Decision for dispute CAC-UDRP-103462

Case number	CAC-UDRP-103462
Time of filing	2020-12-18 09:22:02
Domain names	STARSTABLEJORVIKSHILLINGHACKED.ONLINE

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Star Stable Entertainment AB

Complainant representative

Organization	SILKA AB

Respondent

Name	Sarunas Kujalis

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 is owner of the following trademarks:

- EUTM STAR STABLE (word) no. 008696775, filed on 18 November 2009, registered on 5 April 2010 in class 9;
- EUTM STAR STABLE (word) no. 013204128, filed on 27 August 2014, registered on 13 January 2015 in classes 16, 25, 28, 41;
- EUTM STAR STABLE (device) no. 014171326, filed on 26 May 2015, registered on 21 September 2015 in classes 9, 16, 25, 41;
- EUTM STAR STABLE (word) no. 014673198, filed on 13 October 2015, registered on 24 March 2016 in classes 3, 14, 18, 21, 24, 30, 32;
- US trademark STAR STABLE (word) no. 3814190, filed on 19 November 2009, registered on 6 July 2010 in class 9;
- US trademark STAR STABLE (word) no. 4798274, filed on 10 September 2014, registered on 25 August 2015, in classes 16, 25, 28, 41;
- US trademark STAR STABLE (device) no. 4944619, filed on 8 June 2015, registered on 26 April 2016, in classes 9, 16, 41;
- US trademark STAR STABLE (word) no. 5415338, filed on 12 April 2016, registered on 6 March 2018, in class 14;

- US trademark STAR STABLE (word) no. 5221092, filed on 12 April 2016, registered on 13 June 2017, in classes 18, 24.

The Complainant is also owner of several domain names including <starstable.com> registered on 16 October 2007 and used as the Complainant's main website.

Hereinafter the afore-mentioned rights are referred to as STAR STABLE Trademark.

FACTUAL BACKGROUND

The Complainant is a Swedish private company founded in 2010. It is the operator of a multiplayer online horse adventure game, named Star Stable, in which players (for the vast majority girls) explore the virtual island of Jorvik on their horse and take care of their horse. Jorvik Shilling is one of currencies accepted for payment in the game.

The disputed domain name was registered on 30 November 2019 using a privacy service. The disputed domain name originally resolved to a website generating coins via a hack tool and displaying the script "Star Stable Star Coins and Jorvik Shilling Online Hack Tool" along with the Complainant's device mark. The Complainant has successfully disabled the website through the webhost. At the time of the filing on the Complaint, the disputed domain name resolved to a parking page with third parties' links.

The Complainant sent a cease and desist letter and a reminder to the Respondent without obtaining any response.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that Star Stable is a very popular online horse adventure game having players from all over the world with over 6 million registered users in 180 countries and being available in 11 languages. The Complainant is the registrant of domain names including <starstable.com> and <starstable.org> which it uses to promote its trademarks, games and merchandise. It states that it also has a significant presence on various social media platforms, such as Facebook, Youtube, Instagram, Google+ and Twitter. The Complainant considers extremely important to provide a safe and secure environment for its users. Therefore, it employs a third party social monitoring solution which moderates all chat, prevents the sharing of personal information and filters out unacceptable words.

The Complainant submits that the disputed domain name is confusingly similar to its trademark. In particular, the Complainant states that the disputed domain name consists of the STAR STABLE Trademark with the additional terms “jorvik”, “shilling”, “hacked” and the TLD “online” which do not distinguish the disputed domain name from the Complainant's trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant submits that the Respondent does not own the STAR STABLE Trademark and is not known by the name "Star Stable". It submits that, at the time of filing the Complaint, the disputed domain name resolved to a parking page with links to third parties' websites and, thus, capitalized on the reputation and goodwill of the Complainant and its trademark. Previously it was connected to a website generating coins via a hack tool. The Complainant contends that the Respondent's uses cannot constitute a bona fide offering of goods or services.

The Complainant contends that the disputed domain name has been registered and is being used in bad faith.

The Complainant states that the Respondent's identity was originally hidden behind a "privacy shield". It adds that it

attempted to contact the Respondent via a cease and desist letter and a reminder, both of which were ignored.

The Complainant submits that the use of the disputed domain name for a commercial website where the Complainant's trademark is misappropriated cannot be considered as good faith use. According to the Complainant it is apparent that the disputed domain name was registered with knowledge of the Complainant's trademark rights and with the purpose of disrupting Complainant's business by hacking its game and depriving the Complainant of its income. Third parties' advertisements, the invitation to players to register for free Jorvik Shilling and the absence on the website of any indication of the lack of relationship with the Complainant enhance the likelihood of confusion with the Complainant's trademark and services. Therefore, by using the disputed domain name, the Respondent has intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on that website.

The Complainant requests the transfer of the disputed domain name.

RESPONDENT:

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

IDENTIFICATION OF THE RESPONDENT

Upon filing of the Complaint and further to CAC's request, the Registrar disclosed the registration data of the underlying registrant, identified as Sarunas Kujalisan, an individual residing in Lithuania. The Complainant submitted the Amended Complaint accordingly.

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

I. THREE UDRP ELEMENTS

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:
(i) the disputed domain name 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 respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used by the Respondent in bad faith.

II. THE COMPLAINANT'S RIGHTS. CONFUSING SIMILARITY OF THE DISPUTED DOMAIN

NAME TO THE COMPLAINANT'S MARK

The Complainant has established to have rights in the registered trademarks consisting in the distinctive word STAR STABLE since 2009. The Complainant's marks were registered prior to the registration of the disputed domain name (30 November 2019). Although it is not required under the Policy that the Complainant holds trademark rights within the territory where the Respondent is residing (see 1.1.2 WIPO Overview 3.0), the Panel notes that the Complainant's EUTMs are valid in the entire territory of the European Union of which the Respondent's country is a Member State.

The disputed domain name consists of the terms “star”, “stable”, “jorvik”, “shilling”, “hacked” and the TLD “online”.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, since it incorporates the entirety of the STAR STABLE Trademark and differs from such mark by merely adding the terms “jorvik”, “shilling”, “hacked” and the TLD “online”. The addition of such terms neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain name from the Complainant's mark. On the contrary, taken into account that such words are clearly related to the Complainant (i.e. Jorvik is the name of the virtual island where the Complainant's game takes place and Jorvik Shilling is one of the currencies accepted for payment in the Complainant's game), their use in the disputed domain name even enhances the risk of confusion between the disputed domain name and the STAR STABLE Trademark. See also CAC Case no. 103340.

In UDRP cases where the relevant trademark is recognisable within the disputed domain name, panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) and letters does not prevent a finding of confusing similarity under the first element (see 1.8 WIPO Overview 3.0).

UDRP panels also agree that the TLD is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant’s trademark as it is a technical requirement of registration. The practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD, including with regard to new generic TLDs (like in this case “online”); the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's trademarks.

III. THE RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see paragraph 2.1 WIPO Overview 3.0: “[...] where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”).

The disputed domain name was registered by Sarunas Kujalis, residing in Lithuania.

The Complainant has no relationship with the Respondent whatsoever. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademarks or to register the disputed domain name. There is no evidence that the Respondent has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name originally resolved to a website generating coins via a hack tool and displaying the script "Star Stable Star Coins and Jorvik Shilling Online Hack Tool" and the Complainant's device mark. The Complainant has successfully disabled the website through the webhost. At the time of the filing of the Complaint, the disputed domain name resolved to a parking page with third parties' links. None of such uses of the disputed domain name is a legitimate non-

commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's marks.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

IV. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Complainant has sufficiently demonstrated to be owner of the well-known STAR STABLE Trademark, registered prior to the registration of the disputed domain name and valid in the territory of the Respondent.

The disputed domain name is confusingly similar to Complainant's trademarks, since it incorporates the entirety of the STAR STABLE Trademark and differs from such mark by merely adding the terms "jorvik", "shilling", "hacked" and the TLD "online" which are insufficient to negate the confusing similarity of the disputed domain name to such mark and even enhance the risk of confusion.

Considered that the original website associated with the disputed domain name, before being disabled by the Complainant through the webhost, generated coins via a hack tool and clearly displayed the script "Star Stable Star Coins and Jorvik Shilling Online Hack Tool" along with the Complainant's device mark, it is evident that the Respondent had registered the disputed domain name with actual knowledge of the Complainant, its game and its trademarks and the intention to exploit such reputation for commercial gain.

The Panel shares the view of a previous UDRP panel which considered 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 and Jorvik Shilling) also clearly indicates the bad faith on the Respondent's part (see WIPO Case No. D2015-2315).

Further to the take down of the original website content, the Respondent has used the disputed domain name to host a parked page comprising pay-per-click links.

Therefore, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his/her web site or other on-line location, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on his/her web site or location (paragraph 4(b)(iv) of the Policy).

Furthermore, the Respondent used a privacy service when registering the disputed domain name in order to conceal his/her identity. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact a panel's assessment of bad faith (see 3.6 WIPO Overview 3.0).

Finally, the Respondent has failed to reply to the Complainant's cease and desist letter and to submit a Response in the present administrative proceeding or to provide any evidence of actual or contemplated good faith use.

Considered all the afore-mentioned circumstances, the Panel determines that the disputed domain name has been registered and is being used in bad faith.

Therefore, disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **STARSTABLEJORVIKSHILLINGHACKED.ONLINE**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2021-01-19

Publish the Decision