

ADMINISTRATIVE PANEL DECISION

BlockFi Inc. v. Jose nick
Case No. D2023-0929

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 Jose nick, Brazil.

2. The Domain Name and Registrar

The disputed domain name <wiv-blockfi.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 2, 2023. On March 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 2, 2023, 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 (Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 3, 2023, 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 8, 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 the Respondent of the Complaint, and the proceedings commenced on March 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 30, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on April 6, 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, a financial services company founded in 2017, operates a financial services trading platform focusing on cryptocurrencies under the trademark BLOCKFI. The Complainant's platform manages more than USD 2 billion in assets and is backed by industry-leading investors.

The Complainant is also active on social media platforms, including on Twitter, Facebook, and YouTube, where it posts numerous videos and podcasts on block chain technology, cryptocurrency, and wealth management.

The Complainant owns a trademark registration for BLOCKFI in the United States since 2020, with a registration date of February 18, 2020, and a first use in commerce date of January 2, 2018 (registration No. 5989814). The Complainant also owns the domain name <blockfi.com> (registered on September 27, 2015) redirecting to the Complainant's official website at "www.blockfi.com".

The disputed domain name was registered on September 26, 2022, and does not currently resolve to an active page. As per the uncontested evidence submitted with the Complaint, the disputed domain name previously resolved to a website that mimicked the look of a login portal to the Complainant's services by reproducing the Complainant's stylized logo



To log in, users were requested to enter their email and password.

5. Parties' Contentions

A. Complainant

The Complainant submits and contends that:

- (a) It owns valid and enforceable trademark rights in the BLOCKFI mark which is a coin term created and used exclusively by the Complainant, and which enjoys recognition in its field of financial services.
- (b) The disputed domain name is confusingly similar to the Complainant's registered trademark. The addition of the generic (or possibly meaningless) term "wiv-" does not prevent a finding of confusing similarity.
- (c) The Respondent has no rights nor any legitimate interests in respect of the disputed domain name since: (i) the Complainant has no relationship with the Respondent, (ii) the Respondent is not commonly known by the disputed domain name, and (iii) the Respondent's use of the disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. The Respondent's demonstrated purpose and use of the disputed domain name was to confuse the public into believing that the disputed domain name was associated with the Complainant's in order to benefit from this confusion, and to improperly collect users' personal and financial information as part of a phishing scheme.

Current non-use of the disputed domain name does not preclude a finding that the Respondent lacks any rights or legitimate interests in the disputed domain name.

- (d) The Respondent has registered and is using the disputed domain name in bad faith to disrupt the Complainant's business by using it to impersonate the Complainant for commercial gain, as part of a phishing scheme. The fact that the disputed domain name previously resolved to a website that mimicked the look of a login portal to the Complainant's services by reproducing the Complainant's logo, indicates that the Respondent was well aware of the Complainant's trademark when registering

the disputed domain name. The fact that the Respondent's website is no longer active is of no moment, because it could be revived at any time by the Respondent. As such it represents a continuing use of the disputed domain name in bad faith.

Based on the above the Complainant requests the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove 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;
- (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 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark BLOCKFI based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant's trademark BLOCKFI with addition of the term "wiv-", followed by the generic Top-Level Domain ("gTLD") ".com".

As highlighted in section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the addition of the generic gTLD such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*, "wiv-blockfi".

As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The disputed domain name entirely incorporates the Complainant's mark BLOCKFI and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that disputed domain name is confusingly similar to a mark in which the Complainant has rights. Therefore, the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

(i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;

(ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;

(iii) it 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 Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) the Complainant holds prior rights in the registered and well-known BLOCKFI mark, (b) the Respondent has not been authorized to use the Complainant's mark in any way and is not commonly known by the disputed domain name, and (c) the Respondent cannot demonstrate any legitimate noncommercial or fair use of the disputed domain. In this connection, the Complainant has provided evidence that the disputed domain name does not currently resolve to an active website, but previously pointed to a webpage that mimicked the look of a login portal to the Complainant's services by reproducing the Complainant's logo.

Given the confusing similarity of the disputed domain name to the Complainant's trademark and the absence of any relationship between the Respondent and the Complainant, such a use of the disputed domain name is neither a *bona fide* use nor a legitimate noncommercial or fair use of the disputed domain name.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain names under paragraph 4(c) of the Policy. There is no indication before the Panel of any activity in relation to the disputed domain name that would give rise to rights or legitimate interests to the Respondent.

Therefore, the Panel finds that the Complainant has established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, which

includes: “(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location”.

The disputed domain name fully incorporates the BLOCKFI mark. As per the uncontested evidence submitted with the Complaint, the disputed domain name previously resolved to a website that mimicked the look of a login portal to the Complainant’s services by reproducing the Complainant’s BLOCKFI trademark and logo. This indicates that the Respondent targeted the Complainant’s trademark when registering the disputed domain name, with the deliberate intent to confuse the public into believing that the disputed domain name was associated with the Complainant in order to benefit from the reputation of the Complainant’s trademark and to attract for commercial gain internet users. Use of the disputed domain name by the Respondent to pretend that it is the Complainant or someone acting under the Complainant’s authority was clearly intended to divert internet users and to encourage them to provide their personal information, thereby disrupting the Complainant’s business.

All the above supports a finding of bad faith registration and use of the disputed domain name.

The fact that the disputed domain name does not currently resolve to an active website does not affect the above conclusions. It is an established principle that the lack of active use of a domain name does not as such prevent a finding of bad faith. As stressed by many previous UDRP decisions, “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include, amongst others: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the implausibility of any good faith use to which the domain name may be put.” (See section 3.3 of the [WIPO Overview 3.0](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Each of these considerations points to the Respondent’s passive holding of the disputed domain name being in bad faith. Specifically: (i) the Complainant’s trademark is distinctive and well-established, (ii) the Respondent has failed to submit a response to the Complaint or provide any evidence of good-faith use, (iii) there is no conceivable good faith use to which the disputed domain name could be put by the Respondent, and (iv) it appears the Respondent not only provided false contact information, in light of the courier’s inability to send the Center’s written communication, but it also appears that the Respondent may have engaged in the use of a privacy service, seeing as the previously named Respondent was “Privacy service provided by Withheld for Privacy ehf”, to which the Center’s written communication was also unable to be delivered – the courier reporting that the related contact details were a “bad address”.

Based on the above considerations, the Panel concludes in these circumstances that the requirement of paragraph 4(a)(iii) of the Policy is also satisfied.

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, <wiv-blockfi.com>, be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: April 19, 2023