

Decision for dispute CAC-UDRP-103873

Case number CAC-UDRP-103873

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Domain names Starstable.codes

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Star Stable Entertainment AB

Complainant representative

Organization SILKA AB

Respondent

Name Gabriella Garlo

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 the owner of several trademark registrations for STAR STABLE:

- EUTM reg. 008696775 Star Stable, filed on 18/11/2009 and granted on 05/04/2010, for products in class 9;
 - EUTM reg. 013204128 STAR STABLE, filed on 27/08/2014 and granted on 13/01/2015, for products/services in classes 16, 25, 28 and 41;
 - EUTM reg. 014171326 STAR STABLE (fig), filed on 26/05/2015 and granted on 21/09/2015, for products/services in classes 9, 16, 25 and 41;
 - US reg. 3814190 STAR STABLE, filed on 19/11/2009 and granted on 06/07/2010, for products in class 9; and
 - US reg. 4944619 STAR STABLE (fig), filed on 08/06/2015 and granted on 26/04/2016, for products/services in classes 9, 16 and 41.
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FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

A. The domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

About Complainant

Founded in 2011 in Stockholm, Sweden, Complainant is the maker of the popular adventure game Star Stable Online – the currently #1 ranked and fastest-growing horse game in the world. Over the years Complainant has extended their product line to music, publishing and several apps. Star Stable Online is the exciting online game where adventures, horses, and mysteries are waiting to be explored.

The Complainant has also a significant presence on various social media platforms, such as Facebook, Youtube, Instagram, Google+ and Twitter.

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

TRADEMARK TRADEMARK 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 OHIM 008696775 05/04/2010 EU

STAR STABLE OHIM 013204128 13/01/2015 EU

Figurative

OHIM 014171326 21/09/2015 EU

See 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 trademark registrations predates the registration of the disputed domain name. 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.

Identical or confusingly similar

The disputed domain name <Starstable.codes> which was registered on February 1, 2021 incorporate in full the Complainant's registered trademark STAR STABLE coupled with the generic gTLD "codes". This word is closely connected to the Complainant's activity as Star Stable Codes will get you free rewards in the game. The generic Top-Level Domain (gTLD), in this case ".codes" is typically disregarded under the first element confusing similarity test, as it a standard requirement for registration and does not negate a finding of similarity between the Complainant's trademark and the disputed domain name. Therefore, the disputed 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 disputed domain name;

(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

First of all, there is no bona fide offering of goods or services where the disputed domain name incorporates a trademark which is not owned by Respondent, nor is the Respondent known by the name "Star Stable". On the contrary, the Complainant is known under the name Star Stable especially connected to the term codes since the Complainant uses code vouchers to purchase in game attributes. The legal entity displayed in the Whois record is redacted. The disputed domain name resolves to a parked page which shows links to third party websites. These links therefore capitalize on the reputation and goodwill of the Complainant and its trademark. Therefore, the Respondent has no rights or legitimate interests in respect to the disputed domain name. Obviously, the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services nor for a legitimate non-commercial or fair purpose. Previous UDRP panels have recognized that the mere registration of a domain name, does not by itself automatically confer rights or legitimate interests in the disputed domain name (see WIPO Overview 3.0, section 2.10.) Moreover, Panels have constantly found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links capitalize on the reputation and goodwill of the complainant's marks or otherwise mislead Internet users.

C. The disputed domain name was registered and is being used in bad faith.

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

It is not of itself illegitimate to register domain names and use them for a monetization program. However, when the domain name is registered incorporating a trademark only to capitalize on the good will of that mark, it isn't good faith use. Such use of the disputed domain name which is confusingly similar with Complainant's trademark is a clear indication that Respondent registered the disputed domain names primarily for the purpose of taking advantage of the trademark STARSTABLE. Furthermore, the disputed domain name is registered in the gTLDs "code", which is closely related to the Complainant's services.

On April 20, 2020, the Complainant sent a cease-and-desist letter to the Registrar since asking the Registrar to forward the letter to their end-customer. A reminder was sent on May 4, 2021. In the letter the Complainant requested the Respondent to cease the use of the disputed domain name and transfer it to the Complainant on the basis of the Complainant's trademark. The Respondent failed to respond to the letter. If the Respondent had any legitimate interest in the disputed domain name, they would have at least responded to the initial communication sent by the Complainant.

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 registrations. Respondent bears no relationship to the trademark and the disputed domain name have no other meaning except for referring to Complainant's name and trademark and there is no way in which the disputed domain name could be used legitimately. Consequently, Respondent should be considered to have registered and to be using the disputed 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

I. RIGHTS

The disputed domain name is identical or confusingly similar to the Complainant's registered trademarks since it reproduces the Complainant's mark 'STAR STABLE'.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the domain name in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D20020856:

"As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed domain name, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists." WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, currently the domain name in dispute is redirected to a parking website containing sponsored links. Obviously, this use cannot be considered as legitimate, as such links capitalize on the reputation and goodwill of the complainant's marks or otherwise mislead Internet users.

Furthermore, apparently the Complainant sent a C&D letter to the Responded and failed to respond.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant's allegations and evidence with regard to the Respondent's registration and use of the disputed domain name in bad faith.

The Complainant has filed evidence of the well-known character of its STAR STABLE trademark in the online video game industry. The disputed domain name resolves to a parking with sponsored links. It seems clear that the Respondent is trying to impersonate the Complainant.

It is therefore logical to think that the Respondent registered the domain name for this fraudulent purpose.

Paragraph 4(b) (iiii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of a product or service on its website or location.

As mentioned in *Andrey Ternovskiy dba Chatroulette v. Alexander Ochki*, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see *AT&T Corp. v. Amjad Kausar*, WIPO Case No. D2003-0327)."

It has, therefore, been satisfactorily demonstrated to the Panel that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **STARSTABLE.CODES**: Transferred

PANELLISTS

Name	José Ignacio San Martín
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DATE OF PANEL DECISION 2021-07-16

Publish the Decision
