

ADMINISTRATIVE PANEL DECISION

BlockFi Inc. v. Derick Couso
Case No. D2022-1136

1. The Parties

The Complainant is BlockFi Inc., United States of America (“United States”), represented by Haynes and Boone, LLP, United States.

The Respondent is Derick Couso, United States.

2. The Domain Name and Registrar

The disputed domain name <cryptoblockfi.com> (the “Disputed Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 30, 2022. On April 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 4, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 7, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on May 12, 2022.

The Center verified that the Complaint together with the amended 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 April 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. An informal communication was sent to the Center by the Respondent on April 12, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on May 13, 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 is a financial services company founded in 2017 dedicated to building a bridge between cryptocurrencies and traditional financial and wealth management products. The Complainant manages more than USD 2 billion in assets and is backed by industry-leading investors. Additionally, the Complainant is active on social media platforms, including on Twitter, Facebook, and YouTube, where the Complainant posts numerous videos and podcasts on blockchain technology, cryptocurrency, and wealth management.

The Complainant owns the following United States Trademark for BLOCKFI: United States Registration No. 5,989,814, registered on February 18, 2020, in international classes 36 and 42 (hereinafter referred to as the "BLOCKFI Mark").

The Complainant owns the domain name <blockfi.com>, which resolves to its official website at "www.blockfi.com", and which provides information about the Complainant's cryptocurrency services, a comparison of cryptocurrency and traditional financial and wealth management products, as well as direct links to online retailers for purchase of the Complainant's products.

The Respondent registered the Disputed Domain Name on February 27, 2021. The Disputed Domain Name initially resolved to a website that purported to offer investment and cryptocurrency news and advice from industry experts.¹ The "About" page referenced investment and cryptocurrency news, reviews, and advice, and the "Registration" page was non-functional.

5. Parties' Contentions

A. Complainant

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's BLOCKFI Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent did not submit a formal response. However, the Respondent sent an email communication to the Center on April 12, 2022, stating the following:

"After reading the first 20 pages of this First Amended document I'm beside myself. I started this side project to educate readers about cryptocurrency, blockchain technologies, and how it corresponds to finance and the monetary system, hence the name CryptoBlockFi. The domain was available and suited my vision at the time, so I registered it. Due to working full-time and having a family I never had time to follow through with

¹ The Disputed Domain Name currently resolves to a parking page with pay-per-click sponsored hyperlinks, listed courtesy of the Registrar.

this project hence why I let it expire and didn't renew the domain. After the expiration of the domain, now I hear about this, I didn't even know who was "BlockFi" until now, but they appear to be a nice little venture capital group looking out for their "online image". The last statement was pure sarcasm if you didn't catch it... But I won't bash them, its just business right? This is the problem with the crypto and the blockchain space now, elitists throwing their wallet lawyers around "cyber-squashing" the little guy that just has a passion for this space. If they want to pay you \$1500 plus their attorney fees for the domain name...Give it to them, and enjoy."

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)(i-iii)):

(i) the Disputed Domain Name is identical or confusingly similar to a trademark 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

This element consists of two parts: first, does the Complainant have rights in a relevant trademark, and second, is the Disputed Domain Name identical or confusingly similar to that trademark. The Panel concludes that the Disputed Domain Name is confusingly similar to the BLOCKFI Mark.

It is uncontroverted that the Complainant has established rights in the BLOCKFI Mark based on its several years of use, as well as the registered trademark for the BLOCKFI Mark in the United States. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the BLOCKFI Mark.

The Disputed Domain Name consists of the BLOCKFI Mark in its entirety preceded by the term "crypto", which is an abbreviation of the term "cryptocurrency", and then followed by the generic Top-Level Domain ("gTLD") ".com". It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in 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". For example, numerous UDRP decisions have reiterated that the addition of a term to a trademark does not prevent a finding of confusing similarity. See *Philip Morris USA Inc. v. Stephen Thorpe, vtx agency*, WIPO Case No. [D2021-1103](#) (the mere addition of a generic term to complainant's trademark does not negate the confusing similarity between the disputed domain names and the complainant's trademark).

Finally, the addition of a gTLD such as ".com" to a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11. Thus, the Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant's BLOCKFI Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any evidence to rebut the Complainant's *prima facie* case. Furthermore, the Complainant has not authorized, licensed or otherwise permitted the Respondent to use its BLOCKFI Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any name similar to it. Although the Respondent claimed in its informal communication to the Center that it was using the Disputed Domain Name to resolve to a website that educated the public about cryptocurrency, the Respondent did not submit any evidence to that effect. See Policy, paragraph 4(c).

Based on the Respondent's initial use made of the Disputed Domain Name to impersonate the Complainant, and to create and host a website similar to the Complainant's original website, does not confer rights or legitimate interests on the Respondent.² See [WIPO Overview 3.0](#), section 2.13.1 ("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."). Thus, the Panel concludes that the record does not support a finding that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. Rather, the Panel finds that the Respondent was capitalizing on the confusing similarity of the Disputed Domain Name to the Complainant's BLOCKFI Mark in order to pass itself off as the Complainant, seeking to benefit from Internet traffic intended for the Complainant. Such use of the Disputed Domain Name, which is calculated to lure consumers to the Respondent's website based on the improper belief that the Respondent is sponsored by or affiliated with the Complainant, cannot constitute a *bona fide* offering of goods or services under the Policy.

In this case, 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 not submitted any evidence to rebut the Complainant's *prima facie* case. As such, the Panel determines that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, based on the circumstances here, the Panel concludes that the Respondent registered and is using the Disputed Domain Name in bad faith in an attempt to attract Internet users to the Respondent's initial website by creating a likelihood of confusion with the Complainant's BLOCKFI Mark as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Name. The Respondent's registration and use of the Disputed Domain Name to impersonate the Complainant and create a similar website indicate that such registration and use had been done for the specific purpose of trading on the name and reputation of the

² Moreover, the current use of the Disputed Domain Name to resolve to a landing page with pay-per-click links does not preclude a finding that Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Complainant and its BLOCKFI Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) (“[t]he only plausible explanation for Respondent’s actions appears to be an intentional effort to trade upon the fame of Complainant’s name and mark for commercial gain”).

Second, the registration of a domain name that is confusingly similar to a trademark by an entity that has no relationship to that mark may be sufficient evidence of bad faith. See *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#); and *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#). Therefore, the Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith to target the Complainant’s BLOCKFI Mark for commercial gain.

Finally, because the Complainant had used and registered the BLOCKFI Mark prior to the registration of the Disputed Domain Name by the Respondent, the Panel finds that the Respondent had the Complainant’s mark in mind when registering the Disputed Domain Name. Although the Respondent claimed ignorance with respect to the BLOCKFI Mark, the Panel finds that there was no acceptable explanation for the Respondent to use the Complainant’s BLOCKFI Mark in connection with the industry term “crypto” and purport to offer services related to the Complainant’s own services other than in bad faith. See, e.g., *Blockfi Inc. v. WhoisGuard, Inc. / kilian mpape*, WIPO Case No. [DIO2021-0003](#).

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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 <cryptoblockfi.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: May 27, 2022