Decision for dispute CAC-UDRP-100723

Case number	CAC-UDRP-100723
Time of filing	2013-12-13 16:11:40
Domain names	danskespilonline.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	David Mor

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has registered trade mark rights in "DANKES SPIL" in Denmark, including, but not limited to, the following:

Danish (figurative) Trade Mark No. VR 2001 00116, registered on 2001-01-05, for goods and services in classes 09, 16, 28, 35, 36, 41, 42, 43;

Danish (figurative) Trade Mark No. VR 2006 01391, registered on 2006-04-19, for goods and services in classes 16, 36, 41;

Danish (figurative) Trade Mark No. VR 2006 01392, registered on 2006-04-19, for goods and services in classes 16, 36, 41;

Danish (figurative) Trade mark No. VR 2006 01393, registered on 2006-04-19, for goods and services in classes 16, 36, 41;

Danish (word) Trade Mark No. VR 2012 01590, registered on 2012-06-25, for goods and services in classes 16, 36, 41.

FACTUAL BACKGROUND

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

The Complainant is a Danish gaming company based in Denmark, founded by the Danish Parliament in 1948. In 2002 the Complainant changed its company name from Dansk Tipstjeneste A/S to the current name Danske Spil A/S. Since its inception in 1948 and until January 2012, the Complainant had a monopoly over the gambling market in Denmark. Following the partial gaming liberalization in January 2012, the Complainant retained its 65-year-old monopoly over a number of games, such as LOTTO and bingo. Currently, the Complainant's gaming business includes all types of betting and lottery games distributed through authorized agents and online via the Complainant's official website www.danskespil.dk.

The Complainant’s company name, DANSKE SPIL, is also a registered word and device trade mark in Denmark (as described in the section above).

The Complainant's trade mark is well-known and this has been confirmed in prior WIPO decisions (e.g Danske Spil A/S v. Peter Joergensen, WIPO Case No. D2011-0298). In addition, in May 2008 a Supreme Court decision (Case 28872009 and 289/2009) found that the Complainant had established unregistered rights in the trade mark and company name “DANSKE SPIL”.

The Complainant holds a large number of domain names containing the DANSKE SPIL trade mark including but not limited to <danske--spil.com>, <danske-spil.co>, <danske-spil.org>, <danskespil.co> and <danskespilonline.dk>.

The Complainant has also obtained the transfer of the following domain names in prior UDRP proceedings: <danskespil.org> (WIPO Case No. D2010-0087), <danskespil.info> (WIPO Case No. D2011-0298), <danskespil.net> (WIPO Case No.D2011-0299) and <danskespil.com> (WIPO Case No. D2011-0300).

The disputed domain name <danskespilonline.com> (the Domain Name) was registered on 26 January 2012. It was suspended for an undetermined period of time and, at the time of filing of the Complaint, resolved to a parking website containing commercial links.

The Respondent is a resident of Tel Aviv, Israel. No further details are known about the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainants contends that:

(i) The Domain Name is confusingly similar to the Complainant's trade mark DANSKE SPIL

The Complainant asserts that the Domain Name is confusingly similar to the trade mark DANSKE SPIL, in which the Complainant holds rights. The Domain Name fully incorporates the Complainant's registered trade mark and company name DANSKE SPIL and the only difference between the Domain Name and the Complainant's trade mark is the addition of the generic word “online”. The Complainant asserts that the term "online" is not sufficient to distinguish the Domain Name from the Complainant's trade mark. On the contrary, it increases the likelihood of confusion with the Complainant's trade mark because it refers to the type of activity that the Complainant provides through the website www.danskespil.dk. The Complainant further asserts that the presence of the .com top level domain name is irrelevant in the comparison of a domain name to a trade mark.

(ii) The Respondent has no rights or legitimate interests in respect of the Domain Name.

The Complainant asserts that 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 otherwise from the Complainant, nor has the Complainant

agreed in any way to such use by the Respondent. Furthermore, the Complainant asserts that the Respondent does not hold any trade mark rights nor is he commonly known by the Domain Name.

The Complainant further asserts that the Domain Name was suspended for an unknown period of time. At the time of filing of the Complaint, the Domain Name was parked with Godaddy.com and displayed third-party commercial “pay-per-click” links and advertising from which the Respondent generates revenues. According to the Complainant, it can therefore be concluded that the Respondent is not using the Domain Name in connection with a bona fide offering of goods and services and neither can such use constitute 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” as per Paragraph 4(c) of the Policy. In conclusion the Complainant claims that the Respondent has no rights or legitimate interests in respect of the Domain Name.

(iii) The Domain Name was registered and is being used in bad faith.

In respect of registration of the Domain Name in bad faith, the Complainant asserts that its company name and trade mark DANSKE SPIL has been used 10 years prior to the Respondent’s registration of the Domain Name and is well-known. Thus, according to the Complainant, it is inconceivable that the Respondent registered the Domain Name without prior knowledge of the Complainant and its Rights.

The Complainant further asserts that the Respondent's registration of the Domain Name prevents the Complainant from registering the Domain Name and using its well-known company name and trade mark DANSKE SPIL in the Domain Name in connection with the Complainant's gaming business.

In addition, the Complainant asserts that the Domain Name is offered for sale on the website itself and that this is an additional circumstance indicating that the Domain Name was registered or acquired for the purpose of selling it to the Complainant or a competitor of the Complainant.

As regards to bad faith use, the Complainant asserts that the Respondent is using the Domain Name for a webpage containing third-party commercial links and ads, and is therefore intentionally attempting to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's trade mark. In addition, the Complainant alleges that as a result of the traffic generated by the Domain Name, the Respondent is able to offer for sale the Domain Name to the Complainant.

Finally, the Complainant asserts that the Domain Name was suspended indefinitely and therefore the Respondent has been passively holding the Domain Name and thus using it in bad faith.

RESPONDENT:

No administratively compliant Response was filed by the Respondent.

RIGHTS

Paragraph 4(a)(i) of the Policy requires the Complainant to prove that the Domain Name registered by the Respondent is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

The Complainant has submitted evidence demonstrating that it is the registered owner of several Danish word and figurative trade marks consisting of the terms DANSKE SPIL. Accordingly, the Panel is satisfied that the Complainant has trade mark rights in the term DANSKE SPIL.

The Domain Name incorporates in its entirety the Complainant's DANSKE SPIL trade mark. The only difference between the Complainant's trade marks and the Domain Name is the addition of the generic term "online", which makes reference to the Complainant's activities and thus reinforces the confusing similarity between the Domain Name and the Complainant's trade marks. Thus, such term is insufficient to distinguish the Domain Name from the Complainant's trade marks.

In addition, the suffix ".COM" does not distinguish the Domain Name from the Complainant's trade marks.

The Complainant has therefore shown, to the satisfaction of the Panel, that the Domain Name is identical or confusingly similar to a trade mark 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

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the Domain Name. Paragraph 4(c) of the Policy sets out a list of circumstances on which a respondent may rely to demonstrate rights or legitimate interests in a domain name for the purposes of Paragraph 4(a)(ii), including but not limited to:

(i) before any notice to the Respondent of the dispute, the Respondent used, or made 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) the Respondent is commonly known by the Domain Name, even if the Respondent has acquired no trade mark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark at issue.

Whilst the burden of proof rests on the Complainant, it is often difficult for a complainant to prove a negative, i.e. that a respondent does not have a right or legitimate interests in respect of a domain name. Thus, a complainant must first show a prima facie case that a respondent lacks rights or legitimate interests in the disputed domain name, and upon such a showing, then this burden shifts back to the respondent.

Having considered the evidence put forward by the Complainant, the Panel is of the opinion that the Complainant has made a prima facie showing of the Respondent's lack of rights or legitimate interests in the Domain Name. As a result of his default, the Respondent has failed to rebut such a showing. Whilst a respondent's default does not imply that a decision will be rendered against him, the Panel is entitled to draw appropriate inferences therefrom.

Accordingly, the Panel notes that there is no evidence suggesting that the Respondent is authorised by or affiliated to the Complainant or that the Respondent is commonly known by the Domain Name. Neither is there evidence suggesting that the Respondent is using, or has made preparations to use, the Domain Name in connection with a bona fide offering of goods or services or that the Respondent is making a legitimate noncommercial or fair use of the Domain Name.

In this regard, the Panel notes that whilst the Danish terms "Danske" ("Danish") and "Spil" ("games") may be arguably descriptive, the combination of such terms act as an indicator of source of the Complainant's gaming business. Thus, the Panel finds that the use of the Domain Name for a parking page displaying sponsored links for goods and services related to the Complainant's same business activity does not constitute a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name but rather an illegitimate commercial use of the Domain Name that seeks to capitalize on the Complainant's trade mark.

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

BAD FAITH

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that may indicate that the Domain Name was registered and used in bad faith, as follows:

"(i) circumstances indicating that [the respondent has] registered or acquired a disputed domain name primarily for the

purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the 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 complainant from reflecting the complainant's trade mark or service 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] website 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] website or location".

The Panel is satisfied that the Domain Name was both registered and is being used in bad faith.

As regards to bad faith registration, the evidence shows that many of the Complainant's trade marks were registered long before the registration of the Domain Name. In addition, the Complainant has demonstrated to the satisfaction of this Panel that the Complainant's trade marks are well-known, as confirmed by previous UDRP decisions and a Danish Supreme Court decision produced by the Complainant. Further, the fact that the Respondent registered the Domain Name on 26 January 2012, shortly after the partial gaming liberalization of the Complainant's monopoly in Denmark earlier that same month, suggests that it is inconceivable that the Respondent was unaware of the Complainant and its rights at the time of registration of the Domain Name and thus deliberately chose to register the Domain Name to obtain some sort of financial gain. The Panel therefore finds that the Domain Name was registered in bad faith by the Respondent.

As far as bad faith use of the Domain Name is concerned, the Panel accepts the Complainant's contention that by using the Domain Name to point to a parking website containing commercial links, the Respondent is intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade mark as to the source or sponsorship of the website, within the meaning of Paragraph 4(b)(iv) of the Policy. In addition, the fact that the Domain Name is offered for sale on the parking page to which the Domain Name is pointing is a further indication of the Respondent's bad faith.

Finally, whilst the use of a privacy protection service is not by itself an indication of bad faith, the Panel finds that in this case, particularly in the context of a parking website, the use of a privacy protection service to conceal the Respondent's identity is an additional element supporting a finding of bad faith.

The Complainant has therefore demonstrated, to the satisfaction of the Panel, that 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 the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the Complainant has successfully established each of the following:

(i) the Domain Name registered by the Respondent is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DANSKESPILONLINE.COM**: Transferred

PANELLISTS

Name	**David Taylor**

DATE OF PANEL DECISION 2014-01-31

Publish the Decision