed domain name establishes both that the disputed domain name was registered by the Respondent with an awareness of the Complainant and its NYDIG mark and that the Respondent's objective in registering it was to confuse Internet users into believing that his website was that of the Complainant. Moreover, as explained in section 3.1.4 of the [WIPO Overview 3.0](#), "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith". The Panel therefore finds the Respondent's registration of the disputed domain name to have been in bad faith.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy is if a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. The use to which the Respondent has put the disputed domain name falls within this circumstance in that the form and content of his website will have led Internet users to believe that it was operated by, or with the authorization of, the Complainant. Such a belief will have been reinforced because of the confusing similarity between the disputed domain name and the Complainant's NYDIG service mark. The Respondent's use of the disputed domain name in order to create the false impression that his website was that of the Complainant was accordingly in bad faith. See also *Hero MotoCorp Limited v. Domains By Proxy, LLC, DomainsByProxy.com / Moien Ali (supra)*.

The current inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. In this respect, see section 3.3 of the [WIPO Overview 3.0](#), which explains that; "[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding". The factors that are typically considered when applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealment of its identity or its use of false contact details and (iv) the implausibility of any good faith use to which the domain name may be put. See also *VOLKSWAGEN AG v. Danny de graaf*, WIPO Case No. [D2020-1940](#).

Applying these factors to the current circumstances: (i) in the context of the Policy, the Complainant's NYDIG mark is not a dictionary term and is considered distinctive; (ii) the Respondent has not provided a response to the Complaint and the previous use made of the disputed domain name was in bad faith; (iii)

the Respondent has not sought to conceal his identity and the Complainant has not asserted that the Respondent's contact details are false. However, in isolation, this factor does not point clearly away from bad faith passive holding, particularly in the light of the earlier use made of the disputed domain name; (iv) there is no plausible good faith use to which the disputed domain name could be put by the Respondent. Accordingly, the circumstances of the Respondent's holding of the disputed domain name support a finding of bad faith use under the doctrine of passive holding.

The Panel therefore finds that the Respondent has registered and is using the disputed domain name in bad faith.

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 <nydigcompany.com> be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: May 11, 2022