

ADMINISTRATIVE PANEL DECISION

Cboe Exchange, Inc. v. Privacy Service Provided by Withheld for Privacy ehf / yang zhi

Case No. DIO2022-0013

1. The Parties

The Complainant is Cboe Exchange, Inc., United States of America (“United States”), represented Baker & Hostetler, LLP, United States.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / yang zhi, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <cbous.io> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 18, 2022. On March 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 21, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 21, 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 March 26, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 27, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on April 29, 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

Since 1972 the Complainant and/or any predecessors in title have operated a securities and derivatives exchange in Chicago that is one of the largest and most successful exchanges of its kind in the world. The Complainant offers trading and investment products internationally.

The Complainant is the owner of trade marks consisting of the abbreviation "CBOE" (the "CBOE Mark", an abbreviation for Chicago Board Options Exchange) in the United States, in particular registration no. 2,484,435 for the CBOE Mark in Class 36 registered on September 4, 2001, with a date of first use of February 4, 1972.

The Domain Name was registered on October 22, 2021. The Domain Name is presently inactive but prior to the commencement of the proceeding resolved to a website (the "Respondent's Website"), which purported to offer financial instrument trading services, the same services offered by the Complainant. The Complainant has received a complaint from a consumer who, upon visiting the Respondent's Website, considered that it was connected with the Complainant in some way and made an investment on that basis. Upon making further enquires with the Respondent, the Respondent sent the visitor a letter identifying itself as the parent company of the Complainant and falsely stated it was located at the same address as the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) the Domain Name is identical or confusingly similar to the Complainant's CBOE Mark;
- (ii) the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the CBOE Mark. It owns trade mark registrations for the CBOE Mark in the United States. The Domain Name consists of the "cbo" elements of the CBOE Mark and the geographical abbreviation "us" which does nothing to detract from the identity of the central element of the Domain Name being the Complainant's CBOE Mark. The Domain Name is confusingly similar to the CBOE Mark as it reproduces the majority of the Complainant's CBOE Mark.

The Respondent has no rights or legitimate interests in the Domain Name. The Respondent is not affiliated with the Complainant in any way. The Complainant has not authorized the Respondent to use and register the CBOE Mark or to seek the registration of any domain name incorporating the CBOE Mark. The Respondent is using the Domain Name to operate a site through which the Respondent purports to pass off as being related to the Complainant for the purposes of perpetuating a fraud on investors. The use of the Domain Name in order to perpetrate a fraud does not and never could confer a right or legitimate interest on the Respondent.

The Domain Name was registered and is being used in bad faith. The Domain Name was registered with full knowledge of the CBOE Mark. The Domain Name has been used to perpetuate a fraud by passing off as the Complainant and purporting to offer investment services. Such use is *prima facie* evidence of

registration and use in bad faith under paragraph 4(b)(iv) of the Policy or otherwise. The Respondent's use of the Domain Name is calculated to create confusion with the CBOE Mark and to take advantage of that confusion for financial gain by defrauding visitors who think they are dealing with the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element, the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the CBOE Mark, having registrations for the CBOE Mark as a trade mark in the United States.

Disregarding the ".io" country code Top-Level Domain ("ccTLD") as a necessary technical requirement of the Domain Name, the Domain Name is confusingly similar to the CBOE Mark since it almost wholly incorporates the CBOE Mark, replacing the final letter "e" in the mark with the letters "us" to create a minor misspelling that would be easy for an Internet user to overlook. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

"Any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue." (Policy, paragraph 4(c))."

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the CBOE Mark or a mark similar to the CBOE Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial use.

Rather the Respondent has used the Domain Name to operate a website that, under a confusingly similar mark to the CBOE Mark, purports competing investment services. However, the uncontradicted evidence in the Complainant is that Respondent's Website is used to scam and commit fraud upon visitors who invest with them under the misapprehension that they are dealing with the Complainant, including by sending letters to potential investors asserting that the Respondent is associated with the Complainant. Such use is not a *bona fide* offering of goods or services.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has had an opportunity to rebut the presumption that it lacks rights or legitimate interests but has chosen not to do so. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered or Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the Domain Name in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds that the Respondent must have been aware of the Complainant at the time the Respondent registered of the Domain Name. The CBOE Mark is a well-known mark having been used for over 45 years. Moreover, the Respondent, in its communications with visitors to the Respondent's Website, actively asserts by letter that it is related to the Complainant. The registration of the Domain Name in awareness of the CBOE Mark and in the absence of rights or legitimate interests amounts to registration in bad faith.

The Respondent was using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to a website, by creating a likelihood of confusion with the CBOE Mark as to the source, sponsorship, affiliation or endorsement of its website. The Respondent's Website consists of a website that appears to offer investment services. However the only apparent purpose behind the conduct of the Respondent is to commit fraud upon visitors who think that they are dealing with the Complainant. The nature of the Respondent's Website and the broader evidence of the Respondent's conduct makes it clear that Respondent has used the Domain Name to intentionally attract Internet users to the Respondent's Website by means of confusion with the CBOE Mark, and received or intended to receive revenue for that activity. The Panel finds that such use amounts to use in bad faith.

The Panel, while noting that the Policy only requires that a complainant show that a respondent registered or subsequently used the domain name at issue in bad faith, finds that the Respondent has registered and

used the Domain Names in bad faith under paragraph 4(a)(iii) of the Policy.

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, <cbous.io> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: May 3, 2022