

ADMINISTRATIVE PANEL DECISION

BlockFi Inc. v. Frank Joshua
Case No. D2022-4536

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 Frank Joshua, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <blockfiforexchange.com> (the “Disputed 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 November 29, 2022. On November 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same date, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 1, 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 December 5, 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 December 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 9, 2023.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on January 31, 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

The Complainant is a financial services company founded in 2017. The Complainant offers a cryptocurrency trading and management platform.

The Complainant owns the following registered trademark for BLOCKFI:

- BLOCKFI, United States trademark registered under No. 5989814 on February 18, 2020, in classes 36 and 42.

The Disputed Domain Name was registered on November 1, 2021. According to the Complainant's evidence, the Disputed Domain Name appeared to resolve to a website offering services similar to the Complainant's services. The Panel observes that the website is currently suspended.

5. Parties' Contentions

A. Complainant

The Complainant considers the Disputed Domain Name to be identical or confusingly similar to a trademark in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant, the Respondent is neither affiliated with the Complainant nor has it been authorized to use the BLOCKFI mark in any manner. The Complainant claims that there is no evidence to suggest that the Respondent is commonly known by the Disputed Domain Name, or that the Respondent was commonly or legitimately known as "Blockfi" or "Blockforexchange" or any variation thereof, prior to the registration of the Disputed Domain Name. Also, according to the Complainant, the Respondent does not use the Disputed Domain Name in connection with a legitimate noncommercial or fair use as the Respondent displays the whole of the Complainant's mark with the descriptive terms "forexchange" throughout the website linked to the Disputed Domain Name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. According to the Complainant, there is no plausible reason for the Respondent to legitimately choose to use the term "BlockFi" in connection with a generic industry term and purport to offer services related to the Complainant's own services other than in bad faith. The Complainant contends that the Respondent's registration and use of the Disputed Domain Name constitutes a bad faith disruption of the Complainant's business. The Complainant also claims that the Disputed Domain Name was registered and is used to intentionally create a false affiliation, and likelihood of confusion, with the Complainant and its BLOCKFI mark in order to divert Internet users from the Complainant's own website for the Respondent's commercial gain.

B. Respondent

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

6. Discussion and Findings

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

The *onus* is on the Complainant to make out his case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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.

The Panel will therefore deal with each of these requirements.

A. Identical or Confusingly Similar

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there is a trademark in which it has rights. The Complainant's BLOCKFI trademark has been registered and used in connection to the Complainant's financial services.

The Disputed Domain Name incorporates the Complainant's BLOCKFI trademark and adds the term "forexchange". Where the relevant trade mark 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 (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Additionally, it is well established that generic Top-Level Domains ("gTLDs"), here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's BLOCKFI trademark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel notes that the Respondent has not apparently been commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is "Frank Joshua". The

Respondent's use and registration of the Disputed Domain Name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent exists or existed.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name incorporates the Complainant's BLOCKFI trademark in its entirety and adds the term "forexchange". The Panel agrees with the Complainant's view that this term can be seen as an abbreviation or a misspelling of the term "foreign exchange". Given the Complainant's activities related to financial services, the Panel finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainant and cannot constitute fair use in the circumstances of this case.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Panel observes that the Disputed Domain Name refers to a website which appeared to offer services similar to the Complainant's services under the name "Blockforexchange", which incorporates the Complainant's BLOCKFI mark. The Panel further notes that the website linked to the Disputed Domain Name invited users to create an account by entering personally identifiable information. In the Panel's view, this does not amount to a legitimate noncommercial or fair use of the Disputed Domain Name. Moreover, the Panel finds that this use is not a *bona fide* offering of goods or services but is more likely to be an illicit attempt to impersonate the Complainant to mislead unsuspecting Internet users expecting to find the Complainant. In the Panel's view, the content of the website linked to the Disputed Domain Name supports the Complainant's *prima facie* claim as to the Respondent's phishing intent, which cannot confer rights or legitimate interests (see section 2.13 of the [WIPO Overview 3.0](#)).

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 website or location or of a product or service on the website or location.

In the present case, the Panel finds it very likely that the Respondent was aware of the Complainant and its trademark rights when it registered the Disputed Domain Name. The Complainant's mark predates the Disputed Domain Name and the Panel finds that the Complainant has evidenced that its mark has been noticeable in its field of business. The Disputed Domain Name incorporates the Complainant's distinctive trademark in its entirety with the addition of the term "forexchange". As explained above, this combination can easily be considered to refer to the financial term "foreign exchange", which is related to the

Complainant's business. In the Panel's view, the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#), where it was held that the respondent acted in bad faith when registering the disputed domain name, because widespread and long-standing advertising and marketing of goods and services under the trademarks in question, the inclusion of the entire trademark in the domain name, and the similarity of products implied by addition of a telecommunications services suffix ("voip") suggested knowledge of the complainant's rights in the trademarks).

The Respondent uses the Disputed Domain Name to resolve to a website which appeared to offer services similar to the Complainant's services under the name "Blockfiforexchange", which incorporates the Complainant's distinctive BLOCKFI mark. In the Panel's view, this indicates that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Furthermore, the Respondent provided false and/or incomplete contact details that prevented the courier from delivering the Center's written communication. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Given the totality of the circumstances discussed above, the current suspended state of the Disputed Domain Name does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)). Given the nature of the Disputed Domain Name, the Panel finds it difficult to conceive of any future good faith use to which the Disputed Domain Name may be put.

Therefore, the Panel finds that, on the balance of probabilities, it is established that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last element 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, <blockfiforexchange.com>, be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: February 14, 2023