

Decision for dispute CAC-UDRP-104551

Case number CAC-UDRP-104551

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Domain names lottoarvonta.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Veikkaus Oy

Complainant representative

Organization Berggren Oy

Respondent

Organization Risto Myllymäki, Good Luck Media Ltd

Respondent representative

Organization Roschier Brands, Attorneys Ltd.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant holds rights to the Finnish trademark no. 130720 "LOTTO <fig.>", which has been registered on February 21, 1994 inter alia for the services "Lottery services and the organisation of lotteries." in class 36 (hereinafter referred to as "the Trademark").

FACTUAL BACKGROUND

The Complainant is a lottery and a game of chance service provider operating in Finland. The Complainant was founded in

1940 for sports betting and hosts a lottery in Finland since 1971. The Complainant is the only legally operating betting and game of chance service provider in Finland and holds a monopoly position that is based on law. Today, about 40 percent of adult Finns play the lottery ("Lotto" in Finnish) weekly and more than 80 percent of adult Finns have reported playing Lotto at least once.

The second level of the disputed domain name "lottoarvonta" contains the Finnish words for "lottery draw".

The Respondent registered the disputed domain name in October 2017 and is using it in connection with a website in Finnish featuring information on the Complainant's services, namely, lottery, betting, or games of chance, as well as information on third-party gambling services.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the Trademark as it includes the Trademark and the word "arvonta", which translates to "draw" and does not have any distinctive character due to its generic meaning.

The Complainant also states that the Respondent does not have any rights or legitimate interest with regard to the disputed domain name. The Complainant states that lottery and gambling operations in Finland are strictly regulated and may only be provided by the Complainant, that, to the Complainant's information and belief, the Respondent does not have any rights preceding those of the Complainant to the name "LOTTO", that the Respondent is neither affiliated with the Complainant nor authorized by it to use the trademark "LOTTO", that the Complainant does not have any business relationship with the Respondent, that the Respondent is not commonly known by the disputed domain name, and that the Respondent's use of the disputed domain name is neither non-commercial nor fair use but rather provides consumers with false and misleading information and marketing that is contrary to Finnish law on games of chance.

With regard to bad faith, the Complainant states that the disputed domain name was registered and is being used in bad faith. With regard to bad faith registration, it argues that the Respondent has clearly been aware of the Complainant's business as it directly targets and addresses the Complainant with its website. Regarding bad faith use, the Complainant contends that the disputed domain name is used to attract Internet users to the Respondent's website for commercial gain and that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor. The Complainant also argues that the Respondent's registration of the disputed domain name prevents the Complainant from reflecting its trademark in a corresponding domain name.

RESPONDENT:

The Respondent objects to the Complainant's contentions. It argues as follows:

- The Complainant does not own trademark rights to the word "lotto" but in trademarks that contain the word "lotto" with additional figurative or word elements. It further states that the word "lotto" has systematically been considered as being a non-distinctive word in Finland and that it is therefore clear that the Complainant's trademark registrations do not give exclusive trademark rights to the word "lotto". It further provides evidence that the Complainant filed several trademark applications for the mark "LOTTO" or marks containing the word "LOTTO" which all have been rejected by the Trademark Office of Finland (Finnish Patent and Registration Office) due to non-distinctiveness. One of the decisions also dealt with the Complainant's argument that the word "lotto" had become distinctive through use. The Respondent also asserts that the decisions of the Trademark Office of Finland are in line with the decisions of the EUIPO and cites several decisions to underpin this assertion. The Respondent also cites several decisions under the UDRP stating that decisions of trademark offices regarding the registrability of word marks may also be relevant in UDRP proceedings in relation to the issue of distinctiveness (esp. WIPO Case No. D2012-2211 (<fine-tubes.com>)).

- The Respondent further argues that the UDRP proceeding is a summary procedure where the Complaint should be found substantiated only when a case is sufficiently made out against a Respondent. Otherwise, the Complaint shall be rejected. It argues that the Complainant has failed to prove that it owns trademark rights to the word "lotto" and that the Respondent's claims are so plausible that the Panel shall conclude that the case is not sufficiently made out against the Respondent.

- With regard to the Respondent's rights or legitimate interests in the disputed domain name, the Respondent argues that it had used or made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services. The Respondent states that it is an online marketing company founded on 18 June 2018 and domiciled in Malta and that it is a very established and highly valued company in the field of online marketing. It further states that it has registered the disputed domain name, which consists of the descriptive words "lotto" ("lottery" in English) and "arvonta" ("draw" in English) for legitimate purposes which are in line with the Respondent's business activities. It contends that the purpose of the website is to provide information, that the Respondent, as a marketing company, does not compete with the Complainant in any manner, that the Respondent does not offer lottery or other gaming services, that the only purpose of the website is to provide consumers objective information on lotto results, rules of the game, background and history of lotto, different lotto game variations and gaming strategies, and that the content of the website relates to the words of the domain name.

- The Respondent also argues that the reference to the Complainant's trademarks such as "Veikkaus" are used on the website at the disputed domain name for legal reference purposes in line with the EU Trademark Directive and the Trade Marks Act of Finland, as the content of the website is informative and the Respondent has a right, supported by the law, to refer to the services offered by the Complainant.

- The Respondent also states that the disputed domain name has not been registered and used in bad faith. The Respondent - again - stresses the fact that "lotto" is a generic non-distinctive term and that including a generic and non-distinctive term in the domain name is not an indication of bad faith according to the case law. With regard to bad faith use, the Respondent argues that it uses the disputed domain name in connection with a website corresponding to its generic meaning.

- The Respondent further argues and provides evidence that there is a number of third-party websites containing information on the Complainant and its games using the word "lotto" in Finland, such as "<ottotulokset.net>", "<multilotto.com>", "<lottotulokset.online>", and "<lottonumerot.net>". It contends that the number of websites similar to the Respondent's website is high and the registration and use of the disputed domain name by the Respondent is normal and corresponds to the prevailing practice. The Respondent argues that extensive third-party use has been one of the factors against bad faith.

- Finally, the Respondent states that it does not compete with the Complainant in any manner, as it is domiciled in Malta and as an online marketing company it does not offer any gambling or lottery services in Finland. The Respondent states that its only purpose is to provide information and assessments relating to the lotto and other games, which is not only related to the Complainant, that the Respondent's website is visually highly dissimilar to the Complainant's website and that consumers are not confused or misled by the Respondent's website and cannot play lotto or any other game on the Respondent's website. The Respondent admits that it has of course been aware of the Complainant and the lotto game and that the Respondent's website contains referential and informative content relating to the lotto game provided by the Complainant.

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 not 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

It is not necessary for the Panel to come to a decision in this regard.

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.

Nonetheless, the panel must address two questions:

The first point to be dealt with is the Respondent's representative's request of 19 May 2022 to extend the deadline to file a Response, which was originally due on 23 May 2022. The request was based on the fact that the Respondent did not instruct the representatives until 18 May 2022 and that evidence to support the Respondent's submission could not be provided in the remaining short time. The Center extended the deadline to 28 May 2022. The Response was filed on 27 May 2022. The Panel assumes that the short extension of the deadline was in accordance with Article 5(b) of the Rules and is not objectionable.

The second point to be dealt with is the admissibility of the parties' supplemental submissions, which have been filed on 6 June 2022 and 8 June 2022. The Rules do not allow the parties to file supplemental submissions on their own volition, and paragraph 12 of the Rules provides that a panel may in its sole discretion request further statements or documents from either of the parties. Thus, no party has the right to insist upon the admission of additional arguments or evidence. Grounds justifying new submissions are generally those regarding the existence of new pertinent facts that did not arise until after the complaint was filed. In particular, if a respondent raises objections that reasonably could not have been anticipated when the complaint was filed, a panel can give the complainant a right to reply to the submission or may accept the complainant's unsolicited additional submission (cf. *Universal City Studios, Inc. v. G.A.B. Enterprises*, WIPO Case No. D2000-0416; *QNX Software Systems Ltd. v. Future Media Architects, Inc. and Thunayan K AL-Ghanim*, WIPO Case No. D2003-0921; *Goldline International, Inc. v. Gold Line*, WIPO Case No. D2000-1151). The Complainant does not cite any exceptional circumstances necessitating further submissions, nor does the Response itself disclose any new facts or new legal authority unavailable at the time the Complaint was submitted. Instead, the Complainant appears to have made the supplemental filing solely to reply to the Response. In the present case, such a reply is not justified under the Rules (cf. *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. D2000-0553; *Universal City Studios, Inc. v. G.A.B. Enterprises*, supra; *AIB-Vincotte Belgium ASBL, AIB-Vincotte USA Inc./Corporation Texas v. Guillermo Lozada, Jr.*, WIPO Case No. D2005-0485). Therefore, the Panel elects not to accept the Complainant's supplemental submission and has not relied on it in reaching this Decision. As a consequence, the Panel did not consider the Respondent's supplemental submission, responding to the Complainant's supplemental submission, either.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; and
- (ii) the Respondent has 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.

1.

The Panel accepts that the disputed domain name is confusingly similar to the Trademark.

It is well established that a domain name generally is to be considered as confusingly similar under the Policy where the trademark is recognizable within the disputed domain name.

Furthermore, it is the consensus view that trademark registrations with design elements prima facie satisfy the requirement

that the complainant show "rights in a mark" for further assessment as to confusing similarity. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element.

2.

The parties have different positions on the rights and legitimate interests of the Respondent.

The Panel agrees with the Respondent that "lotto" is a common descriptive term when used in connection with related information, products or services. The Panel assumes that the Policy was not intended to permit a party who elects to register a common term as a trademark to bar others from using the common term in a domain name, unless it is clear that the use involved is seeking to capitalize on the goodwill created by the trademark owner (cf. *National Trust for Historic Preservation v. Barry Preston*, WIPO Case No. D2005-0424 (<historichotels.com>); *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230 (<flowersmatch.com> et al.)). As a result, the use of a descriptive domain name in connection with a website corresponding to its meaning can be principally considered permissible.

The Panel is not convinced that the Respondent's use of the disputed domain name is outside what can be considered permissible in the context of the use of a descriptive domain name for a website corresponding to the meaning of the domain name. The following points play a role in the Panel's decision in this context:

- The Panel assumes that the Respondent was – of course – aware of the Complainant when registering the disputed domain name because the Respondent's intent was to publish a website which deals with the services of the Complainant. However, the Panel has not found evidence that the Respondent used the Complainant's figurative trademark on its website. Rather, the Respondent always refers to the generic word "lotto".
- The record reflects several domain names other than the disputed domain name using the term "lotto" in its descriptive sense in Finland in a similar way. This gives reason to believe that the Internet user is likely to be accustomed to the descriptive use of domain names containing the word "lotto" and does not automatically conclude from the word "lotto" in the disputed domain name that the domain name originates from the Complainant.
- The fact that the content of the website is in Finnish alone does not decide the case in favor of the Complainant since the language of the domain name is the same as the language of the website and both refer to lottery services in Finland.
- The Complainant states that the Respondent uses the colors of the lottery ball used by the Complainant when displaying the lottery balls on its website. This may be an infringement of the registered Union design on its lottery balls referred to by the Complainant from the perspective of design law, but not subject to examination under the Policy. Furthermore, even if the Respondent's use of colored balls on its website might collide with the Complainant's registered design, it does not, in the Panel's view, infect the question of the general permissibility of the registration and use of the disputed domain name in connection with a website corresponding to its content.
- There is no evidence that the Respondent has engaged in an abusive pattern of registering domain names to prevent the Complainant or other trademark owners from reflecting their marks in corresponding domain names, or that the Respondent registered the disputed domain name primarily for the purpose of disrupting the Complainant's business or selling the domain name to the Complainant. And while the Respondent clearly is using the disputed domain name to attract Internet users to the Respondent's website for commercial gain, the record as a whole is consistent with the Respondent's use of the domain name in its descriptive sense. The Panel is unable to conclude on the record before it that the Respondent is intentionally using the domain name to create a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

Accordingly, the Panel finds that the Complainant has not proven that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

With regard to the Finnish national regulation concerning the provision of lottery draws or any other game of chance or gambling services in Finland, the Panel is unable to finally decide whether the content of the website in its concrete form complies with Finnish law or not. However, in the opinion of the Panel, this question must be clarified in proceedings before the national courts or the national competent authorities and does not relate to the question of the permissibility of the registration and use of the disputed domain name per se. With regard to this issue, the Panel assumes that the subject matter of the dispute is beyond the scope of the Policy.

3.

In the light of the Panel's finding above it is not necessary for the Panel to come to a decision in this regard.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. LOTTOARVONTA.COM: Remaining with the Respondent

PANELLISTS

Name	Peter Müller
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DATE OF PANEL DECISION	2022-06-14
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Publish the Decision