

ADMINISTRATIVE PANEL DECISION

Money Metals Exchange, LLC v. John Derry Case No. D2023-3832

1. The Parties

Complainant is Money Metals Exchange, LLC, United States of America (“U.S.”), represented by Akerman LLP, “U.S.”.

Respondent is John Derry, US.

2. The Domain Name and Registrar

The disputed domain name <usmoneymetals.com> (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 September 13, 2023. On September 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. Also on September 15, 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 (US Money Metals) and contact information in the Complaint. The Center sent an email to Complainant on September 19, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on September 22, 2023.

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 Respondent of the Complaint, and the proceedings commenced on September 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 16, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 17, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on October 19, 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

According to the Complaint, “Complainant Money Metals Exchange is a well-known brand in the distributorship and brokerage of gold, silver, platinum, and palladium coins, as well as gold bullion, silver, platinum, and palladium, as well as other goods and services.” Complainant holds several registered trademarks, including United States Patent and Trademark Office (“USPTO”) Reg. No. 4,816,109 for MONEY METALS EXCHANGE (and design), registered on September 22, 2015 in International Class 35 in connection with “Distributorship services in the field of gold coins, silver coins, platinum coins, palladium coins, gold bullion, silver, platinum and palladium,” and in International Class 36 in connection with, among other things, “Brokerage services in the field of gold coins, silver coins, platinum coins, palladium coins, gold bullion, silver, platinum and palladium.” Complainant also holds USPTO Reg. No. 4,857,047 for the word mark MONEY METALS EXCHANGE, registered on November 17, 2015.

The foregoing USPTO registrations indicate that Complainant has used the MONEY METALS EXCHANGE mark in commerce since September 1, 2014.

According to Complainant:

“Complainant has 24,000 followers on Facebook and 11,000 subscribers on YouTube, nearly 500,000 paid customers historically, more than 2 million customer and subscriber email addresses, and was ranked as the best overall Online Gold Dealer by Investopedia.”

Complainant’s main commercial website is located at “www.moneymetals.com”.

The Domain Name was registered on June 3, 2023. The Domain Name currently resolves to an “Account Suspended” web page. According to Complainant, beginning in July 2023, the Domain Name resolved to a website seeking to imitate Complainant’s website and purporting to offer the same types of products as Complainant.

Complainant alleges:

“Respondent provides identical goods and services to those provided by Complainant, operates in the same market, and uses the same marketing channels as Complainant. Specifically, Respondent offers goods and services for distributorship and brokerage in the field of gold coins, silver coins, platinum coins, palladium coins, gold bullion, silver, platinum and palladium, through the disputed domain. In making these offerings, Respondent’s website at usmoneymetals.com contains numerous references to Complainant’s trademarks, and incorporates multiple images and extensive text that are identical to images and text that appear on Complainant’s website and are copyright protected property and trademarks belonging to Complainant.”

Complainant has provided evidence that its stylized mark MONEY METALS EXCHANGE is reproduced, in both word and design, on Respondent’s website (albeit in colorized form).

According to Complainant:

“Respondent is clearly seeking to deceive customers into mistakenly believing that it is Complainant, or is affiliated with Complainant and that Complainant endorses the commercial services it offers. Complainant has received reports of actual consumer confusion and/or concern. Moreover, Respondent has failed to clarify in response to inquiries from at least one prospective purchaser that it is not Complainant.”

Complainant also alleges:

“Additionally, shortly after making a recent purchase of a [USD] 12.00 coin from Respondent, the purchaser was contacted by Respondent who informed the purchaser that the minimum purchase was [USD] 150.00, so the purchaser would have to send an additional payment to complete the purchase. This smacks of unfair, unlawful and/or fraudulent business practices, which are likely to be attributed to Complainant and tarnish its reputation.”

Respondent has not disputed any of the foregoing allegations.

5. Parties' Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent has not replied to Complainant's contentions.

6. Discussion and Findings

6.1 Preliminary Issues

A. Identity of Respondent

The Complaint and amended Complaint both cite “US Money Metals” as the Respondent, identifying various third parties as potential contacts for US Money Metals. The Complaint provides no explanation for why the third parties are cited, though the Panel notes that one individual reportedly shares an almost identical address to the US Money Metals Respondent, being an address allegedly found on the disputed domain name website. The Panel also notes that the mail courier was ultimately unable to deliver the Center's written communication to this address. The Complainant claims that the legal status of this Respondent is unclear.

The amended Complaint adds, in addition to the above, the Registrar-disclosed registrant, John Derry. In view of the Panel's findings below on the substantive merits, as well as the faulty address associated with “US Money Metals”, that said address and name were found on the disputed domain name, and lastly that there appears to be no registered legal entity in California under “US Money Metals”, the Panel finds that “US Money Metals” was solely used by the Respondent on the website connected to the disputed domain name in an attempt to legitimize the registration and use of the disputed domain name. Accordingly, the appropriate Respondent is John Derry and all references to “Respondent” will be in reference thereto.

6.2 Substantive Issues

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 MONEY METALS EXCHANGE through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The Domain Name incorporates the MONEY METALS portion of the mark, and adds the term “us.” The Panel concludes that Complainant’s mark is recognizable within the Domain Name.

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 you [Respondent] 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 [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) you [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.

Given Complainant’s contentions mentioned above, the Complainant has raised a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed 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 falsely suggesting to consumers that Respondent’s website is Complainant’s site. Such a use of the Domain Name is clearly illegitimate.

Complainant has not 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 logo on Respondent's website 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 <usmoneymetals.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: October 21, 2023