Decision for dispute CAC-UDRP-100980

Case number	**CAC-UDRP-100980**
Time of filing	**2015-05-15 11:22:03**
Domain names	**sfgame.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Playa Games GmbH**

Respondent

Organization	**CBS Interactive Inc.**

Respondent representative

Organization	**Kilpatrick Townsend & Stockton LLP**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided that relate to the domain name <www.sfgame.com> (the "disputed domain name").

IDENTIFICATION OF RIGHTS

The Complainant owns 30 sfgame.countrycode domain names worldwide which resolve to an online game called “Shakes & Fidget”.

The Complainant does not currently own any registered trade marks for “SFGAME”. A Community Trade Mark (“CTM”) application and a national trade mark application in Germany for the trade mark SFGAME are currently pending.
The Complainant asserts common law rights in the trade mark based on use.

FACTUAL BACKGROUND

The Complainant is a company registered under the laws of the Federal Republic of Germany. The Complainant is the creator and operator of an online game called “Shakes & Fidget” which it says is known as “SFGAME”. The Complainant owes numerous second level country codes domain name that incorporate its “SFGAME” mark. The Complainant does not currently own any registered trade mark for “SFGAME” but has made trade marks application for a Community trade mark and German mark respectively.

The Respondent is based in the United States of America and is a subsidiary of CBS Corporation. CBS Interactive provides online content, including games and is a leader in gaming content. The Respondent owns 250 domain names that include the term “game” and it registered the disputed domain name on 8 August 2007.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant submits that the disputed domain name is identical to Complainant’s”SFGAME” mark.
The Complainant claims that more than 40 million players have signed up worldwide to play “SFGAME” and that its’ revenues have reached an 8 digit volume of sales per year. It says that the Respondent does not have any rights or legitimate interests in the disputed domain name as it was inactive and unused until three weeks ago.

The Complainant further claims that the disputed domain name has been registered and is being used in bad faith by the Respondent as it confuses Internet users into thinking that the disputed domain name has some affiliation with, or resolves to the official website, of the Complainant’s game. The Complainant also alleges that the disputed domain name resolves to a website featuring Google ads and that the Respondent has been remunerated by Google accordingly.

The Complainant claims that the Respondent installed a forwarding search engine recently without any connection to the disputed domain name.

Finally, Complainant alleges that it has tried unsuccessfully to contact the Respondent since 2009 in order to acquire the disputed domain name.

RESPONDENT

The Respondent contends that the disputed domain name is neither identical nor confusingly similar to a trade mark for the purposes of the Policy as the Complainant does not have any registered trade mark but only applications and that it has failed to provide adequate proof of usage and rights under the Policy. The Respondent stresses that the disputed domain name was registered in August 2007, well prior to the development of Complainant’s game and that the Complainant’s other domain names incorporating “SFGAME” all point to a website for the game “Shakes & Fidget”. The Respondent adds that there is no mention of “SFGAME” anywhere on the Complainant’s website except in these domain names. The Respondent contends that the use of “SFGAME” in the disputed domain name does not provide the Complainant with trade mark rights.

The Respondent claims that the Complainant owns no registered trade mark for “SFGAME” and has merely made a couple of pending trade marks application in Europe but not in the United States. It notes that it does however have trade mark registrations for its “SHAKES & FIDGET” mark.

The Respondent states that the Complainant has no legitimate interest in the disputed domain name as it does not have a registered trade mark and has not demonstrated common law usage. As the disputed domain name was registered at least years prior to the commencement of Complainant’s activities, the Respondent says that it is the senior user. Moreover, the Respondent provides evidence from wayback machine that the disputed domain name has been used since early in 2005
The Respondent also states that San Francisco is commonly referred to as SF (and notes that the Respondent is based there) and says that there is no evidence that consumers recognise SF as standing for “SHAKES & FIDGET”.
The Respondent also claims that the disputed domain name could not have been registered and used in bad faith because the registration predates use by the Complainant of “SFGAME” by at least two years and therefore it predates any rights that the Complainant could have as the Respondent could not have contemplated the Complainant’s non-existent rights at the time of registration.

The Respondent states that it had never received any communication from the Complainant and that even if it had done so,

it was under no obligation to negotiate with the Complainant as the disputed domain name was registered at least two years prior to the existence of the “SHAKES & FIDGET” game.

Finally, the Respondent alleges that this complaint amount to a reverse high jacking domain name by the Complainant as it should have known as a junior user that this complaint could not succeed and the fact that it wants the disputed domain name and that the Respondent does not wish to sell it is beside the point and amounts to an attempt to “hijack” the disputed domain name.

RIGHTS

The Complainant has not demonstrated that it has a registered trade mark right but only that it has made two pending trade mark applications. It has also failed to show common law or unregistered trade mark rights.

Under the Policy, the Complainant might have been able to show that the name “SFGAME” had acquired secondary meaning for the purposes of demonstrating common law use or rights if it had provided relevant evidence of sales made under the mark, the length of time it has been used in the course of trade, the nature and extent of advertising, consumer surveys and media recognition. The threshold for demonstrating rights in an unregistered mark is relatively high and the Complainant has not provided adequate evidence (other than asserting that it has 40 million players worldwide and that it has 8 digits of sale per year) to support this assertion and mere evidence of pending trade mark applications does not suffice. Previous panels such as the panel in Amsec Enterprises, L.C. v. Sharon McCall Case No. D2001-0083, Blandy & Blandy LLP v. Mr. Daniel Beach Case No. D2012-0972 have adopted a similar approach.

NO RIGHTS OR LEGITIMATE INTERESTS

Accordingly, the Panel notes that in view of its findings in relation to the first and third elements of the Policy it is unnecessary to consider the second element.

BAD FAITH

Even if the Complainant was able to demonstrate trade mark rights for the purposes of the first limb of the Policy, it must demonstrate that the Respondent has both registered and used the disputed domain name in bad faith. It has not done so as the Respondent demonstrated that the disputed domain was registered by the Respondent at least 2 years prior to the Complainant’s first use of “SFGAME” mark. The disputed domain name was registered by the Respondent in 2007 and there is some prior evidence of use on the Internet since 2005. The Complainant submits that it started developing its game in 2009 and on checking the Complainant’s website the Panel notes that the Complainant’s company was only founded in 2009. The Respondent could therefore not have contemplated the Complainant’s existence or game at the time that the disputed domain name was registered. There is no evidence that the Respondent was aware of Complainant at that time. This Panel’s approach is consistent with the consensus view of panellist as noted in article 3.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition. It is, indeed, well-established that bad faith cannot be found when a disputed domain name has been registered by the Respondent before the acquisition of unregistered trade mark rights by the Complainant.

Therefore, the Panel finds that the Respondent did not register the disputed domain name in bad faith and the third element of the Policy has not been made out.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the Policy and the Rules have been met and there is no reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel decides that the Complainant has failed to meet its burden of proof under paragraph 4 of the Policy. The Panel therefore denies the Complainant’s request that the Disputed Domain Name be transferred from the Respondent to the Complainant.

The Panel notes as set out above, that the Complainant has not provided any evidence that it has any rights in the disputed domain name as it failed to submit evidence showing that it has a common law or unregistered trade mark identical or similar to the disputed domain name. The Complainant has also failed to demonstrate that the Respondent registered the disputed domain name in bad faith as required under the conjunctive third element of the Policy.

REVERSE DOMAIN NAME HIJACKING

A finding of reverse domain name hijacking is appropriate when a Complainant clearly should have known at the time that it filed its complaint that it could not prove an essential element under the Policy. In this case the Complainant should have been very well aware that the disputed domain name could not have been registered in bad faith because the Complaint's mark and company did not exist at the date of registration of the disputed domain name. As a result, the Panel finds that reverse domain name hijacking is made out in this case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **SFGAME.COM**: Remaining with the Respondent

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2015-07-06

Publish the Decision