Decision for dispute CAC-UDRP-102803

Case number	CAC-UDRP-102803
Time of filing	2019-12-11 11:45:08
Domain names	getstarstablejorvikshilling.top

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Star Stable Entertainment AB

Complainant representative

Organization	SILKA Law AB

Respondent

Name	Sarunas Kujalis

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner, inter alia, of the following trademark registration(s) which enjoy protection e.g. in Latvia where the Respondent apparently is domiciled:

Word mark STAR STABLE, European Union Intellectual Property Office (EUIPO), registration no.: 008696775, registration date: April 5, 2010, status: active;
Word-/device mark STAR STABLE, EUIPO, registration no.: 014171326, registration date: January 13, 2015, status: active.

Furthermore, the Complainant has evidenced to own various domain names relating to its STAR STABLE trademark, including the domain name <starstable.com> which the Complainant uses since years to promote its STAR STABLE online game and related business.

FACTUAL BACKGROUND

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

1. Power Of Attorney
2. Business registration certificate
3. Whois extract
4. About Complainant
5. (5.1-5.4) US and EUTM Trademark registrations for STAR STABLE
6. Domain Names owned by Complainant
7. Full websites to which the Domain Name is connected
8. Correspondence

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))

About Complainant

The Complainant was founded in 2011 and is a privately held company located in Sweden operating the online horse game starstable.com. The game has players from all over the world with active users in 180 countries and 11 languages. When the game debuted in late 2012, it was in Swedish only. As the company developed and improved the game the market grew to Northern Europe, the US and the rest of the world. Today the Complainant has over 6 million registered users and about 98 percent of them are girls. Based on an existing and popular story, the company is set out to create the best and most engaging horse adventure games where the player will explore the beautiful island of Jorvik on the back of their own horse. Every player rides, takes care of their own horse, embarks on quests, participates in competitions and takes part in the epic story that unfolds in the world of Star Stable.
Providing a safe and secure environment that is suitable for Star Stable's players is extremely important to the Complainant and therefore they use Crisp Thinking, a third-party social monitoring solution, to automatically moderate and monitor all chat to ensure a safe environment. Crisp Thinking prevents the sharing of personal information and filters out "bad words" and trigger phrases. The Complainant has also a significant presence on various social media platforms, such as Facebook, Youtube, Instagram, Google+ and Twitter
Nearly 200 000 followers 55,549 subscribers 67 500 followers 6 900 followers

The Complainant is the owner of the registered trademark STAR STABLE as a word mark in numerous of countries all over the world including in Europe and in the United States.

Overview of relevant trademark registrations
STAR STABLE USPTO July 6, 2010 3814190 UNITED STATES
STAR STABLE USPTO January 13, 2015 13204128 UNITED STATES
DESIGN PLUS WORDS, LETTERS

USPTO September 21, 2015 14171326 UNITED STATES
Star Stable OHIM 008696775 05/04/2010 EU
STAR STABLE OHIM 013204128 13/01/2015 EU
Figurative

OHIM 014171326 21/09/2015 EU

The Complainant cites as an example the US trademark registration No. 3814190 (registered in 2010), US Trademark Registration No. 13204128 (registered in 2015), US Trademark Registration No. 14171326 (registered in 2015). The majority of the trademark registrations predates the registration of the Domain Names. Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "STAR STABLE" see for example, <starstable.com> (created in 2007) and <starstable.org> (created in 2012). The Complainant is using these domain names to connect to websites through which it informs potential customers about its STAR STABLE mark, games and merchandise.

Identical or confusingly similar

The Domain Name was registered on May 5, 2019 and incorporate in full the Complainant's registered trademark STAR STABLE. The addition of the terms "get" and "jorvik shilling" do not distinguish the Domain Name from the Complainant's STAR STABLE trademark. On the opposite, it rather exaggerates the confusingly similarity element since Jorvik Shillings is one of two currencies that are accepted for payment of the Complainant's game. The generic Top-Level Domains (gTLDs), in this case ".top" is typically disregarded under the first element confusing similarity test, as it a standard requirement for registration. Therefore, the Domain Name is confusingly similar to the Complainant's trademark. See the WIPO Overview on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), paragraph 1.7 and 1.11.

B. Respondent has no rights or legitimate interests in respect of the Domain Name;
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

First of all, it is noted that Respondent has no authorization or license from the Complainant to register a domain name incorporating Complainant's trademark. Respondent is not affiliated with Complainant in any way. There is no bona fide offering of goods or services where the domain name incorporates a trademark which is not owned by Respondent, nor is the Respondent commonly known by the name "Star Stable". The legal entity displayed in the WHOIS record is a privacy shield. Should the Respondent have any legitimate interest in the Domain Name it would most likely not have chosen to register anonymously. In fact, the WHOIS privacy service hides the identity of the person behind an infringing website and makes it more challenging for brands to enforce their trademarks.

The website
Respondent is using the Domain Name to redirect to a website titled: "Star Stable Online Generator" - Star Stable players are invited to use Respondent's software to hack and circumvent the game by use of a hack tool. By submitting their personal Star Stable login information on the website, players can, for instance, obtain unlimited Star Coins. Star Coins that would otherwise have to be bought through Complainant's official game. Users may think it is officially sanctioned cheating which it isn't.

This website/software is not distributed or authorized by Complainant and, apart from hacking, if unauthorized, being by its nature an illegitimate activity, these unofficial websites/software programs often have virus programs that will be downloaded to the player's computer for the website to which the Domain Name resolves.

The Complainant doesn't have control over the website and cannot guarantee the safety of their players. The purpose of the website appears to be to collect personal data and encouraging players to obtain Star Coins unlawfully. The personal data that is entered is sensitive information and Respondent is attempting to take undue advantage from the registration of a Domain Name which is confusingly similar in all aspects with the Complainant. Such use of the Domain Name might be hazardous for the users as well as for the Complainant's business and reputation. Accordingly, adequate measures have to be taken to prevent further potential fraudulent attempts from the Respondent through the use of the Domain Name.

Similar to the WIPO Case No. D2015-2312, Star Stable Entertainment AB v. WhoisGuard Protected / WhoisGuard, Inc. with nearly identical elements of the current case, the Panel stated: "It is clear to the Panel that such use unfairly targets the Complainant's trademark and is intended to mislead Internet users or otherwise to take unfair advantage of the Complainant's trademark rights." The same circumstances apply in the current case. Complainant has successfully filed various UDRP proceedings against domain names including the term "hack" with corresponding hack sites, see, for instance, Star Stable Entertainment AB v. WhoisGuard Protected, WhoisGuard Inc. / Federico James, WIPO Case No. D2016-1427; Star Stable Entertainment AB v. Rafael Velez / Domains By Proxy, LLC, Registration Private, WIPO Case No. D2015-2314; Star Stable Entertainment AB v. Victor Arreaga / WhoisGuard Protected, WhoisGuard, Inc., WIPO Case No. D2015-2315.

C. The Domain Name is registered and is being used in bad faith.

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

The Complainant first tried to contact the Respondent on July 31, 2019 through a cease and desist letter. The Complainant advised the Respondent that the unauthorized use of the STAR STABLE trademark within the Domain Name violated Complainant's rights in said trademark. The Complainant requested a voluntary transfer of the Domain Name. Respondent has simply disregarded such communication. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the UDRP process. It has been mentioned in earlier cases that the failure of a respondent to respond to a cease and desist letter, or a similar attempt at contact, has been considered relevant in a finding of bad faith, e.g., News Group Newspapers Limited and News Network Limited v. Momm Amed Ia, WIPO Case No. D2000-1623; Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598; and America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460.

Masked registration:

As pointed out earlier, the Respondent uses a privacy shield and although use of a privacy or proxy registration service is not in itself an indication of bad faith, the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith. The Complainant would like to emphasize the fact that it also suggests that a motive for using a domain privacy service in this instance has been to increase the difficulty for the Complainant of identifying the Respondent, which does not reflect good faith.

The Complainant also refers to its arguments under section B above and submits that the use of the Domain Name for a commercial website where the Complainant's trademark is misappropriated cannot be considered as good faith use of the Domain Name. It is apparent that the Domain Name was registered with knowledge of the Complainant's trademark rights with the purpose of disrupting Complainant's business by hacking its game and depriving Complainant of its income. Moreover, the third-party advertisements and the invitation to players to register for free Star Coins and the lack of clear indication on the (lack of any) relationship between the Complainant and Respondent, strongly suggest that the Domain Name was registered and are being used with the intention of attracting customers for commercial gain by creating a likelihood of confusion with that same 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. Similar to Star Stable Entertainment AB v. Victor Arreaga / WhoisGuard Protected, WhoisGuard, Inc., WIPO Case No. D2015-2315, resembling the current case where the Respondent incorporated the term "hack" the Panel stated that: "The Panel considers that the references to a 'hack' in connection with the Complainant's game (i.e. an unauthorized method of obtaining the Complainant's Star Coins) also clearly indicate bad faith on the Respondent's part." The website at the Domain Name also advises users of the hack tool to use a proxy to prevent being banned from the official game. This further indicates bad faith on Respondent's part.

To summarize, STAR STABLE is a well-known trademark in the online video game industry. It is highly unlikely that Respondent was not aware of the rights Complainant has in the trademark and the value of said trademark, at the point of the registration. Respondent bears no relationship to the trademark and the Domain Name have no other meaning except for referring to Complainant's name and trademark. Respondent is targeting Complainant with an online hack tool. Hacking, if unauthorized, is by its nature an illegitimate activity. Further, Respondent uses the Domain Name, and thus Complainant's trademark, for commercial gain by showing third-party advertisements. There is no way in which the Domain Name could be used legitimately. Consequently, Respondent should be considered to have registered and to be using the Domain Name in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed 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 disputed 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.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name <getstarstablejorvikshilling.top> is confusingly similar to the Complainant's STAR STABLE trademark, since the disputed domain name incorporates the latter in its entirety and the mere addition of the terms "get" as well as "jorvikshilling" (the latter of which even refers to a currency that is accepted for payment in the Complainant's online game) is not capable to dispel the confusing similarity arising from such incorporation of the Complainant's STAR STABLE trademark in the disputed domain name. Also, the applicable new generic Top Level Domain (TLD) ".top" is a standard registration requirement and as such may be disregarded under the first element confusing similarity test.

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain, nor is the Respondent commonly known thereunder. Rather, the Complainant has demonstrated that at some point before the filing of the Complaint, the disputed domain name redirected to an active website titled "Star Stable Online Generator" which invited STAR STABLE players to use the Respondent's software to hack and circumvent the Complainant's STAR STABLE game through an offered hack tool and also displayed third-party advertisement. Such making use of the disputed domain name obviously neither qualifies as a bona fide nor as a legitimate non-commercial or fair use under the UDRP.

Finally, the Complainant argues, and the Panel agrees to this line of argumentation, that the Respondent's making use of the disputed domain name to redirect to a website that invites STAR STABLE players to use the Respondent's software to hack and circumvent the Complainant's STAR STABLE game and, by the same time, displaying third-party advertisement, not only is a clear indication that the Respondent has registered the disputed domain name with full knowledge of the Complainant's STAR STABLE trademark but also shows that the Respondent obviously registered and is using the disputed domain name in an effort to disrupt the Complainant's business and, by the same time, intends to attract, for commercial gain, Internet users to the Respondent's own website, by creating a likelihood of confusion with the Complainant's STAR STABLE trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Such circumstances shall be evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraphs 4(b)(iii) and (iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GETSTARSTABLEJORVIKSHILLING.TOP**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2020-01-20

Publish the Decision