

ADMINISTRATIVE PANEL DECISION

Marathon Digital Holdings, Inc. v. Thomas Neill
Case No. D2023-3804

1. The Parties

Complainant is Marathon Digital Holdings, Inc., United States of America (“United States”), represented by Warshaw Burstein LLP, United States.

Respondent is Thomas Neill, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 12, 2023. On September 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 12, 2023, 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 (Redacted for Privacy, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email to Complainant on September 18, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on September 18, 2023.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on September 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 15, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 19, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on October 26, 2023. 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

Complainant describes itself as “a well-known company in the United States, formerly known as Marathon Patent Group, that mines cryptocurrencies with a focus on the blockchain ecosystem and the generation of digital assets.” According to the Complaint, “Complainant’s mining sites now include multiple operations in Texas and North Dakota, and as of December 31, 2022, Complainant is solely focused on the mining of Bitcoin and ancillary opportunities within the Bitcoin ecosystem.”

Since January 2021, Complainant asserts, it has used the service mark MARA “for services related to cryptocurrency mining and providing financial information relating to cryptocurrency.”

Complainant holds various registrations for the marks MARATHON DIGITAL HOLDINGS and MARATHON, as well as an application for MARA. Complainant holds United States Patent and Trademark Office (“USPTO”) Reg. No. 6,861,977 for the mark MARATHON DIGITAL HOLDINGS, registered on October 4, 2022 in connection with “Providing financial information about cryptocurrency mining,” with a January 2021 date of first use on commerce. Complainant also holds USPTO Reg. No. 6,861,995 for the mark MARATHON, registered on October 4, 2022 in connection with “Providing financial information about cryptocurrency mining,” with a November 2017 date of first use on commerce. In addition, on March 22, 2022, Complainant filed an application with the USPTO, Serial No. 97323880, to register the mark MARA in connection with “Cryptocurrency mining services, namely, providing financial information about cryptocurrency mining.”

Complainant registered the domain name <mara.com> on May 16, 2023, and uses that domain name to host its commercial website. Previously, and as early as March 2, 2021, Complainant operated a commercial site at the domain name <marathondh.com>, a domain name it had registered on October 29, 2020.

Annexed to the Complaint are several news articles discussing Complainant. For instance, an August 10, 2020 article in Coindesk refers to “Marathon,” and a December 28, 2020 article in Business Insider refers to “Marathon Patent Group” and “Marathon.”

Complainant’s Facebook page has approximately 1,600 followers, and Complainant’s X page has approximately 25,700 followers. Both social media pages feature the MARA mark, as well as Complainant’s multi-colored logo featuring the letter “M” and a landscape with wind turbines and other items.

The Domain Name was registered on August 16, 2023. The Domain Name resolves to a website bearing the banner, “Marathon Digital Holdings.” The site also features Complainant’s colorful logo, described above.

Complainant alleges that Respondent offers “the same or similar cryptocurrency mining services” as Complainant. According to Complainant:

“Respondent’s use of the confusingly similar Domain Name <marakenye.com> directs Internet searches, traffic, and business away from Marathon Digital Holdings. It also creates uncertainty and confusion in the marketplace and minds of those seeking Marathon Digital Holdings’ services. The Respondent also garners commercial gain by confusing the public into wrongfully assuming that Marathon Digital Holdings and Respondent are the same company or are operating together, by not providing any reasonable basis to distinguish the two. Respondent is not known as Marathon Digital Holdings (Annex 1 to the Complaint), nor is there any use of their mark on the web-site [associated with the Domain Name], but instead visitors see Marathon Digital Holdings’ marks displayed on the website associated with the [Domain Name].”

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark MARATHON through registration and use demonstrated in the record, and has rights in the unregistered mark MARA through use (on social media and at Complainant's "www.mara.com" website) demonstrated in the record.

With respect to identity or confusing similarity, it is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Panel concludes that the Domain Name is confusingly similar to the MARA mark. The Domain Name incorporates the MARA mark in its entirety – and also incorporates the leading dominant portion of the MARATHON mark, and adds the letters "kenye." The Panel concludes that, notwithstanding these additional letters, Complainant's mark is entirely reproduced in, and is recognizable within, the Domain Name. The Panel also notes the Domain Name resolves to a website bearing the banner, "Marathon Digital Holdings" which features Complainant's logo. Accordingly, the Domain Name is confusingly similar to a mark in which Complainant has rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to [Respondent] of the dispute, [Respondent's] 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) [Respondent] (as an individual, business, or other organization) have been commonly known by the [Domain Name], even if you have acquired no trademark or service mark rights; or
- (iii) [Respondent] are making a legitimate noncommercial or fair use of the [Domain Name], without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name. Respondent has not come forward to dispute Complainant's allegations or articulate some *bona fide* basis for registering the Domain Name.

On the undisputed record, the Panel concludes that Respondent targeted Complainant's mark (and used Complainant's logo) to create a website seeking to imitate Complainant's site. It is clear from the record that Respondent's site is designed to create the false impression that Respondent's website is Complainant's site (or is somehow affiliated with or endorsed by Complainant). Such a use of the Domain Name is clearly illegitimate.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that [Respondent] has registered or has acquired the [Domain Name] primarily for the purpose of selling, renting, or otherwise transferring the [Domain Name] registration to [Complainant] who is the owner of the trademark or service mark or to a competitor of that [Complainant], for valuable consideration in excess of its documented out of pocket costs directly related to the [Domain Name]; or
- (ii) that [Respondent] has registered the [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; or
- (iii) that [Respondent] has registered the [Domain Name] primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the [Domain Name], [Respondent] has intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] website or other online location, by creating a likelihood of confusion with [Complainant's] mark as to the source, sponsorship, affiliation, or endorsement of [Respondent's] website or location or of a product or service on [Respondent's] website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. The Panel incorporates here its discussion above in the "Rights or Legitimate Interests" section. It is clear that Respondent had Complainant's mark in mind when registering the Domain Name. The use of Complainant's name and logo on Respondent's website, as well as the similarity of the Parties' respective offerings is enough to dispel any doubt about this.

The Panel concludes that Respondent's registration and use of the Domain Name falls squarely within the above-quoted Policy paragraph 4(b)(iv), and hence constitutes bad faith registration and use of the Domain Name.

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <marakenye.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: November 9, 2023