Decision for dispute CAC-UDRP-106272

Case number	CAC-UDRP-106272
Time of filing	2024-02-22 09:45:25
Domain names	runemetaverse.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Jagex Limited

Complainant representative

Organization	Stobbs IP

Respondent

Organization	Binzy, Inc.

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 registrant of some registered trademarks for the word “RUNE”, including:

- the EU trademark registration No. 011161239, registered on October 9, 2013, for goods and services in classes 16, 25, 36 and 41;
- the EU trademark registration No. 018622946, registered on May 20, 2022, for goods and services in classes 9, 16, 25, 28, 36 and 41.

The disputed domain name was registered by the Respondent on January 13, 2024.

FACTUAL BACKGROUND

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

The Complainant states that it is well-known internationally for its Massively Multiplayer Online Role-Playing Games (“MMORPG”) RuneScape and Old School RuneScape. The Complainant adds that Old School RuneScape has been recognised by the Guinness World Records for being the largest free-to-play MMORPG with over 300 million accounts.

The Complainant points out that its domain name <runescape.com> has resolved to an active website relating to online video games since 2000. The Complainant clarifies that in addition to <runescape.com>, the Complainant has acquired further domain names which incorporate the RUNE trade mark and which resolve to active websites.

The Complainant observes that it is also active on social media and has generated a significant level of endorsement.

The Complainant submits that it also uses a wide range of other marks which include the RUNE trade mark.
The Complainant underlines that a substantial quantity of user-generated content which relates to the RuneScape games, including blogs, articles, forums, videos, message boards, as well as a dedicated wiki are available online.

The Complainant notes that its RUNE trade marks significantly pre-dates the registration of the disputed domain name.
The Complainant considers that the disputed domain name is identical or confusingly similar to its trademark "RUNE".

The Complainant notes that the disputed domain name includes its trademark "RUNE" in its entirety.

The Complainant observes that the addition of the generic term “METAVERSE” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark "RUNE".

The Complainant contends that the top-level domain ".COM" is a standard registration requirement and as such should be disregarded under the first element confusing similarity test.

The Complainant submits that the Respondent does not have any rights or legitimate interests in the disputed domain name.
The Complainant considers that based on the reputation enjoyed by the Complainant in its RUNE and RUNESCAPE brands, there is no believable or realistic reason for registration or use of the disputed domain name, other than to take advantage of the Complainant’s rights and reputation.

The Complainant submits that the Respondent is using the disputed domain name and the website it resolves to, which offers and/or advertises goods and services overlapping with those protected by the Complainant’s trade marks, specifically in relation to online video games and entertainment services. The Complainant submits that the Respondent has chosen to use the RUNE brand to create the disputed domain name, in order to take advantage of the goodwill generated by the Complainant’s well-established and successful online video game business. The Complainant considers that this cannot constitute a bona fide offering of goods or services.

The Complainant argues that the intention behind the Respondent’s registration and use of the disputed domain name is to impersonate/pass itself off as the Complainant or otherwise to take unfair advantage of the goodwill associated with the Complainant’s trade marks in order to promote its competing online video game offering, without the Respondent having to incur its own advertising or branding expenditure.

The Complainant confirms the Respondent does not have, and has never had, authorisation to use the RUNE brand in relation to online video games, nor any other goods and services protected by the Complainant's trade marks.

Upon information and belief, the Complainant submits that the Respondent has never legitimately been known as RUNE or any other similar name at any point in time. The Complainant concludes that the only reason the Respondent registered the disputed domain name was to take advantage of the Complainant’s goodwill and valuable reputation in the RUNE brand in relation to MMORPG style online games in order to promote a similarly styled game for the purpose of promoting NFTs and cryptoassets for financial gain.

The Complainant submits that nothing about the disputed domain name suggests that it is being used by the Respondent legitimately or for non-commercial and fair use. The Complainant recalls that the disputed domain name and the related website have been set-up to take advantage of the Complainant’s significant goodwill and valuable reputation in order to promote a similarly styled game for the purpose of promoting NFTs and cryptoassets for financial gain, as can be inferred from the content published on the website.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith.

The Complainant reiterates that the trade marks significantly pre-date the registration of the disputed domain name and the Complainant enjoys a substantial reputation in the RUNE brand. Furthermore, the Complainant considers that the Respondent was unequivocally aware of the RUNE, RUNESCAPE and other brands which contain the "RUNE" mark, given the Respondent’s deliberate impersonation of the Complainant’s RUNE brand, the naming structure and the Complainant’s RuneScape in-game assets and mechanics, including the Grand Exchange trading system.

The Complainant submits that the Respondent is using in its website several elements used also in the Complainant's games.
The Complainant argues that the only plausible explanation is that the Respondent 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 submits that the disputed domain name was registered with prior knowledge of the Complainant and their brands and is highly likely to be under the control of the respondent in CAC Case No. UDRP-105937, and in particular as regards the <rune.game> domain name.

The Complainant clarifies that the disputed domain name was registered one day after <rune.game> was transferred to the Complainant's corporate registrar and the infringing content was made disabled following the above-cited decision. The Complainant observes that the website content is identical to content previously found in the framework of the above-cited decision.

The Complainant further submits that the Respondent is the same entity as the Respondent in the above-cited case, as can be seen from the disclosure of contact details by the Registrar, and this fact entails a pattern of bad faith conduct in accordance with the Policy.

The Complainant further submits that the Respondent's prior knowledge is 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 observes that actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name is indication of bad faith under the Policy.
The Complainant points out that using a trade mark to divert traffic to the Respondent's own website is consistently held to amount to bad faith registration and use under the Policy.

The Complainant concludes that, in the light of the arguments submitted, all elements of the Policy are satisfied.

PARTIES CONTENTIONS

The Complainant´s contentions are summarised above.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

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.

A non standard communication was sent from a third party, who clarified that, even if he owned the Respondent's company in the past, he was not affiliated with the disputed domain name in any way and currently he does not have anything to do with the Respondent's company.

In line with other similar UDRP cases (see for example WIPO Case No. D2009-1788), the Panel considers that this fact does not constitute an obstacle to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

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

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "RUNE", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark "RUNE" only by the addition of the term "METAVERSE", and of the top-level domain ".COM".

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case, the generic word "METAVERSE" has no impact on the distinctive part "RUNE". It is well established that where the relevant trademark is recognizable within the domain name, the addition of a word would not prevent a finding of confusing similarity (see, for example, WIPO case No. D2022-0073).

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark "RUNE".

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] 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 [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

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

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- its brands RUNE and RUNESCAPE enjoy reputation;

- the Respondent is using the disputed domain name and the website it resolves to, which offers and/or advertises goods and services overlapping with those protected by the Complainant's trade marks;

- by his use of the disputed domain name, the Respondent takes advantage of the goodwill generated by the Complainant's well-established and successful online video game business and this cannot constitute a bona fide offering of goods or services;

- the Respondent does not have, and has never had, authorisation to use the RUNE brand in relation to online video games, nor any other goods and services protected by the Complainant's trade marks.

- the Respondent has never legitimately been known as RUNE or any other similar name at any point in time;

- in its website, the Respondent promotes a game similar to the Complainant's game for the purpose of promoting NFTs and cryptoassets for financial gain.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain name resolves to a website which offers goods and services similar to the goods and services offered by the Complainant.

Taking into account the reputation of the Complainant's trade marks, that the disputed domain name resolves to a website which offers, for financial gain, goods and services similar to the goods and services offered by the Complainant, that the Respondent has never been authorised to use the RUNE brand and that the Respondent is not known as the disputed domain name, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] 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 [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site 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] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

Indeed, taking into account the reputation of the trade mark "RUNE", which long predated the disputed domain name, it is inconceivable that the Respondent was not aware of the Complainant's rights in the trade mark "RUNE" when registering the disputed domain name. The Respondent should have performed an internet search, aimed at excluding possible conflicts with third party rights. Therefore, the Respondent has failed to carry out such a search and has to be considered responsible for the resulting abusive registration under the concept of wilful blindness (see, for example, WIPO Case No. D2018-1182). Consequently, this circumstance is considered by the Panel as evidence of bad faith.

The Panel points out that the disputed domain name resolves to an online video games website, which are based on the

Complainant’s goodwill and 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. The Panel considers that this circumstance constitutes evidence of bad faith.

The Panel, taking into account that the Respondent registered other seven domain names transferred to the Complainant by UDRP proceedings, agrees that this shows a pattern of conduct, and, consequently, an indication of bad faith.

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain name it would have filed a response in this proceeding.

The Panel, having taken into account the Respondent's knowledge of the "RUNE" trade mark at the time of the disputed domain name’s registration, that the disputed domain name resolves to an online video games website which has a style similar to the Complainant's website and is aimed at generating financial gains, that the Respondent registered other similar domain names transferred by UDRP proceedings, that no response to the complaint has been filed, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **runemetaverse.com**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2024-03-26

Publish the Decision