

Decision for dispute CAC-UDRP-104388

Case number	CAC-UDRP-104388
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Time of filing	2022-03-01 08:57:32
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Domain names	grandduke.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Name	Mindaugas Vaitkunas
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Complainant representative

Organization	Dimov Internet Law Consulting
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Respondent

Name	Henrik Pisky
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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

In this proceeding the Complainant relies on the following trademarks with the "GRAND DUKE" word element:

- the Japanese word trademark "GRANDDUKE" No. 1248195, registered on February 10, 1977, registered for goods in class 3;
- the UK word trademark "GRAND DUKE" No. UK00003505735, registered on October 9, 2020, registered for goods in classes 3, 5, 30, 32 and 34;
- the Swiss word trademark No. 759215 "GRAND DUKE", registered on February 11, 2021, registered for goods in classes 3, 5, 30, 32 and 34;
- the EU figurative trademark No. 018179583 "GRAND DUKE", registered on June 6, 2020, registered for goods in classes 3, 5, 30, 32 and 34; and
- the EU word trademark No. 018500786 "GRAND DUKE", registered on December 14, 2021, registered for goods in classes 3, 5, 30, 32 and 34.

The Complainant also refers to its various US, Canadian and Australian trademark applications with the "Grand Duke" word elements.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS.

The Complainant is the owner of the UK company GRAND DUKE GLOBAL LIMITED and the US company GRAND DUKE GLOBAL, INC. The Complainant has granted licenses to those companies to use the Complainant's trademarks. The Complainant's trademarks are protected for certain goods in classes 3, 5, 30, 32 and 34, including "soaps", "cosmetics" and "dentifrices".

The exact date of registration of the disputed domain name is unknown. The disputed domain name was initially registered in 2002 and the Complainant asserts that the Respondent registered the disputed domain name in 2012 or later. The Complainant claims that it extended its operations to Japan by recently purchasing the Japanese trademark "GRANDDUKE". The Complainant states that the disputed domain name is confusingly similar to the registered trademarks and the pending applications of the Complainant because the disputed domain name consists of the following three elements: (i) "grand"; (ii) "duke"; and (iii) ".com".

The first two elements of the disputed domain name (i.e., the elements "GRAND" and "DUKE") are identical to the trademarks of the Complainant. In the view of the Complainant, this clearly indicates confusing similarity between the disputed domain name and the Complainant's trademarks.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME.

The Complainant's submissions on the second element can be summarized as follows. According to the Complainant, the disputed domain name has not been used in connection with a bona fide offering of goods and services. The Complainant states that the website by the disputed domain name has been used for providing gambling services and services of online casino and the license of the operator has been suspended by the UK Gambling Commission.

The Complainant concludes that the use of the website by the disputed domain name to host an inactive online casino while falsely alleging that the operator is licensed to provide gambling services cannot be regarded as a use in connection with bona fide offering of goods and services.

The Complainant also claims that the Respondent has been engaged in unfair commercial practices. In particular, the Complainant refers to complaints by customers about the website by the disputed domain name and about its online casino. It also refers to violation of Google's Webmaster Guidelines (e.g. "cloaking" - the practice of presenting different content or URLs to human users and search engines), "black hat advertising" and advertising in jurisdictions where gambling is regulated (thus violating laws in these jurisdictions).

Based on the above, the Complainant claims that the Respondent is not engaged in a bona fide offering of goods or services. The Complainant contends that the Respondent does not have any trademarks corresponding to the disputed domain name and the Respondent is not otherwise commonly known by the disputed domain name.

The Complainant alleges that the Respondent does not make a legitimate non-commercial or fair use of the disputed domain name because the website was used for commercial purposes and the use of the website may tarnish the trademarks of the Complainant due to the association with a highly-criticized unlicensed and inactive casino.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH.

In respect of the bad faith element, the Complainant alleges that the disputed domain name "was registered in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the domain name registrant has engaged in a pattern of such conduct".

The Complainant claims that the disputed domain name was registered by the Respondent in 2012 or later. The Complainant provides information and evidence about previous registrants of the disputed domain name.

The initial registration date of the disputed domain name is December 31, 2002 and the disputed domain name changed various registrants. The Complainant notes that the initial registration date was after the date of the Japanese trademark registration. The Complainant claims that when the Respondent registered the disputed domain name, the Japanese trademark

“GRANDDUKE” was registered and publicly available for inspection. According to the Complainant, the Japanese trademark “GRANDDUKE” owned by the Complainant has been consistently in use at least since 1977 in relation to the sale of goods. Taking into account the global nature of Respondent’s business (online gambling services provided internationally), at the time when the disputed domain name was registered, the Respondent knew or should have known about the Japanese trademark of the Complainant.

A global trademark search would have revealed that the trademark “GRANDDUKE” is registered. The Respondent registered the disputed domain name in order to prevent the Complainant from reflecting its mark in the disputed domain name. The current use of the disputed domain name leads to tarnishing to Complainant’s trademarks, thus harming the reputation of the Complainant. The Complainant again refers to unfair commercial practices of the Respondent (e.g. “cloaking”).

The Complainant also states that some of the previous registrants of the disputed domain name and their related businesses were engaged in unlawful activities, i.e. referring to a decision of the Maltese court against one of the Respondent’s companies and referring to unlawful activities of a previous registrant in Israel. The Complainant indicates that frequent changes of IP address is also an indicator of changes of ownership of the disputed domain name. The Complainant highlights that the fact that 10 years passed since the registration of the disputed domain name does not prejudice the Complainant from submitting and a winning a UDRP claim.

The first registrant of the disputed domain name, “WebRe”, according to the Complainant, “had a history of bad behavior” and the Complainant refers to some of the previous UDRP decisions against “WebRe”.

The Complainant further cites some of these decisions where “WebRe” was the respondent.

The Complainant concludes that the disputed domain name had a long chain of owners who were engaged in illicit activities.

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

In the view of the Panel, taking into account findings in respect of bad faith, there is no need to consider this element for the purpose of this proceeding.

BAD FAITH

The Complainant has not, 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.

Unsolicited submission of the Complainant.

After beginning of the dispute, the Complainant submitted supplemental filing informing the Panel that after the submission of the complaint, the Respondent has shut down the website associated with the disputed domain name. The Complainant claims that this submission contains information which the Complainant could not have known before filing the complaint.

In the view of the Complainant, this indicates that: (i) the website is not currently used in relation to the legitimate provision of any goods and services; and (ii) the respondent has shut down the website in order to hide the evidence available.

As the Rules stipulate under par. 10:

(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

(d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), par. 4.6 in all such cases, panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some “exceptional” circumstance).

The Panel takes note of the Complainant’s additional submissions regarding content of the website by the disputed domain name after submitting of the complaint and is willing to accept them for the sake of completeness. However, the Panel finds them irrelevant for the purpose of the decision in this dispute.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar with Complainant’s trademark

The Complainant owns various trademarks with the “Grand Duke” verbal element.

As confirmed by WIPO Overview 3.0, see paragraph 1.2.1: “Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”.

The Panel notes that trademark applications do not establish trademark rights for the purpose of UDRP (see par. 1.1.4 of WIPO Overview 3.0) and therefore the Panel does not take into account pending trademark applications of the Complainant.

The Panel is uncertain about the Japanese trademark relied on by the Complainant.

The only proof of Complainant’s rights in the Japanese trademark is a copy of the assignment declaration signed by the Assignor (previous owner). However, there is no extract from the Japanese trademark registry confirming that the assignment was duly recorded. The date of the assignment deed is February 10, 2022, shortly before the complaint was submitted. Therefore, the Panel is not persuaded that the Japanese trademark was properly assigned to the Complainant on the date the Complainant submitted its complaint to the Czech Arbitration Court (February 27, 2022).

However, the Complainant provided evidence of its rights in respect of the other “Grand Duke” trademarks. The fact that the other trademarks were registered after the registration date of the disputed domain name is irrelevant for the first element analysis.

The disputed domain name fully incorporates the “Grand Duke” word trademark.

As stated in WIPO Overview 3.0 “It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name... While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.” (see par.1.7).

The Complainant’s “Grand Duke” mark is fully incorporated in the disputed domain name.

The Complainant’s mark is clearly recognizable within the disputed domain name as there is both visual and phonetic (aural) similarity between the disputed domain name and the Complainant’s “Grand Duke” trademarks. The disputed domain name is confusingly similar with the Complainant’s trademarks.

The gTLD suffix “.com” shall be disregarded under the confusing similarity test as it does not change the overall perception of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

In light of the Panel's finding in respect of the third element of UDRP and for the sake of speed and efficiency of this proceeding, it is unnecessary for the Panel to address the issue of the Respondent's rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith. These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element. Some of such factors are:

- (i) the nature of the domain name;
- (ii) the content of any website to which the domain name directs;
- (iii) the timing and circumstances of the registration;
- (iv) other indicia generally suggesting that the respondent had somehow targeted the complainant (see par. 3.2.1 of WIPO Overview 3.0).

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see par. 3.1 of WIPO Overview 3.0). Targeting of the complainant by the respondent is necessary in establishing bad faith under UDRP.

Complaints alleging the types of conduct described in UDRP paragraph 4(b) should be supported by arguments and available evidence. Even in cases of respondent default, panels have held that wholly unsupported conclusory allegations may not be sufficient to support a complainant's case.

The Complainant made a number of statements and assertions in this dispute and the arguments of the Complainant in respect of the bad faith element are related to complaints about online casino operated by the Respondent by the disputed domain name, negative reviews of this online casino, alleged unfair commercial practices by the Respondent and "bad behavior" of the previous registrants of the disputed domain name. The complaint submitted by the Complainant in this dispute is rather lengthy and detailed with over 50 annexes.

However, as noted before to succeed under the third UDRP element it is necessary to establish that the Respondent targeted the Complainant and its trademarks.

The Panel first notes, that the trademarks of the Complainant were registered after the registration date of the disputed domain name. The Complainant's trademarks were registered in 2020 and 2021, whereas the disputed domain name was registered by the Respondent either in 2012 or later however in any case earlier than the Complainant accrued trademark rights.

The Panel already noted that it has doubts as to the proper assignment of the Japanese trademark to the Complainant, the only mark cited by the Complainant with the registration date prior to the date of registration of the disputed domain name. According to par. 3.8.1 of WIPO Overview 3.0 where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent.

However, the Panel notes that even if the Complainant had provided evidence of proper assignment of the Japanese trademark, this would not have changed the outcome of this dispute as explained below.

The Complainant in his complaint alleges that the Respondent's conduct falls within 4 (b) (ii) of the UDRP, namely "the Respondent has registered the disputed 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". The pattern of conduct means, at least, more than one case and as explained by WIPO Overview 3.0: "this may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner.

A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-

abusive domain names corresponding to the distinct marks of individual brand owners” (see par. 3.1.2).

The Complainant, however, failed to provide any proof of pattern of conduct on the side of the Respondent.

The Complainant cited previous UDRP decisions in respect of the very first registrant of the disputed domain name “WebRe”. However, “WebRe” is not a party to this proceeding and is not a respondent in this dispute. The Complainant failed to provide any evidence of “pattern” in respect of the Respondent, Henrik Pisky.

As stated before, examples of bad faith are not exhaustive and other factors and circumstances may indicate bad faith even if Respondent’s conducts do not strictly fall under any of the scenarios described in 4 (b) of the UDRP, provided that a respondent takes unfair advantage of or otherwise abuses a complainant’s mark and had complainant’s trademark in mind while registering the domain name. However, no such evidence is available in this proceeding.

Second, the Complainant failed to provide any proof of use of his trademarks in relation to any goods whatsoever and any proof of Complainant’s trademarks reputation on the market.

To prove bad faith the Complainant needs to demonstrate targeting by the Respondent and in the present dispute there is no proof of targeting whatsoever.

The fact that the Respondent may have been engaged in unfair commercial practices and was operating an online casino breaching some rules and regulations on gambling are not material for this dispute.

UDRP is not designed to punish online businesses for their bad behavior per se or for any violations of rules applicable to such online businesses.

It is designed to deal with cybersquatting and tackle bad faith registration and use of domain names.

The Panel does not see any evidence in this proceeding that the Respondent intended to take unfair advantage of the Complainant’s trademarks in any way or somehow had the Complainant in mind when he registered the disputed domain name. The Complainant claimed that the Respondent should have been aware of the Japanese trademark registered in 1977, when he registered the disputed domain name. The Panel does not see how the Respondent could have been aware of the Complainant and its trademarks, even the Japanese trademark, since the Complainant failed to provide any evidence of its actual business operations under the “Grand Duke” trademarks and any fame and reputation of the “Grand Duke” marks.

The terms “Grand” and “Duke” are dictionary words and per se are not associated with the Complainant. Even if this Panel took into account the Japanese trademark, the Panel cannot see how the Respondent operating online casino business and based in France should have been aware of a trademark protected in Japan for goods in class 3 such as “soaps” and “detergents” in the absence of fame or reputation of such mark.

None of the trademarks of the Complainant are protected for gambling services and these marks have nothing to do with online casinos. There is no evidence on the record that the Respondent was aware of the Complainant and his trademarks.

Previous UDRP decisions confirm that in the absence of targeting, there can be no bad faith of the respondent, see e.g.: BlankPage AG v. Waleed Altywajri, WIPO Case No. D2012-2189 (“Is there anything to suggest that the Respondent was even aware of the existence of the Complainant when he registered the Domain Name? Again, the Panel has no information on the topic”); CAC Case No. 103374 (“the ICRM acronym is not unequivocally associated with the Complainant and is subject to a wide range of interpretations and uses. As indicated above, the Respondent is not targeting the Complainant or its trademark”); CAC Case No. 102970 (“Based on the facts and the evidence provided by the Complainant, the Respondent must not necessarily have been aware of the Complainant when registering the disputed domain name. The disputed domain name was registered on February 8, 2011, and the Complainant had just one registered trademark in Japan at that time”) and CAC Case No. 102809 (“Although no Response has been filed, the burden of proof rests with the Complainant...”).

Third, the Complainant spent a great deal of his complaint explaining bad reputation of Respondent’s online casino and bad reputation of previous registrants of the disputed domain name. However, this has nothing to do with the nature of this UDRP proceeding.

The Complainant, despite lengthy submissions and lots of annexes, failed to explain how Respondent’s behavior targeted the

Complainant's trademarks specifically and why the Respondent should have been aware of the Complainant and his trademarks.

To sum up, in this dispute there is no evidence of bad faith registration and use whatsoever, in particular taking into account: (i) the nature of the domain name and the trademarks – the domain name consists of dictionary words “Grand” and “Duke” that are not associated exclusively or primarily with the Complainant's trademarks and there is no proof of any reputation and popularity of Complainant's trademarks; (ii) the content of the website– there is no relation between the content of the website of the Respondent and the activities of the Complainant and his trademarks; (iii) the timing and circumstances of the registration – the disputed domain name had been registered before the registration of the Complainant's trademarks, with the exception of the Japanese trademark owned by a different entity for which the Complainant failed to provide proof of proper assignment and its transfer to the Complainant (and even providing a proper proof would not have changed the outcome) and (iv) other indicia generally suggesting that the respondent had somehow targeted the Complainant – other indicia are absent in this proceeding and there is no proof of targeting, in particular considering proximity of goods/services and proximity of the parties in this proceeding: the website by the disputed domain name has been used for online casino, whereas the Complainant's marks are protected for completely different products and the parties are located in different geographic regions, e.g. the US and France. There is no evidence that the Respondent was somehow aware of the Complainant and his “Grand Duke” trademarks.

Therefore, Panel holds that the third requirement of the Policy has not been satisfied and the complaint shall be rejected.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **GRANDDUKE.COM**: Remaining with the Respondent

PANELLISTS

Name	Igor Motsnyi / Mocni Konsalting doo
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DATE OF PANEL DECISION	2022-04-05
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Publish the Decision