Decision for dispute CAC-UDRP-100722

Case number	CAC-UDRP-100722
Time of filing	2013-12-12 16:26:17
Domain names	danskespilbonus.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Danske Spil A/S

Complainant representative

Organization	Zeusmark Consulting Group, Ms. Anne-Louise B. Andersen

Respondent

Name	Marthese French

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any such pending or determined proceedings.

IDENTIFICATION OF RIGHTS

The Complainant owns a registered Danish national trade mark No. T80901618DK00, being the word mark 'DANSKE SPIL' (which translates as Danish Game) registered in 2012 based on an application made in 2009.

The Complainant has used the name in trade since 2002 and in 2012 the Danish Supreme Court in case No. 28872009 and 289/2009 made a finding that the Complainant had unregistered rights to the name and mark 'DANSKE SPIL' as of 2008.

The name and mark are well known marks in Denmark.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a Danish gaming company based in Denmark. The Danish Parliament founded the company in 1948. In 2002 the company changed its name from Dansk Tipstjeneste A/S to Danske Spil A/S. From 1948 up till January 2012 the Complainant had a monopoly on providing gaming in Denmark and even after a partial liberalization in January 2012, it retained its 65-year-old monopoly on some games such as LOTTO and bingo. Since 1948 the Complainant has marketed an

increasing number of games and today the Complainant's gaming business includes all types of betting and lottery games distributed through authorized agents and online via the Complainants official website danskespil.dk.

The Complainant’s company name, DANSKE SPIL is a registered word and device trade mark in Denmark.
The Complainant´s trade mark is well-known and this has been confirmed in a previous WIPO decision, see e.g Danske Spil A/S v. Peter Joergensen, WIPO Case no. D2011-0298. A Supreme Court decision (Case 28872009 and 289/2009) found that the Complainant had established an unregistered right to the trade mark and company name “DANSKE SPIL” in May 2008. Furthermore, the Complainant holds a large number of domain names containing the DANSKE SPIL trade mark including danske- -spil.com, danske-spil.co, danske-spil.org and danskespil.co.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

The Complainant's case is as follows:

A: The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1)):

The disputed domain name is confusingly similar to the trade mark DANSKE SPIL, in which the Complainant has rights. The domain name fully incorporates the Complainants registered trade mark and company name DANSKE SPIL and the only difference between the disputed domain name and the Complainant´s trade mark is the addition of the generic word “bonus.” The addition of this generic word “bonus” is not sufficient to differentiate the disputed domain name from the Complainant´s well-know trade mark, on the contrary it increases the likelihood of confusion because the word “bonus” refers to a type of common activity which is known in the gaming industry. See e.g., IM Production v. Delao Dkeo, WIPO Case No. D2013-1735. Furthermore, the Complainant asserts that it is an established and recognized principle under the UDRP that the presence of the .com top level designation is irrelevant in the comparison of a domain name to a trade mark.

B: The Respondent has no rights or legitimate interests in respect of the domain name;
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

The Respondent has not received any license or consent, express or implied, to use the Complainant´s trade mark DANSKE SPIL in a domain name or in any other manner from the Complainant, nor has the Complainant agreed in any way to such use or application by the Respondent. At no time did the Respondent have authorization from the Complainant to register the disputed domain name. Further, the Respondent has no legitimate right in the contested domain name danskespilbonus.com. Firstly, the Respondent did not use the domain name as a trademark, company name, business or trade name prior to the registration of the disputed domain name, nor is the Respondent otherwise commonly known in reference to the name. The domain danskespilbonus.com is currently inactive but the evidence shows that in the beginning of February 2011, the disputed domain name was parked with GoDaddy.com. Since it is now inactive, clearly the Respondent does not use the disputed domain name in connection with a bona fide offering of goods and services. In conclusion the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C: The domain name was registered and is being used in bad faith.
(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

The Complainant’s company name and trademark DANSKE SPIL was used 8 years before the Respondent’s registration of

the disputed domain name and due to the fact that the Complainant and the Complainant´s trade mark is well-known, it is inconceivable that the Respondent registered the domain name without prior knowledge of the existence of the Complainant and its trade mark. The Respondent´s registration of the domain name danskespilbonus.com prevents the Complainant from registering the domain name and using the well-known company name and trade mark DANSKE SPIL in the domain name in connection with the Complainants gaming business.

As to bad faith use, currently the domain name in question is inactive and the Respondent has been passively holding the domain name danskespilbonus.com for more than two years and the disputed domain name is therefore used in bad faith. Furthermore, the Complainant alleges that the Respondent previously intentionally attempted to attract Internet users to the Respondent´s website by creating a likelihood of confusion with the Complainant´s trade mark. The Respondent acted in order to generate traffic to enable the Respondent to sell the disputed domain name the Complainant.

In summary, the disputed domain name, danskespilbonus.com, is confusingly similar to the Complainant's well-known name and trade mark DANSKE SPIL, that the Respondent has no rights or legitimate interests and finally that the domain name was registered and is being used in bad faith in accordance with paragraph 4(a).

Additionally it should be stated that the Complainant has had the following domain names transferred to the Complainant: danskespil.org (Case No. D2010-0087), danskespil.info (Case No. D2011-0298), danskespil.net (Case No. D2011-0299) and danskespil.com (Case No. D2011-0300).

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

There is an obvious issue here as the mark and the disputed domain name are comprised of common descriptive words. Third parties can have legitimate interests in the use of such words.

Although the Respondent has not come forward, the burden of proof rests with the Complainant, which is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such a prima facie case is made out, the burden of production shifts to the Respondent. However a panel weighs all the evidence, with the burden of proof always remaining on the Complainant.

The form and manner of use of the disputed domain name is often determinative in these cases. Here the use is not connected to the descriptive meaning of the words. Further, the use appears at an earlier point to have been commercial when revenue was earned from traffic to the parking page provided.

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision. In particular, we note that the email notification of the Complaint sent to web@forsaleinmalta.com was relayed although the email to postmaster was undelivered. However the evidence shows that the Respondent accessed the online platform repeatedly on 17 December 2013. We are satisfied that the Complainant had proper notice.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name was registered in 2010. The Panel accepts the finding of the Danish Supreme Court that the Complainant had an unregistered right in the marks in 2008. It also accepts that given its unique role and monopoly in Danish gaming since 1948, the marks are well known marks in Denmark. The generic but related word 'bonus' does not alter the fact of confusing similarity. While the mark is highly descriptive, it would not have been registered unless it indicated a trade source and acquired distinctiveness. The Respondent's use in 2011 appears to have been a commercial one and the Panel finds that both the registration and use of the disputed domain name were in bad faith in all of the circumstances.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **DANSKESPILBONUS.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2014-01-10

Publish the Decision