Panel Decision for dispute CAC-ADREU-004154

Case number	**CAC-ADREU-004154**
Time of filing	**2007-01-09 13:11:32**
Domain names	**globetcasino.eu, globetvip.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Globet-International Sports Betting Limited, N/A**

Respondent

Organization / Name	**Cassini Limited, N/A**

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 unaware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

FACTUAL BACKGROUND

The Complainant in this ADR Proceeding is Globet International Sports Betting Limited, a limited company with a place of business in London, United Kingdom. The Complainant operates a members-only online gaming business.

The Respondent is Cassini Limited, an entity with an address in Gibraltar (United Kingdom overseas territory).

The Complainant is the proprietor of UK registered trademark number 2068509, for the word mark GLOBET covering the provision of betting and gaming services and relative information.

Both disputed domain names globetcasino.eu and globetvip.eu were registered by the Respondent on 7 April 2006.

The Complaint was filed on 9 January 2007, originally in respect of globetcasino.eu only. The Czech Arbitration Court acknowledged receipt of the Complaint and issued a Request for EURid Verification for that disputed domain name on the same date. On 9 January 2007, EURid replied in a non-standard communication confirming that the disputed domain name globetcasino.eu was registered with Mobile Name Services Incorporated, that the current Registrant of the domain name was the Respondent, that the domain name would remain locked during the pending ADR Proceeding and that the specific language of the registration agreement as used by the Registrant for the disputed domain name was English. It also provided the full details from the WHOIS database for the registrant, technical, administrative and billing contacts.

In a non-standard communication dated 9 January 2007, the Czech Arbitration Court noted that two Complaints had been filed by the Complainant:- No 4153 (globetvip.eu) and No 4154 (globetcasino.eu); the Parties and language of both were identical and consequently the Czech Arbitration Court approved the Complainant's request to join the Proceedings under a single case and issued a second Request for EURid Verification regarding the latter domain name. On the same date EURid provided its verification report for globetvip.eu in the same substantive terms as its earlier verification regarding globetcasino.eu.

On 16 January 2007 the Czech Arbitration Court provided a Notification of Deficiencies in Complaint regarding the absence of hard copies of the Complaint and annexes. On 22 January 2007 the Complainant filed an amended Complaint combining its two previous complaints and this passed the Czech Arbitration Court's formal compliance review. The formal date of the commencement of the ADR Proceeding was therefore 22 January 2007 and a Notification of Complaint and Commencement of ADR Proceeding was issued to the Respondent on that date. This stated that a Response was to be submitted within 30 working days. On 16 March 2007 the Czech

Arbitration Court filed a non-standard communication stating that the date by which a Response should be filed was 26 March 2007. The Respondent did not comply with this deadline and the Czech Arbitration Court notified the Respondent of its default on 27 March 2007.

Following an invitation to serve on the Panel in this dispute, the Panel accepted the mandate and submitted the Declaration of Impartiality and Independence in due time. The Czech Arbitration Court duly notified the parties of the identity of the Panel appointed on 3 April 2007, in accordance with paragraph B4(e) of the .eu Alternative Dispute Resolution Rules ('ADR Rules') and the date by which a decision on the matter was due, which was specified as 4 May 2007.

In the absence of a challenge to the Panel's appointment by either Party according to Paragraph B5(c) of the ADR Rules, the Czech Arbitration Court transmitted the case file to the Panel on 6 April 2007.

A. COMPLAINANT

The Complainant operates an online gaming business using a number of different domain names most of which incorporate the Complainant's GLOBET trade mark and through which the Complainant operates members-only online gambling services.

The Complainant spent over €400,000 in 2005 on advertising its services named Globetcasino and Globetvip with a corresponding budget for 2006 of €5.25 million. The Complainant has approximately 91,500 members and loyalty amongst members is high. The "Globet", "Globetcasino" and "Globetvip" brands have therefore each separately acquired a great deal of goodwill.

On 7 April 2006 the Respondent registered the disputed domain names and has since published websites associated with them offering links to various providers of services including online casinos and gambling services that are in direct competition with the Complainant's services as well as links to providers of credit, dating and adult dating services. A link to an "inquiry form" originally appeared on each website which solicited offers to purchase each disputed domain name.

Confusingly Similar

The Complainant submits that the disputed domain names are confusingly similar to the Complainant's trade mark within the meaning of Rule B1(b)(10)(i)A and within the meaning of section 10 paragraphs 2(b) and 3 of the Trade Mark Act 1994 ("TMA") of the United Kingdom. The Respondent is infringing the Claimant's rights in the Complainant's trade mark in terms thereof.

The disputed domain names merely consist of the Complainant's trade mark with "casino" and "vip" added respectively to each of them as a suffix. The Complainant's trade mark is very distinctive and a large number of the services offered or advertised by the Respondent on or through the websites associated with the disputed domain names are the same or similar to the services offered by the Complainant using the Complainant's trade mark.

It is likely that the Complainant's past and present customers, others who access or have accessed the Complainant's websites at each of the disputed domain names and those who know the Complainant by reputation will think that the services offered at the corresponding websites are offered by the Complainant or an undertaking that is economically linked to the Complainant.

Alternatively the Complainant submits that it has a right in each of "globetcasino" and "globetvip" which is protected by English Law under the doctrine of passing off as the Complainant has the requisite goodwill in the names, the Respondent makes a misrepresentation of an association with the Complainant and it is reasonably foreseeable that the Complainant will suffer damage (1) through loss of custom to competitors, (2) to its reputation and (3) via loss of advertising revenue due to decrease in traffic to the Complainant's websites.

The Complainant submits that "globetcasino" and "globetvip" are each very distinctive brands, which include the Complainant's trade mark, and so could only denote the Complainant as the trader. The registration and maintenance of a domain name which leads people to believe that the domain name holder is linked with the Complainant is also sufficient to make it an instrument of fraud contrary to English law (per British Telecommunications Plc & Other v One in a million Limited & Others [1999] 1 ETMR 61 and Global Projects Management Limited v Citigroup Inc (High Court) [2005] All ER (D) 182 (Oct)). It would be entirely reasonable to believe that sites with such similar yet unusual domain names are run by persons who are linked in some way.

Bad faith

The Respondent registered each of the disputed domain names with the intention 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. The link that existed until recently on each website inviting persons to make offers to purchase each disputed domain name is a clear indication of

such intention.

Each of the disputed domain names is being used to intentionally attract Internet users, for commercial gain, to the associated websites or other on-line location, by creating a likelihood of confusion with the Complainant's protected name. One of the ways in which the Respondent is likely to be making commercial gain is by using the reputation of the Complainant to increase traffic through the associated websites thus increasing the value of the advertising space thereon; the larger the number of hits on the website the bigger the premium on sale of each disputed domain name.

Lack of legitimate interest

Should the Panel find that the Respondent is not acting in bad faith, the Complainant would submit that, in relation to each of the disputed domain names, the Respondent does not have a legitimate interest.

B. RESPONDENT

The Respondent has not responded to the Complaint.

DISCUSSION AND FINDINGS

1. Preliminary - No Response

The Respondent has not filed a Response to the Complaint. In such an eventuality, the effect of the provisions of Article 22(10) of Commission Regulation (EC) No 874/2004 ('Regulation 874') and Paragraph B10(a) of the ADR Rules is that the failure may be considered by the Panel as grounds to accept the claims of the Complainant. However, this does not mean a Complaint will automatically be upheld whenever a Respondent fails to respond; the Complainant is still required to demonstrate that the provisions of Article 21(1) of Regulation 874 and Paragraph B11(d)(1) of the ADR Rules are satisfied.

2. Applicable provisions

This Complaint is brought under the auspices of Regulation 874 and the ADR Rules. Article 22(1)(a) of Regulation 874 allows any party to initiate an ADR procedure where the registration is speculative or abusive within the meaning of Article 21.

Article 21(1) states that a registered domain name may be subject to revocation 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.

Article 21(2) provides examples whereby the Respondent's legitimate interest may be demonstrated (echoed in Paragraph B11(e) of the ADR Rules), while Article 21(3) provides examples whereby bad faith may be demonstrated (similarly echoed in Paragraph B11(f) of the ADR Rules).

Article 10(1) states that:

"[...]

"'Prior rights' shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works."

Article 22(11) states that in the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, the domain name is to be transferred to the complainant if the complainant applies for it and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002.

Paragraph B11(d)(1) of the ADR Rules provides as follows:-

"The Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves

(1) in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated that

(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law and; either

(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) The domain name has been registered or is being used in bad faith."

It is clear from the applicable provisions that the burden of proving that a .eu domain name registration is speculative or abusive lies with the Complainant. Accordingly, the first question for the Panel is whether the Complainant has proved that the disputed domain 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. The Complainant indicates that it is the proprietor of both registered and unregistered rights in the names GLOBET, globetcasino and globetvip.

3. Rights - identical or confusingly similar

The Complainant cites a UK registered trade mark for the word mark GLOBET. Clearly this is a name in respect of which a right is recognised by national law. Neither disputed domain name is identical to this name. Accordingly, it is necessary to consider whether the disputed domain names are confusingly similar to it. For the purposes of comparison the top level domain ".eu" must be eliminated as wholly generic, leaving a comparison of "globetcasino" and "globetvip" with "GLOBET". The disputed domain names consist of the term "globet" accompanied by "casino" and "vip" respectively. Clearly the made-up word GLOBET is the distinctive element of each of the two disputed domain names and there is nothing on the record to indicate that this term is anything other than uniquely referable to the Complainant. The term "casino" is descriptive of the Complainant's services while the term "vip" (taken by the Panel to stand for "very important person" and often when used in a service context implying a preferred class of customer), might reasonably be intended to refer to the Complainant's membership. The Panel does not believe that the generic words clearly distinguish the disputed domain names from the trade mark and in fact considers that they may well cause further association with that mark given that the generic words are somewhat related to the Complainant's business. The disputed domain names are thus, in the Panel's view, confusingly similar to the name in which the Complainant holds registered rights.

The Complainant also asserts common law rights in the composite name making up each of the disputed domain names. The Complainant submits that the names Globetcasino and Globetvip are the names of two online businesses operated by the Complainant which are used by over 91,000 members and carry a very substantial advertising budget. It is reasonable to infer in the absence of any contradiction from the Respondent that such business names carry significant goodwill which would be protectable under the national law of the United Kingdom (in this case, English law) by action of passing off. Accordingly, on this ground alone the Panel determines that the disputed domain names are identical to names in which the Complainant holds appropriate rights.

4. Respondent's Rights or Legitimate Interest

The Panel then turns to the question of whether the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name. The Panel notes that contrary to certain other domain name dispute resolution policies Article 21 of Regulation 874 and the corresponding ADR Rules express the question in terms of the holder having registered without rights *or* legitimate interest [Expert's emphasis].

Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules provide non-exhaustive examples of how a Respondent might demonstrate a legitimate interest. These may be summarised as where (a) prior to notice of the dispute the Respondent has used (or made demonstrable preparations to use) the domain name in connection with the offering of goods and services; (b) the Respondent has been commonly known by the domain name; or (c) the Respondent is making a legitimate, non-commercial or fair use of the domain name without the intention to mislead consumers or to harm the reputation of a name in which there are rights under national or Community law.

There is no evidence on the record which indicates that Respondent might be able to satisfy any of these tests. Although the Complainant's direct submissions on this point are extremely limited, it is clear from its submissions as a whole that it is asserting that the Respondent is operating websites in respect of each disputed domain name containing advertising links to various providers of online casinos and gambling services in competition with the Complainant. The Respondent has provided no explanation for this use and the Panel cannot conceive of any potential explanation that might confer a right or legitimate interest upon the Respondent in the disputed domain names, whether in terms of the non-exhaustive examples in Article 21(2) of Regulation 874 and paragraph B11(e) of the ADR Rules or otherwise. Consequently, the Panel finds that the Respondent registered the disputed domain names without rights or legitimate interest.

5. Registered or used in bad faith

For the sake of completeness, the Panel will also deal with the issue of bad faith. This is expressed in Article 21(1)(b) of Regulation 874 and paragraph B11(d)(iii) as a further alternative to a lack of rights or legitimate interest which may be proved by the Complainant. It is important to note that registration or use in bad faith may be proved. Article 21(3)(a) to (e) and the corresponding paragraph B11(f)(1) to (5) provide non-exhaustive examples which may be evidence of bad faith registration or use.

In the present case, the Complainant focuses first upon Article 21(3)(a) [paragraph B11(f)(1)], namely circumstances indicating 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 recognized or established by national and/or Community law. The Complainant states that a link existed until recently on each website inviting persons to make offers to purchase each disputed domain name and it also provides screenshot copies of the relevant web form entitled 'Inquiry'. There is a disclaimer on this form stating that its presence does not constitute an offer to sell the domain name concerned, nor should it be taken that the registrant is stating any intention to sell it.

The Panel considers that the disclaimer is wholly inconsistent with the other terms of the 'Inquiry' form, which clearly invites offers in monetary terms. Given that the disputed domain names and relative website content are under the Respondent's control, in the Panel's view the Respondent cannot escape the consequences of having published the form (or allowed its publication) merely by the addition of such a disclaimer. Accordingly, the Panel finds that this circumstance is highly indicative of a use of the disputed domain names in bad faith.

The Complainant also focuses on Article 21(3)(d) [paragraph B11(f)(4)], namely that the disputed domain names were intentionally used to attract Internet users, for commercial gain to the Respondent’s website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is 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 Respondent. The Complainant submits that the commercial gain being made is not necessarily of a single type but that the Respondent is likely to be making commercial gain from the increase of traffic to the websites arising from the use of confusingly similar names to those in which the Complainant has a reputation. The Panel considers that this is a reasonable inference to make, and that it is highly probable that the websites associated with the disputed domain names have a commercial purpose which trades off the reputation of the Complainant, particularly in the absence of any alternative explanation by the Respondent. This circumstance is also highly indicative of bad faith use.

Taking both sets of circumstances together, the Panel finds that the disputed domain names have been used in bad faith.

The Panel has found that the Complainant has proved the required elements within Article 21(1). The Complainant seeks a transfer of the disputed domain names and appears to be eligible under Regulation (EC) No 733/2002. Accordingly, in terms of Article 22(11) of Regulation 874 the Panel determines that both of the disputed domain names should be transferred to the Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain names GLOBETCASINO.eu and GLOBETVIP.eu be transferred to the Complainant.

PANELISTS

Name	**Andrew D S Lothian**

DATE OF PANEL DECISION 2007-04-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant in this case claimed rights in the UK registered trade mark GLOBET and goodwill sufficient to found an action of passing off according to English Law in the trading names Globetvip and Globetcasino, being the names of two of its online gaming businesses. It asserted that the disputed domain names globetcasino.eu and globetvip.eu were confusingly similar to these names and had been registered and used in bad faith, on the basis that the associated websites had (1) originally contained an invitation to sell the names and (2) provided a series of advertising links to the Complainant's competitors. The Complainant also claimed in the alternative that the Respondent had no rights or legitimate interest in the disputed domain names.

The Respondent did not file any Response.

The Panel found that the disputed domain names were confusingly similar to the Complainant's registered trade mark GLOBET and were identical to its trading names (and that the Complainant had produced sufficient evidence of goodwill in the trading names which would found an action of passing off).

The Panel also found that there was no indication of any rights or legitimate interest on the part of the Respondent in the disputed domain names and that given the present use it was difficult to conceive of the Respondent having any such rights or interest. Accordingly, the Panel found that the Respondent did not have any rights or legitimate interest in the disputed domain names.

The Panel found that the disputed domain names had been used in bad faith in light of (1) the offer to sell the disputed domain names on the relative webpage [despite a disclaimer that the enquiry form soliciting offers should not be taken as an invitation to treat] and (2) the use of the disputed domain names for commercial gain by creating a likelihood of confusion with the names in which the Complainant has rights.

The Panel therefore ordered that the disputed domain names be transferred to the Complainant.