Anonymized decision for dispute CAC-ADREU-007168

Case number	CAC-ADREU-007168
Time of filing	2016-05-02 18:24:25
Domain names	teeria.eu, jteeria.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	Re-Logic, Inc.

Respondent

Name	[redacted]

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The panel is not aware of any pending or decided proceedings related to the Domain Names.

A. COMPLAINANT

Complainant Rights The Complainant relies on its registered marks as follows: 1. CTM No. 013460316 in classes 9, 14, 16, 18, 25, 26, 28, 41 for the word mark TERRARIA (registered 4 May 2015); 2. CTM No. 013460431 in the same classes for the figurative mark TERRARIA (registered 4 May 2015); 3. U.S. Reg. No. 4,176,854 in classes 9 and 41 for the word mark TERRARIA (application 12 May 2011, registered 17 July 2012. First used: May 16, 2011.); 4. U.S. Reg. No. 4,180,576 in classes 9 and 41 for the figurative mark TERRARIA (same). The Complainant also relies upon common law rights arising from use of its marks and names in the European Union, the United States and worldwide and claims it is a famous mark. The Complainant submits the Domain Names are confusingly similar to its name and marks. It says the alphanumeric strings comprising the Domain Names are identical to the Complainant's mark or sufficiently approximates it, visually or phonetically, so that the Domain Names on their face are "confusingly similar" to the Complainant's mark. The Complainant also relies on "initial confusion" -- the simple appearance of similarity – to an internet user – that can make a disputed domain name confusingly similar to the trademark. It says the overall impression left by the names "teeria" and "jteeria" suggest that these names belong to or are associated with Complainant as there are only minor differences in the terms in that, for example, when comparing the term "Terraria" with the term "Teeria" there are only three different letters – with the comparison being made essentially between the terms "errar" and "eer". The dominant portions of both marks are the "Te" at the beginning of the marks/names and the "ria" at the end of the marks/names. The "overall impression" of the Domain Names is confusingly similar to the registered TERRARIA marks, and suggests a joint ownership or affiliation by these companies. Consumers will naturally assume that the "teeria" and/or "jteeria" names are owned or affiliated with Complainant, and involve some affiliated or authorized use and/or promotion of the Terraria game – especially since the content of the website at issue relates exclusively to the Terraria game. The Complainant relies on a previously WIPO case between the same or similar parties based on the Respondents' registration and use of the domain names <teeria.net> and <jteeria.net>in 2015, Case No. D2015-1331 ((1) Complainant had rights in respect to the TERRARIA Trademark; (2) the domain names <teeria.net> and <jteeria.net> were confusingly similar to the TERRARIA trademark; (3) that Respondent had no rights or legitimate interests with respect to the domain names; and (4) that Respondent registered and used the domain names in bad faith). The Complainant says the Respondent has no rights or legitimate interests in respect of the Domain Names, and in particular, as below. 1. The Respondent is not now, nor has it ever been, an authorized reseller, agent, dealer or handler of the Terraria game or any other products of the Complainant and this constitutes a prima facie showing that the Respondent lacks rights or legitimate interests in the <teeria.eu> and <jteeria.eu> domain names. The Respondent does not have a license to use the marks in any way. 2. The Domain Names resolve to the Teeria Legends website which in part, provides consumers with access to unauthorized (and, in some cases, illegal) versions of the Terraria game online and the Respondent has never used or made demonstrable preparations to use, the Domain Names in connection with a bona fide offering of goods or services. 3. The Respondent does not own any trademark for, or incorporating, the term "Teeria" and has never been commonly known by the trademark or name TERRARIA, the name "Teeria", or the Domain Names, and only registered the Domain Names for the purpose of trading off the Complainant's goodwill. 4. The Respondent is not making a legitimate, non-commercial, or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the marks at issue. 5. The Respondent is using the Domain Names to attract, for commercial gain, visitors to its web site by creating a likelihood of confusion with Complainant's marks. In short it says one of the primary purposes, if not the primary purpose of the Teeria Legends website is to attract those consumers interested in playing the Terraria game. It says the Respondent has in the past (submitted in the WIPO matter) made representations in online forums and in communications with Complainant that he is in fact generating revenue from unlawfully linking to free downloads of the Terraria game ("If you look on the http://jteeria.net/store you can clearly see I already made more than $3000 just this year"). 6. Respondent's website contains an online store so it cannot be disputed that the use of the site is designed to generate profits in some form. Bad Faith The Complainant says the Respondent was aware of the Complainant's Rights before he registered the Domain Names. The Complainant's registrations on both the CTM and United States Patent and Trademark Office's databases of registrations, are freely

searchable and accessible on the Internet. The Respondent cannot dispute that he was aware of the name and marks since his website contains links to illegal and/or pirated versions of the Terraria game. Further the Respondent was involved in the similar domain name dispute with Complainant at WIPO and registered the Domain Names just days after that proceeding was initiated. The intentional registration and use of a domain name incorporating another party's well-known trademark is evidence of an intentional attempt to attract, for commercial gain, visitors to the registrant's site by creating a likelihood of confusion as to source, sponsorship, or affiliation. See e.g., Andreas Kannas & Sons Limited v. Zheng Qingying, CAC 5941, <kannas.eu> (ordering transfer); Partslife GmbH v. Mandarin & Pacific Services Ltd., CAC 5149, <partslife.eu> (ordering transfer); and Société Air France v. ibiz hosting, CAC 4645, <airfranceonline.eu> (ordering transfer). The Respondent does not have any rights or legitimate interests in the Domain Names. The Respondent is using the website at the disputed Domain Names to link to other websites which offer illegal and/or unauthorized downloads of the Terraria game. It follows that the only reason the Respondent is using the confusingly similar domain name is intentionally to attract, for commercial gain, visitors to his website by creating a likelihood of confusion with Complainant's mark in violation of the ADR Rules. See e.g., AVAST Software a.s. v. Avira GmbH, CAC 5739, <avast.eu> (ordering transfer). The Respondent's use of the Complainant's diverts traffic through a likelihood of confusion and by generating click-through commissions and revenues by creating a likelihood of confusion as to source, sponsorship, or affiliation. This constitutes bad faith use and registration of the Domain Names and is "opportunistic".

B. RESPONDENT

In strong plain language the Respondent disputes similarity and denies that his site makes available the Complainant's game. The Respondent also points to its express disclaimer of any connection with the Complainant. Further, it says it is financed by donations and does not sell or resell the Complainant's game or copy it and the work at the website is its own.

DISCUSSION AND FINDINGS

Article 22(1)(a) of Commission Regulation (EC) No 874/2004 of 28 April 2004 ("the Policy Regulation") allows a party to initiate an ADR procedure where a registration is speculative or abusive, as defined in Art. 21. This allows for revocation where the name is identical or confusingly similar to a name in respect of which a right is recognized or established by national or Community law and where registered without rights or legitimate interest and registered or used in bad faith. This is reflected in §11 of the ADR Rules. Art 21 provides: "Speculative and abusive registrations 1. A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it: (a) has been registered by its holder without rights or legitimate interest in the name; or (b) has been registered or is being used in bad faith. 2. A legitimate interest within the meaning of point (a) of paragraph 1 may be demonstrated where: (a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so; (b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law; (c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law. 3. Bad faith, within the meaning of point (b) of paragraph 1 may be demonstrated, where: (a) circumstances indicate that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognised or established by national and/or Community law or to a public body; or (b) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognised or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that: (i) a pattern of such conduct by the registrant can be demonstrated; or (ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or (iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated; (c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or (d) the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognised or established by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder of a domain name; or (e) the domain name registered is a personal name for which no demonstrable link exists between the domain name holder and the domain name registered." Note that Art. 21(2) provides examples of how legitimate interest may be demonstrated, and Art. 21(3) provides examples of bad faith. Procedural and other matters In the panel's view there were two potential issues that arise on the face of this case. The Respondent's site is prima facie a fan site and this can be a legitimate and fair use and further, the copies at the linked sites could be from valid resellers or distributors - even if unauthorized. As neither party had adequately addressed these issues, on 26 April 2016, the panel made a request for a further statement from each of the parties pursuant to §B(8) of the ADR Rules as follows: "The panel would like the Respondent to provide clearer statements/evidence on these points." The Complainant responded and submitted that it was not a fan site case. In relation to the bona fide offering point it said: "The Respondent operates a server whereby the Terraria game can be played online. However, the Respondent in this case does not simply offer a server whereby consumers can access and play authorized versions of the copyrighted Terraria game. The Respondent [also] links consumers to pirated, illegal downloads of the Terraria game and then generates revenues based on this activity. " It says further "Annexes 12 and 10 to the Complaint depict links on Respondent's website to pirated versions of the Terraria game [...] sold without the Complainant's permission and in violation of the law of the European Union (see Article 3 of Directive 2001/29) and International law (including the Berne Convention). These links directly affect the copyright in the Terraria game in that consumers are essentially being provided unauthorized free versions of the game to the detriment of Respondent, the copyright owner. These consumers are "new public" consumers in that there would be no reason for someone who has already lawfully purchased the Terraria game to then download an unauthorized version of the game as linked by Respondent. See C-466/12 Svensson ("[…] here a clickable link makes it possible for users of the site on which that link appears to circumvent restrictions put in place by the site on which the protected work appears in order to restrict public access to that work to the latter site's subscribers only, and the link accordingly constitutes an intervention without which those users would not be able to access the works transmitted, all those users must be deemed to be a new public, which was not taken into account by the copyright holders when they authorised the initial communication, and accordingly the holders' authorisation is required for such a communication to the public"). The Respondent himself admittedly then benefits from the links in that consumers who have downloaded the unauthorized versions of the game can then use Respondent's server. See Annex 13 to the Complaint

(“Well the fact that over 50% of the population just torrents the game because they don’t think it is worth the money and I basically run a popular server just suits perfectly together.”). The Respondent thus gets the best of both worlds in that anyone who has either lawfully purchased the Terraria game or illegally downloaded an unlawful version of the game can then access his server to play the game online..” (emphasis added). This it says also deals with the genuine goods point. As to the disclaimer issue it concedes that the Respondent has a disclaimer on his website which reads: “T.L. Works is not affiliated with Terraria or Re-Logic” but says this does not alleviate the damage caused by the linking to pirated versions.“ The Respondent did not make a further submission. Rights The Complainant clearly has Rights in its CTM and US national marks and unregistered rights arising from its worldwide use of the name and marks in trade. I find that the Complainant has the requisite rights. Neither teeria nor jteeria are identical to TERRARIA. As to similarity, while there may be some degree of aural and visual similarity, this is low and there is no real conceptual similarity unless perhaps based loosely on a play on the Latin word Terra for Earth. The case for visual similarity is weak in the view of this panel. The “initial confusion” point generally adds nothing to the analysis and given the significant differences visually between the names here is of no assistance. On a standalone basis, this panel does not find the Domain Names identical or confusingly similar to the name and marks in which the Complainant has rights for the test under Art 21 of the Policy Regulation. There is no attempt here to impersonate or usurp the name and Rights of the Complainant and the selection of the Domain Names demonstrates this. Nor do those names in any way indicate endorsement, sponsorship or authorization in the view of the panel. In relation to the WIPO case between the parties based on <teeria.net> and <jteeria.net> in 2015, Case No. D2015-1331, while it is relevant to Bad Faith, due to the knowledge it created for the Respondent, and while it may have some value as a precedent, it does not bind this panel. Legitimate Rights and Interests Turning now to legitimate interests, we must determine if any of the factors in Art. 21(2) of the Policy Regulation (also set out in §B11(e) of the ADR Rules) apply. The panel found it difficult to obtain a clear picture of the use in this case from the evidence and submissions. The panel therefore visited the Domain Names on 28 April 2016. Links were clicked through and other publicly available resources viewed –these are mentioned below as relevant. This is generally regarded as acceptable investigation by a panel. The panel therefore viewed the Teeria Legends website. Based on this panel review the website has a number of functions; it is a host for member forums, a store (where ranks and in-game rewards are sold), a host for online accounts (where members’ in-game creations can be stored) and a game server (where games can be played on a multiplayer basis). There are banner and other advertisements advertising the goods and services of others. There is no question that the site relates entirely to the Complainant’s game Terraria. This case is far from easy or straightforward. We try to look at and work through these uses below. The members' forum on the Teeria Legends website is a place where gamers communicate, discuss and chat about the game. This use is nominative or referential descriptive use – the public and members are entitled to call the game by its name and talk about it and no - one is entitled to prevent that. That is free expression. The forum and other elements of the site share characteristics with fan sites and the Teeria Legends website is in predominant part a fan site in this panel's assessment. In such part, the use is perfectly legitimate and fair use of the name of the game. The Policy Regulation recognizes in art. 21(2) (c) that free expression is fair use and fan sites fall within that. The fact of banner and/or pop up advertising, being minor commercial activity, does not prevent that use being legitimate fair use and this is an accepted view in domain name cases now. In relation to the WIPO case Case No. D2015-1331, with respect, that panel did not consider or avert sufficiently to rights or legitimate interests with respect to those domain names. So in summary, a predominant use appears to be fair and legitimate. Turning to the other uses; the Complainant accepts in its supplemental statement that the site includes/is a game server. Game servers require that players have a client copy of the game in question, and the point of the server is to enable them to play together. Without trying to connect, the panel could not identify authentication methods, if any, on the site. One needs the game to play however. Is use of a game server an infringing use where players own the game? Unlikely but a question governed possibly by contract terms and the relevant jurisdiction’s copyright law. The position may be different if the players or any of them have unlicensed copies. The Complainant says some users of the site do not have licensed copies and points to Annex 13 of its evidence, which comprises screen shots from a thread in a member forum on the Teeria Legends site, and includes the following statement “Well the fact that over 50% of the population just torrents the game because they don’t think it is worth the money and I basically run a popular server just suits perfectly together..” This was written is by a forum participant called ‘”Anonymous”.’ This is of very limited assistance as it is not clearly attributable to the Respondent. Annex 12 submitted as evidence by the Complainant refers to a page at http://jteeria.eu/classic, and an announcement pointing to it. That page has links to two third party websites --Mega and MediaFire--with express reference to Terraria 1.2.4.1 being available there. The Complainant says this is illegal and/or unauthorized. The evidence at Annex 10 is similar and includes the store front for sale of in game ranks and trophies. The Complainant’s says in its supplemental statement that there is no reason for players with legal copies to want this older version it claims is provided at the links. The Respondent’s position seems to be that its game server is for use by those with a valid copy who are downgrading. A notice on the page at http://jteeria.eu/classic says: “Terraria® Version 1.2.4.1 is provided and hosted from a third-party download website like Mediafire, MEGA and other sites by which T.L. Works does not own or is not affiliated to in any way. All downloads under Terraria® Version 1.2.4.1 are embedded downloads from these said sites and Terraria® Version 1.2.4.1 is not hosted, uploaded or owned by T.L. Works or its Server. Older game versions of TERRARIA® can freely be downloaded all over the web & throughout the use of the Official Game Launcher. T.L. Works does not support any up-to-date 'illegal' downloads regarding TERRARIA®. The sole purpose of this webpage is merely to provide players to an older version of TERRARIA® which is required to play on our Service. Complaint against this webpage? Please refer to our Terms & Conditions. Terraria and associated Terraria images are copyright of Re-Logic. T.L. Works ("Teeria 'Legends' Works) is not affiliated with Terraria or Re-Logic.” Based on the panel's visit, the link to the Official Games Launcher clicks through to http://forums.terraria.org/index.php?threads/game-launcher-3-2-1-5.1061/ --the Complainant’s official site. Clicking the link through to the Mega service shows that an account is required to progress (and the panel could not). The terms of service contain all the usual prohibitions on infringements of the intellectual property and rights of others. MediaFire does appear to offer a download. See http://www.mediafire.com/policies/terms_of_service.php and the very detailed policy there, also prohibiting illegal activity. We do not know whether these terms are enforced or whether there is an authentication stage. In the EU there are limits to the right of a copyright owner to control sales of software and once exhausted, software may be resold and so “unofficial” and/or “unauthorised” downloads may be perfectly legal in the EU and it is possible that valid genuine copies are available at the links. The panel cannot determine whether the linked to downloads are genuine and legal or infringing or not and makes no finding on the point. This is not the correct forum for claims of either infringement or breach of contract and the panel cannot possibly make any definitive findings on the evidence available and no finding is made. Even if the downloads at those linked sites were not the genuine game, this would not necessarily render the Respondent’s publication or provision of the links alone infringements under EU law, see Cases 466/12 Svensson and C160/15 GS Media v Sanoma Media). The fact that this question arises tells us we are in territory that is not appropriate to this forum. To refuse to make findings as to counterfeits in a domain name decision is an accepted stance, see Bettinger and Waddell, Domain Name Law and Practice, Second Edition at p.1438, para. IIIE.431-4. Often a high level of evidence is required and it can rarely be met in these types of proceedings. If the Complainant has a valid claim of infringement against any party, including Mega and MediaFire, the forum for that is the relevant national courts based on the requisite sworn evidence and proper verification. This is not a forum for regulating or policing content or copyrights on the internet. Parties other than the trade mark owner can make use of a trade mark as necessary in order to sell or resell the genuine item, and this is recognized by the OKI Data rule, WIPO Case No.D2001-0903. The Complainant accepts that here the website has the appropriate disclaimers and that the Domain Names do not try to corner the market for the rule but disputes that the genuine game is offered at the links citing C-466/12 Svensson. As noted above, we cannot and do not make any finding on this so cannot determine whether OKI Data applies or whether this use is a bona fide offering under the Policy Regulation or not. A google search by the panel on Terraria 1.2.4.1 on 29 April 2016 revealed a discussion on https://www.reddit.com/r/Terraria/comments/3s7686/is_there_any_way_to_downgrade_to_1241/ which is illuminating and one of the

exchanges reads : “I really want to downgrade so I can use mods such as Exxo Avalon, but I can't find any way to do it. Is there any way to play 1.2.4.1? [–]Chrom_Of_Ylisse 9 points 5 months ago I own the actual game, but I have a pirated copy of 1.2.4.1 to use with mods. I don't think there is another way [–]I-Am-Gaben-AMA 2 points 5 months ago There used to be a Terraria launcher mod called Game Launcher, however (ironically) I don't believe it is available any more. I would recommend following others suggestions if pirating the game. Assuming that you have already payed for it, you are technically moraly OK….” This explains the demand for the older version. It also makes sense in light of the statement on the Respondent's page as set out above and makes sense of the Respondent's submissions. Mods, we assume are modifications and these and rewards can it seems be saved in members’ account section of the platform for the Teeria Legends site, where members can also store other game information. The terms are at http://www.enjin.com/terms and these include “Acceptable Use and Conduct” policies which prohibit certain conduct on pain of termination. The same rewards and mods and ‘in game’ ranks can be sold by members in the store (probably from storage in member accounts). Modifications and sale by users of in-game ranks and rewards and indeed 'unofficial' game servers may not be viewed favourably by game developers and may breach end user licences and/or contract terms. They may or may not infringe copyright. Again, the panel cannot determine this and this is not the correct forum for these questions. Once the Complainant has made a prima facie showing the burden shifts to the Respondent. Here the panel finds the Respondent has made out a legitimate and fair use of the Domain Names in the member forums and elements of the site that are in essence a fan site. The panel is unable to and so makes no findings on the other uses and whether they are a bona fide offering. The Complainant has failed on this ground. Bad Faith In terms of art.21 of the Policy Regulation, “(c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or (d) the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion[…]” The panel finds neither of these grounds made out here. The Respondent registered the Domain Names to make use which is in part fair and legitimate. While the Respondent was aware, from the WIPO case at least, that the Complainant objected to its use, and so had knowledge of its Rights and its opposition, that objection does not determine bad faith. There is no attempt here to impersonate or usurp the Rights of the Complainant and the selection of the Domain Names demonstrates this. Nor do those names in any way indicate endorsement, sponsorship or authorization. The Complainant has not made out Bad Faith.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied

Panelists

Name

DATE OF PANEL DECISION 2016-05-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: TEERIA, JTEERIA II. Country of the Complainant: USA, country of the Respondent: The Netherlands III. Date of registration of the domain name: 15 August 2015 IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision: 1. Word mark, registered as a CTM No. 013460316, for the term TERRARIA registered 4 May 2015 in respect of in classes 9, 14, 16, 18, 25, 26, 28, 41; 2. Figurative mark, registered as a CTM No. 013460431, for the term TERRARIA registered 4 May 2015 in respect of in classes 9, 14, 16, 18, 25, 26, 28, 41; 3. Word mark, registered as U.S. Reg. No. 4,176,854 for the term TERRARIA, filed 12 May 2011, registered 17 July 2012. First used: May 16, 2011 in respect of classes 9 and 41; 4. Figurative mark, registered as U.S. Reg. No. 4,180,576 for the term TERRARIA filed 12 May 2011, registered 17 July 2012. First used: May 16, 2011in classes 9 and 41. 5. geographical indication: 6. designation of origin: 7. unregistered trademark: Common law rights arising from use in the European Union, the United States and worldwide 8. business identifier: 9. company name: 10. family name: 11. title of protected literary or artistic work: 12. other: Name of game/software V. Response submitted: Yes VI. Domain name/s is/are not identical/confusingly similar/neither identical nor confusingly similar to the protected right/s of the Complainant VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004): 1. Yes 2. Why: A significant use is fair and legitimate as nominative and commercial activity is minor. No findings could be made as to other uses complained of VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004): 1. No 2. Why: Due to the fair and legitimate use IX. Other substantial facts the Panel considers relevant: Evidence not adequate for findings on other uses, nor did panel have jurisdiction X. Dispute Result: Complaint denied XI. Procedural factors the Panel considers relevant: N/A