Decision for dispute CAC-UDRP-107356

Case number	CAC-UDRP-107356
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Domain names	runeguild.org

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Jagex Limited

Complainant representative

Organization	Stobbs IP

Respondent

Name	Haydn Whittaker

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 owns a number of Trademark Registrations for the mark RUNE including the following:

- RUNE (word) - United Kingdom Registration Number UK00911161239, covering Nice Classifications 16, 25, 36, 41, registered since 9 October 2013;
- RUNE (word) - European Union Intellectual Property Office Registration Number 011161239, covering Nice Classifications 16, 25, 36, 41, registered since 9 October 2013; and
- RUNE (word) - European Union Intellectual Property Office Registration Number 018622946, covering Nice Classifications 9, 16, 25, 28, 36, 41, registered since 20 May 2022.

FACTUAL BACKGROUND

Incorporated on 28 April 2000, the Complainant is well-known internationally for its Massively Multiplayer Online Role-Playing Games (“MMORPG”) RuneScape, and Old School RuneScape, (collectively, the “Games”). The trademarks RUNE and RUNESCAPE are registered with many national and multi-national offices around the world and the Complainant’s website and email addresses include the domain names runescape.com, runescape.net, runeservice.com, and others. Further, the term “guild” is a common term used in the MMORPG genre of games and features in the Complainant’s Games. The disputed <runeguild.org> domain name, registered on September 14, 2023, resolves to a website that incorporates graphics from the Complainant’s own site and displays

the message “Looking for the best RuneScape private server (RSPS)? Look no further than RuneGuild, A Semi-Custom OSRS server.”.

PARTIES CONTENTIONS

COMPLAINANT:

The <runeguild.org> domain name is confusingly similar to the RUNE and RUNESCAPE trademarks.

The Respondent has no rights or legitimate interests in the disputed domain name where it is operating the same line of business as the Complainant and offering the same categories of products and services.

The disputed domain name was registered and is used in bad faith where the Respondent uses it to confuse users by operating a website that displays the RUNE trademark and offers online games and virtual assets for sale in competition with the Complainant.

RESPONDENT:

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.

PRINCIPAL REASONS FOR THE DECISION

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also GROUPE CANAL + v. Danny Sullivan, 102809 (CAC January 21, 2020) (“the Panel, based on the poorly supported and conclusory allegations of the Complainant, retains that the Complainant has not prevailed on all three elements of the paragraph 4(a) of the Policy and, therefore, rejects the Complaint.”).

1. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrate its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant, 103255 (CAC September 30, 2020) ("it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).").

The Complainant claims ownership of a number of trademark registrations with the United Kingdom Intellectual Property Office (IPO) and the European Union Intellectual Property Office (EUIPO). Registration with such national and multi-national offices has been found sufficient to satisfy the threshold requirement of proving trademark rights under Paragraph 4(a)(i) of the Policy. Beijing Dajia Internet Information Technology Co., Ltd. and Beijing Kuaishou Technology Co., Ltd. v. Phan Van Thuong, UDRP-107028 (CAC January 11, 2025) ("A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner."). The Complainant has submitted into evidence screenshots from the UK IPO and the EUIPO, thus demonstrating that it possesses rights in the RUNE trademark.[1] Further, the disputed domain name adds the generic word "guild" to the RUNE trademark as well as the ".org" gTLD and the Complainant asserts that the second level of the disputed domain name is confusingly similar to the asserted trademark and will lead internet users to wrongly believe that the disputed domain name originates or is endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. Avast Software s.r.o. v. Milen Radumilo, 102384 (CAC April 19, 2019) ("it is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity.").

Also, the extension ".org" typically adds no meaning or distinctiveness to a disputed domain name and may most often be disregarded in the Paragraph 4(a)(i) analysis. Novartis AG v. Wei Zhang, 103365 (CAC December 9, 2020) ("it is generally accepted that the addition of the top-level suffix in the domain name (e.g., '.com') is to be disregarded under the confusing similarity test").

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the addition of a generic word thereto in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant's trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Pursuant to Paragraph 4(a)(ii) of the Policy, the Complainant has the burden of making a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name. Cephalon, Inc. v. RiskIQ, Inc., 100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the Respondent to demonstrate that it does have rights or legitimate interests in the disputed domain name. Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

With reference to Paragraph 4(c)(ii) of the Policy the Complaint states that "[f]or the avoidance of doubt, 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 Trade Marks.". Further, the Panel notes that the Respondent is identified by the Registrar verification to the CAC as "Haydn Whittaker" and this bears no relation to the RUNE mark or the words that make up the disputed domain name. The Respondent has not participated in this case and so it does not contest this or provide any argument or evidence to defend against the Complaint. As such, the Panel finds no evidence that the Respondent is commonly known by the disputed domain name and its use of the Complainant's trademark on its website does not, alone, support a different conclusion. Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com", D2000-0847 (WIPO October 16, 2000) ("use which intentionally trades on the fame of another" should not be considered. "To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy."). Based upon the available evidence in this case, the Panel cannot conclude that the Respondent is commonly known by the disputed domain name.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. The disputed domain name resolves to a website that makes prominent use of the RUNE trademark and claims to offer access to "the best RuneScape private server". Using a confusingly similar domain name to pass oneself off as a Complainant is not a bona fide offering of goods or services or a legitimate non-commercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy. See Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund, FA 1790949 (FORUM July 9, 2018) (finding that the

Respondent did not use the disputed domain name to make a bona fide offering of goods or services per Paragraph 4(c)(i) of the Policy or for a legitimate non-commercial or fair use per Paragraph 4(c)(iii) where the website resolving from the disputed domain name featured the Complainant's mark and various photographs related to the Complainant's business). Here, the Complainant claims that the Respondent "offers a pirated version of the Complainant's Old School RuneScape game" and it provides screenshots of the Respondent's website showing the prominent display of the RUNE mark at the top and images of the RUNESCAPE game, the message "Experience all of our unique custom content", and links titled "Home", "Update", "Vote", "Store", and others. The footer of the website displays the following message, in small type and in a dark grey font against a black background "© RuneGuild - All rights reserved. We are in no way affiliated with Jagex or Runescape. This is for educational purpose only.". Also submitted into evidence are screenshots of a page at the Respondent's website titled "Store". This invites users to purchase "Guild Coins", a "Battle Pass", and "Other … useful items.".

Although the Respondent has defaulted, the Panel will review this case under the test for distributors and resellers of trademarked goods and serves as set out in the seminal case of Oki Data Americas, Inc. v. ASD, Inc., D2001-0903 (WIPO Nov. 6, 2001). This test considers whether the Respondent:

- is actually offering goods or services of the Complainant;
- uses its website to sell only the Complainant's trademarked goods or services and not those of competitors or other third-parties;
- accurately discloses its relationship (or lack thereof) with the Complainant; and
- has tried to corner the market in all relevant domain names, thus depriving the Complainant of the ability to reflect its own trademark in a domain name.

Of most relevance to the current case are the first, second, and third elements of the Oki Data test. The Complainant claims that the Respondent is not an authorized distributor of its products and that it is, in fact, offering services that compete with those offered under the RUNE and RUNESCAPE trademarks. Upon a review of the Respondent's website, the Panel concludes that, even if the Complainant's services are being offered, the Respondent's primary focus is to promote its own online game services and server, as well as a virtual currency, all of which compete with the Complainant. Finally, although the Respondent's website displays a disclaimer at the bottom of the page, this appears to be intentionally obscure and fails to clearly disclose its lack of a relationship with the Complainant.

The Complainant's assertion that this use of its trademark is for the purpose of impersonation and commercial gain through passing off appears well-founded. Further, the Panel concludes that the Respondent is not making a legitimate noncommercial or fair use of the RUNE trademark for the reasons stated above and the fact that it is selling virtual assets on its site despite the claim that the site "is for educational purpose only.". Finally, the Respondent has not filed a Response or made any other submission in this case to offer an alternative explanation for its actions. As the Complainant has made out a prima facie case that has not been rebutted by the Respondent, upon a preponderance of the evidence before it the Panel finds that the Respondent fails to make a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

3. The disputed domain name was registered and used in bad faith

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. Further guidance on that requirement is found in Paragraph 4(b) of the Policy, which sets out four examples of possible actions by the Respondent that may satisfy this burden of proof.

The Complainant argues that the Respondent had prior knowledge of the RUNE mark at the time of registering the disputed domain name. Actual knowledge of a complainant's trademark, through reputation of the trademark and/or through the use made of the disputed domain name, may form the foundation upon which to build a case for bad faith under Policy paragraph 4(a)(iii). See, Xiaomi Inc. v. Nguyễn Đức Đạt (N/A), UDRP-107237 (CAC February 12, 2025) ("The Panel infers that the Respondent had actual knowledge of the Complainant's rights in the XIAOMI mark at the time of registration, as demonstrated by the Respondent's use of the mark, its offering of competing products, and the widespread recognition of the Complainant's trademark."). Here, the Complainant submits copies of its own runescape.com website, screenshots of a page at the runescape.wiki site which sets out a definition of "guilds" as the term is used within the Complainant's game, images of the runeguild.com website which promotes a periodic gathering of RUNESCAPE players, samples of the Complainant's social media account pages, news and media reports focussed on its services, and images of reviews of the Complainant's services. The Panel accepts this as evidence supporting the broad reputation of the RUNE and RUNESCAPE trademarks. Further, the Respondent's website displays images of the Complainant's game and specifically mentions that it offers a "RuneScape private server", the Panel finds that the Complainant's trademarks are very well-known and that the Respondent knew of and targeted the Complainant's trademarks in bad faith at the time that it registered the disputed domain name.

Next, the Complainant argues that the Respondent registered and uses the disputed domain name in bad faith as the Respondent passes itself off as the Complainant to offer competing services. Using a confusingly similar domain name to pass oneself off as a Complainant can demonstrate bad faith under Paragraphs 4(b)(iii) and (iv) of the Policy. See Harley-Davidson Motor Company Inc. v. Liu Peng et al., UDRP-106275 (CAC March 27, 2024) ("use of a disputed domain name to pass off as a complainant and offer competing or counterfeited goods may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv)."). The Complainant asserts that, by use of the disputed domain name, "the Respondent disrupts the Complainant's business by diverting potential customers to the Website which offer similar and competing goods and services." It further claims that "the Respondent's service impersonates the Complainant's Games or otherwise intentionally uses the Complainant's copyright-protected works and adopts confusingly similar names and assets, with a view to diverting traffic from the Complainant's websites in order to promote a pirated copy of the Old School RuneScape game." The evidence in this case shows that the Respondent has, for commercial gain, used its website at the disputed domain name to pass itself off as the Complainant to actual and potential customers in furtherance of allegedly promoting the sale of gaming services and virtual currency under the RUNE trademark. The Respondent has not participated in this case to explain its actions and so, based upon a preponderance of the available evidence, the Panel finds that the Respondent registered and uses the disputed domain name in bad faith by disrupting the Complainant's business and by seeking commercial gain through confusion with the Complainant's trademark, per Paragraphs 4(b)(iii) and (iv).

In light of the above, the Panel finds firm ground upon which to conclude that the Respondent both registered and used the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

[i] In support of its claim of registered trademark rights Complainant also submits a table listing additional registration numbers, countries, dates, and related information. However, a mere textual recitation of trademark registration data is not evidence of trademark rights. As no trademark registration certificates or screenshots from the listed trademark offices are submitted, this informational table is not evidence of Complainant's claimed trademark rights and the Panel declines to consider it.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **runeguild.org**: Transferred

PANELLISTS

Name	**Steven Levy**

DATE OF PANEL DECISION 2025-04-07

Publish the Decision