

ADMINISTRATIVE PANEL DECISION

SundaeSwap Labs, Inc. v. Privacy service provided by Withheld for Privacy ehf / Lilly Smith

Case No. D2022-0810

1. The Parties

The Complainant is SundaeSwap Labs, Inc., United States of America (“United States”), represented by Much Shelist PC, United States.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Lilly Smith, Canada, represented by Greenberg & Lieberman, United States.

2. The Domain Names and Registrar

The disputed domain names <sundaeswap.com> and <sundaeswap.net> are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 8, 2022. On March 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 9, 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 17, 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 March 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 15, 2022. The Response was filed with the Center on April 13, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 28, 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

The Complainant is a United States corporation. According to the Complaint, it has been providing since at least January 20, 2022, a range of services related to cryptocurrencies. These include the provision, via a website at “www.sundaeswap.finance”, of a decentralized exchange for cryptocurrency transactions such as trading tokens and viewing and managing liquidity positions.

The date of the Complainant's incorporation has not been disclosed.

On April 4, 2021, however, it registered the domain name <sundaeswap.finance>. On April 12, 2021, it made its first post on its @SundaeSwap Twitter account. On April 18, 2021, it launched a subreddit topic and a Discord server.

On April 26, 2021, the Complainant published its first blog post on the website to which its domain name resolved. This post featured the trademark “SundaeSwap” and included advice about creating a digital wallet and information about the Complainant's forthcoming service.

Although the Complainant's social media posts announced that its digital exchange services would be launched in May 2021, some obstacles were encountered or delays arose and, the Complainant did not begin providing its cybercurrency trading services to the paying public until January 2022.

In the meantime, on April 30, 2021, the Respondent registered the two disputed domain names and a third domain name <sundaeswap.io>.

By early August 2021, the two disputed domain names redirected to the website at “www.sushi.com” which is an online, decentralized platform for trading and managing digital currencies.

On August 3, 2021, a “nbahoop” contacted the Complainant through its Discord account, initiating an exchange which continued over several days until August 12, 2021.

“nbahoop” identified him- or herself as the holder of the first disputed domain name <sundaeswap.com>. To verify that claim, “nbahoop” redirected the disputed domain names from the “www.susi.com” website to the Complainant's website for several minutes during the communications.

“bahoop stated that he or she had been “approached by other projects to sell it to them but would rather give it to [the Complainant]. Can I get some tokens in exchange?”

“nbahoop” pointed out that he or she was aware the Complainant had reserved some 13 *per cent* of its token allocation for investments and argued that “[o]wning the .com is a very important investment in the project”. “nbahoop” claimed that the value of the first disputed domain name “now” was in six figures but, after launch, would be at least seven figures (that is, over USD 1,000,000). After again pointing out that the domain name would be the most valuable asset of the business – including that the Complainant's competitors including Sushi.com and Pancakeswap.com held the “.com” names of their trademarks, “nbahoop” made a final offer to transfer the first disputed domain name for nine *per cent* of the tokens to be issued by the Complainant.

According to the Complainant, this valued the first disputed domain name at between USD 3,600,000 and USD 18,000,000.

The Complainant did not take “nbahoop” up on this offer.

“nbahoop’s” final offer was made on August 12, 2021.

Earlier, on August 11, 2021:

(a) the Respondent filed two applications to register “Sundaeswap” as a trademark in the United States, Trademark Application Nos 90877935 and 90877566 in, respectively, International Classes 36 and 42. These applications were filed in the name of Fantastic GT Supply Inc.,¹ and

(b) the Complainant filed three applications to register SUNDAESWAP as a trademark in the United States, Trademark Application Nos 90878036, 90878057, and 90878068 in, respectively, International Classes 9, 36, and 42.

As the serial numbers show, the Respondent’s applications were filed before the Complainant’s applications.

None of these applications is registered.

On August 16, 2021, the Complainant filed a complaint under the Policy in respect of the first disputed domain name. On September 14, 2021, the panelist dismissed that complaint on the basis that the Complainant had failed to prove it had rights in the trademark “Sundaeswap”. See *SundaeSwap Labs, Inc. v. tech in FA2108 - 1959736*.

On September 16, 2021, Fantastic GT Supply Inc. launched a website at the domain name “www.sundaeswap.net” to which the first disputed domain name redirects. The landing page for this website displays a table of statistics for at least 100 different cryptocurrencies such as price, percentage changes over the previous 24 hours, the previous seven days, the previous 30 days, market capitalization and trading volume over the last 24 hours, and how much supply is in circulation. There are other pages for (1) Advisory, consultancy and research services, (2) Terms, (3) Privacy Policy, and (4) Tips & Commentary.

The Terms and Privacy Policy pages appear to be comprehensive sets of relevant terms.

The Advisory, Consultancy and Research Services page states:

“Our mission is to educate the world about cryptocurrencies so they are not left behind during the next financial and technological revolution. We are dedicated to empowering ordinary people with knowledge to navigate the cryptocurrency industry and invest in one of the most disruptive technologies since the internet. We offer advisory and consultation in the field of cryptocurrency, finance and investments.

Please fill in the form below and we will contact you soon!”

There is also a link to the form which takes one to a Google docs page which one must sign into before being able to use it.

The tips and commentary page includes four tips (such as “Do your research before investing”), links to two recommended courses and two recommended books. Clicking on the two links to the recommended courses takes one only to the home page for “Udemy”. The books link to the pages on Amazon.com for *Cryptocurrency Investing for Dummies* and *The Bitcoin Standard: The Decentralized Alternative to Central Banking*. (The URL for the page itself is <<https://sundaeswap.net/cookies-policy>>).

¹ The precise relationship between the Respondent, Lilly Smith, and this company is not disclosed although the telephone number in the Whois record is the same as the telephone number on the website.

5. Discussion and Findings

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

- (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.

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. Refiled Complaint

In view of the earlier unsuccessful complaint in respect of the first disputed domain name, the first issue is whether or not the Complaint should be permitted.

The Policy does not contain an express prohibition on refiling a complaint. Conscious of the potential for well-resourced complainants to harass potential respondents by repeated filings following an unsuccessful complaint, however, UDRP panels have exercised their powers under the Policy to reject further complaints over the same domain name against the same respondent in the interests of finality and certainty, bearing in mind that no decision under the Policy precludes a party from pursuing its grievance in an appropriate court.

Accordingly, UDRP panels have been prepared to accept a refiled complaint only in highly limited circumstances. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.18. Circumstances which have been taken into account include:

- (i) when the complainant establishes that legally relevant developments have occurred since the original UDRP decision,
- (ii) a breach of natural justice or of due process has objectively occurred,
- (iii) where serious misconduct in the original case (such as perjured evidence) that influenced the outcome is subsequently identified,
- (iv) where new material evidence that was reasonably unavailable to the complainant during the original case is presented, or
- (v) where the case has previously been decided (including termination orders) expressly on a "without prejudice" basis.

These considerations are not an exhaustive listing and the issue calls for a "common sense" approach. See e.g., *Jones Apparel Group Inc v. Jones Apparel Group.com*, WIPO Case No. [D2001-1041](#) and *Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V.* WIPO Case No. [D2011-0057](#).

The onus is on the Complainant, who is seeking to refile, to establish that the refiling should be permitted in the circumstance and the Complainant must clearly identify the circumstances which it relies on to justify refiling. See e.g., [WIPO Overview 3.0](#), section 4.18.

In the present case, the Complainant relies on the first, second, and fourth considerations above. First, the Complainant contends refiling should be permitted because the Complainant's rights in its trademark have

become “more clearly established”. Secondly, the Complainant contends that “additional investigation” has revealed the Respondent’s conduct to be more extensive than the Complainant knew – when the Complainant filed the previous proceeding it was unaware that the Respondent had also registered the second disputed domain name and <sundaeswap.io>. Thirdly, the Complainant contends the previous panel denied it natural justice by not exercising its powers to invite the Complainant to provide certain additional evidence.

The Panel does not accept the denial of natural justice claim in this case. Proceedings under the Policy are proceedings on the papers and meant to be conducted expeditiously and efficiently. To achieve those aims, the Policy provides for only a complaint and a response. While UDRP panels may reasonably exercise their powers under paragraph 12 of the Rules to invite a supplemental filing to clarify a point, there is no obligation to do so and unsolicited supplemental filings are accepted in limited circumstances. See e.g., [WIPO Overview 3.0](#), section 4.6. It is therefore incumbent on the Complainant to advance its case in full and all the materials it considers necessary to support its claim.

On the other hand, the fact (if it be a fact) that a complainant had obtained a registered trademark after an earlier complaint could be considered a legally relevant development where, as in the present case, the earlier complaint failed for want of proof of trademark rights. Whether or not refiling was permitted would nonetheless require consideration of all the circumstances.

By parity of reasoning, the Panel considers that a claim to rights in an unregistered trademark based on the acquisition of reputation and goodwill arising from growth of the business over time and more extensive development of the use of the trademark (especially where such growth occurs in almost real time in rapid “Internet speed” fashion) could also be considered a legally relevant development.

In the present case, as discussed below, there has been at the least a very significant change in the scale and scope of the Complainant’s business under its trademark so that, in the circumstances of this case, the Panel considers refiling should be permitted, particularly applying the common sense approach approved in *Jones Apparel Group Inc v. Jones Apparel Group.com*, WIPO Case No. [D2001-1041](#).

The Complainant also relies on its discovery after the earlier complaint was filed of the additional disputed domain name. One might expect a person in the position of the Complainant might have investigated whether its trademark had been registered in other domains. In the present case, there is no evidence about what inquiries, if any, the Complainant made. On the other hand, there were arguably complicating factors given the use of the privacy service and there is no information about whether or not the second disputed domain name resolved to any website. It is unnecessary to consider argument this further in light of the Panel’s earlier conclusion to permit the refiling.

A. Consolidation of Complaints

Paragraph 3(c) of the Rules permits a complaint to relate to more than one domain name where both or all are held by the same registrant.

As confirmed by the Registrar, that is the case here.

Accordingly, the Panel finds the complaints against the two domain names have been appropriately consolidated.

C. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or

confusingly similar to the trademark.

The Complainant seeks to rely on its pending trademark applications as one basis to satisfy this criterion. However, it is well-established under the Policy that a pending trademark application does not qualify. See e.g., [WIPO Overview 3.0](#), section 1.1.4.

The Complainant also claims rights in “Sundaeswap” as an unregistered trademark.

It is well-established that a claimant to rights in an unregistered trademark must demonstrate the likely existence of those rights by evidence and not mere assertion. [WIPO Overview 3.0](#), section 1.3. Generally, speaking that evidence should address matters such as the duration and nature of the use of the mark, the amount of sales under the mark, the nature and extent of advertising using the mark, the degree of public recognition and possibly consumer surveys.

First, it is not in dispute between the parties that the Complainant’s website at “www.sundaeswap.finance” was made publicly available bearing the trademark “SundaeSwap” (in some cases with a device element and others without) on April 21, 2021. At that stage, the website only offered information about the Complainant’s proposed service without an ability to trade in those services. It is also not in dispute between the parties that the Complainant formally began offering its cybercurrency trading services to the public on or about January 20, 2022.

The Complainant claims that the website has had almost two million visitors since its launch.

The materials submitted in the Complaint demonstrate, however, that as at January 22, 2022:

- (1) the Complainant’s Twitter account, @SundaeSwap, featuring the trademark had over 287,000 followers;
- (2) the Complainant’s Discord server had over 108,000 members;
- (3) the Complainant’s Medium account had 20,000 followers with a number of the posts recording between 1,000 and 2,000 “claps”;
- (4) the Complainant’s SundaeSwap subreddit had more than 33,000 members;
- (5) the Complainant’s Telegram group “SundaeSwap Finance” had more than 20,000 members.

In January 2022, the launch of the Complainant’s service also received extensive media coverage in relevant media including the Motley Fool, Crypto & Blockchain, Newsweek, Markets Insider, Coindesk, Tech Times, and Cryptoglobe.

The Complaint does not include evidence of the number of account holders, revenues generated, or advertising expenditure incurred. The Panel considers, however, the statistics outlined above are sufficient to establish a legitimate claim to rights under the Policy in an unregistered trademark for “SundaeSwap” particularly when regard is paid to the short time the Complainant has been operating.

The Respondent disputes that the Complainant has established its claim to trademark rights. First, the Respondent contends that the Complainant’s activities prior to January 2022 (when the Complainant actually began offering its paid services to the public) do not constitute trademark use.

Secondly, the Respondent contends it is in fact the owner of the trademark on the basis of its first use either through being the first to file the trademark applications and also the first to actually provide goods and services from its website before the Complainant actually began offering paid services in January 2022. The Respondent’s argument that the Complainant’s rights accrue only from January 2022 would not be decisive at this stage of the inquiry. As this requirement under the Policy is essentially a standing

requirement to ensure that the Complainant has an appropriate basis to invoke jurisdiction under the Policy, the Policy has been held to require demonstration of that the trademark rights existed at the time the Complaint was filed. Arguments about a prior entitlement are more appropriately considered under the second and third elements of the Policy.

Accordingly, the Panel finds that the Complainant has established sufficiently for the purposes of the Policy that it has rights in “SundaeSwap” as an unregistered trademark. Although it is not determinative of the issue in this case, the Panel notes this conclusion is consistent with the decision in *SundaeSwap Labs, Inc. v. solana art* WIPO Case No. [D2022-0231](#).

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain names to the proven trademark. 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 of the disputed domain names as a functional aspect of the domain name systems. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” and “.net” gTLDs, therefore, the disputed domain names consist of the Complainant’s trademark alone.

Accordingly, the Panel finds that the Complainant has established that the disputed domain names are identical with the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

D. Rights or Legitimate Interests

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

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 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 Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Complainant states that there is no relationship between it and the Respondent. There has been no licence, sponsorship, or permission given. Further, the Complainant has not authorised the Respondent to use the disputed domain names.

The Respondent is not commonly known by the distinctive element of the disputed domain names.

The Complainant further contends that the nature of the Respondent's use precludes a claim of noncommercial or other fair use.

Finally, the Complainant contends that the Respondent cannot rely on use or preparations for use in connection with the provision of goods and services in good faith.

It may be inferred that these contentions apply equally to the Respondent's associated company, Fantastic GT Supply.

Save for the last point, these contentions are not in dispute between the parties. As already noted in section 5.C. above, the Respondent contends that it has the prior entitlement to the trademark.

First, the Respondent contends that United States law requires there actually be use of the trademark in the sale of goods or services, citing *Department of Parks and Recreation for State of California v Bazaar Del Mundo Inc* 448 F.3d 1118, 1125 (9th Cir 2006). According to the Respondent, the Complainant's use prior to the commencement of sales in January 2022, therefore, does not constitute use of the trademark conferring ownership under United States law. In addition, mere token use will not suffice. The Respondent also contends that mere advertising alone will not suffice, citing *Chance v. Pac-Tel Teletrac Inc.*, 242F.3d 1151 at 1158. The Respondent also points out that the Courts are often suspicious of electronic communications given the relatively minimal effort associated with sending emails, making Tweets, or posting comments on a message board, citing *Brookfield Commc'ns, Inc. v. West Coast Ent'mt Corp.*, 174 F.3d 1036, 1052 (9th Cir. 1999).

In the *Bazaar Del Mundo* case, the Court did hold that the Department had not used the posited trademarks as trademarks in commerce. For example, two brochures about an historic area were advanced. The asserted trademarks, Casa de Pico and Casa de Bandini, were used in the brochures but only as the names of people who had lived in the area or houses located there and not as the badge of origin for the tourism services being offered by the Department. That is a very different case to the present.

In the *Chance* case, the Court agreed with the approach taken in a prior decision, *West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122 (Fed. Cir. 1994) which the *Chance* Court considered did not indicate whether there had been actual sales of services in holding that advertisements coupled with a State trade name registration, regulatory licences and a state health report listing the trademark were sufficient to confer ownership. The Court stated that "mere advertising by itself may not establish priority of use, advertising combined with other non-sales activity is sufficient to establish use in commerce". Accordingly, the Court directed that the totality of the circumstances must be considered.²

Consistently with these authorities, in *Geniebooks.com Corporation v. William E. Merritt* WIPO Case No. [D2000-0266](#), the panelist found that there had been use of the trademark geniebooks.com even though there had been no sales of the services:

"Complainant has had business contacts with investors and secured financing for the company using the mark geniebooks.com; has incorporated under the name geniebooks.com in Washington State; has worked

² See also the extracts quoted by the Chance Court from *New West Corp. v. NYM Co. of Calif., Inc.*, 595 F.2d 1194 at 1200 (9th Cir. 1979): "a party may acquire rights in a designation which may be superior to any rights that a subsequent user may acquire in a confusingly similar term through use thereof in advertising or promotional material connected with the publicizing and/or offering for sale of goods or services, providing that this use has been of such nature and extent as to create an association of the goods or services and the mark with the user thereof."

with website and software developers using the mark geniebooks.com; and has entered into a signed agreement with Online Web Ventures to provide web hosting for geniebooks.com. There is no need for evidence of an actual sale to establish trademark rights, as long as the company is not merely trying to reserve a right in a mark. Here it is clear that geniebooks.com is not merely trying to reserve a mark, but has used and intends to continuously use the mark in the ordinary course of its trade as an electronic book publisher.”³

Although the evidence is not as clear in this case, it appears to be very a very similar situation. On one hand, there were direct engagements with the public through the Complainant’s website and other social media accounts. There were arrangements being made with investors. Indeed, “nbahoop’s” approach was predicated on such arrangements. There were arrangements being made for the provision of infrastructure. It may also be inferred that there were arrangements being made with Cardano, the developer of the “Ada” cryptocurrency.

Although the evidence is not on all fours with the *Geniebooks.com Corporation* case, the Panel’s assessment of the totality of the evidence supports a conclusion that the Complainant had adopted the trademark before the Respondent. The overall impression that emerges from the evidence is not one of the Complainant merely trying to reserve a mark but was using and intending to continuously use it in the ordinary course of commerce.

On the other hand, the Respondent’s trademark applications were filed just before the Complainant’s. They were filed at the tail end of “negotiations” with “nbahoop”. And, as the Respondent contends with respect to the Complainant’s applications, a mere application without more does not confer title to the trademark.

The Respondent’s reliance on its website may be subject to the criticism made in the *Brookfield* case which the Respondent invokes against the Complainant. Moreover, the Respondent has not provided evidence of any services that it actually provides, the number of visitors to the site or whether and, if so, how many paying customers there have been.

Furthermore, use to confer rights or legitimate interests under paragraph 4(c)(i) must be use in good faith. This precludes acts of competition contrary to honest practices in industrial or commercial matters. Article 10*bis* of the Paris Convention gives as examples of acts contrary to honest practices in industrial or commercial matters:

“(i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;

...

“(iii) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.”

In this respect, it is significant that “Sundaeswap” is a combination of ordinary words but those words, and their combination, are not descriptive of cryptocurrencies or associated services. It is significant, therefore, that the Response does not explain how the Respondent came to adopt the disputed domain names only a few days after the Complainant’s website became public.

Further, it is significant that the Response does not address at all the conduct of “nbahoop”. As noted above, “nbahoop” demonstrated that he or she was in control of at least the first disputed domain name by temporarily redirecting it to the Complainant’s website when the Complainant was pressing for evidence of his or her *bona fides*. It appears likely, therefore, that “nbahoop” was the Respondent or acting with her authority or that of Fantastic GT Supply.

³ Citation to *Walt Disney Productions v. Kusan, Inc.*, 204 U.S.P.Q. 284, 287 (1979) omitted.

“nbahoop’s” initial approach to the Complainant, indicating that he or she had received interest in the first disputed domain name from “other projects” but preferred to sell it to the Complainant, does not sit at all comfortably with the Respondent’s claim in this proceeding that it registered the disputed domain names in connection with a genuine cryptocurrency business of its own. Likewise, the initial redirection of the first disputed domain name to the Sushi.com website. As already indicated, the comparatively rudimentary nature of the Respondent’s website and the failure to provide more substantive details reinforces the questionable nature of the Respondent’s claim.

Also as recounted above, it appears that “nbahoop” was very well aware of the significance of the disputed domain names as the Complainant’s trademark. The disputed domain names were registered shortly after the Complainant announced its plans to use the trademark. He or she reminded the Complainant on several occasions of the importance and competitive advantage of a “.com” domain name. He or she also pointed out how the commercial value of the first disputed domain name would greatly increase once the Complainant’s commercial offering launched. “nbahoop’s” demand for nine *per cent* of the tokens is also far, far in excess of any likely out-of-pocket costs the Respondent may have incurred.

In these circumstances, the Panel finds that the Complainant has established a *prima facie* case that the Respondent does not have rights or a legitimate interest in the disputed domain names for the Policy.

Further, the Respondent has not rebutted that *prima facie* case by demonstrating use, or demonstrable preparations to use, the disputed domain name in connection with a good faith offering of goods and services.

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

E. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: 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.

Paragraph 4(b) identifies situations which may demonstrate that registration or use of a disputed domain name was not in bad faith under the Policy:

For the purposes of paragraph 4(a)(iii), 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 disputed] domain name in bad faith:

- (i) circumstances indicating that [the Respondent] has registered or [the Respondent has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of [the Respondent’s] documented out-of-pocket costs directly related to the [disputed] domain name; or
- (ii) [the Respondent has] registered the [disputed] 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 [the Respondent has] engaged in a pattern of such conduct; or
- (iii) [the Respondent has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line 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] web site or location.

For the reasons outlined in section 5.D. above, the Panel considers the Complainant has established a compelling case that the Respondent was well aware of the Complainant and its trademark before registering the disputed domain names and did so to take advantage of that trademark significance.

The conduct of the Respondent outlined above falls squarely within the circumstances specified in paragraph 4(b)(i) of the Policy.

Accordingly, the Complainant has established all three requirements under 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 names, <sundaeswap.com> and <sundaeswap.net> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: May 13, 2022