Decision for dispute CAC-UDRP-104070

Case number	CAC-UDRP-104070
Time of filing	2022-01-17 10:05:13
Domain names	SBERGAMES.COM

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Sberbank of Russia

Respondent

Name	Enge Li Enge Li

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

Complainant indicates and provides evidence that is the owner of the following trademark registrations:

1. Russian wordmark SBERBANK, Reg. Nr. 463470, Date: 04.06.2012, for different services at Class 36 (as shown in an English translation provided by Complainant);

2. International Registration SBERBANK, Reg. Nr. 1097227, Date: 05.09.2011, for different services at Class 36, Designated countries: AT, BA, BX, BY, CN, CY, CZ, DE, FI, HR, HU, IE, IT, JP, PL, RS, SG, SI, SK);

3. International Registration СБЕРБАНК (in Latin transliteration – SBERBANK), Reg. Nr. 1109123, Date: 05.09.2011, for different services at Class 36, Designated countries: AT, BA, BY, CN, CZ, DE, HR, SG, SI, SK);

4. International Registration SBER, Reg. Nr. 1355502, Date: 09.02.2017, for different services at Class 36, Designated countries: AT, BA, BY, CH, CN, CY, CZ, DE, HR, KZ, RS, SI, SK, UA, GB, IN, TR, US);

5. International Registration SBER, Reg. Nr. 1565177, Date: 27.10.2020, for different services at Class 36, Designated countries: AT, BA, BY, CZ, DE, HR, KZ, RS, SI);

6. International Registration SBER, Reg. Nr. 1568173, Date: 10.11.2020, for different services at Class 36, Designated countries: AT, BA, BY, CZ, DE, HR, KZ, RS, SI);

7. Russian wordmark SBER, Reg. Nr. 623735, Date: 13.07.2017, for different services at Class 36 (as shown in an English translation provided by Complainant);

8. Russian wordmark СБЕР (in Latin transliteration – SBER), Reg. Nr. 433395, Date: 24.03.2011, registered in the Russian Federation concerning 1-45 classes (as shown in an English translation provided by Complainant).

FACTUAL BACKGROUND

The Complainant is Sberbank of Russia, a Russian company which owns several Russian and International Registrations with the term SBER such as SBERBANK, SBER & СБЕР (in Latin transliteration – SBER).

The trademarks are mainly registered at class 36 with respect to Banking, Insurance, Financial activities, etc. The Complainant claims to be one of the largest banks in Russia and Europe, with operations in many foreign countries of Central and Eastern Europe, as well as in China, India and Turkey. Furthermore, the Complainant claims that in Russia, Sberbank has more than 110 million customers. Under the company name and firm designation in which the word "Sberbank" is used, the Complainant carries out his activity since 1991.

According to the Complainant, Sberbank operates under the following firm name: Public joint-stock company "Sberbank of Russia" (abbreviated company: PJSC Sberbank). In English: Sberbank of Russia (Sberbank). The word "sber" is also used in the domain name of the Sberbank' web site (www.sber.ru).

The Respondent is a physical person residing in China which claims to be the owner of the Chinese company Anyang Shi Bi ER Trading CO, Ltd established on 6.9.2017.

The disputed domain name <sbergames.com> was registered by Respondent with DYNADOT LLC on October 31, 2020.

Before addressing the substantive requirements under the Policy, the Panel would like to address the Complainant's supplemental filing sent on February 22, 2022.

Without presenting any particular reason for seeking to file a supplemental filing, the Complainant tried to do so on using the following wording: "in response to the Respondent's response".

In light of the current UDRP doctrine and applicable Rules, the Panel does not consider that the Complainant's application to file a supplemental filing is justified since no specific reason was presented and, consequently, the Panel declines to accept the supplemental filing. The Respondent's supplemental filing will be treated similarly.

As a general rule, it is important to remind the Parties that neither the Policy nor the Rules expressly provide for supplemental filings. Their admissibility is therefore in the discretion of the Panel to ensure that the proceeding is conducted with due expedition and both parties are treated equally, with each party being given a fair opportunity to present its case.

In light of the above, the Parties should bear in mind that there is no clear right under the Rules to file supplemental filings. Here is important to adopt the wording issued at WIPO Case Nr. D2008-1889 where the Panel stated the following:

"The Center has rightly put before the Panel for consideration (or otherwise) at its discretion under the Rules the Complainant's unsolicited Supplemental Filings and e-mail in response received from the Respondent. In The E.W. Scripps Company v. Sinologic Industries, WIPO Case No. D2003-0447, this Panel summarised the position regarding supplemental filings in proceedings under the Policy in the following terms:

[']Under the Policy and the Rules, parties have no right to submit additional arguments or evidence. However, the Panel may, in its sole discretion, request further statements or documents from the parties under paragraph 10 of the Rules; and a party's request may be regarded as an invitation to the Panel to exercise this discretion.

The principles which should be applied in exercising this discretion have been considered in numerous cases decided under the Policy and Rules. The principles adopted and confirmed in these decisions are that additional evidence or submissions should only be admitted in exceptional circumstances, such as where the party could not reasonably have known the

existence or relevance of the further material when it made its primary submission; that if further material is admitted, it should be limited so as to minimise prejudice to the other party or the procedure; and that the reasons why the Panel is invited to consider the further material should, so far as practicable, be set out separately from the material itself.

These principles are based on the purpose of the Policy and Rules of providing an expeditious and relatively inexpensive procedure for determining a certain type of domain name dispute, in which each party is entitled to make just one submission. One of the matters which the Panel has to bear in mind is that the admission of a further submission from one party may lead the other party to submit a further document in reply, which may lead to a further submission by the first party, and so on, thereby compromising the procedural economy sought to be established by the Policy and the Rules.[']"

Since the Panel does not see any exceptional cirmstances to accept both supplemental filings, the Panel has decided not to accept them and, therefore, they will not be taken into account for the current decision.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

First element: Confusingly similar to the protected mark.

The Complainant argues to be the owner of intellectual property rights on the family of trademarks «Sberbank» and «Sber».

The Complainant states that the disputed domain name <sbergames.com> includes the identical word trademark "Sber" (WIPO Certificate № 1355502, Russian Certificate № 623735) and also is confusingly similar to the trademark «СБЕР» («SBER» in Latin transliteration, Russian Certificate № 433395), to the combined trademark «SBER» (WIPO Certificate № 1565177, WIPO Certificate № 1568173), "SBERBANK" (WIPO Certificate № 1025684).

The Complainant argues that the confusing similarity between the domain name <sberbank.org> (sic) and Sberbank's trademarks «SBER» is confirmed by sound (phonetic) similarity in connection with the inclusion of the element «Sber» in the disputed domain name. The Complaint states that the Word "Sber" has an identical pronunciation in Russian and English languages that enforce the phonetic similarity of a domain name with trademarks of the Complainant.

The Complainant asserts that there is a graphic (optical) confusing similarity between the disputed domain name <sbergames.com> and the Complainant's trademarks «SBER» according to WIPO Certificates № 1355502, 1565177, 1568173, the Russian Certificate № 623735 (on the assumption of the general visual perception; regarding use of the same alphabet in the name of «Sber» trademark and the disputed domain name <sbergames.com>).

Second element: Rights or legitimate interest.

The Complainant contends that the Respondent doesn't have any legal rights and real interests concerning the disputed domain name <sbergames.com>. In this sense, the Complainant indicates that it was not possible to contact Respondent to send a cease-and-desist letter directly due to the use of privacy/proxy registration services covering the Respondent's data as Registrant.

In September 2021, the Complainant argues that a request was sent by e-mail to the Registrar DYNADOT, LLC to disclose personal data of the administrator/holder of the disputed domain name <sbergames.com> (full name, postal and e-mail addresses, the telephone and telefax number) in order to send pre-trial claim to the administrator to stop the infringement of exclusive rights of the Complainant and transfer to Complainant the right of administration of the disputed domain name <sbergames.com>.

The Complainant states that they received a response from Registrar indicating that they would not release customer

information or account information without the express permission of the customer or when required by law. Thus, no concrete data about the administrator/registrant of the disputed domain name was provided.

The Complainant mentions that only as per January 17, 2022 (the moment of the start of these proceedings) the Registrar provided full information about the holder of the domain name: Name: Enge Li, E-mail Address: boris@88.com, Phone Number: +86 17839161 128, Address: Kaifeng JingSiLu YaohuaS hiyanZhongxue, City/Town: Kaifeng, State/Province/Reg ion: Henan, Zip/Postal Code: 475200, Country: China.

The Complaint was amended accordingly with the Respondent's data.

The Complainant indicates that Respondent has no relation to the business activities of the Complainant and didn't receive any written consent from the Complainant to use on the Internet, including the disputed domain name <sbergames.com>, the designations identical and/or confusingly similar to Sberbank's family of trademarks «SBER».

The Complainant points out that is one of the largest banks in Russia and Europe, has its representative offices and subsidiaries in many foreign countries, such as CIS countries as well as in several countries of the Central and Eastern Europe, and also in China, India and Turkey. Moreover, Sberbank operates in many other countries.

The Complainant indicates that it has more than 110 million customers. Under the company name and firm designation in which the word "Sberbank" is used, the Complainant carries out his activity since 1991. Since that moment according to the constituent documents, the Complainant operates under the following firm name: Public joint-stock company "Sberbank of Russia" (abbreviated company: PJSC Sberbank). In English: Sberbank of Russia (Sberbank). The word "sber" is also used in the domain name of the Sberbank' web site (www.sber.ru).

The Complainant states that in the absence of Respondent's right or real legitimate interest such administration of the domain name <sbergames.com> contradicts the provisions of the article 16 of the TRIPS Agreement. In accordance with article 16 of the Agreement on trade-related aspects of intellectual property rights (Marrakech, 15 April 1994, further referred as the "TRIPS Agreement"), the owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. The Complainant points out that such unfair use of the trademarks in the absence of permission of the right holder is recognized as the infringement of exclusive rights of the Complainant.

Finally, the Complainant states that the Respondent registered the disputed domain name for the Web-site http://sber.com/ (sic) that is used as a platform for placing advertising banners.

The Complainant contends that the «Privacy Policy» posted on the Web site related to the disputed domain name states that: "…its dynamically generated website that includes third-party advertising. These third-party advertising companies may use technologies to gather anonymous website statistics about your visits to this and other websites. These statistics may be used by these third-party advertising companies to provide ads of relevance. Our advertisers and us may have the occasion to collect information in regards to your computer for our services».

In this regard, Complainant indicates that the Respondent uses the Web-site in commercial purposes by providing the opportunity for the third parties to place advertising materials and attracting the consumers by using designations «Sber» in the disputed domain name <sbergames.com>.

Third element: The domain name has been registered and is being used in bad faith.

The Complainant argues that the designation «Sber» is used in the disputed domain name <sbergames.com> and on the Web-site with intention of the owner of the disputed domain name to provide advertising space to the 3rd parties, to attract as much as possible users by parasitizing on Sberbank's reputation and its well-known among the consumers and in the result to gain a profit.

The Complainant further states that when the users click on such advertising banners, they are redirected to the hyperlinks to the web sites that have nothing in common with the Complainant and aren't connected with the Complainant by any commercial relations.

The Complainant contends that the disputed domain name <sbergames.com> is used by Respondent illegally only for obtaining the benefits by granting to the 3rd parties the advertising space on the Web site. The use of the trademarks of Sberbank based on intention of the Web site's owner to increase rating (position) of Web site in Search Engines due to reputation and popularity of Sberbank among the population / customers. The purpose of the Web site's owner is to increase the number of visitors of the Web site by using trademark «SBER» in the domain name. Moreover, the use of the designation similar to the Sberbank's trademarks represent the act of unfair competition as they create obstacles to the Complainant to use in the Internet the information about Sberbank / SBER and its products and services with the use of trademarks "Sber" in the domain zone .com, including in the disputed domain name <sbergames.com>.

The Complainant concludes that actions also create infringement of trademark rights registered under the certificates with Russian national protection (trademark No. No. 623735) and international protection (trademarks No. No. 1355502, 1565177, 1568173).

RESPONDENT:

First element: Confusingly similar to the protected mark.

In his reply, the Respondent indicates that the disputed domain name <sbergames.com> is neither identical nor confusingly similar to the trademarks of the Complainant ("SBERBANK", "SBER" and their Russian version).

The Respondent further claims that "SBERBANK" and "SBER" trademarks listed by the Complainant are not well-known trademarks in the world. The Respondent also mentions that the Complainant does not own the "SBER" trademark in China and has no protection rights in China.

In addition, the Respondent indicates that many Chinese companies own the trademark "SBER", or trademarks containing the letters "SBER". "SBER" is not the Complainant's exclusive and proprietary trademark or name in the world.

The Respondent mentions that he has never been abroad and has never heard of the Complainant's company name and all its trademarks.

The Respondent indicates that "SBERBANK" and "SBER" trademarks held by the Complainant are all Class 36 trademarks for insurance, finance, monetary affairs and real estate affairs. In this regard, the disputed domain name <sbergames.com> held by Respondent is planned to be used by Respondent's company Shi Bi ER to engage in the games equipment business in China.

In accordance with Respondent, there is no conflict with the trademarks protected business held by the Complainant. The Complainant has no subsidiary in China, no actual business, especially no games equipment business.

Second element: Rights or legitimate interest.

The Respondent claims that his company Anyang Shi Bi ER Trading Co., Ltd, is a legal person of non-government enterprise registered in China's territory. The Respondent mentions that his company was established on September 6, 2017 with a registered capital of 1 million CNY.

The Respondent also states that his Last name is: Li and his First name is Enge, according to the custom of Chinese Last

name in the front, his name is: Li Enge. According to the custom of Western last name in the back, his name is: Enge Li. "Li Enge" and "Engel Li" are the same name.

The Respondent claims that he is the Legal Representative and general director of the company, and is fully responsible for the operation and management of the company. In accordance with Respondent, "SBER" is the English abbreviation of the company's English name "Shi Bi ER". On this point, Respondent claims to have legal rights to the company name and its English abbreviation "SBER".

The Respondent further claims that "SBER" is the English abbreviation of Shi Bi ER, the company he owns, and he has legally the right to use it. According to the business license issued by the Administration for industry and commerce of the People's Republic of China, Shi Bi ER has the right to legally engage in the business of machinery and equipment. In accordance with Respondent, Respondent’s company originally planned to start the games equipment business in 2019, registered the disputed domain name <sbergames.com> and was ready to use it for the website of Shi Bi ER games equipment business in 2020.

The Respondent concludes indicating that due to the severe impact of the Covid-19 epidemic, the business cannot be carried out smoothly for the time being.

Third element: The domain name has been registered and is being used in bad faith.

The Respondent mentions that Complainant wrote in Paragraph B(3) on page 9 of the Complaint that "The Respondent registered domain name for the Web-site http://sber.com/ that is used as a platform for placing advertising banners. It’s also confirmed by the «Privacy Policy» posted on the Web-site stating that its «dynamically generated website that includes third-party advertising." In this sense, Respondent claims that the Complainant provided the unrelated Web-site http://sber.com/ as evidence in an attempt to fabricate the facts. This is false evidence and has nothing to do with this Complaint.

Regarding the Complainant's point of using the domain name privacy protection service, the Respondent counterargues the following:

- This privacy protection service was provided by the domain name Registrar Dynadot, LLC for free and automatically when the Respondent registered the disputed domain <sbergames.com>. and it was not Respondent’s own initiative to set it up;

- The domain name privacy protection service can effectively prevent spam and advertisements, it is a common domain name service function.

On the issue of setting up advertisements on the website and using the reputation and well-known of the Complainant's company to attract visitors to the website to obtain commercial benefits, Respondent provided the following info:

As confirmed by the Registrar Dynadot, LLC, the website parking advertisement is automatically set when Respondent registered the disputed domain name “<sbergames.com>. Respondent indicates that he never actively set up the disputed domain name <sbergames.com> to park an ad page.

The Respondent also contends that the Registrar Dynadot, LLC does not offer domain name parking for profit and, therefore, the Respondent did not have any motive or possibility to obtain commercial benefits through website advertisements.

The Respondent claims again that he has never been abroad, have never heard of the Complainant's company and its trademarks, and had no motive or possibility to use its reputation and well-known to attract website visitors to obtain commercial benefits.

Furthermore, the Respondent points out that Complainant's complaint indicates that he maliciously used the domain name to obtain commercial benefits is unfounded.

The Respondent claims that he never considered getting commercial benefits by selling, leasing or parking domains, etc. The Respondent finally claims that he registered the disputed domain name <sbergames.com> for use in good faith for the games equipment business of Shi Bi ER.

Reverse Domain Name Hijacking.

The Respondent argues that Complainant's behavior of providing false information of the Respondent is a malicious complaint aimed at harassing him. The Respondent claims that the Complainant’s attempt is Reverse hijacking of the disputed domain name <sbergames.com>.

According to the facts and the disputed domain name <sbergames.com>, in the Holder/Registrant information provided by the Registrar DYNADOT,LLC. the Name of the Respondent is Enge Li. First Name: Enge, Last Name: Li.

The Respondent mentions that on the First page of the complaint, the Respondent's information filled in by the Complainant was: "Respondent. Respondent type: Domain holder (Registrant), First Name Enge Li, Last Name Enge Li”.

Respondent mentions that according to Paragraph 3(b)(xiii) of the Rules: "Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.".

According with Respondent, the Complainant provided wrong, invalid and illegal information of the Respondent and, therefore, the arbitration subject was wrong. The Respondent set outs that the arbitration object was Enge Li Enge Li, not the domain name holder, Enge Li. The Complainant arbitrated maliciously and attempted to hijack the domain name in reverse.

The Respondent indicates that Complainant's behavior of providing false information is a malicious complaint aimed at harassing him and, therefore, the Respondent requests to immediately reject the Complainant's illegal complaint and identify the behavior of the Complainant as Reverse domain name hijacking.

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 not 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

In accordance with Article 15 of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy), these Rules and any rules and principles of law that it deems applicable.

Article 4(a) of the Policy sets out the three elements which must be proved by the Complainant to be successful in the present administrative proceeding:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) Respondent does not have no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Below, the Panel present the review of the three elements based on the statements and documents submitted by the Parties.

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE TRADEMARK SBER OF THE COMPLAINANT.

The Policy in its Paragraph 4(a)(i) indicates the obligation of Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

In accordance with the evidence provided, Complainant owns different trademarks with the wordmark "SBER" with ownership at least since 2017. Furthermore, Complainant owns different trademarks with the wordmark “SBERBANK” at least since 2011.

In the present case, the disputed domain name is composed of the trademark SBER together with the generic term „GAMES”. Furthermore, the addition of the Top-Level Domain Name “.com” in a domain is considered as a standard registration requirement and, therefore, it should be disregarded under the first element confusing similarity test (see paragraph 1.11, WIPO Overview 3.0).

It is important to consider some important aspects defined by the UDRP Doctrine about the types of trademark rights which are encompassed by the expression “trademark or service mark in which the complainant has rights” for the purpose of the paragraph 4(a)(i):

1.1.1 The term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

1.1.2 Noting in particular the global nature of the Internet and Domain Name System, the jurisdiction(s) where the trademark is valid is not considered relevant to panel assessment under the first element.

Also, the goods and/or services for which the mark is registered or used in commerce, the filing/priority date, date of registration, and date of claimed first use, are not considered relevant to the first element test. These factors may however bear on a panel’s further substantive determination under the second and third elements.

See paragraph 1.1, WIPO Overview 3.0.

In light of the above, there is no need to review the argument presented by Respondent in the sense that “SBERBANK” and “SBER” trademarks held by the Complainant are all class 36 trademarks for insurance, finance, monetary affairs and real estate affairs and that the disputed domain name <sbergames.com> held by Respondent is planned to be used by Respondent’s company Shi Bi ER to engage in the games equipment business in China. For the purpose of this first element, the goods and services are not relevant.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is confusingly similar to Complainant’s mark.

2. RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME.

The Complainant contends that the Respondent doesn't have any legal rights and real interests concerning the disputed domain name <sbergames.com>. Furthermore, the Complainant indicates that Respondent has no relation to the business activities of the Complainant and didn't receive any written consent from the Complainant to use on the Internet, including the disputed domain name <sbergames.com>, the designations identical and/or confusingly similar to Sberbank's family of trademarks «SBER».

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach by UDRP panels, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it (see WIPO Overview 3.0., paragraph 2.1).

Based on Complainant's arguments, the burden of proof relies on the Respondent.

Paragraph 4 (c) of the Policy establishes the following non-exclusive respondent defenses to demonstrate rights or legitimate interest in a domain name:

(i) before any notice of the dispute, the respondent's 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) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
(iii) the respondent is 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.

For the purpose of this proceeding, the Panel will review the three defenses set out at Paragraph 4 (c) of the Policy in light of the evidence presented by Respondent in his reply:

(i) BEFORE ANY NOTICE OF THE DISPUTE, THE RESPONDENT'S 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.

The Respondent claims to be the owner of the Chinese company Anyang Shi Bi ER Trading Co., Ltd. On this point, Respondent provided with a Business License (in Chinese and with English translation) regarding the mentioned company. In the Business License, Mr. Li Enge (Respondent for this proceeding) appears as the Legal Representative.

The company was established on September 6, 2017 and it has the following business scope: sales: building materials, chemical products (excluding inflammable, explosive and dangerous chemicals), hardware and electromechanical products, iron ore products, mechanical equipment, coal (only for direct supply of coal for enterprise).

The Business License was issued by the Yindu District Market Supervision and Administration Bureau of Anyang City in China.

In his reply, the Respondent indicated that his company Anyang Shi Bi ER Trading Co, Ltd. has the right to legally engage in the business of machinery and equipment. Moreover, the Respondent argues that his company originally planned to start the games equipment business in 2019 and for this reason he registered the disputed domain name and it was ready to use it for the website of Shi Bi ER games equipment business in 2020. However, and due to the severe impact of the Covid-19 epidemic, the business cannot be carried out smoothly for the time being.

The Panel notices that no additional evidence was presented by the Respondent regarding the preparations to use the disputed domain name other than the Business License for the Chinese company Anyang Shi Bi ER Trading Co, Ltd.

The UDRP doctrine have held the following concerning examples to show use:

Non-exhaustive examples of prior use, or demonstrable preparations to use the domain name, in connection with a bona fide offering of goods or services may include: (i) evidence of business formation-related due diligence/legal advice/correspondence, (ii) evidence of credible investment in website development or promotional materials such as advertising, letterhead, or business cards (iii) proof of a genuine (i.e., not pretextual) business plan utilizing the domain name, and credible signs of pursuit of the business plan, (iv) bona fide registration and use of related domain names, and (v) other evidence generally pointing to a lack of indicia of cybersquatting intent. While such indicia are assessed pragmatically in light of the case circumstances, clear contemporaneous evidence of bona fide pre-complaint preparations is required.

Acknowledging that business plans and operations can take time to develop, panels have not necessarily required evidence of such use or intended use to be available immediately after registration of a domain name, but the passage of time may be relevant in assessing whether purported demonstrable preparations are bona fide or pretextual.

If not independently verifiable by the Panel, claimed examples of use or demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services cannot be merely self-serving but should be inherently credible and supported by relevant pre-complaint evidence.

See paragraph 2.2, WIPO Overview 3.0.

Since no additional evidence was presented other than the Business License, the Panel is of the opinion that the Business Licence for the company Anyang Shi Bi ER Trading Co, Ltd is not enough to show demonstrable preparations to use the domain name, in connection with a bona fide offering of goods or services; in particular taking into the account the following:

1. The disputed domain name <sbergames.com> is composed of the terms “SBER” and the generic term “GAMES”, however, in the Business Licence, there is no mention about the use of the term SBER as an abbreviation of Anyang Shi Bi ER Trading Co, Ltd.

2. As stated in the Business License, Respondent’s company has the following full name: Anyang Shi Bi ER Trading Co, Ltd which makes complicated to believe that SBER is the abbreviation of Shi Bi ER.

In accordance with Respondent, "SBER" is the English abbreviation of the company's English name "Shi Bi ER". In this vein, Respondent claims to have legal rights to the company name and its English abbreviation "SBER", however, Respondent failed to provide evidence supporting his rights over the English abbreviation “SBER”.

Moreover, the Respondent mentioned that several Chinese companies own the trademark "SBER", or trademarks containing the letters "SBER" but did not present any evidence to support this argument.

(ii)THE RESPONDENT (AS AN INDIVIDUAL, BUSINESS, OR OTHER ORGANIZATION) HAS BEEN COMMONLY KNOWN BY THE DOMAIN NAME, EVEN IF THE RESPONDENT HAS ACQUIRED NO TRADEMARK OR SERVICE MARK RIGHTS.

As confirmed by the Registrar’s verification dated January 14, 2022, the disputed domain name was registered using the following data:

Name: Enge Li E-mail Address: boris@88.com Phone Number: +86 17839161128 Address: Kaifeng JingSiLu YaohuaShiyanZhongxue City/Town: Kaifeng State/Province/Region: Henan Zip/Postal Code: 475200 Country: China

The UDRP doctrine have held the following with respect to this point:

For a respondent to demonstrate that it (as an individual, business, or other organization) has been commonly known by the domain name or a name corresponding to the domain name, it is not necessary for the respondent to have acquired

corresponding trademark or service mark rights.

The respondent must however be “commonly known” (as opposed to merely incidentally being known) by the relevant moniker (e.g., a personal name, nickname, corporate identifier), apart from the domain name. Such rights, where legitimately held/obtained, would prima facie support a finding of rights or legitimate interests under the UDRP.

Insofar as a respondent’s being commonly known by a domain name would give rise to a legitimate interest under the Policy, panels will carefully consider whether a respondent’s claim to be commonly known by the domain name – independent of the domain name – is legitimate. Mere assertions that a respondent is commonly known by the domain name will not suffice; respondents are expected to produce concrete credible evidence.

Absent genuine trademark or service mark rights, evidence showing that a respondent is commonly known by the domain name may include: a birth certificate, driver’s license, or other government-issued ID; independent and sustained examples of secondary material such as websites or blogs, news articles, correspondence with independent third parties; sports or hobby club publications referring to the respondent being commonly known by the relevant name; bills/invoices; or articles of incorporation. Panels will additionally typically assess whether there is a general lack of other indicia of cybersquatting. In appropriate cases panels may refer to the respondent’s domain name-related track record more generally.

See paragraph 2.3, WIPO Overview 3.0.

The Panel is of the opinion that the relevant moniker at the Whois database does not provide enough elements to support that the Respondent has been commonly known by the disputed domain name.

(iii) THE RESPONDENT IS 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.

In the complaint, the Complainant indicated that the Respondent registered the domain name for the Web-site http://sber.com/ (sic) that is used as a platform for placing advertising banners. Additionally, the Complainant contends that the «Privacy Policy» posted on the Web site related to the disputed domain name states that: “…its dynamically generated website that includes third-party advertising. These third-party advertising companies may use technologies to gather anonymous website statistics about your visits to this and other websites. These statistics may be used by these third-party advertising companies to provide ads of relevance. Our advertisers and us may have the occasion to collect information in regards to your computer for our services”. In this regard, Complainant indicates that the Respondent uses the Web-site in commercial purposes by providing the opportunity for the third parties to place advertising materials and attracting the consumers by using designations «Sber» in the disputed domain name <sbergames.com>.

Here is important to point out two relevant facts:

i) Complaint erroneously included in the above paragraph the disputed domain name as http://sber.com/; and

ii) Complainant forgot to include as evidence a copy of the website linked to the disputed domain name for the purpose of Panel’s review.

Regarding the mistake made by Complaint and pointed out by the Respondent of including in the argumentation the domain name http://sber.com/ rather than the disputed domain name, the Panel does not see any material issue to be raised since the Complaint corrected the argument at the end of the paragraph by including the rightful disputed domain name; i.e. <sbergames.com>.

However, the Panel is concerned about the lack of diligence of Complaint to include the evidence to prove the current use of the disputed domain name <sbergames.com>. On this topic, the Panel reminds Complaint about the applicable standard of

proof in UDRP cases following the application UDRP Doctrine:

The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”; some panels have also expressed this as an “on balance” standard. Under this standard, a party should demonstrate to a panel’s satisfaction that it is more likely than not that a claimed fact is true.

While conclusory statements unsupported by evidence will normally be insufficient to prove a party’s case, panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case e.g., where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent.

See paragraph 4.2, WIPO Overview 3.0.

Since in this case there was indeed a reply from Respondent, it is important to review what Respondent mentioned about the website linked to the disputed domain name. In this sense and rather than denying the content and/or use of the disputed domain name, the Respondent presented the following arguments regarding the current use of the disputed domain name:

- On the issue of setting up advertisements on the website and using the reputation and well-known of the Complainant's company to attract visitors to the website to obtain commercial benefits, Respondent provided the following info:

a. As confirmed by the Registrar Dynadot, LLC, the website parking advertisement is automatically set when Respondent registered the disputed domain name “<sbergames.com>. Respondent indicates that he never actively set up the disputed domain name <sbergames.com> to park an ad page.

b. The Respondent also contends that the Registrar Dynadot, LLC does not offer domain name parking for profit and, therefore, Respondent did not have any motive or possibility to obtain commercial benefits through website advertisements.

To support his argument, the Respondent included as evidence one communication with the Registrar dated 18.01.2022.

Since both Parties referred to the same use of the disputed domain name and absent of evidence of the use, the Panel, using the general powers of a Panel articulated inter alia in paragraphs 10 and 12 of the Rules, visited on February 22, 2022 the website linked to the disputed domain name in order to confirm the current use of the disputed domain name.

As to the general powers of the Panel, please refer to the following accepted UDRP Doctrine:

Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.

This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name, consulting historical resources such as the Internet Archive (www.archive.org) in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopedias (e.g., Wikipedia), or accessing trademark registration databases.

See paragraph 4.8, WIPO Overview 3.0.

In this sense, it appears that the Respondent is using the disputed domain name to direct consumers to a presumed Pay Per Click (PPC) parking page suggesting general links to websites that offered goods and/or services of different nature.

The Complainant indicates that the Respondent uses the website linked to the disputed domain name <sbergames.com> in commercial purposes by providing the opportunity for the third parties to place advertising materials and attracting the consumers by using designations «Sber» in the disputed domain name. On the contrary, the Respondent claimed that he

never actively set up the disputed domain name <sbergames.com> to park an ad page. In this sense, the Respondent provided, as evidence, a confirmation from the Registrar dated January 18, 2022 indicating that the website parking advertisement is automatically set when Respondent registered the disputed domain name “<sbergames.com>.

Panels have generally recognized that use of a domain name to post parking and landing pages or PPC links may be permissible in some circumstances, but would not of itself confer rights or legitimate interests arising from a "bona fide offering of goods or services" or from "legitimate non commercial or fair use" of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder» (see WIPO Overview of WIPO Panel Views).

It is important to mention that in the case of advertising links appearing on an "automatically" generated basis, panels have generally found that a domain name registrant is normally deemed responsible for the content appearing on its website, even if it is not exercising direct control over such content.

Here is important to include some important elements used by the UDRP Doctrine when it comes to applying UDRP paragraph 4 (c):

Panels have 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 compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.

Panels have additionally noted that respondent efforts to suppress PPC advertising related to the complainant’s trademark (e.g., through so-called “negative keywords”) can mitigate against an inference of targeting the complainant.

Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant’s (or its competitor’s) trademark.
See paragraph 4.8, WIPO Overview 2.9.

It is also important to point out that the Registrar informed the Respondent the following:

“The domain name was set to use our free parking service when it was registered, as your account settings are configured to use the parking service for any new domain name registrations. As no changes were made to the domain since registration the domain name has continued to use the parking service. You can find and edit your default name servers settings for new registrations here …“

This means that Respondent indeed has a possibility to chance the settings to delete the parking service but since the Respondent has not shown efforts to supress PPC advertising, there is no way to mitigate an inference of targeting the Complainant. In addition, Respondent has not been able to provide with enough evidence to confirm the reason behind the domain name registration. Therefore, Respondent has not shown any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name in accordance with the Policy.

In light of the facts at hand, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

3. THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH.

Paragraph 4(a)(iii) of the Policy indicates that Complainant must assert that the Respondent registered and is using the disputed domain name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed 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 Respondent has engaged in a pattern of such conduct; or

(iii) The Respondent has registered the disputed domain name primarily for the purpose of disrupting the competitor 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.

The Panel is of the opinion that the third element shall be reviewed carefully to be able to take the best decision. This view is supported by the current UDRP Doctrine which confirms that bad faith under the UDRP is broadly understood to occur where a Respondent takes unfair advantage of otherwise abuses a complainant's mark. Contrary to the first element of the Policy where Complainant only requires to demonstrate general trademark rights, when it comes to the review of the third element the burden of proof for Complainant is higher. In fact, the UDRP Rules in principle provide only for a single round of pleadings, and do not contemplate discovery as such. Accordingly, a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response unless exceptional circumstances.

See paragraph 3.1, WIPO Overview 3.0

The Complainant included the following arguments with respect to bad faith:

1. The Complainant argues that the designation «Sber» is used in the disputed domain name <sbergames.com> and on the Web-site with intention of the owner of the disputed domain name to provide advertising space to the 3rd parties, to attract as much as possible users by parasitizing on Sberbank's reputation and its well-known among the consumers and in the result to gain a profit.

2. The Complainant further states that when the user clicks on such advertising banners, he is redirected to the hyperlinks to the web sites that have nothing in common with the Complainant and aren't connected with the Complainant by any commercial relations.

3. The Complainant contends that the disputed domain name <sbergames.com> is used by Respondent illegally only for obtaining the benefits by granting to the 3rd parties the advertising space on the Web site. The use of the trademarks of Sberbank based on intention of the Web site's owner to increase rating (position) of Web site in Search Engines due to reputation and popularity of Sberbank among the population / customers. The purpose of the Web site's owner is to increase the number of visitors of the Web site by using trademark «SBER» in the domain name. Moreover, the use of the Respondent in the disputed domain name the designation similar to the Sberbank's trademarks represent the act of unfair competition as they create obstacles to the Complainant to use in the Internet the information about Sberbank / SBER and its products and services with the use of trademarks "Sber" in the domain zone .com, including in the disputed domain name <sbergames.com>.

4. The Complainant concludes that actions also create infringement of trademark rights registered under the certificates with Russian national protection (trademark No. No. 623735) and international protection (trademarks No. No. 1355502,

1565177, 1568173).

The Complainant argues that the designation «Sber» is used in the disputed domain name <sbergames.com> and on the Web-site with intention of the owner of the disputed domain name to provide advertising space to the 3rd parties, to attract as much as possible users by parasitizing on Sberbank's reputation and its well-known among the consumers and in the result to gain a profit. On the opposite, the Respondent claims that he has never been abroad, have never heard of the Complainant's company and its trademarks, and had no motive or possibility to use its reputation and well-known to attract website visitors to obtain commercial benefits.

In this vein, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

See paragraph 3.1.4, WIPO Overview 3.0

In the Complaint, Complainant only provided with evidence regarding the following three International Trademark with designations in China but there is no evidence as to whether those trademarks are fully registered and valid in China, where Respondent is located.

1. International Registration SBERBANK, Reg. Nr. 1097227, Date: 05.09.2011, for different services at Class 36, Designated countries: AT, BA, BX, BY, CN, CY, CZ, DE, FI, HR, HU, IE, IT, JP, PL, RS, SG, SI, SK).

2. International Registration СБЕРБАНК (in Latin transliteration – SBERBANK), Reg. Nr. 1109123, Date: 05.09.2011, for different services at Class 36, Designated countries: AT, BA, BY, CN, CZ, DE, HR, SG, SI, SK).

3. International Registration SBER, Reg. Nr. 1355502, Date: 09.02.2017, for different services at Class 36, Designated countries: AT, BA, BY, CH, CN, CY, CZ, DE, HR, KZ, RS, SI, SK, UA, GB, IN, TR, US).

The Complainant mentioned about having operations in China but did not include any supporting evidence. Furthermore, Complaint mentioned that Respondent is parasitizing with the disputed domain name on Sberbank's reputation and its well-known among the consumers, however, there is no evidence about the famous or well-known status of Complainant's trademarks.

It might be the case that the Sber trademarks are in fact "well-known" or "famous" but the Complaint has the obligation to formulate such claim in a convincing manner and bring the evidence to support the allegation.

Here is important to mention that Complainant amended the Complaint to redirect it against the Respondent. At that moment, the Complainant was made aware of the Respondent's full data – including location - and, therefore, the Complainant had the chance to also include facts to confirm the well-known status of its trademarks, trademark rights in China plus any additional consideration which could make the Panel confirm that the Respondent registered the domain name in bad faith.

The Panel relies on the current UDRP Doctrine about how a complainant proves a respondent's bad faith which indicates the following:

General evidentiary framework: complaints alleging the types of conduct described in UDRP paragraph 4(b) should be supported by arguments and available evidence such as dated screenshots of the website to which the disputed domain name resolves or correspondence between the parties. Even in cases of respondent default, panels have held that wholly unsupported conclusory allegations may not be sufficient to support a complainant's case.

Noting that the UDRP normally provides for a single round of pleadings without opportunity for discovery, panels have expressed an expectation that a complainant should anticipate and address likely plausible respondent defenses with

supporting arguments and evidence in its complaint.

See paragraph 3.1.4, WIPO Overview 3.0

The Panel reiterates that it is bound by Article 15 (a) of the Rules and that it should thus decide the complaint based on the statements and documents submitted by the parties. On the balance of probabilities, and given the lack of convincing evidence to demonstrate that the Respondent had constructive or prior knowledge of the Complainant's Sber trademarks, the Panel concludes that the Complainant failed to establish the third element of Paragraph 4(a) of the Policy.

For the record, the Panel is of the opinion that the facts of this case appear to give the Complainant a strong case under the Policy but the lack of any relevant evidence in the Complaint has left the Panel with the only alternative to deny the complaint.

Reverse Domain Name Hijacking.

Since Complainant was successful in the first and second element of the Policy, the Panel finds that this administrative proceeding was not brought in bad faith and, therefore, there is no abuse or Reverse Domain Name Hijacking to be granted as requested by the Respondent.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Victor Hugo Garcia Padilla, LL.M.**

DATE OF PANEL DECISION 2022-02-24

Publish the Decision