

Decision for dispute CAC-UDRP-100480

Case number CAC-UDRP-100480

Time of filing 2012-07-09 14:06:02

Domain names volcano-club.com

Case administrator

Name Tereza Bartošková (Case admin)

Complainant

Organization Ritzio Entertainment Group

Respondent

Organization GBpress LTD

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant shows to be the holder of the International verbal trade mark "VOLCANO", registered under number 989103 on 11 August 2008 in classes 9, 16, 21.

FACTUAL BACKGROUND

Complainant is the Limited Liability Company Ritzio Entertainment Group Limited, incorporated under the laws of the Republic of Cyprus under the number 102055, registered at Diagorou 4, KERMIA BUILDING, 6th floor, Flat/Office 601 P.C. 1097, Nicosia, Cyprus (hereinafter – the "Complainant"). Complainant shows to be the holder of the International verbal trade mark "VOLCANO", registered in classes 9, 16, 21.

The Disputed Domain Name <volcano-club.com> was created on 17 September 2010 and is registered by GBpress LTD, located at Portland House, Glacis Road, Gibraltar, Respondent in this case. Respondent uses the Disputed Domain Name in connection with a website on which gaming services are offered. Complainant argues that its 'VOLCANO' trademark is used in connection to gaming services and requests the transfer of the Disputed Domain Name.

PARTIES CONTENTIONS

COMPLAINANT: Complainant considers the Disputed Domain Name "VOLCANO-CLUB.com" to be identical to the complainant's registered 'VOLCANO' trademark. Furthermore, Complainant considers Respondent not to have any rights or legitimate interest in the domain name. Finally Complainant contends that the Disputed Domain Name was registered and is being used in bad faith.

RESPONDENT: NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

Complainant has rights in the international trademark 'VOLCANO' (word mark), registered under number 989103 on August 11, 2008. The disputed domain name is not identical to Complainant's VOLCANO trademark. However, the Panel considers the disputed domain name to differ from Complainant's trademark by the addition of a hyphen and the generic word 'CLUB'. The Panel is of the opinion that the mere addition of non-distinctive text and a hyphen to a complainant's trademark constitutes confusing similarity, as set out in paragraph 4(a)(i) of the Policy (See Lime Wire LLC v. David Da Silva/Contactprivacy.com, WIPO Case N° D2007-1168, where the domain name <downloadlimewirenow.com> was held to be confusingly similar to the LIME WIRE trademark, especially with addition of the word "download" because users typically download complainant's software; International Business Machines Corporation v. Scott banner, WIPO Case N° D2008-0965, where the domain name <ibmdownload.com> was held to be confusingly similar to the IBM trademark because many Internet users would assume that the Domain Name identifies a website from which they can download software supplied by the Complainant; Nintendo v. Beijin, WIPO Case N° D2001-1070, where the addition of the words 'mail', 'post', 'fan' and 'top50' to the word 'POKÉMON' in the disputed domain names was held to be of minimal impact on what the visitor of the website focuses on, namely the word 'POKÉMON'; Nintendo v. Gray West International, WIPO Case N° D2000-1219, where it was held that the addition of the word 'games' in the domain name does nothing to reduce its confusing similarity with Nintendo's POKÉMON marks); Dr. Ing. h.c. F. Porsche AG v. Kentech, Inc. a.k.a. Helios Lab a.k.a. Orion Web a.k.a. Titan Net a.k.a. Panda Ventures a.k.a. Spiral Matrix and Domain Purchase, NOLDC, Inc., WIPO Case No. D2005-0890, where the domain name <Porsche-repair-parts.com> was held to be confusingly similar to the trademark PORSCHE).

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

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not shown, to the satisfaction of the Panel, that the Respondent has no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

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

It is established case law that it is sufficient for Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the domain name in order to place the burden of rebuttal on Respondent. (See: Champion Innovations, Ltd. v. Udo Dussling (45FHH), WIPO Case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003 0455; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110).

Complainant considers that Respondent has no rights to use the 'VOLCANO' trademark and that Respondent would therefore have no rights or legitimate interest in the domain name <volcano-club.com>. At the same time, Complainant states that the website linked to the disputed domain name may be described as "virtual gaming club Vulkan, where the users have the possibility to gamble." The website linked to the disputed domain name indeed appears to be offering gaming services and shows stylized letters showing the Russian word for 'volcano'.

According to the Panel, 'VOLCANO' does not only refer to Complainant's trademark, but it also is a generic word. Hence, third parties can make legitimate uses of the 'VOLCANO' word. Complainant argues that its 'VOLCANO' trademark is strongly associated with games, organized by Complainant and other companies from Complainant's company group. However, this is not apparent from Complainant's trademark registration and Complainant did not provide – at least not in the language it chose for these proceedings – any evidence of its use of the 'VOLCANO' trademark in connection to gaming services. Therefore, the Panel is of the opinion that Complainant is not making any prima facie showing of why Respondent would not be allowed to identify itself as a "virtual gaming club Vulkan" and to operate under the disputed domain name <volcano-club.com> that it uses in connection to gaming services. Therefore, Complainant failed to show that the Respondent has no rights or legitimate interests in respect of the Domain Name

BAD FAITH

In light of the findings set out above, it is unnecessary for the Panel to make any determination on bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The language of the Registration Agreement between the Registrar and the Respondent is Russian, therefore the language of the proceeding should have been Russian too. However, the Complainant asks to change the language of proceeding from Russian to English.

As many panelists have decided in equivalent UDRP cases, the language of administrative proceeding can be changed under the paragraph 11 of the UDRP Rules if the circumstances indicate that the Respondent can understand the complaint and other documents in the new language ((See e.g., *The Dow Chemical Company v. Hwang Yiyi*, WIPO Case No. D2008-1276, decision according to which, where a respondent can clearly understand the language of the complaint, and the complainant would be disadvantaged by being forced to translate, the language of proceedings can remain the language of the complaint, even though it is different to the language of the Registration Agreement). According to the Registrar's Whois information, the Respondent is residing in Gibraltar. The official language of Gibraltar is English. Furthermore, the domain name includes the English word "club" and it terminates with the combination "com". The games offered on the web-site, linked to the disputed domain name are named with the English words ("Fruit cocktail" "Crazy Monkey", "Resident", "Lucky Lady's Charm", etc.). These circumstances indicate that the Respondent understands English and that the use of English would not result to any relevant disadvantages for the Respondent.

Therefore, 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

Complainant has shown to have trademarks in the 'VOLCANO' trademark. The addition of a hyphen and the generic term 'club' do not take away the confusing similarity between the disputed domain name and Complainant's 'VOLCANO' trademark. However, 'VOLCANO' is also a generic word. Respondent seems to use this word in connection to gaming services. Complainant did not provide any evidence showing that its 'VOLCANO' trademark would be used in connection to those services. Complainant fails to make a prima facie showing that this use would not be legitimate or that Respondent should have Complainant's approval to register and use the Disputed Domain Name for the provision of gaming services.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **VOLCANO-CLUB.COM**: Remaining with the Respondent
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PANELLISTS

Name	Flip Petillion
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DATE OF PANEL DECISION 2012-08-16

Publish the Decision
