Decision for dispute CAC-UDRP-100726

Case number	CAC-UDRP-100726
Time of filing	2014-01-13 14:10:41
Domain names	danskespilandroid.com, danskespilbingo.com, danskespiliphone.com, danskespilpoker.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

Organization	IM SARL

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceeding related to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant has documented to be the registered owner of the Danish trademarks "DANSKE SPIL" (word) registered on June 25, 2012, "DANSKE SPIL BINGO" (word) - registered on January 20, 2013 and "DANSKE SPIL POKER" (word) registered on November 7, 2012.

Complainant has also indicated (without documenting it) to be the holder of several trademark registrations for DANSKE SPIL and device, the first registration of these trademarks dates back to the year 2001. The Panel has verified this data.

In addition, Complainant’s company name has been DANSKE SPIL A/S since 2002.

The Complainant has shown to be the holder of the following domain names: danskespil.com (transferred to the Complainant following a UDRP decision issued on May 2, 2011), danskespil-poker.com (registered on September 22, 2012) and danskespilpoker.dk (registered on November 4, 2011).

Complainant has also indicated to be the holder of many other domain names containing and/or corresponding to its trademarks, in support Complainant has attached a list of these domain names. The data provided does not include the

dates of registration of the domain names. The Panel has however verified that some of them such as danskespil.dk dates back to May 5, 2000.

Finally, the Complainant has documented to have established an unregistered right to the trade mark and company name “DANSKE SPIL” in May 2008. In support of this statement Complainant has attached a Supreme Court decision (Case 28872009 and 289/2009).

The disputed domain names were registered on August 26, 2010.

FACTUAL BACKGROUND

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

This Complainant is Danske Spil A/S, a Danish gaming company based in Denmark. The Danish Parliament founded the company in 1948 and in 2002 the Complainant changed its company name from Dansk Tipstjeneste A/S to the current name Danske Spil A/S.

From 1948 up till January 2012 the Complainant had a monopoly on providing gaming in Denmark and after the partial gaming liberalization in January 2012, the Complainant kept its 65-year-old monopoly on providing a number of games e.g. LOTTO, bingo, casino and poker.

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 Complainant's official website danskespil.dk.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

Complainant claims that:

the Complainant´s trade mark DANSKE SPIL is well-known and that this fact has been confirmed in a previous WIPO decision, see e.g Danske Spil A/S v. Peter Joergensen, WIPO Case no. D2011-0298. In order to support this statement Complainant has also attached a Supreme Court decision (Case 28872009 and 289/2009). The Supreme Court found that the Complainant had established an unregistered right to the trade mark and company name “DANSKE SPIL” in May 2008.

The contested domain names danskespilandroid.com and danskespiliphone.com are confusingly similar to the trade mark DANSKE SPIL, in which the Complainant holds rights.

The addition of the generic words “android” and “iphone” are not sufficient to differentiate the disputed domain names danskespilandroid.com and danskespiliphone.com from the Complainant´s well-known trade mark DANSKE SPIL, on the contrary the use of the mentioned generic words increases the likelihood of confusion because the words refer to activities in connection with the gaming services provided by the Complainant.

In addition, the contested domain names danskespilbingo.com and danskespilpoker.com fully consist of the Complainant´s trade marks DANSKE SPIL BINGO and DANSKE SPIL POKER with the suffix gTLD “.com”.

The Respondent has no rights or legitimate interests in respect of the domain names.

The Respondent has not received any license or consent, express or implied, to use the Complainant´s trade marks DANSKE SPIL, DANSKE SPIL BINGO and DANSKE SPIL CASINO in the domain names 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 names.

The Respondent has no legitimate rights in the contested domain names danskespilandroid.com, danskespilbingo.com, danskespiliphone.com and danskespilpoker.com.

The Respondent did not use the domain names as a trade mark, company name, business or trade name prior to the registration of the disputed domain names, nor is the Respondent otherwise commonly known in reference to the names.

The domains danskespilandroid.com, danskespilbingo.com, danskespiliphone.com and danskespilpoker.com are inactive.

The domain name danskespiliphone.com also hosted third-party ads in April 2012.

The Complainant claims that the domain names in question solely contained text to optimize the web pages in different search engines and thereby generate traffic to the domains in question making them attractive for the Complainant or competitors of the Complainant.

Due to the fact that the domain names in question are inactive, it can be concluded that the Respondent is not using the domain names 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 domain names danskespilandroid.com, danskespilbingo.com, danskespiliphone.com and danskespilpoker.com.

C: The domain names were registered and are being used in bad faith.

Registration in bad faith

The Complainant's company name and trade mark DANSKE SPIL had been used for many years before the Respondent's registration of the disputed domain names and due to the fact that the Complainant and the Complainant´s trade mark DANSKE SPIL is well-known, it is inconceivable that the Respondent registered the domain names without prior knowledge as to the existence of the Complainant and the Complainant´s trade marks.

The Respondent´s registration of the domain names danskespilandroid.com, danskespilbingo.com, danskespiliphone.com and danskespilpoker.com prevents the Complainant from registering the domain names and using the well-known company name and trade mark DANSKE SPIL and the trade marks DANSKE SPIL BINGO and DANSKE SPIL CASINO in the domain names in connection with the Complainants gaming business.

Bad faith use

Currently the domain names in question are inactive hence the Respondent is not using the domain names for active web pages. The domain names are therefore used in bad faith.

Furthermore, the Complainant alleges that the Respondent has intentionally attempted to attract Internet users to the Respondent´s websites by creating a likelihood of confusion with the Complainant´s trade marks. The Respondent has done so to generate user traffic to the websites and as a result of this traffic the Respondent can offer to sell the domain names in question to the Complainant or competitors of the Complainant.

RESPONDENT:

The Respondent did not file a response

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are 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

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

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that the domain names have been registered and are 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.

There are a number of procedural complications in this case. They are as follows:

(i) Some of the attachments to the Complaint were filed in Danish whereas the language of the proceeding was and is English. As well, Complainant's website www.danskespil.com (to which the Complainant refers for further information) is solely in Danish;
(ii) The written notice of the Complaint (sent to the Respondent) was returned to the Czech Arbitration Court as undelivered, stating the reason why it was not duly delivered in Arabic;
(iii) The Panel decision that an additional fee was due from the Complainant.

It is this Panel's opinion that taking a decision partially based on documents written in languages the Panel is not familiar with would have been quite questionable.

Moreover, the language regime provided by Paragraph 11(a) of the Rules serves to protect the interests of the Respondent.

Therefore, the Panel considers it necessary to undertake his own inquiries to understand all the documents and information that are deemed to be relevant for the proceeding.

In addition to the attachments to the Complaint that were filed in Danish, also the explanation why the written notice of the Complaint was returned to the Czech Arbitration Court - that is written in Arabic - is an element that needs to be understood and then evaluated.

Indeed, the Panel is requested to be fair with both parties, thus it would have been unfair to the Respondent to solely rely on Complainant's statements regarding the attachments to the complaint that were in Danish.

Finally, the Panel noted, from the WhoIs of the disputed domain names, that the Respondent appears to be indicated as the holder of more than 2.000 domain names. The Complainant has not mentioned this fact and the Respondent has not defended itself. The Panel considers this element quite important. Therefore, in compliance with his powers, has conducted some limited searches to establish whether this fact could be relevant to infer Respondent's bad faith in registering the disputed domain names or not.

For all the above reasons the Panel has decided to avoid a “simplified decision” and thus requested the payment of the additional fee from the Complainant.

PRINCIPAL REASONS FOR THE DECISION

Discussion and findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy lists three elements that Complainant must prove to merit a finding that the domain names registered by the Respondent be transferred to the Complainant:

1) the domain names are identical or confusingly similar to a trademark or service mark (“mark”) in which the Complainant has rights; and
2) the Respondent has no rights or legitimate interests in respect of the domain names; and
3) the domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

Whereas the domain name danskespilbingo.com is identical to Complainant's trademark DANSKE SPIL BINGO, the other disputed domain names entirely contain Complainant's trademark DANSKE SPIL.

The addition of the terms "android", "poker", "bingo" and "iphone" is not sufficient to differentiate the disputed domain names from Complainant's trademarks.

In addition, in the present case the terms "android", "poker" and "bingo" are descriptive of services rendered by the Complainant, thus this is a further element of confusion.

Therefore this Panel, having verified Complainant's rights to the trademarks DANSKE SPIL BINGO and DANSKE SPIL, finds that the Complainant has established rights to a trademark that is confusingly similar to the disputed domain names.

B. Rights or Legitimate Interests

Complainant must show that Respondent has no rights or legitimate interests in respect of the disputed domain names.

Respondent in a UDRP proceeding does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:

a) that before any notice to the respondent of the dispute, he or she used or made 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;
b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or
c) that 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 trademark.

Respondent has no connection or affiliation with Complainant, which has not licensed or otherwise authorized Respondent to use or apply for any domain name incorporating Complainant’s trademark. Respondent does not appear to make any legitimate use of the domain names for non-commercial activities. Respondent does not appear to have been commonly known by the domain names. Respondent has not shown any facts or elements to justify prior rights and/or legitimate interests in the disputed domain names.

Indeed, the Respondent has not filed any response. This fact combined together with the assertions made by the Complainant and the documents available, convince the Panel that the Respondent for the purposes of this proceeding has no legitimate rights to the disputed domain name.

C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

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

Accordingly, for a Complainant to succeed, the Panel must be satisfied that the domain names have been registered and are being used in bad faith.

The Complainant has to the satisfaction of the Panel shown that Respondent registered and used the disputed domain names in bad faith.

Indeed it appears that the Respondent, for a certain period, intentionally attempted to attract Internet users to his own websites misleading them into believing that the websites corresponding to the disputed domain names were operated, authorized and/or connected to the Complainant. By so deflecting Internet users, Respondent has shown bad faith registration and use of the disputed domain names that clearly falls within the example given in paragraph 4(b)(iv) of the Policy.

In addition, on the balance of probability, the Panel finds that the registration of four domain names all including Complainant's trademark is not a coincidence, but on the contrary it is an inference that Respondent had actual knowledge of Complainant's trademark when it registered the disputed domain names.

It should also be noted that the words "danske spil" (i.e. Danish game in Danish) have no meaning in French and/or in Arabic, namely the languages spoken in Lebanon, the country where apparently the Respondent resides. In addition, there are no indications that the Respondent is a Danish entity or has any relationship with Denmark. Therefore, this fact is further evidence that the registration of the disputed domain names - which all include the DANSKE SPIL trademark - were made having in mind Complainant's trademark.

The Panel, in accordance with previous decisions issued under the UDRP, is of the opinion that actual knowledge of Complainant's trademark and activities at the time of the registration of the disputed domain name may be considered an inference of bad faith (See Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226 and Sony Kabushiki Kaisha (also trading as Sony Corporation) v. Inja, Kil WIPO Case No. D2000-1409. "It is inconceivable that the Respondent could make any active use of the disputed domain name without creating a false impression of association with the Complainant. The Respondent was not authorized by the Complainant to use neither its mark nor the disputed domain name".

Moreover, Respondent is listed as the holder of more than two thousand domain names, thus considering Respondent's activity of registering domain names, before registering the disputed domain names, it should have checked if there were third parties' rights on the DANSKE SPIL names.

In this sense this Panel agrees with the findings of the Panel in Modern Times Group (MTG) AB v. Stefan Häge, Kriströms Advokatbyrå AB WIPO Case No. DTV2000-0004 (domain name everyday.tv), who affirmed that: "In these days when "cybersquatting" has become an important issue it falls naturally to assume that a purchaser of a domain name takes

adequate actions in order to avoid a violation of another person´s trademark rights" and "One must assume that a company that decides to register a domain name with the intention of making real use of the domain name in its business activities on the Internet must have checked if the domain name in question is available for registration in the gTLD's at least. If there are competitors that use a similar domain name or if the domain name is registered in other TLD, it is reasonable to take precautions in order to avoid confusion or trademark infringement, at least if there is a bona fide intention to offer goods and services under the domain name".

Finally, it appears that at present the disputed domain names are not used. This Panel agrees with the numerous previous UDRP decisions where it was affirmed that the passive holding of a domain name may constitute further inference of bad faith registration and use.

In view of all the above, based on the evidence on record, the Panel can conceive of no other reason for the Respondent's registration and use of the disputed domain names than to intentionally attempt to attract users to its website by creating a likelihood of confusion with the complainant's trademarks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DANSKESPILANDROID.COM**: Transferred
2. **DANSKESPILBINGO.COM**: Transferred
3. **DANSKESPILIPHONE.COM**: Transferred
4. **DANSKESPILPOKER.COM**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2014-03-13

Publish the Decision