

ADMINISTRATIVE PANEL DECISION

SundaeSwap Labs, Inc. v. Barbara Russell, Lorie Williams and Ulysses

Thomas

Case No. D2024-1151

1. The Parties

Complainant is SundaeSwap Labs, Inc., United States of America (“United States” or “U.S.”), represented by Neal & McDevitt, LLC, United States.

Respondents are Barbara Russell, United States, Lorie Williams, United States, and Ulysses Thomas, United States.

2. The Domain Names and Registrar

The disputed domain names <sundaelabs.online>, <sundaelabs.org>, <sundaelabs.site> (each a “Disputed Domain Name and collectively, the “Disputed Domain Names”) are registered with Nicenic International Group Co., Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 15, 2024. On March 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On March 18, 2024, the Registrar transmitted by email to the Center its verification response confirming that Respondents are listed as the registrants and providing additional contact details.

The Center sent an email communication to Complainant on March 22, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting Complainant to either file separate complaints for the Disputed Domain Names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all of the Disputed Domain Names are under common control. Complainant filed an amended Complaint on March 30, 2024.

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 Respondents of the Complaint, and the proceedings commenced on April 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 23, 2024. None of the Respondents submitted any response. Accordingly, the Center notified Respondents' default on April 25, 2024.

The Center appointed Scott R. Austin as the sole panelist in this matter on May 10, 2024. 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

Without contest by Respondents, Complainant asserts in its Complaint as amended, and its attached Annexes provide evidence sufficient to support that:

Complainant is a Wyoming corporation formed in May 2021 and headquartered in Greenbrae, California, United States. Complainant provides a variety of cryptocurrency-related services, primarily through an app that enables users to trade Cardano-based assets, earn fees and rewards by providing liquidity, and track progress through a decentralized portfolio view under the unregistered trademarks SUNDAESWAP and within the "past few months" prior to the filing of its complaint on March 15, 2024, SUNDAE (collectively, the "SUNDAESWAP Marks") for which Complainant claims common law trademark rights based on use in commerce and widespread marketplace recognition.

Complainant began operations and announced itself to the marketplace through a number of public channels in the spring of 2021. Complainant announced a "DEX" or decentralized exchange for cryptocurrency trading and related transactions, registering its official domain name <sundae.fi> on November 5, 2021. On April 12, 2021, it first posted from its X (then Twitter) account (@SundaeSwap), tweeting that "SundaeSwap [is] going live very soon!". On April 13, 2021, a subreddit committed to the topic of the SundaeSwap platform was launched and quickly gained popularity, having now more than 33,000 followers. Complainant's DEX trading application went live on its official website and trading and related services commenced on January 20, 2022.

Complainant asserts it has common law rights in the SUNDAE and SUNDAESWAP marks because it has used these marks extensively which has resulted in widespread exposure of the SUNDAESWAP Marks to the users and potential users of Complainant's cryptocurrency-related services. In support of its claimed public recognition, Complainant has submitted its followings on various platforms related to its cryptocurrency services, as well as press and media coverage, including:

Complainant's X (formerly Twitter) account prominently featuring the SUNDAESWAP mark, launched in April 2021, has amassed more than 262,000 followers;

A Discord server committed to the discussion of SundaeSwap prominently featuring the SUNDAESWAP mark has more than 56,000 members;

The SundaeSwap subreddit on Reddit prominently featuring the SUNDAESWAP mark has more than 33,000 members and many of the posts have hundreds of upvotes and dozens of comments; and

The development and launch of Complainant's services under the SUNDAESWAP mark has been covered by many press and media outlets including feature articles in Newsweek, Forbes, Markets Insider and Coindesk.

Complainant also submits as evidence in support of its unregistered trademark rights reference to three pending applications for U.S. Trademark Registration by which Complainant has sought to register its rights in the SUNDAESWAP mark with the United States Patent and Trademark Office ("USPTO"): Application Serial Nos. 90878036, 90878057 and 90878068, each filed August 11, 2021 in International Classes 9, 36

and 42, respectively, alleging dates of first use in commerce of the mark of April 1, 2021. The Panel's independent research conducted pursuant to paragraphs 10 and 12 of the Rules has shown that all three cited trademark applications are currently suspended.

Complainant also contends that the above facts regarding recognition of the SUNDAESWAP Marks are enhanced in support of sustaining common law trademark rights due to the relatively accelerated period of time in which they achieved such recognition. Complainant shows that "The SUNDAESWAP brand became enormously popular in a relatively short period (hundreds of thousands of enthusiasts in less than a year's time" and references a prior UDRP panel decision in which common law trademark rights were sustained for other brands in the presence of "relatively rapid recognition", where the platform featuring the mark had quickly become popular – it had gained thousands of daily visitors within a year of its launch.

Complainant also submits decisions by five prior UDRP panels finding in favor of Complainant's claim of common law trademark rights in the SUNDAESWAP mark.

The SUNDAE mark also remains the distinctive element of Complainant's official domain name, <sundae.fi>, used to access the official SUNDAESWAP Marks website ("Official SUNDAESWAP Website"), launched in November 2021 to provide information about Complainant and access to its services, prominently displaying the SUNDAESWAP mark and more recently the SUNDAE mark.

Respondents registered the Disputed Domain Names <sundaelabs.org>, <sundaelabs.online>, and <sundaelabs.site>, respectively, on January 9, 2024, January 17, 2024, and February 2, 2024. As of the filing of the Complaint, two of the Disputed Domain Names <sundaelabs.online> and <sundaelabs.site> resolved to a "copycat" website identical to Complainant's Official SUNDAESWAP Website. Complainant also claims that the Disputed Domain Name <sundaelabs.org>, currently inactive, redirected to the copycat website accessed through the <sundaelabs.site> Disputed Domain Name.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Names. Complainant contends that the Disputed Domain Names are identical or confusingly similar to Complainant's trademark; that Respondent has no rights or legitimate interests in respect of each Disputed Domain Name; and that each Disputed Domain Name was registered and is being used in bad faith.

B. Respondents

Respondents did not reply to Complainant's contentions.

6. Discussion and Findings

6.1 Procedural Issue

Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. Complainant requests the consolidation of Respondents pursuant to paragraph 10(e) of the Rules.

Respondents did not comment on Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing Complainant's request, the Panel will consider whether (i) the Disputed Domain Names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that all three Disputed Domain Names are registered with the same Registrar within a short period of time of each other in January and February 2024, at least two of them resolved to websites that displayed the same copycat version of Complainant's website; and the physical address information for all three Disputed Domain Names appears to be false and located in the same country.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides it is appropriate to consolidate in a single proceeding the disputes regarding the nominally different disputed domain name registrants (referred to below collectively as "Respondent").

6.2 Substantive Issues

Paragraph 15(a) 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 Complainant to make out its case and it is apparent from the terms of the Policy that 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 a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. [WIPO Overview 3.0](#), section 4.2.

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

- (i) the Disputed Domain Names are 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 Disputed Domain Names; and
- (iii) the Disputed Domain Names have been registered and are being used in bad faith.

The Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

A. Identical or Confusingly Similar

To prove this element, Complainant must first establish that there is a trademark or service mark in which it has rights. Ownership of a nationally or regionally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of standing under paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant's evidence submitted in support of unregistered trademarks rights in the SUNDAESWAP Marks includes reference to three pending applications for U.S. Trademark Registration by which Complainant has sought to register its rights in the SUNDAESWAP mark with the USPTO.

The Complainant's pending applications for U.S. trademark registration submitted in support of its burden under the first element do not carry the day. First, Complainant's pending applications do not establish any enforceable rights until registration issues. Second, the Panel's review of each application finds each is currently suspended by the USPTO based on Office Actions showing a conflicting registration.

However, based on the remaining evidence presented supporting the facts set forth in Section 4 above and in light of the unique industry in which Complainant operates, the Panel need not rely on the referenced applications to find Complainant has met its burden showing the SUNDAESWAP Marks have acquired distinctiveness. Based on the evidence of use and promotion especially given the unique context of "relatively rapid recognition" that UDRP panels have found to support trademark rights, even in the absence of a trademark registration, as well as the careful considerations made in the analyses of Complainant's use and promotion evidence by prior UDRP panels who recognized Complainant's common law trademark rights this Panel concurs and finds Complainant has common law rights in the SUNDAESWAP mark. See *Andrey Ternovskiy dba Chatroulette v. Envient*, WIPO Case No. [D2018-2240](#); see also *SundaeSwap Labs, Inc. v. solana art*, WIPO Case No. [D2022-0231](#) (transfer of <sundaeswap.tech>). Moreover, the fact that at least two of the Disputed Domain Names have been used to target Complainant, supports Complainant's assertion that its mark has achieved significance as a source identifier. See [WIPO Overview 3.0](#), Section 1.3.

With Complainant's rights in the SUNDAESWAP mark established, the remaining question under the first element of the Policy is whether each of the Disputed Domain Names is identical or confusingly similar to Complainant's SUNDAESWAP mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name".

[WIPO Overview 3.0](#), section 1.7. However, as prior UDRP panels have found, in some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain name to ascertain confusing similarity. See *Id.*

Most importantly, [WIPO Overview 3.0](#) states "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". The Panel finds that the dominant feature of Complainant's SUNDAESWAP mark, "sundae" is recognizable in each of the Disputed Domain Names, which also constitutes the entirety of Complainant's SUNDAE mark, and each Disputed Domain Name, therefore, is confusingly similar to the SUNDAESWAP mark for purposes of meeting Complainant's burden under the first element of the Policy. See, 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](#).

[WIPO Overview 3.0](#), section 1.8 further provides: "Where the relevant trademark 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." While the addition of the term here, "labs", a term identical to the second formative in Complainant's corporate name, SundaeSwap Labs, Inc., may bear on assessment of the second and third elements, the Panel finds the addition of such term within each respective Disputed Domain Name does not prevent a finding of confusing similarity between the Disputed Domain Names and Complainant's mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. See *Advance Magazine Publishers Inc. v. Arena International Inc.*, WIPO Case No. [D2011-0203](#).

Prior UDRP panels have also found the Top-Level Domains, such as ".online", ".org", and ".site", being viewed as a standard registration requirement, may typically be disregarded under the first element analysis. See [WIPO Overview 3.0](#), section 1.11.1; see also *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#); *L'Oréal v. Tina Smith*, WIPO Case No. [D2013-0820](#).

The Panel finds the dominant feature of Complainant's SUNDAESWAP mark is recognizable within each of the Disputed Domain Names. Accordingly, all three of the Disputed Domain Names are confusingly similar to the SUNDAESWAP mark for the purposes of the Policy.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which a respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1. See also *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

Having reviewed the available record, the Panel finds Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in each of the Disputed Domain Names. Complainant contends that none of the circumstances provided in paragraph 4(c) of the Policy for demonstrating Respondent's rights to and legitimate interests in a domain name are present in this case. Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Names such as those enumerated in the Policy or otherwise.

First, Complainant asserts that it has no commercial relationship with Respondent, who is not sponsored by or affiliated with Complainant in any way, nor has Complainant given Respondent authority or license to register or use the Disputed Domain Names. Prior UDRP panels have held "in the absence of any license or permission from Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed". *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#).

Second, Complainant contends no Respondent is commonly known by any of the Disputed Domain Names, which evinces a lack of rights or legitimate interests under paragraph 4(c)(ii) of the Policy. The Registrar's registrant data submitted to the Center for each of the corresponding Disputed Domain Names, identified "Barbara Russell" as registrant/registrant organization for the Disputed Domain Name <sundaelabs.org>; "Ulysses Thomas" as registrant/registrant organization for the Disputed Domain Name <sundaelabs.site>; and "Lorie Williams" as registrant/registrant organization for the Disputed Domain Name <sundaelabs.online>. Prior UDRP panels have held where no evidence, including the Whois record for the disputed domain name, suggests that Respondent is commonly known by the disputed domain name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the disputed domain name within the meaning of the Policy paragraph 4(c)(ii). See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#).

Most importantly, Complainant contends Respondent is not using the Disputed Domain Names in connection with a bona fide offering of goods or services because, as Complainant's Annex evidence shows, the web pages connected to two of the Disputed Domain Names resolve to a carefully crafted "copycat" version of Complainant's Official SUNDAESWAP Website to create a false association with Complainant.

Panels have held that the use of a domain name for illegal activity, as applicable to this case: impersonation/passing off, or other types of fraud through Respondent's potential phishing can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel notes that evidence submitted in the Annexes to the Complaint persuasively supports Complainant's argument because it shows Respondent websites at Disputed Domain Names <sundaelabs.online> and <sundaelabs.site> prominently feature unauthorized use of Complainant's SUNDAESWAP mark for the sale of ostensibly competing cryptocurrency related services to create the false impression that products for sale at each of these Respondent websites are authorized or affiliated with Complainant but also may be used as a phishing scheme to unlawfully extract financial and personal information from unsuspecting consumers believing Respondent to be Complainant. Respondent, therefore, is using the Disputed Domain Names <sundaelabs.online> and <sundaelabs.site> to confuse Internet users and suggest an affiliation with or sponsorship by Complainant to attract Internet users to websites associated with these Disputed Domain Names for its commercial gain. Complainant also claims that the Disputed Domain Name <sundaelabs.org>, currently inactive, redirected to the copycat website accessed through the <sundaelabs.site> Disputed Domain Name. Based on these facts the Panel finds Respondent's actions are clearly not legitimate and clearly are misleading. Respondent, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy. See *Six Continents Hotels v. "m on"*, WIPO Case No. [D2012-2525](#).

According to the [WIPO Overview 3.0](#), section 2.5.1, where a domain name consists of the complainant's trademark and certain additional terms, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the complainant.

Having reviewed the record, the Panel finds Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the Disputed Domain Names. Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Names such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established for each of the Disputed Domain Names.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may also be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Complainant contends that Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business by configuring and registering each of the Disputed Domain Names that incorporates the dominant portion of its SUNDAESWAP mark and its SUNDAE mark in its entirety with the addition of the term "labs", the term identical to the second term in Complainant's corporate name. Respondent has thereby configured three domain names for registration that are each confusingly similar to Complainant's trademark, as well as its official domain name <sundae.fi>. Prior UDRP panels have found a domain name was registered in bad faith where the respondent registered the domain name for the purpose of intentionally attempting to impersonate or mislead in order to commit fraud. See, e.g., *Houghton Mifflin Co. v. The Weatherman Inc.*, WIPO Case No. [D2001-0211](#); *Marlink SA v. Sam Hen, Elegant Team*, WIPO Case No. [D2019-1215](#); *Beam Suntory Inc. v. Name Redacted*, WIPO Case No. [D2018-2861](#).

The Disputed Domain Names incorporate the dominant portion of Complainant's SUNDAESWAP mark and its SUNDAE mark in its entirety, with the additional common term taken from its corporate name here. Therefore, the Disputed Domain Names can only sensibly refer to Complainant; thus, there is no obvious possible justification for Respondent's selection of the Disputed Domain Names other than registration in bad faith.

As discussed in greater detail in Section 6B above, Complainant shows in evidence in the Annexes to its Complaint that Respondent used two of the Disputed Domain Names to link to a copycat website to impersonate Complainant which constitutes evidence of bad faith use. See [WIPO Overview 3.0](#), section 3.4. Complainant also claims that the Disputed Domain Name <sundaelabs.org>, currently inactive, redirected to the copycat website accessed through the <sundaelabs.site> Disputed Domain Name.

Having reviewed the record, the Panel finds Respondent's registration and use of the Disputed Domain Names constitutes bad faith registration and use under the Policy. The Panel finds that the evidence presented here, including Respondent's two respective copycat websites selling unauthorized versions of Complainant's cryptocurrency services under its SUNDAE mark on the respective copycat websites to pass itself off as affiliated with Complainant, as well as further the risk of a fraudulent phishing scheme is sufficient for this Panel to find bad faith registration and use of all three of the Disputed Domain Names. See [WIPO Overview 3.0](#), section 3.4; see also *On AG, On Clouds GmbH v. Web Commerce Communications Limited, Domain Admin, Whoisprotection.cc / Christin Schmidt, Sandra Naumann, Jana Papst*, WIPO Case No. [D2021-2263](#).

The Panel finds the third element of the Policy has been established.

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 <sundaelabs.online>, <sundaelabs.org>, and <sundaelabs.site> be transferred to the Complainant.

/Scott R. Austin/
Scott R. Austin
Sole Panelist
Date: June 9, 2024