Decision for dispute CAC-UDRP-101044

Case number	CAC-UDRP-101044
Time of filing	2015-09-01 11:21:08
Domain names	DANSKESPIL.CASINO

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Danske Spil A/S

Complainant representative

Organization	Zeusmark Consulting Group, Jean-Jacques Dahan

Respondent

Organization	Kortea AB

OTHER LEGAL PROCEEDINGS

No legal proceeding has been commenced or terminated in connection with the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several registered word and figurative trademarks in Denmark for DANSKE SPIL, including the word trademark No. VR 2012 01590, registered on June 25, 2015, in classes 16, 36 and 41, and the figurative marks VR 2001 00116, registered on January 5, 2001, in classes 9, 16, 28, 35, 36, 41, 42 and 43, and VR 2006 01391, registered on April 19, 2006, in classes 16, 36 and 41.

The Complainant is also the owner of a large number of domain names containing the trademark DANSKE SPIL, including <danskespil.dk>, registered on May 29, 2000, <danskespil.com>, registered on March 15, 2008, <danskespil.net>, registered on July 29, 2009, and <danskespil.lotto>, registered on August 18, 2015.

FACTUAL BACKGROUND

The Complainant Danske Spil A/S is a Danish gaming company based in Denmark. The Danish Parliament founded the Complainant in 1948 and in 2002 the Complainant changed its company name from Dansk Tipstjeneste A/S to the current name Danske Spil A/S.

From 1948 up till January 2012 the Complainant had monopoly on providing gaming in Denmark and, after the partial

gaming liberalization in January 2012, the Complainant kept its 65-year-old monopoly on providing a number of games, including LOTTO and bingo.

Since 1948 the Complainant has marketed an increasing number of games and today the Complainant's gaming business includes all types of betting and lottery games distributed through authorized agents and online via the Complainant's official website "www.danskespil.dk".

The Complainant is the owner of trademark registrations for the word and figurative trademark DANSKE SPIL.

The disputed domain name <danskespil.casino> was registered on June 6, 2015, and is not pointed to an active website.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

A. COMPLAINANT

The Complainant highlights that the well-known character of its trademark DANSKE SPIL has been confirmed in previous UDRP decisions, such as Danske Spil A/S v. Peter Joergensen, WIPO Case no. D2011-0298, and in the decision issued by the Danish Supreme Court in the case Nos. 288/2009 and 289/2009, where it was found that the Complainant had established an unregistered right to the trademark and company name DANSKE SPIL since May 2008.

The Complainant contends that the disputed domain name is confusingly similar to the trademark DANSKE SPIL, in which it holds rights, as it fully incorporates the Complainant's registered and well-known trademark and company name DANSKE SPIL with the mere addition of the gTLD suffix ".casino". The Complainant asserts that it is an established and recognized principle under the UDRP that the presence of a generic top level domain such as the .casino designation is irrelevant in the comparison of a domain name to a trade mark.

The Complainant submits that the Respondent has not received any license or consent, express or implied, to use the Complainant´s trademark DANSKE SPIL in the disputed domain name or in any other manner from the Complainant, nor has the Complainant agreed in any way to such use or application by the Respondent.

The Complainant further states that, to the best knowledge of its knowledge, the Respondent has no legitimate rights in the disputed domain name since i) the Respondent did not use the disputed domain name as a trademark, company name, business or trade name prior to the registration of the disputed domain name, nor is the Respondent otherwise commonly known in reference to the name; and ii) the disputed domain name has not been used for an active website since its registration, thus it was not used in connection with a bona fide offering of goods and services.

With reference to the registration of the disputed domain name in bad faith, the Complainant states that, in light of the fact that the Complainant's company name and trademark DANSKE SPIL has been used 11 years before the Respondent's registration of the disputed domain name and due to well-known character of the Complainant's trademark, it is inconceivable that the Respondent registered the domain name without prior knowledge as to the existence of the Complainant and its trademark. The Complainant also claims that the Respondent´s registration of the disputed domain name prevents the Complainant from registering it and use the well-known company name and trademark DANSKE SPIL in the disputed domain name in connection with the Complainant's gaming business.

With reference to the bad faith use, the Complainant asserts that that the Respondent has passively held the disputed domain name as it has not used it in connection with an active website for more than two months. The Complainant alleges that the Respondent has intentionally attempted to attract Internet users to the its website by creating a likelihood of confusion with the Complainant´s trademark and that, as a result of the user traffic to its website, the Respondent could offer to sell the disputed domain name to the Complainant.

The Complainant also informs the Panel that the following domain names were transferred to the Complainant through

previous UDRP proceedings: <danskespil.org> (WIPO Case No. D2010-0087), <danskespil.info> (WIPO Case No. D2011-0298), <danskespil.net> (WIPO Case No.D2011-0299) and <danskespil.com> (WIPO Case No. D2011-0300).

B. RESPONDENT

No administratively compliant response has been filed.

RIGHTS

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

1. The disputed domain name includes the registered trademark DANSKE SPIL in its entirety, with the mere addition of the Top-Level suffix .casino, that must be disregarded under the identity and confusing similarity test as it is a necessary technical requirement of registration. Moreover, since the Complainant provides gambling services under the trademark DANSKE SPIL, the Panel finds that the addition of the suffix “casino” to the trademark in the disputed domain name is particularly apt to enhance the likelihood of confusion.

2. The Complainant has stated that the Respondent is not affiliated with or authorized by the Complainant in any way. The Respondent does not appear to have made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services since, based on the evidence on records, the disputed domain name has not been used in connection with an active website. In view of the above and considering that the Respondent has not submitted a Response, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

3. As to the bad faith at the time of the registration, the Panel finds that, in light of the Complainant’s registration and use of the trademark DANSKE SPIL since 2001 and of the well-known character of the trademark recognized also in prior UDRP and Court decisions, the Respondent was or ought to be aware of the Complainant's trademark when it registered the disputed domain name. The selection of the Top-Level suffix .casino, which is descriptive of one of the gaming services offered by the Complainant, supports the finding that the Respondent was indeed aware and targeted the Complainant and its trademark. In any case, given the reputation of the Complainant’s trademark as far as bad faith is concerned, the Respondent should have been aware of the Complainant’s rights as it was obliged to determine whether its domain name registration infringe or violate someone else's rights under paragraph 2 of the Policy.

As to the use of the disputed domain name, as mentioned above, the disputed domain name has not been used in connection with an active website, i.e. has been passively held. As established in a number of prior cases, the concept of “bad faith use” in paragraph 4(b) of the Policy includes not only positive action but also passive holding; see the landmark

case Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. Moreover, in view of the identity of the disputed domain name with the Complainant's trademark and the Top-Level domain in which it is registered, the Panel cannot conceive any active use of the disputed domain name that could be legitimate.

Therefore, the Panel concludes that the Respondent has registered and used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DANSKESPIL.CASINO**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2015-10-16

Publish the Decision