

ADMINISTRATIVE PANEL DECISION

Marathon Digital Holdings, Inc. v. c/o WHOISt trustee.com Limited, Registrant of marathondhstock.net / Marat Johnbull, Kinsmen ICT Solutions
Case No. D2022-1256

1. The Parties

Complainant is Marathon Digital Holdings, Inc., United States of America (“United States”), represented by Goodhue, Coleman & Owens, P.C., United States.

Respondent is c/o WHOISt trustee.com Limited, Registrant of marathondhstock.net, United Kingdom / Marat Johnbull, Kinsmen ICT Solutions, Nicaragua.

2. The Domain Name and Registrar

The disputed domain name <marathondhstock.net> (the “Domain Name”) is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 12, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on April 12, 2022, 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 April 15, 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 Respondent of the Complaint, and the proceedings commenced on April 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2022. Respondent’s informal communications were received by the Center on April 12, 2022. The Center notified Commencement of Panel Appointment Process to the Parties on May 18, 2022.

The Center appointed Marina Perraki as the sole panelist in this matter on May 31, 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

Complainant is a United States publicly traded company, active in the field of cryptocurrency mining, with a focus on the blockchain ecosystem and the generation of digital assets. The brands MARATHON DIGITAL HOLDINGS and MARATHON, are used by Complainant as service marks for services related to cryptocurrency mining and providing financial information relating to cryptocurrency. Complainant's marks have been used at least since January 2021.

Per Complaint, Marathon Digital Holdings was founded on February 23, 2010 under the name Verve Ventures, Inc. and was incorporated in the state of Nevada in the United States. On December 7, 2011, Complainant changed its name to American Strategic Minerals Corporation. In October 2012, Complainant changed its name to Marathon Patent Group, Inc. and began managing and licensing intellectual property. On November 1, 2017, Complainant entered into a merger agreement with a third party, focusing on mining digital assets. Complainant has since purchased cryptocurrency mining machines and established a data center in Canada to mine digital assets. Complainant revealed in October 2020 that it had formed a "joint venture" with a third company to provide electricity to Complainant's new Hardin, Montana data center on a long-term basis. Complainant was registered as a corporation in Nevada on February 12, 2021 as a subsidiary to Marathon Patent Group. On February 27, 2021, Marathon Digital Holdings and Marathon Patent Group merged, with Marathon Patent Group surviving the merger and the company name changed to Marathon Digital Holdings. Prior to the merger and the incorporation of Marathon Digital Holdings, Marathon Patent Group was involved in cryptocurrency mining. The change of name from Marathon Patent Group to Marathon Digital Holdings along with Marathon Digital Holdings' offering of cryptocurrency mining services was presented in Complainant's own websites and social media accounts as well as in the news. Complainant is known for using the "dh" abbreviation of the digital holdings portion of their mark and its twitter handle is Marathon Digital Holdings (@marathonDH).

Complainant is the owner of the following trademark applications/registrations for MARATHON and MARATHON DIGITAL HOLDINGS:

- United States trademark application No. 90466678, MARATHON DIGITAL HOLDINGS (word), filed on January 14, 2021, for services in international classes 36 and 42, disclaiming the words "digital holdings";
- United States trademark application No. 90503821, MARATHON (word), filed on February 2, 2021, for services in international classes 36 and 42; and
- International trademark registration No. 1611535, MARATHON DIGITAL HOLDINGS (word), registered on July 1, 2021, for services in international classes 36 and 42, designating *inter alia* the European Union and the United Kingdom.

Complainant is also the owner of the domain name <marathondh.com>, registered on October 29, 2020.

The Domain Name was registered on January 6, 2022. At the time of filing of the Complaint, it was used to host a website mimicking the official website of Complainant, reproducing Complainant's trademarks, company name, and corporate address and purportedly offering the same services as Complainant (the Website). The Website referenced Complainant's proprietary data center in Hardin, Montana and advertised a white paper which copied Complainant's investor presentation. The Website also stated "Marathon Digital Holdings Company is a digital asset technology company that mines cryptocurrencies, with a focus on the blockchain ecosystem and the generation of digital assets. We currently operate our proprietary Data Center in Hardin MT with a maximum power capacity." Furthermore, the how it works section on the mining page of the Website was an exact replica of the how it works page on Complainant's webpage. The Website invited

consumers to invest, mentioning “pick the investment plan that fits your best goals, and you are ready to go! You can change it any time” with a wording similar to Complainant’s website.

The Domain Name currently leads to an inactive webpage.

5. Parties’ Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not submit a formal response. On April 12, 2022, Respondent sent an email to the Center confirming that the Website and all its content would be taken down. On April 12, 2022, it then sent a second email to the Center indicating that the Domain Name would be cancelled within 24 hours.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements that 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 Domain Name incorporates the main and characteristic part of Complainant’s MARATHON DIGITAL HOLDINGS marks, namely the word “marathon”. This is sufficient to establish confusing similarity (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7).

The addition of the letters “dh”, short for Digital Holdings, and the word “stock” do not alter the above as the trademark of Complainant remains clearly recognizable ([WIPO Overview 3.0](#), section 1.7).

The generic Top-Level Domain (“gTLD”) “.net” is disregarded, as gTLDs typically do not form part of the comparison as they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); and *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#)).

The Panel finds that the Domain Name is confusingly similar to the MARATHON DIGITAL HOLDINGS mark of Complainant.

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

B. Rights or Legitimate Interests

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

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

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complainant, Respondent was not authorized to register the Domain Name.

Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name is used to host the Website to impersonate Complainant and attempt to mislead Internet users into thinking that the services purportedly offered on the Website originate from Complainant. Such use demonstrates neither a *bona fide* offering of goods or services nor a legitimate interest of Respondent (*Arkema France v. Aaron Blaine*, WIPO Case No. [D2015-0502](#)).

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

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

C. Registered and Used in Bad Faith

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

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

location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith.

Because the MARATHON and MARATHON DIGITAL HOLDINGS marks had been used and registered by Complainant before the Domain Name registration, the Panel finds it more likely than not that Respondent had Complainant's marks in mind when registering the Domain Name (*Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, WIPO Case No. [D2014-1754](#); and *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)).

Respondent should have known about Complainant's rights, as such knowledge is readily obtainable through a simple browser search (see *Caesars World, Inc. v. Forum LLC*, WIPO Case No. [D2005-0517](#); and *Compart AG v. Compart.com / Vertical Axis, Inc.*, WIPO Case No. [D2009-0462](#)).

Furthermore, Respondent could have conducted a trademark search and would have found Complainant's prior registrations in respect of MARATHON and MARATHON DIGITAL HOLDINGS (*Citrix Online LLC v. Ramalinga Reddy Sanikommu Venkata*, WIPO Case No. [D2012-1338](#)).

Lastly, the content of the Website gives the impression that it originates from Complainant, eminently displaying its logo and a company name, as well as company information and extracts from its own official website, thereby giving the false impression that the Website emanates from Complainant. This further supports registration in bad faith reinforcing the likelihood of confusion with Complainant's trademarks and business, as Internet users are likely to consider the Domain Name as in some way endorsed by or connected with Complainant ([WIPO Overview 3.0](#), section 3.1.4 and 3.2.1).

The above further removes any doubt that Respondent knew of Complainant and chose the Domain Name with knowledge of Complainant and its industry (*Safepay Malta Limited v. ICS Inc*, WIPO Case No. [D2015-0403](#)).

As regards bad faith use, Complainant demonstrated that the Domain Name was employed to host a Website, which appeared falsely to be that of Complainant.

The Panel considers the following factors:

- (i) the fact that the Domain Name used to lead to the Website impersonating Complainant, inviting Internet users to invest through it;
- (ii) the failure of Respondent to submit a formal response;
- (iii) the fact that Respondent confirmed to the Center that it would take down the Website and its content and cancel the Domain Name; and
- (iv) the fact that the Domain Name was initially registered with a privacy service to hide Respondent's identity.

The Domain Name currently leads to an inactive website. The non-use of a domain name would not prevent a finding of bad faith (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); [WIPO Overview 3.0](#), section 3.3).

Under these circumstances and on this record, the Panel finds that Respondent has registered and used the Domain Name in bad faith.

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, <marathondhstock.net>, be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: June 14, 2022