

ADMINISTRATIVE PANEL DECISION

BCH Pacific Limited, Noel William Lovisa v. Hayden Otto, Bundaberg
Concrete Casters
Case No. D2022-3446

1. The Parties

The Complainants are BCH Pacific Limited and Noel William Lovisa, both from Australia, represented by Lexcode Legal Pty Ltd, Australia.

The Respondent is Hayden Otto, Bundaberg Concrete Casters, Australia, internally represented.¹

2. The Domain Names and Registrar

The disputed domain names <bchpacific.com> (“the first disputed domain name”) and <bitcoincashcity.com> (“the second disputed domain name”) are both registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 1, 2022. On September 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, 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 sent an email communication to the Complainant on September 19, 2022, requesting the Complaint to comply with the word limit, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 21, 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”).

¹ The Complaint and the Amended Complaint also name Otto Developments Pty Ltd as a respondent. The directors and shareholders of that company are the parents of the Respondent. The Complaint and the numerous supplemental filings made by the Complainants do not provide a basis for the inclusion of Otto Developments Pty Ltd in the dispute and, accordingly, the Panel proceeds on the basis that it has not properly been named in the dispute.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 11, 2022. The Response was filed with the Center on September 25, 2022. The Parties also submitted Supplemental Filings on September 27, 2022. The Complainant's supplemental filing consisted of a correction to a factual error and a request to be permitted to file a supplemental filing.

The Response having been filed, the Center notified the of panel appointment process on October 12, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on October 21, 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.

On October 26, 2022, the Complainant sought permission to file a further unsolicited supplemental filing said to relate to documentary material discovered on October 17, 2022, which had not been available at the time the Amended Complaint was filed.

Without deciding on the admissibility of the supplemental filings, the Panel issued an Administrative Panel Order on October 26, 2022, permitting the Complainant to make its foreshadowed supplemental filing and any explanation why it should be permitted by October 28, 2022. The Administrative Panel Order allowed the Respondent until November 4, 2022 to file a response to the Complainant's supplemental filing and extended the due date for the Panel's decision to November 13, 2022.

On October 28, 2022, the Complainant submitted a supplemental filing. On October 31, 2022, the Respondent submitted a supplemental filing in response. On October 31, 2022, the Complainant submitted a further unsolicited supplemental filing.

4. Factual Background

The Second Complainant is one of the three directors, and the secretary of, the First Complainant, a not-for-profit company. He is also the sole director of other companies including Bitcoin BCH Pty Ltd, Code Valley Corp Pty Ltd and Satoshiware NQ Pty Ltd.

He is described in the Bitcoin Cash City Conference program as the CEO of "Code Valley" and, having been interested in Bitcoin since 2011, as a serial entrepreneur active in the North Queensland Bitcoin BCH scene.

The Respondent describes himself as a cryptocurrency influencer and video producer. He has published numerous videos on at least two YouTube channels. His Hayden Otto Films channel was established in December 2017, and currently has approximately 3,830 subscribers. There have been over 144,000 views on this channel. The Respondent's second channel, Hayden Otto Crypto, was created in November 2021, and currently has just over 1,000 subscribers, and there have been some 61,000 views.

According to the Respondent, he was also involved with others in setting up and operating another YouTube channel, CoinSpice. The CoinSpice YouTube channel was created in June 2018. There are currently approximately 2,480 subscribers to the channel, and there have also been almost 271,000 views of its videos. However, the Respondent ceased his involvement in the CoinSpice channel in about June 2019.

According to the Complaint, Satoshiware has been promoting the adoption of Bitcoin Cash ("BCH") in Townsville, Queensland since 2018.

In February 2019, the Second Complainant or Satoshiware arranged for the Respondent and a videographer to visit Townsville for the purpose of making a video to promote Townsville as a Bitcoin Cash scene.

It is not in dispute that Satoshiware paid at least their travel and accommodation costs of this expedition and the videographer's fee. Nor is it in dispute that a film was made.

Both Complainants and the Respondent were involved (to use a neutral term) in the Bitcoin Cash City Conference in September 2019. This conference was held in Townsville on September 4 and 5, 2019.

There were plans for the conference to become an annual event. However, the onset of the COVID-19 pandemic forced the cancellation of the proposed 2020 and 2021 conferences.

To come to the involvement of the First Complainant requires consideration of the circumstances around the above events in more detail.

As noted above, it is not in dispute between the parties that the Second Complainant invited the Respondent to visit Townsville in February 2019 to make a film about the use of Bitcoin Cash in Townsville. The film was made and uploaded to the CoinSpice YouTube channel on March 5, 2019, entitled "North Queensland Bitcoin Cash City". According to the Respondent, it was subsequently taken down as some background music was unlicensed and re-uploaded in May 2019 as "Bitcoin Cash City".

The video, at least as uploaded to the CoinSpice YouTube channel, is almost five minutes in duration. It features the Respondent as presenter visiting various venues and attractions around Townsville, Queensland promoting it as "Bitcoin Cash City".

Subsequently, on May 20, 2019, the Respondent registered the second disputed domain name. The parties are in dispute about the basis on which the Respondent did this. It does not appear to be in dispute, however, that the Respondent paid for the registration and subsequent renewal fees.

On May 21, 2019, the Respondent registered the Twitter account @BitcoinCashCity.

In addition, the Respondent also created a Facebook account for "Bitcoin Cash City Conferences".

This Facebook account and the Twitter account feature numerous posts under the name "Bitcoin Cash City" juxtaposed to the Bitcoin "BCH" logo. In the print outs in evidence, the Facebook account has 313 followers and, it appears, 287 "likes".

On May 29, 2019, the Respondent also became the registrant of the domain name <bitcoinbch.com>. This domain name had previously been registered to a third party, who is unrelated to the parties and not involved in the dispute.

On June 6, 2019, the Respondent commenced employment with Code Valley, the Complainants say as Lead Web Developer. The Complainants also say his responsibilities involved the promotion of Bitcoin Cash and the preparation of the Bitcoin Cash City Conference for the Second Respondent or his company Bitcoin BCH Pty Ltd.

On June 21, 2019, the First Complainant was incorporated. The Complainants say the First Complainant was incorporated to conduct the Bitcoin Cash City Conference and future events.

On August 31, 2019, the Respondent's employment was transferred from Code Valley to Bitcoin BCH Pty Ltd. The Respondent became the CEO of that company.

Following its incorporation, the First Complainant received and paid the invoices relating to the expenses for the Bitcoin Cash City Conference. These amounted to just over AUD 374,000.

The expenses included AUD 13,000 for the development of a website to which the second disputed domain name resolved. Neither party has included examples of the website in evidence. Wayback Machine captures the website promoting the "Bitcoin Cash City Conference" on different times commencing from

June 22, 2019. In captures before November 2019, the website does not appear to mention the First Complainant by name. It does list Code Valley as a Platinum Partner and CoinSpice as a media partner of the conference. The Respondent is featured as a speaker. The Second Complainant is also featured as a speaker in his capacity as CEO @ Code Valley.

A media monitoring report included in the Complaint shows that, between August 7 and September 2, 2019, the website had 4,652 visitors. In the preceding 28 days, the Facebook page had a “reach” of 452,329 people with 186 likes, 45,554 engagements, and there were 18,671 views of a video on the website.

There was also digital advertising arranged through News Corp. This generated some 115,000 impressions. The advertisements in evidence, in the Townsville Bulletin, feature prominently Bitcoin Cash City Conference at the top next to what the Panel understands to be the “Bitcoin logo” and direct prospective delegates wishing to purchase tickets to the website at the second disputed domain name. The advertisements also invite inquiries to an email account based on the second disputed domain name. There is no mention of the First Complainant or the Second Complainant or, for that matter, the Respondent.

According to a Whois search, the first disputed domain name was registered on September 12, 2019. The Respondent says he was the person who registered and paid for this registration.

On August 18, 2021, the Respondent’s employment with Bitcoin BCH Pty Ltd ceased. Subsequently, the Respondent transferred to Bitcoin BCH Pty Ltd the domain name <bitcoinbch.com>. He has refused to transfer the disputed domain names to either of the Complainants.

From December 2021, there has been an exchange of letters between lawyers for the parties alleging various breaches and failures. Some of these appear to have been resolved. The dispute over the disputed domain names, however, has not been.

Both disputed domain names now redirect to the Respondent’s website at “www.haydenotto.com”.

In exchanges on Reddit, the Respondent has suggested he would be prepared to transfer the second disputed domain name for AUD 40,000.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainants must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which a 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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Consolidation of Complaints

The two Complainants assert different trademarks against two different domain names, but both disputed domain names are held by the Respondent.

Paragraph 3(c) of the Rules expressly permits a complaint to relate to more than one domain name where all the domain names are registered by the same domain name holder. The Panel's powers under paragraph 10(e) have also been held to permit consolidation of complaints by different trademark owners. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1 indicates that consolidation will generally be allowed where:

“(i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.”

The Respondent objects to consolidation on the basis that there are two different complaints based on different facts which leads to confusion and prejudice in attempting to deal with the two complaints within the word limit prescribed in the Rules.

There is some force in the potential for confusion. On the other hand, it is plain that the First Complainant is under the control of the Second Complainant. While the Complainants' claims to entitlement to their respective trademarks do arise from different facts, both parties' claims to the disputed domain names ultimately derive from a common substratum of facts or sequence of events. It would not contribute to efficiency for there to be two separate proceedings in relation to the two disputed domain names as it is likely that both Complaints would require consideration of many of the same facts. It also appears to the Panel that the Respondent has been able to address both disputed domain names efficiently.

In these circumstances, the Panel considers consolidation is appropriate.

B. Supplemental Filings

Apart from documents requested by the Panel pursuant to paragraph 12 of the Rules, neither the Policy nor the Rules expressly provide for supplemental filings. Their admissibility is therefore in the discretion of the Panel bearing in mind the requirements under paragraph 10 of the Rules to ensure that the proceeding is conducted with due expedition and both parties are treated equally, with each party being given a fair opportunity to present its case.

Where unsolicited supplemental filings are admitted, it is usually because the material corrects some error or addresses something raised in a Response which could not reasonably have been anticipated or which was not otherwise appropriate to deal with until a respondent's position on a particular point was clear.

The Panel accepts that parts of the Complainants' unsolicited supplemental filings do seek to correct errors in the Complainants' previous filings. To that extent at least, they should be admitted.

It is rather more doubtful that other materials qualify. Some relate to correspondence between the parties' legal representatives with claim and counter-claim about who was in breach of their arrangements about matters not directly related to entitlement to the disputed domain names. Others were found on the Second Complainant's computer after a search resulting from receipt of the Response.

In the result, the Panel has had to read all of the materials and the Respondent has responded to the supplemental filings. As the Panel has read the materials, it is questionable whether they can simply be “put out of mind”. Moreover, the Respondent seeks to rely on parts of them as admissions in his favour. It would certainly involve much more effort than would be warranted to engage in a thorough winnowing process having regard to the conclusions the Panel has reached after reading the materials carefully. Accordingly, with considerable reservations, the Panel will admit all the supplemental filings into the record but will endeavour to focus on those materials that relate directly to the issues arising under the Policy.

C. Identical or Confusingly Similar

The first element that the Complainants must establish is that each disputed domain name is identical with, or confusingly similar to, trademark rights of one of the Complainants.

There are two parts to this inquiry: the Complainants must demonstrate that one of them has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain names must be shown to be identical or confusingly similar to the trademark.

The Complainants do not have any registered trademarks. Instead, they rely on rights in what they call “unregistered trademarks” – BCH PACIFIC in the case of the First Complainant, and BITCOIN CASH CITY in the case of the Second Complainant.

It is well-established that unregistered trademarks can qualify as trademark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3 explains:

“To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

“Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

“....

“Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.”

“Bitcoin Cash City”

The materials before the Panel show the expression “Bitcoin Cash City” being used in two different senses. First, it is used by the parties and the public to refer to the place, Townsville. Examples of this type of use include the video uploaded to the CoinSpice YouTube channel and other promotional materials. Secondly, it is also used as the name of a person or entity, although the person or entity is not necessarily otherwise identified. Examples of this type of use are particularly the posts on the Facebook page and the Twitter account being used to promote the Bitcoin Cash City Conference.

According to the Complaint, the expression came about in February 2019 when the Respondent read out a post on Reddit to the Second Complainant: “It’s like you guys are the Bitcoin Cash City”. The city of Arnhem in The Netherlands had apparently previously been known as “Bitcoin City”. The Second Complainant says that he immediately recognized the importance of the name in relation to the adoption of BCH in Townsville. Therefore, he decided that Satoshiware and his other companies should use the expression for marketing the adoption and use of Bitcoin in Townsville.

In addition to Satoshiware funding production of the film, the Second Complainant says he prepared and drafted the Video Plans, inserted the logos of the participating businesses (including CoinSpice) into the video and prepared and drafted the time lapse sequences. While the Complainants accept that the Respondent was at the time employed by CoinSpice, the Second Complainant says he retained the Respondent to make the video and the Respondent was at all times acting on the instructions and under the direction of the Second Complainant.

In addition to the email of the Video Plan to the videographer, there is an email chain on March 3 and 4, 2019, in which the videographer sent the Second Complainant and the Respondent links to transition clips for review and the Second Complainant replied expressing his approval and saying he looked forward to the final cut.

The Second Complainant then says that in April 2019 he was planning the Bitcoin Cash City Conference to be held in Townsville in September that year. To facilitate this, he directed the Respondent to register the second disputed domain name on behalf of the Second Complainant. In fulfillment of that instruction, the Respondent subsequently registered the second disputed domain name on May 20, 2019 doing so, according to the Second Complainant, as his agent.

The Respondent denies this account. He claims he invented the expression himself without any involvement from the Complainants. The Respondent says the first use of the expression was in the video which he made and uploaded to the CoinSpice YouTube channel. According to the Respondent, he wrote the script, did most of the editing and paid most of the costs incurred in its production (apart from the travel and accommodation costs and the videographer's fees). In making the video, he was acting on his own account for the purposes of his own business or activities as a cryptocurrency influencer and podcaster.

The Annexes to the Complainants' second supplemental filing include what the Complainants identify as the Video Plans. The second Video Plan is also referenced as being attached to an email to the videographer dated February 25, 2019. The email also states the Second Complainant is completing a full draft (presumably of the script) and will send it through on completion. The materials in evidence do not include the full draft.

However, the Respondent also contends that the video "has little resemblance" to the Second Complainant's "script":

"Multiple locations that appear in the video are not mentioned in [the Second Complainant]'s plan; for example, Castle Hill, Australian Laundries, Magnetic Island. His plan requires filming at the airport, but there are no scenes at the airport in final video that I made. His plan requires interviews with business owners, there are no interviews in the final video that I made. In short, [the Second Complainant]'s document is clearly not a script, and it is not a document or plan that I used in any way to make my video."

One notable feature of both Video Plans is that neither uses the expression "Bitcoin Cash City". There are references to "Bitcoin Cash" and "Bitcoin BCH", the name of the particular Bitcoin fork.

In the second supplemental filing, the Complainants also concede that the Respondent did not read out the expression "Bitcoin Cash City" from the Reddit user. Rather, the Second Complainant now says the Reddit user referred to "Bitcoin City". As already noted, both of the Complainants' supplemental filings in part seek to correct mistakes made in the Amended Complaint. Another example is retraction of the claim that the Respondent worked in the Complainants' office in February 2019, several months before the property was in fact leased.

The Respondent claims that he originated the idea for the Bitcoin Cash City Conference and proposed it to the Second Complainant during a visit to Townsville in May 2019. He says he and his girlfriend invited most of the guests, organised the program and dealt with "substantive matters". The Respondent contends that the Second Complainant and his companies arranged the accommodation and the like.

The Respondent also claims that he registered the second disputed domain name, Facebook and Twitter accounts in his own name and on his own account.

The Complaint does include evidence that (at least) the formal invitations to speakers and presenters were sent out on the First Complainant's letter head and name. Also, that the bills for the conference were invoiced to the First Complainant. Other materials in the Complaint, however, also clearly identify the Respondent as the organizer.

The conference made a substantial loss. However, it was intended to hold a second conference on a similar scale in 2020 before the COVID-19 pandemic intervened.

The Panel is plainly not in a position to decide between the two competing accounts of how the video was made or who coined the expression "Bitcoin Cash City".

There are no contemporaneous documents setting out the relationships of the parties in evidence. Such documentary evidence as there is at best equivocal in supporting the Complainants' version.

The Panel is also not in a position to determine how the idea for the Bitcoin Cash City Conference came about or who was the moving force. The publicly available materials included in the record describe the Respondent as the organiser. It is also clear, however, that after its incorporation the First Respondent was the corporate vehicle through whom sponsors were secured, accommodation and all the other elements that go into a conference involving international speakers were arranged and paid for. And, at least from June 2019, the Respondent concedes he was employed as the CEO of one of the Second Complainant's companies.

The Respondent appears to contend that he "lent" or licensed the second disputed domain name to, first, Code Valley and then the First Complainant for the purposes of promoting, arranging and holding the Bitcoin Cash City Conference (just as the Second Complainant claims the First Complainant made use of these tools with his permission).

At the time he registered the second disputed domain name (and the Twitter and Facebook accounts), the Respondent was not an employee of any of the Second Complainant's companies. There is no evidence of any payment to him. There is no documentary record of any arrangements between the parties at this stage.

The Respondent points out that, unlike the second disputed domain name, the domain name <bchbitcoin.com>, which he also registered, was paid for by the First Complainant and consequently he has transferred it to the Complainants after his employment finished.

As it appears that the Respondent registered <bchbitcoin.com> before the First Complainant was incorporated, he must be mistaken about which entity in the Complainants' group paid for the registration.

The Complainants have not explained why they paid, or arranged for payment, for the registration of the domain name <bchbitcoin.com> but not the disputed domain names. The Complainants do say that the Respondent explained he registered the second disputed domain name in his own name as he had extra domain space on his account. The Panel does not understand this contention since, as the Respondent points out, domain names are typically registered on a fee per domain name basis independent of hosting. In any event, the Complainants do not explain their failure to pay for the registrations of the disputed domain names while, apparently, paying for the registration of <bchbitcoin.com>.

It may well be that the First Complainant, or some other entity within the Second Complainant's group of companies, is the owner of the rights in the content of the website at the second disputed domain name, especially if, to the extent the Respondent was the author, he did so in the course of his employment by BCH Bitcoin Pty Ltd. It does not necessarily follow, however, that the Second Complainant is entitled to the disputed domain names.

Apart from the contested claims that the Second Complainant directed the Respondent to register the second disputed domain name for the Second Complainant as his agent, the evidence does not address who are the employees of the First Complainant using email accounts based on the second disputed domain name or how they came to be doing so. The fact that the employees (if it be a fact) were permitted to use email accounts based on the second disputed domain name in connection with the conference does not necessarily lead to a conclusion that the second disputed domain name was held by the Second Complainant or some other company that he controlled especially in circumstances where the Respondent

claims (albeit contrary to the claims of the Second Complainant) the conference was his idea and he was the organising influencer.

In these circumstances, the Panel is unable to find that the Second Complainant is the owner of the second disputed domain name. The nature of the dispute between the parties over this issue is not something that can be resolved on the very limited written record before the Panel.

Accordingly, the Panel finds that the Second Complainant has not established rights in the trademark BITCOIN CASH CITY sufficient to satisfy the requirements for the first element under the Policy.

“BCH Pacific”

The Respondent contends that BCH PACIFIC is a generic expression with essentially no ability to distinguish goods or services in itself. The Respondent contends further that the First Complainant was a back-room administration company with virtually no public face. Accordingly, the Respondent contends the First Complainant has not made a sufficient showing of acquired distinctiveness to qualify as trademark rights under the Policy.

The Panel accepts that “BCH” is the common abbreviation for the Bitcoin Cash fork – corresponding to usages such as USD for the United States currency. “Pacific” is also an ordinary geographic term. However, that does not necessarily mean that the terms in combination are devoid of any distinctive character.

Moreover, as already mentioned, the Complaint includes evidence that the First Complainant corresponded with participants in the conference and the numerous suppliers to the conference on letter head which clearly identified its name. The suppliers also addressed their invoices and the like to the First Complainant, usually by name. The Complaint also includes evidence that potential sponsors for the conference were approached under the name “BCH Pacific”.

It has long been recognized under the Policy that nascent reputation or trademark rights will be sufficient to qualify as rights in a trademark especially where the circumstances indicate that a respondent has registered a domain name to take advantage of those nascent rights. Although they involve trademarks where the individual components also exhibited acquired distinctiveness, examples include *Clifford Chance LLP And Pünder GmbH v. CPIC Inc.*, WIPO Case No. [D2000-1603](#) and the Panel’s own prior decision in *Time Warner Inc. and EMI Group plc v. CPIC Net*, WIPO Case No. [D2000-0433](#). See also, relevant to the existence of protectible rights at common law in Australia *Glaxo plc v. GlaxoWellcome Ltd* [1996] FSR 388; 42 IPR 317, *Fletcher Challenge Ltd v. Fletcher Challenge Pty Ltd* [1981] 1 NSWLR 196; [1982] FSR 1, the latter two both approved in *British Telecom plc v. One in a Million Ltd* [1998] 4 All ER 476; 42 IPR 289 (Eng CA).

There is ample evidence therefore to find that the First Complainant has rights in its name, or the customary abbreviation “BCH Pacific” as an unregistered trademark for the purposes of the Policy.

The second stage of the inquiry under this element of the Policy simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, the first disputed domain name consists of the Complainant’s trademark or the Complainant’s trademark without the word “Limited”. It is also common in Australia for corporate entities to be referred to without reference to corporate indicators such as “Limited” or “Ltd”. As this requirement under the Policy is essentially a standing requirement, therefore, the omission of this term does not preclude a finding of confusing similarity. Apart from anything else, the Complainant’s trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the First Complainant has established that the first disputed domain name is identical with or confusingly similar to the First Complainant’s trademark and the requirement under the first limb of the Policy is satisfied in respect of the first disputed domain name.

As the Complainants have not established the second disputed domain name is identical with or confusingly similar to their trademarks, the Complaint in respect of the second disputed domain name must fail. Therefore, the remainder of this decision will consider the second and third elements of the Policy in respect of the first disputed domain name only.

D. Rights or Legitimate Interests

The second requirement the First Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the First Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the First Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name after the First Complainant began using its trademark.

The Complainants contend that the Respondent registered the first disputed domain name in the course of his employment by one company under the control of the Second Complainant for the benefit of another company under the Second Complainant’s control, the First Complainant. The Complainants further contend that the Respondent was not authorised to use the first disputed domain name for purposes other than the First Complainant’s business.

The Respondent contends that he registered and paid for the first disputed domain name because he was the organiser of the conference. As already noted, the Respondent points out that he paid for this registration, unlike the <bchbitcoin.com> domain name.

So far as the record in this proceeding shows, however, the Respondent registered the first disputed domain name on September 12, 2019. That was two months after the First Complainant was incorporated and was being used as the “back-room administration company” for the conference. It was also almost two weeks after the Respondent had assumed the position of CEO in BCH Bitcoin Pty Ltd, effectively a related member of the Complainants’ corporate group.

Even accepting the Respondent’s claim that the Bitcoin Cash City Conference was “his conference”, there is nothing in the name of the conference that involves the use of BCH PACIFIC. The only role of that expression was as the name of the First Complainant.

Bearing in mind the Respondent was employed as the CEO of the related company and the role of the First Complainant, the Panel finds there is a very strong inference that the Respondent registered the first disputed domain name on behalf of the First Complainant and, in any event, held any rights in the first disputed domain name on behalf of the First Complainant.

The Panel finds, therefore, that the Respondent does not have rights to the first disputed domain name independently of its use for and on behalf of the First Complainant and in his capacity as CEO of the First Complainant’s related company. As the Respondent is not using the first disputed domain name for that purpose and is no longer in that capacity, he does not have rights or legitimate interests in it.

Accordingly, the Panel finds the First Complainant has established the second requirement under the Policy in respect of the first disputed domain name also.

E. Registered and Used in Bad Faith

Under the third requirement of the Policy, the First Complainant must establish that the first disputed domain name has been both registered and used in bad faith by the Respondent: see e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

Given the circumstances outlined above, there can be no dispute that the Respondent was aware of the First Complainant and its use of its name.

For the reasons explained in section 5D above, the Respondent registered the first disputed domain name as agent for and on behalf of the First Complainant. The Respondent had no rights to register the first disputed domain name in his own name when he registered it. As a result, his registration qualifies as registration of the first disputed domain name in bad faith. See e.g. *Ruby’s Diner, Inc. v. Joseph W. Popow*, WIPO Case No. [D2001-0868](#) and *Blomquist Builder’s Group, Inc. v. Domains By Proxy, LLC / Denise L Chapman*, WIPO Case No. [D2022-0307](#).

The Respondent’s use of the first disputed domain name to redirect to his own website constitutes use in bad faith: *Accenture Global Services Limited v. David Jentz*, WIPO Case No. [D2021-3275](#) (“Respondent’s ownership of the Domain Name was always as an agent for Complainant and never as a legitimate owner in his own right. Any use to which Respondent ever put the Domain Name which was not entirely for the benefit of Complainant would be illegitimate”) and *Blomquist Builder’s Group, Inc. v. Domains By Proxy, LLC / Denise L Chapman, supra*.

Accordingly, the First Complainant has established all three requirements under the Policy in respect of the first disputed domain name. As already noted, however, the Second Complainant has failed to establish the requirements under the Policy in respect of the Second disputed domain name.

F. Reverse Domain Name Hijacking

The Respondent contends that the Complaint has been brought in bad faith and, accordingly, the Complainant should be sanctioned by a finding of reverse domain name hijacking.

Paragraph 15(e) of the Rules provides, in part:

“If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.”

Paragraph 1 of the Rules defines “Reverse Domain Name Hijacking” to be “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”.

As the Complaint has succeeded in respect of the first disputed domain name, there can be no basis for a finding of reverse domain name hijacking in respect of that disputed domain name.

The Complaint has failed in respect of the second disputed domain name. However, that was not because of any finding that the Respondent had rights or a legitimate interest in the disputed domain name or that it was obvious that the Complaint must fail even before it was filed. Rather the Complaint failed because in the circumstances of this case it was not possible or appropriate for the Panel to find that the Second Complainant (and not the Respondent) was the owner of the rights in the name Bitcoin Cash City. It may be arguable that, given the nature of the proofs the Second Complainant advanced, it should have been apparent that would be the outcome. However, for the same reasons the Panel could not make a determination in the Second Complainant’s favour, the Panel is not in a position to make a positive finding that the Respondent is the owner.

In these circumstances, a finding of reverse domain name hijacking is not appropriate.

6. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the first disputed domain name, <bchpacific.com>, be transferred to the First Complainant, BCH Pacific Limited.

For the foregoing reasons, however, the Complaint is denied in respect of the second disputed domain name, <bitcoincashcity.com>.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: November 13, 2022