

Decision for dispute CAC-UDRP-105931

Case number CAC-UDRP-105931

Time of filing 2023-11-01 09:43:41

Domain names pitkavetovihjeet.com

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization Veikkaus Oy

Complainant representative

Organization Berggren Oy

Respondent

Organization Mediatoimisto Haiku Oy

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 is the owner of the Finnish trademark "PITKÄVETO" no. 276534 registered since January 7, 2020. The Complainant is also the owner of the domain names <pitkaveto.fi> registered on September 1, 2003 and <pitkäveto.fi> registered on September 1, 2005.

FACTUAL BACKGROUND

The Complainant is a state-owned company operating in Finland in the field of betting and lottery related services since 1940. In 2017, previous three operators Fintoto (operating toto horse racing games), RAY (casino) and Veikkaus (betting and lottery) merged into a single gambling, betting and game of chance company Veikkaus Oy (the Complainant) owned by the Finnish State. Since the betting and gambling services are strictly regulated in Finland, the Complainant is the only operator of such services having a legal monopoly right under the Lottery Law. The Complainant is the only company that is entitled to legally offer gambling, betting and lottery in Finland and it is under strict monitoring and control.

The Complainant holds a trademark registration for "PITKÄVETO" dating back to 2020 in Finland, a domain name incorporating "PITKÄVETO" trademark as <pitkäveto.fi> since 2005 and a domain name incorporating "PITKAVETO" trademark as <pitkaveto.fi> since 2003.

On January 12, 2019; the Respondent registered the disputed domain name <pitkavetovihjeet.com>. The disputed domain name is

in use for providing betting tips, advertising betting and gambling websites, as well as directing the users to such websites.

PARTIES CONTENTIONS

COMPLAINANT:

THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name <pitkavetovihjeet.com> is confusingly similar to its trademark "PITKÄVETO", as it comprises of the trademark and the additional Finnish word "VIHJEET" meaning tips in English, which has no distinctive character and is a generic term directly linked to betting services of the Complainant.

The Complainant also refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions Third Edition ("the Overview") sections 1.1.3 and 1.3 stating that the fact that a Respondent is shown to have been targeting the Complainant's mark (e.g., based on the manner in which the related website is used) may support the Complainant's assertion that its mark has achieved significance as a source identifier. Also, the Complainant asserts that it is also the owner of similar domains consisting of "PITKÄVETO" and "PITKAVETO", therefore, consumers will presume that the disputed domain name <pitkavetovihjeet.com> is also owned by the Complainant or it has some other close connection to it.

It is claimed that the Complainant's trademark is recognizable within the disputed domain name and adding other verbal elements will not prevent a finding of confusing similarity. Consequently, the disputed domain name is claimed to be confusingly similar and cause likelihood of confusion with the Complainant's trademark and domain names.

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

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and it is not related or affiliated in any way with the Complainant.

The Complainant further states that betting services in Finland are strictly regulated and may only be provided by the Complainant according to Finnish law. It was claimed that the Respondent's website providing links to Finnish gambling sites that are in breach of Finnish law cannot be legitimate and registering the disputed domain name was only for profit and to prevent the Complainant from registering the domain name. The Complainant also contends that the consumers are likely to consider that all the games are provided by the Complainant, as no other company is authorized to provide them in Finland and to Finnish consumers.

The Complainant claims that the Respondent does not have any rights preceding those of the Complainant to the name "PITKÄVETO" or on the name "PITKAVETOVIHJEET". In addition to using the Complainant's trademark in the disputed domain name, the Respondent is claimed to have used it also on the website, which proves that the Respondent knows the Complainant and its business and brands very well.

The Complainant submits that the Respondent will benefit from the Complainant's trademarks as they attract users of the Complainant's games because the Respondent seeks commercial benefit from directing the consumers to such Respondent's websites will result in monetary compensation under affiliate marketing scheme. This affiliate marketing scheme was explained by the Complainant as the affiliated web page receiving profit for each player who find the games through such domain name/website. Since the website of the disputed domain name provides direct links to the paid online casinos and if a person creates an account for and plays games on the site, the owner of the disputed domain name will receive provision of any revenue or similar monetary compensation. The Complainant states that this is the only reason why the Respondent has registered the disputed domain name and established a website "to promote" the Complainant's products.

The Complainant asserted that there is a substantial risk that the websites linked in the content of the disputed domain name are mistaken by the consumers for legal providers of gambling services, however, according to the Finnish Lottery Act, no one other than the Complainant can legally provide betting or gambling services in Finland. It is further stated that the websites appear as if they were maintained by or on behalf of the Complainant or that the pages are released with consent or in cooperation with the Complainant, since they are in Finnish language. The disputed domain name is claimed to be causing serious harm to the Complainant's strongly regulated business and to the Finnish consumers without legitimate reason.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant claims that the use and registration of the disputed domain name by the Respondent has been done with the intention to attract Internet users to the Respondent's website by creating a likelihood of confusion with registered and well-known "PITKÄVETO" trademark and betting services of the Complainant, the Respondent's conduct is not compliant with the law, and it also causes harm and inconvenience to the Complainant's strictly regulated business. The Complainant states that the Respondent derives undue commercial profit and financial gain because of users visiting the website and finding themselves to web pages that could not be legally marketed to Finnish consumers.

The Complainant contends that the Respondent has clearly been aware of the Complainant's business and the Respondent

undeniably knew the identity and business of the Complainant and had intent to target its rights for commercial purposes before it registered the disputed domain name, which is evident from the use of the disputed domain name.

It was claimed by the Complainant that the intention should be determined by an objective test as stated in the WIPO Case No. D2003-0453, Paule Ka v. Paula Korenek, and that even if it was not the Respondent's original intention to the cause harm to the Complainant, the Complainant's trademark and business, consequences of the Respondent's actions have resulted in doing so and have prevented Complainant from reflecting their trademark in a corresponding domain name.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name <pitkavetovihjeet.com> in bad faith.

RESPONDENT:

The Respondent claimed that the websites provided in the content of the disputed domain name are not illegal, and that Finns can gamble on other sites than the Complainant's, which would not be illegal. The Respondent further claims that in Finland, it is not illegal to maintain a website that advertises foreign casinos. Furthermore, it is stated that it should also be considered that the Respondent's website has a domain name ending in ".com" and the server is located abroad.

The Respondent also states that the Finnish National Police Board has contacted them numerous times, about the disputed domain name where they advertised gambling sites, and that they have found it legal and has seen no cause to intervene.

It is claimed that the disputed domain name can in no way be confused with the Complainant's trademark, and that the Respondent makes no reference to the Complainant at any point. Also, it was stated that the Respondent does not in any way give the impression or attempt to mislead anyone about its site being owned by the Complainant.

The Respondent contends that it has the right to operate on the website and provide tips to gamblers. The Respondent also states that the website has been in its current form and has been offering tips for 2.5 years already and it is the owner of the disputed domain name for almost four years. Besides, a lot of time and money has been spent on the site.

It was asserted that the disputed domain name was registered in good faith to offer betting services and before registering the domain name, the Respondent checked the trademark registers, and the Complainant did not have a valid trademark at that time.

The Respondent does not make further comments on the content of the website or its legality because it is of the opinion that since both parties are from Finland, such matters should be resolved in the Finnish Court. It is stated that the only thing to deal with in this particular issue is whether the domain name infringes the Complainant's trademark, and it does not. The Respondent refers to the WIPO UPDR Case No. D2000-0836.

Lastly, the Respondent asserted its opinion as Finnish trademarks should not extend to ".com" domains, and if it ends up losing the disputed domain name, it will open Pandora's box. As a result, it was stated that the trademark holders in quite small countries could claim a ".com" domain name, even if it does not fully correspond to the trademark.

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, 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.

The Complainant requested to submit a response to the Respondent's response. The Panel concluded that the existing contentions are sufficient to grant a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

The Panel will therefore deal with each of these requirements in turn.

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Panel is satisfied that the Complainant is the owner of registration of "PITKÄVETO" trademark. Although the date of the registration of the trademark is later than the date of the registration of the disputed domain name, as also stated under the WIPO Jurisprudential Overview 3.0 section 1.1.3., the Panel considers that the UDRP makes no specific reference to the registration date of the trademark and it is enough that the rights are in existence at the time the complaint is filed, as well as that a domain name being registered before the registration of trademark rights does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element. It is also stated that in case a domain name has been registered before the trademark, only in exceptional cases would a complainant be able to prove a respondent's bad faith. However, the Panel considers that in this case there are exceptional circumstances that the Complainant can legally be operating solely by itself in betting and gambling industry in Finland due to the monopoly rights granted to the Complainant by the Finnish Lottery Act. Since the content of the website is in Finland and it is directed to the Finnish consumers, the Panel considers that the fact that the gTLD is ".com" and that the server is located abroad, or the date of the trademark filing is later than the disputed domain name does not affect the outcome of this decision.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's "PITKÄVETO" trademark. Moreover, the addition of the gTLD ".com" is not enough to abolish the identity.

The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar to the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

2. NO RIGHTS OR LEGITIMATE INTERESTS

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

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making 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 of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name. The Complainant also claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name and it is not related or affiliated in any way with the Complainant.

It is understood from the explanations of the Complainant that it is not possible to offer betting or gambling services in Finland by third parties other than the Complainant, which is a state-owned company and under strict regulation. Therefore, since it was also not refuted by the Respondent that the Complainant and the Respondent have no relationship or affiliation, the Respondent does not have the right to register and use the disputed domain name, which includes the Complainant's trademark and prior domain names with an addition to the equivalent of tips in Finnish.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

According to WIPO Overview section 1.3, to establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. (Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of the complainant's goods and/or services.)

In that sense, the Panel found that the information on the extract on Annex-4b showing the commencement of the Complainant's activities in 1993 and the expression of "In addition, we can add to this the flawless security and reliability, which make Veikkaus a very respectable gaming company in the eyes of everyone in the gaming industry." indicates its lasting reputation put forth by a third party. In addition, since the Complainant's domain name <pitkaveto.fi> was registered since 2003 operating in online betting services, the duration and nature of the use of the mark is considered as sufficient to be able to become a distinctive identifier, also considering the fact that the Complainant has been operating as a legal monopoly in Finland and the public in relation to the betting sector should have been aware of the Complainant's domain name for a long time that is the same as its later registered trademark. Since there has been no competition or alternative, the relevant public must know the Complainant and its trademark and prior domain names.

Therefore, the Panel is of the opinion that due to the rights of the Complainant in the "PITKÄVETO" trademark and its prior domain names, and the fact that the Complainant operates solely as a legal monopoly in the betting and gambling sector in Finland because it can be clearly seen from the Finnish Lottery Act article 11 that only the Complainant has the right to offer betting services in Finland, and also that the Complainant's domain name consisting of its trademark registered since 2003, the Respondent should have been aware of the Complainant and its trademarks at the time of registration of the disputed domain name. The Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name despite there was no registration belonging to the Complainant at the time is to be considered an inference of bad faith registration, because the Respondent could easily exploit the gap in the trademark registry. It must be noted that the

The Complainant's claims on the legal monopoly can be confirmed from the Finnish Lottery Act article 11, whereas the Panel is not fully satisfied as to the true nature of the Police contact with the Respondent that it is related to their website and there is no concrete evidence as to the Police finding the Respondent's activities legal. Nevertheless, whether or not the Respondent's conduct is compliant with the Finnish law, which would not be the subject of this decision, the fact that it should have been aware of the Complainant and its activities under the name PITKAVETO with legal monopoly may indicate that the Respondent derives undue commercial profit and financial gain because of users visiting the website with disputed domain name including the Complainant's trademark as a whole provides commission for the Respondent per click, the Panel considers the use of the disputed domain name is also in bad faith to gain unfair advantage from the legal monopoly and reputation of the Complainant's trademark.

This finding would be in line with the similar exemplary case law of *Kangwon Land, Inc. v. Bong Woo Chun (K.W.L. Inc)*, WIPO UDRP Case No. D2003-0320, where the Panel considered the following: "On the other hand, as the translations to the trademark and service mark registrations of Complainant show that Respondent's registration of the Domain Name was prior to any of the

trademark or service mark registration applications of Complainant, the first of which were filed in 1999, whereas the Domain Name was registered in 1998. The Panel is well aware that that this situation is not directly addressed by paragraph 4(b) of the Policy. Paragraph 4(b), however, is a non-exclusive enumeration of circumstances that may prove the existence of bad faith of the disputed domain name holder. Considering the circumstances under which the Respondent registered the Domain Name - Kangwon Land, Inc. was established in June 1998, and Respondent registered the Domain Name in September of the same year -, the Panel comes to the conclusion that Respondent registered the Domain Name fully conscious of what "business" he could make out of mistakenly being affiliated with the Complainant. As a Korean national allegedly in the online casino business, Respondent must have known Complainant's reputation as a state-run casino, established by special law. Thus, and in view of *America Online, Inc. v. Bongwoo Chun*, NAF Case No. 104974 (where the Respondent was found to having registered the domain name <casinoaol.com> in bad faith under similar circumstances), the Panel rules that the Respondent has pursued a bad faith activity under the Policy." The Panel found this case similar in terms of the facts that in this case the disputed domain name was only registered 2 months before the Complainant's trademark and it is also a state-owned betting company having a legal monopoly according to a special law.

Additionally, in *BML Group Limited v. Rikard Beach, Proxy My Whois AB*, WIPO UDRP Case No. D2015-1897, the Panel made the following considerations: "The Panel accepts that in the present case there had been trade mark use of the term "betsafe" prior to the time that the Domain Name was registered and that the Domain Name was registered with knowledge of that use and with the intention of taking advantage of the reputation that had or would attach to that term by reason of that use. Therefore, the fact that at that time the Complainant had not applied for or obtained a registered trade mark for that term, does not prevent a finding of bad faith registration and use."

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **pitkavetovihjeet.com**: Transferred

PANELLISTS

| | |
|------|-----------------------|
| Name | Mrs Selma Ünlü |
|------|-----------------------|

DATE OF PANEL DECISION **2023-11-23**

Publish the Decision
