

Decision for dispute CAC-UDRP-103600

Case number CAC-UDRP-103600

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Domain names stastable.com

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization Star Stable Entertainment AB

Complainant representative

Organization SILKA AB

Respondent

Organization Fundacion Privacy Services LTD

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

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.

The US trademark registration with registration number 3814190 predates the registration of the Domain Name.

The EUTM with registration number 008696775 predates the registration of the Domain Name as well.

Other trademark registrations of the Complainant are:

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- OFFICE DATE OF REGISTRATION TRADEMARK NO. JURISDICTION;

- 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 EUTM April 5, 2010 008696775 Europe.

The trademarks are hereinafter referred to as "the STAR STABLE trademarks".

The 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.

FACTUAL BACKGROUND

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 it uses 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.

The Complainant is concerned that the Respondent has registered the domain name and caused it to resolve to a web site that carries advertisements for various enterprises, one of which is STAR STABLE ONLINE, which is a colourable attempt to use the domain name to mislead internet users into thinking that by using the disputed domain name they have arrived at a website that either is the website of the Complainant or a website that is approved or endorsed by the Complainant, neither of which is true.

The other enterprises advertised on the website do not appear to have any connection with the Complainant, although some of them are associated with children's games which must suggest to internet users that they have arrived at the Complainant's site or one endorsed or approved by it, which is not so.

The Complainant therefore wishes to have the Domain Name transferred to itself to stop a continuing abuse of its trademark.

PARTIES CONTENTIONS

CONTENTIONS OF THE PARTIES

COMPLAINANT

The Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

The Complainant was founded in 2011 and is a privately held company located in Sweden operating the online horse game <starstable.com>.

The Complainant is the owner of the registered STAR STABLE trademarks, details of which are provided under Identification of Rights in this decision. Complainant submits evidence to verify the registrations.

The Domain Name <stastable.com> was initially registered in 2013 but has since then changed registrars. The last change was in 2018 and as such, the current creation date with the owner is set to 2018.

The Domain Name is identical to the STAR STABLE trademarks except for a spelling variation of the Complainant's trademark that omits the letter "r". This alteration does not diminish the similarity between the Domain Name and the Complainant's mark. The generic Top-Level Domains (gTLD), in this case ".com" is typically disregarded under the first element confusing similarity test, as it is a standard requirement for registration. Therefore, the Domain Name is confusingly similar to the Complainant's trademark.

A. Respondent has no rights or legitimate interests in respect of the Domain Name

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 owner is anonymous. Should the Respondent have any legitimate interest in the Domain Name it would most likely not have chosen to monetize the website by adding pay per click links related to the Complainant's activity.

Nor would Respondent have published the Domain Name for sale.

The Domain Name resolves to a parked page which shows links to third party websites. The sponsored links refer to the Complainant and its field of activities (such as online playing games, kids games, horse games etc). These links capitalize on the reputation and goodwill of the Complainant and its trademark and do not give Respondent a right or legitimate interest in the Domain Name.

Moreover, the Respondent's name does not correspond with the Domain Name and Respondent does not appear to have any trademark rights associated with the term Star Stable.

The Respondent has not used the Domain Name in connection with a bona fide offering of goods or services nor for a legitimate noncommercial or fair purpose but rather to offer the Domain Name for sale and not to redirect to any legitimate content on the Internet. Previous UDRP panels have recognized that the mere registration of a domain name, does not by itself automatically confer rights or legitimate interests in a disputed domain name.

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

The Domain Name was registered and used in bad faith because it included the Star Stable trademark which was done intentionally to capitalize on the good will of that mark. That is so because what clearly happened here is that a confusingly similar domain name was registered and caused to resolve to a website that was linked to a pay per click website showing that the main purpose of the registration was to exploit the trademark and probably for profit.

The Respondent was aware of the trademark at the time it registered the Domain Name. STAR STABLE is a well-known

trademark in the online video game industry and Respondent must have been aware of it and its value.

The Respondent has no relationship to the trademark and the Domain Name has no meaning other than for referring to Complainant's name and trademark.

There is no legitimate reason for registering the Domain Name as there is no legitimate use that could be made of the Domain Name.

Consequently, Respondent should be considered to have registered and to be using the Domain Name in bad faith.

RESPONDENT

Respondent did not file a Response in this proceeding.

RIGHTS

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

A. Administrative compliance

Pursuant to paragraph 4 (c) of the Rules, the CAC reviewed the Complaint for administrative compliance with the Policy and the Rules and found that it was compliant.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) The respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the STAR STABLE trademarks and as such has rights in those trademarks.

The Panel next finds that the Domain Name <stastable.com> is confusingly similar to the STAR STABLE trademarks for the following reasons.

First, the domain name includes the entirety of the STAR STABLE trademark, merely omitting the letter "r" from between the word "Star" and the word "Stable" in the trademark. It is apparent to the reader that the entire STAR STABLE trademark has been used and that this slight spelling alteration has been made to conceal the fact that Respondent is in effect copying the trademark and making an attempt to show that it is a genuine domain name of the Complainant.

Secondly, even with the spelling alteration, the internet user would readily conclude that the domain name is seeking to reproduce the entire trademark.

Thirdly, taken as a whole, the domain name would convey to the objective bystander that it related to the activities of the Complainant, giving rise to inevitable confusion.

It is also now well established that the addition of a generic top level domain, such as ".com" in the present case, cannot negate confusing similarity that is otherwise present, as it is in the present case.

Finally, in every respect the internet user would conclude that the Domain Name is similar to the trademark and that this similarity is likely to confuse internet users as to whether the Domain Name is legitimate or not.

Accordingly, the Panel finds that the domain name is confusingly similar to the Complainant's trademarks.

The Complainant has thus made out the first of the three elements that it must establish.

B. RIGHTS AND LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Domain Name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [respondent] of the dispute, your use of, or 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) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [respondent] are making 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the Domain Name.

That prima facie case is made out from the following considerations.

It is clear that the Respondent has taken the trademark of the Complainant and used it in its domain name, making only a minor spelling alteration which could not negate the confusing similarity which is otherwise present, as it is in the present case.

It is apparent from the evidence that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the trademark STAR STABLE and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that the Respondent is not commonly known by the Domain Name under Policy 4(c)(ii).

The Domain Name also points to a website with commercial links in relation to the Complainant and its competitors. It is now well established that such conduct cannot give rise to a right or legitimate interest in the Domain Name and the Panel so holds in the present proceeding.

The Domain Name has also been advertised for sale. This evidence shows that the Respondent was trying to advance its own interest by trading on the Complainant's good name and then giving the impression that the Domain Name and its website were created with the agreement or under the auspices of the trademark owner, the Complainant, thus enabling Respondent to sell it.

These facts give rise to the prima facie case made out by the Complainant. The Respondent has not filed a Response or used any other means to show that it has a right or legitimate interest in the Domain Name.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the Domain Name.

The Complainant has thus made out two of the three elements that it must establish.

C. REGISTERED AND USED IN BAD FAITH

The Complainant must prove on the balance of probabilities both that the Domain Name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the 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 site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the Domain Name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b) (iv) of the Policy and probably within other provisions of paragraph 4 (b).

That is so for the following reasons.

First, the Complainant submits that Respondent was aware of Complainant and its well-known trademark at the time of registration of the Domain Name. The Panel agrees. Because of the fame and strong reputation of the STAR STABLE trademark, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the Domain Name. Thus, it uses the actual words of the trademark in the Complaint and makes only a minor spelling alteration to the trademark. It is highly likely that the Respondent chose such combination of words to invoke the concept of the Complainant and its activities. By that means the Respondent, in registering the Domain Name deceptively and without any authority to do so, must be taken to have created a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Accordingly, the Domain Name was registered in bad faith.

The Panel has examined the website to which the disputed domain name resolves and it is apparent from that examination that the Respondent has registered the Domain Name and caused it to resolve to a web site that carries advertisements for various enterprises, one of which is STAR STABLE ONLINE. This is a colourable attempt to use the Domain Name to mislead internet users into thinking that by using the Domain Name they have arrived at a website that either is the website of the Complainant or a website that is approved or endorsed by the Complainant, neither of which is true.

The other enterprises advertised on the website do not appear to have any connection with the Complainant, although some of them are associated with children's games which must suggest to internet users that they have arrived at the Complainant's site or one endorsed or approved by it, which is not so.

Secondly, the Domain Name was in all probability registered and used in bad faith because it included the STAR STABLE trademark which was done intentionally to capitalize on the good will of that mark. That is so because what clearly happened is that a confusingly similar domain name was registered and caused to resolve to a website that was linked to a pay per click website showing that the main purpose of the registration was to exploit the trademark and probably for profit.

Thirdly, Respondent has no relationship to the trademark and the Domain Name has no meaning other than for referring to Complainant's name and trademark.

Fourthly, there is no legitimate reason for registering the Domain Name as there is no legitimate use that could be made of the Domain Name.

Fifthly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the Domain Name using the STAR STABLE mark and in view of the conduct that Respondent has engaged in when using the Domain Name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

Accordingly, the Complainant has made out the third of the three elements that it must establish.

The Complainant is therefore entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. STASTABLE.COM: Transferred

PANELLISTS

Name	The Hon. Neil Brown, QC
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DATE OF PANEL DECISION 2021-03-31

Publish the Decision
