Decision for dispute CAC-UDRP-105937

Case number	CAC-UDRP-105937
Time of filing	2023-11-03 09:42:18
Domain names	rune.game, rune.farm, runesanctuary.com, runeraid.com, runeinfinite.com, runeevolution.com, runeguardians.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Jagex Limited

Complainant representative

Organization	Stobbs IP

Respondent

Name	Adam McDonald

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 names.

IDENTIFICATION OF RIGHTS

The Complainant owns, among multiple Trademarks across other jurisdictions, the following ones:

RUNE:

- RUNE (word) - United Kingdom IPO UK00911161239, in ICs 16, 25, 36, 41, registered on October 9, 2013 and in force until September 4, 2032;

- RUNE (word) - European Union EUIPO 011161239, in ICs 16, 25, 36, 41, filed on September 4, 2012 registered on October 9, 2013 and in force until September 4, 2032;

- RUNE (word) - European Union EUIPO 018622946, in ICs 9, 16, 25, 28, 36, 41, filed on December 16, 2012, registered on May 20, 2022 and in force until December 16, 2031.

RUNESCAPE:

- RUNE SCAPE AND DESIGN - United Kingdom IPO UK00911161239, in ICs 9,16, 25, 28, 41, registered on May 20, 2009 and in force until September 10, 2028;

- RUNE SCAPE AND DESIGN - European Union EUIPO 007223662, in ICs 9,16, 25, 28, 41, filed on September 10, 2008, registered on May 20, 2009 and in force until September 10, 2028;

- RUNE SCAPE AND DESIGN – US USPTO Reg. No. 6063394, in ICs 9,16, 25, 28, 41, registered on May 26, 2020 and in force until May 26, 2026.

RUNE-formative marks:

-RUNEFEST (word) - Canada CIPO TMA813156, in ICs 35, 41, registered on December 1, 2011 and in force until December 1, 2026;

-RUNEWIZARDS (word) - United Kingdom IPO UK00002532037, in ICs 9,16, 25, 28, 41, registered on February 19, 2010 and in force until November 18, 2029.

FACTUAL BACKGROUND

The Complainant is a British company founded in 2000, specialized in the business of designing, developing, publishing and operating online video games and other electronic-based entertainment.

The Complainant is recognized at international level for its Massively Multiplayer Online Role-Playing Games ("MMORPG") RuneScape. The Complainant also offers a separate and older version of the MMORPG, Old School RuneScape, which has been recognized by the Guinness World Records for being the largest free-to-play MMORPG with over 300 million accounts.

The Complainant owns the domain name <runescape.com> has resolved to an active website relating to online video games since at least as early as August 17, 2000. In addition, the Complainant owns various further domain names which incorporate the RUNE trademark and which resolve to active websites, as e.g.: <runescape.net> and <runeservice.com>.

The Complainant is also active on social media and has generated a significant level of endorsement, being:

Instagram - https://www.instagram.com/runescape/ - 174,000 followers

Facebook - https://www.instagram.com/runescape - 987,000 followers

YouTube - https://www.youtube.com/@runescape/featured - 253,000 subscribers

Twitter - https://twitter.com/RuneScape - 323,000 followers

Discord - https://discord.com/invite/rs - 83,163 members

The Complainant has also received public recognition for its RuneScape MMORPGs. Old School RuneScape was awarded 2019 EE Mobile Game of the Year at the British Academy Games Awards, while maintaining a Metacritic score of 87, a 4.8 rating (out of 5) on the iOS App Store, and 14,252 "Very Positive" user ratings on Steam.

The Complainant also uses a wide range of other RUNE-formative marks within and in association with RuneScape, being (but not limited to): Goldrune / RuneGold; Rune equipment; Rune essence; Rune Memories; Rune Mysteries; Rune running; Runebeard; RuneCoins; Runecrafting; RuneFest; RuneLabs; RuneMetrics; RuneScore; Runespan; RuneTek; Runite; ScapeRune; Rune Mechanics; RuneDate; RunePass; Runeversi; Runelink; and Runesquares.

The Complainant's RuneScape games have also provided substantial quantity of online user-generated content relating to the games, including blogs, online articles, forums, videos, message boards, as well as a dedicated wiki.

The seven (7) disputed domain names were registered and resolve as follow:

<**rune.game**> registered on **April 23, 2021**, which resolves to an active video game website.

<**rune.farm**> registered on **March 4, 2021**, which it is redirected to <**rune.game**> and resolves to an active online video game website.

<**runesanctuary.com**> registered on **July 25, 2021**, which resolves to an active online video game website.

<**runeraid.com**> registered on **August 18, 2021**, which resolves to an active online video game website.

<**runeinfinite.com**> registered on **June 18, 2021**, which resolves to an active online video game website.

<**runeevolution.com**> registered on **July 25, 2021**, which resolves to an active online video game website.

<**runeguardians.com**> registered on **July 27, 2021**, which resolves to an inactive website with no content at all.

PARTIES CONTENTIONS

Complainant´s contentions:

- The Complainant contends inter alia that the disputed domain names were registered and are being used in bad faith due to: the Complainant's trademarks significantly pre-date the registration of the disputed domain names and that the Complainant enjoys a substantial reputation in the RUNE Trademark and associated RUNE-formative marks; that given the Respondent's deliberate impersonation of the Complainant's RUNE Trademark, the RUNE-formative naming structure and the Complainant's RuneScape in-game assets and mechanics, including its Grand Exchange trading system, shows that the Respondent was unequivocally aware of the Complainant's Trademarks; that the Respondent's service impersonates the Complainant's official service or otherwise intentionally adopts confusingly similar names and assets, with a view to diverting traffic from the Complainant's websites in order to promote its own business of selling in-game NFTs; the Complainant also contends that the disputed domain names were registered with prior knowledge of the Complainant and their RUNE and RUNE-formative marks as evidenced by the substantial similarity of in-game assets, naming conventions, and art style, with a view to taking advantage of the attractive power of those brands to consumers of online video games.

- The Complainant contends that the Respondent registered the disputed domain names with prior knowledge of Complainant's Trademarks, providing evidence where at the Respondent's website there is an assertion of have been inspired by various games, including RUNSCAPE. The Complainant provides evidence related to the Respondent's actual knowledge, where on an online interview of April 14, 2021, with a team member from the Respondent's RUNEFARM product on Medium.com, in response to questions regarding potential intellectual property infringement claims concerning <rune.farm> and the goods and services offered from the corresponding website, the Respondent is reported as stating:

  > "We get this one a lot. All I've borrowed are images and rune names. Images can be easily changed, and rune names are not copyright. Everything else is kept generic for rebranding if necessary. When we hit top 100 there will be a rebrand remove anything associated with other RPGs."

- The Complainant also contends that the Respondent disrupts the Complainant's business by diverting potential customers to the Websites which offer similar and competing goods and services. Using a confusingly similar domain name in a manner disruptive of a Complainant's business by trading upon the goodwill of a Complainant for the commercial gain evinces bad faith under paragraph 4(b)(iii) and (v) of the Policy.

Response

The Respondent did not reply to any of the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names 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.

Consolidation

Paragraph 3(c) of the UDRP Rules states that:

"The Complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder."

In addition, as the Complainant refers on its Complaint, the WIPO Overview 3.0, Section 4.11.2, addresses the question of whether a single consolidated complaint may be brought against multiple Respondents. Specifically, "where (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties."

On this case, the Registrar Verification provided by the CAC of November 11, 2023, has indicated that the seven (7) disputed domain names have been registered by the same Registrant, identified as Adam McDonald. Furthermore, the evidence provided by the Complainant, indicates that (i) the seven (7) disputed domain names and its corresponding websites are subject to common control. Therefore, this Panel for procedural efficiency reasons grants the Consolidation.

Language of Proceedings

According to Paragraph 11(a) of the UDRP Rules, which states: "Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding." This Panel notes that the Complainant requested English as the Language of the Proceedings, and that on November 11, 2023, the concerned Registrar confirmed English as the Language of the Registration Agreement. In addition, given that the Respondent's seems to be located in California, United States, plus that the active websites are available on English, including tutorial videos, this Panel, considers that there is sufficient evidence to conclude that the Respondent is perfectly able to communicate on English. Therefore, English is the corresponding Language of this Proceeding and of its Decision.

PRINCIPAL REASONS FOR THE DECISION

In accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

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

(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.

The Panel will consider each of these requirements in turn.

1. **Identical or Confusingly Similar**

The Complainant has sufficiently proved of having Trademark Rights over the word RUNE since at least 2013. The Panel notes at first instance, that some of the RUNESCAPE Trademarks submitted by the Complainant are composed by figurative elements as well, and that there are no disclaimers over its textual elements, from which this Panel concludes that, in this case, that the Complainant has sufficiently proved of having Trademark Rights over the words RUNESCAPE, since at least 2009.

In relation to what the Complainant defines as RUNE-formative marks, this Panel finds that the Complainant has sufficiently proved of having Trademark Rights over such terms as well, however, for the purposes of the first UDRP element analysis, this Panel will be focused on the Trademarks RUNE and RUNESCAPE only.

According to the WIPO Overview 3.0, Section 1.10: "Panel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. 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."

The Panel finds that the disputed domain names <**rune.game**> and <**rune.farm**> exactly reproduces the Complainant's Trademark RUNE on its entirety, and that the gTLDs, despite of constituting new gTLDs, will be disregarded for the purposes of the first UDRP element analysis, however given its intrinsically relation to the Complainant's business activity, this Panel will consider them for the purposes of the second element (see WIPO Overview 3.0, Section 1.11.2).

In relation to the disputed domain names <**runesanctuary.com**>, <**runeraid.com**>, <**runeinfinite.com**>, <**runeevolution.com**>, and <**runeguardians.com**>, this Panel finds that are composed by the Complainant's Trademark RUNE plus descriptive terms as "Sanctuary", "Raid", "Infinite", "Evolution" and "Guardians", terms that do not prevent a finding of confusing similarity under the first element (see WIPO Overview 3.0, Section 1.8).

In relation to the gTLD ".com", it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark, as it is a technical requirement of registration (see WIPO Overview 3.0, Section 1.11.1).

Therefore, this Panel finds that the disputed domain names <**rune.game**> and <**rune.farm**> are identical to Complainant's Trademark RUNE, and that the disputed domain names <**runesanctuary.com**>, <**runeraid.com**>, <**runeinfinite.com**>, <**runeevolution.com**>, and <**runeguardians.com**> are confusingly similar to Complainant's Trademark RUNE.

2. **Rights or Legitimate Interests**

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the circumstances, but without limitation, described in paragraph 4(c) of the Policy.

As multiple UDRP panelists have stablished, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy "may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element" (see WIPO Overview 3.0, Section 2.1).

The Respondent has not submitted its Response and or any communication rebutting the Complainant's contentions.

According to the evidence submitted by the Complainant, this Panel finds that:

(1) there is no evidence that the Respondent has become commonly known by the terms "rune.game", "rune.farm", "runesanctuary.com", "runeraid.com", "runeinfinite.com" "runeevolution.com" and "runeguardians.com";

(2) the Respondent is not associated or affiliated with the Complainant; the Complainant has not formative Trademarks, or has granted any license to offer any product or service, or any rights to apply for registration of the disputed domain names;

(3) there is no evidence, prior of the present dispute, of the Respondent's use of or demonstrable preparation to use the disputed domain name in connection with a bona fide offering of goods or services, in contrary the Respondent purposely choose a recognized Trademark in the online video game business as RUNE added descriptive terms, with it, also evoking the Complainant's RUNE-formative naming structure to create the disputed domain names, register them as domain names, selected ngTLDs as ".game" and ".farm" which are intrinsically related to the Complainant's business, and/ or to the online video game tactics, to take advantage of the goodwill generated by the Complainant's well-established and successful online video game business, and to promote a similarly styled game for the purpose of promoting NFTs and cryptoassets for financial gain, and with all of it, generating confusion among the users and/or the video gamers who seeks or expects to find the Complainant on the Internet.

Therefore, to the satisfaction of the Panel, the Complainant has made out its prima facie case. No Response or any communication from the Respondent has been submitted. In the absence of a Response, this Panel accepts Complainant's undisputed factual assertions as true. Thus, the Panel concludes, that the Complainant has satisfied the second element under paragraph 4(a)(ii) of the Policy.

3. **Registered and Used in Bad Faith**

a) Registration in Bad Faith:

The Complainant acquired its Trademark Rights over the words RUNE and RUNESCAPE since at least **2013** and **2009** respectively. The disputed domain names were registered within a five-month period in **2021** (see "Factual Background" point of this Decision). According to the evidence submitted before this Panel, the Complainant has registered its Trademarks across multiple jurisdictions, also the Complainant owns a recognized online video game with active and consistent presence on the Internet at least since 2000.

According to the WIPO Overview 3.0, Section 3.1.3:

> "Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: (i) **actual confusion**, (ii) **seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful**, (iii) **the lack of a respondent's own rights to or legitimate interests in a domain name**, (…) and (vi) **absence of any conceivable good faith use**.(…)." (emphasis added).

In addition, the WIPO Overview 3.0, Section 3.2.2 has established that:

> "Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. (…)".

According with the evidence submitted by the Complainant, the Respondent's website https://rune.game/about contains an assertion of having been inspired by several video games, including RUNSCAPE. In addition, according with the interview's extract conversation of April 14, 2021 with an -apparent- team member from the Respondent's RUNE.FARM product on Medium.com, in relation to potential intellectual property infringement claims concerning <rune.farm> and the goods and services offered from the corresponding website, the response was as follows:

> "**Geoff Bones**: Sounds like you are on a mission my friend, but this next
>
> question relates to the previous

Do you guys think there could be a copyright issue, as you're using artwork

from Diablo? How will you handle it if it happens?

Binzy: We get this one a lot

All I've borrowed are images and rune names. Images can be easily changed,

and rune names are not copyright. Everything else is kept generic for

rebranding if necessary. When we hit top 100 there will be a rebrand remove

anything associated with other RPGs. It might occur before then though :)

I don't plan on fighting Blizzard. If you're from Blizzard, email

binzy@rune.farm

Geoff Bones: HAHAHA, great response, it seems like you have a good strat

going forward

Binzy: We're all team Diablo here :)"

(Underline added).

In relation to the above-described evidence, this Panel finds that, copyright issues are out of the scope of the Policy, however, the assertion of being "inspired by the RUNSCAPE video game" confirms to this Panel that the Respondent was aware of the Complainant's online video game business and of its Trademarks existence at the moment of the registration of the disputed domain names.

From the interview's extract, this Panel notes that nothing in the evidence, sufficiently proves to this Panel that such statements come from a Respondent's Rune.Farm's Team member as such. However, based on the balance of probabilities (see WIPO Overview 3.0, section 4.2), if that was the case, such statements would lead to this Panel to emphasized the Respondent's awareness in terms of potential intellectual property rights infringements due the Complainant's business, online video game and Trademarks pre-existence.

Therefore, considering the facts and the submitted evidence, to this Panel, it is clear that the Respondent knew about Complainant's reputation and RUNE, RUNESCAPE and/or RUNE-formative Trademark's existence and value at the time of the registration of the disputed domain names. Also, to this Panel, it is clear, that the Respondent has incurred in Paragraph 4.b.(iv) of the Policy, which proves that the disputed domain names have been registered in bad faith.

b) Bad Faith Use:

This Panel finds that the disputed domain names **<rune.game>**, **<rune.farm>**, **<runesanctuary.com>**, **<runeraid.com>**, **<runeinfinite.com>** and **<runeevolution.com>** resolved to active online video games websites, which as described along this Decision, are based on the Complainant's goodwill and sustained online video game business, and are being used to promote a similarly styled game for the purpose of promoting NFTs and cryptoassets for financial gain, falling inevitably under the present circumstances into Paragraph 4.b(iii) and (iv) of the Policy.

In relation to the inactivity of the disputed domain name **<runeguardians.com>**, the WIPO Overview 3.0, Section 3.3, considers the following factors related to the Passive Holding Doctrine, which to this Panel are evident in this case, being:

(i) the degree of distinctiveness and reputation of the Complainant's Trademark RUNE and RUNESCAPE,

(ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use,

(iii) the respondent's concealing its identity, by the use of Respondent's Privacy Protect Service;

(iv) the implausibility of any good faith use to which the domain names may be put; and

(iii) additionally, the fact that Respondent might configured further MX-servers, which will only increase the confusion level among the Internet users and/or video gamers, on detriment of the Complainant's business and Trademarks' reputation.

Therefore, given the facts and the evidence, this Panel concludes that, the disputed domain names <rune.game>, <rune.farm>, <runesanctuary.com>, <runeraid.com>, <runeinfinite.com>, <runeevolution.com> <runeguardians.com> are being used in faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **rune.game**: Transferred
2. **rune.farm**: Transferred
3. **runesanctuary.com**: Transferred
4. **runeraid.com**: Transferred
5. **runeinfinite.com**: Transferred
6. **runeevolution.com**: Transferred
7. **runeguardians.com**: Transferred

PANELLISTS

Name	**María Alejandra López García**

DATE OF PANEL DECISION 2023-12-07

Publish the Decision