

ADMINISTRATIVE PANEL DECISION

Merryvale Limited v. Privacy service provided by Withheld for Privacy ehf /
Sommai Jongsuebpan
Case No. D2022-0373

1. The Parties

The Complainant is Merryvale Limited, Guernsey, represented by Herzog, Fox & Neeman, Israel.

The Respondent is Privacy service provided by Withheld for Privacy ehf / Sommai Jongsuebpan, Thailand.

2. The Domain Name and Registrar

The disputed domain name <royalbetway.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 13, 2022. On January 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 13, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 17, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 31, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 8, 2022.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on March 10, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complaint is filed by Merryvale Limited a company member of the Betway group (“Betway Group”), which operates in the online gaming and sport betting fields, via a website operated under the domain name <betway.com>.

The Complainant is the proprietor of trademark registrations for the word mark BETWAY in, *inter alia*, the European Union, United Kingdom, India, New Zealand, Japan and China including the following trademarks (hereafter the BETWAY Trademarks);

- the European Union (“EU”) trademark BETWAY No 018041195, registered on March 26, 2019, for products and services in classes 9 and 41;
- the EU semi-figurative trademark BETWAY No 012771564, registered on April 8, 2014, for products and services in classes 9, 41 and 42;
- the United-Kingdom (“UK”) trademark BETWAY No UK00003234076, registered on August 18, 2017, for products and services in classes 9 and 41;
- the Indian trademark BETWAY No 3202826, registered on March 4, 2016, for products and services in classes 9 and 41; and
- the New Zealand trademark BETWAY No 1036086, registered on January 26, 2016, for products and services in classes 9 and 41.

The disputed domain name <royalbetway.com> was registered on November 28, 2020.

The disputed domain name resolved to a website which offered online gaming and gambling services similar to those provided by the Complainant and the Betway Group and reproducing the BETWAY Trademarks.

On June 29, 2021, the Complainant sent the Respondent, via its privacy services provider, a cease-and-desist letter demanding to take down the website and cease its fraudulent activity.

At the date the Complaint was filed the disputed domain name was not active anymore.

5. Parties’ Contentions

A. Complainant

First, the Complainant claims that the disputed domain name <royalbetway.com> is confusingly similar to the BETWAY Trademarks, given that it reproduces the BETWAY Trademark in its entirety with a mere addition of the generic term “royal” and the generic Top-Level Domain (“gTLD”) suffix “.com” which do not detract from the confusing similarity between the disputed domain name and the Complainant’s trademarks. The Complainant adds that the dominant and distinctive element of the disputed domain name is their trademark BETWAY.

Second, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it is not affiliated with the Complainant and has never been licensed or otherwise authorized to use the BETWAY Trademarks. The Complainant highlights that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services. On the contrary, the Complainant finds that (i) the Respondent clearly used the disputed domain name to unlawfully benefit from the BETWAY Trademarks’ reputation and in order to attract the Complainant’s customers, or potential customers to its website (ii) even passive holding of the disputed domain name does not constitute a *bona fide* offering of goods or services.

At last, the Complainant claims that the Respondent has registered and is using the disputed domain name in bad faith, considering that: (i) the Complainant has owned and used the BETWAY Trademarks, which were world-famous brand, long before the Respondent had registered the disputed domain name so that the Respondent knew or should have known the Complainant's trademarks; (ii) the use of the disputed domain name is clear evidence that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its website and to the services provided thereunder by creating a likelihood of confusion with the BETWAY Trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, the Complainant shall prove the following three elements:

- (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.

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the BETWAY Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainants' trademark and the disputed domain name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name consists of a common, obvious, or intentional misspelling of a trademark, the domain name will be considered by panels to be confusingly similar to the relevant mark for purposes of the UDRP (see section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Regarding the disputed domain name <royalbetway.com>, the Panel finds that it is composed of;

- the word "royal";
- the BETWAY Trademark in its entirety; and
- the gTLD ".com", it being specified that the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

According to prior UDRP panel decisions, it is sufficient that the disputed domain name incorporates the

entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of a word to a mark does not prevent a finding of confusing similarity (See *Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov*, WIPO Case No. [D2011-1474](#); *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#); *Bayerische Motoren Werke AG v. bmwcar.com*, WIPO Case No. [D2002-0615](#); *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. [D2013-0150](#); and *RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#)).

The Panel considers that, in this case, the addition of the term “royal” to the BETWAY trademark included in the disputed domain name does not prevent a finding of confusing similarity.

Therefore, the Panel holds that the disputed domain name <royalbetway.com> is confusingly similar to the BETWAY Trademarks and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainants shall demonstrate that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent’s rights or legitimate interests in the disputed domain name.

These circumstances are;

- before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in UDRP proceedings is on the complainant, previous UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Indeed, it appears that the Respondent has no affiliation with the Complainant and has not received any authorization or license to use the BETWAY Trademarks in the disputed domain name or in any other manner.

Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the disputed domain name or that the Respondent has the intent to use the disputed domain name in connection with a *bona fide* offering of goods and services. Indeed, the Complainant has provided evidence that the disputed

domain name was used in order to unlawfully benefit from the BETWAY Trademarks' reputation and in order to attract the Complainant's customers, or potential customers to its website. Prior UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., counterfeit) can never confer rights or legitimate interests upon a respondent (see section 2.13 of the [WIPO Overview 3.0](#)).

In any case, the Respondent did not reply to the Complainant's contentions.

Therefore, according to the Policy, paragraph 4(a)(ii) and 4(c), the Panel considers that the Respondent does not have rights or legitimate interests in the disputed domain name <royalbetway.com>.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the disputed domain name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 domain name; or
- (ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

First, the Panel considers that it is established that the Complainant's BETWAY Trademarks were registered before the registration of the disputed domain name so that there is a presumption of bad faith registration of the disputed domain name, given the fact that the disputed domain name wholly reproduces the BETWAY Trademark. In addition, the Panel considers that the Respondent clearly had knowledge of the Complainant's prior trademarks at the time of registration of the disputed domain name, as the website accessible from the disputed domain name reproduced the BETWAY Trademarks without authorization and offered online gaming and gambling services similar to those provided by the Complainant. As a result, there is no doubt that at the time of registration of the disputed domain name, the Respondent was aware of the Complainant's trademarks and registered the disputed domain name in bad faith.

Furthermore, the Panel finds that the disputed domain name resolved to a website, which offered online gaming and gambling services similar to those provided by the Complainant and the Betway Group and reproducing the BETWAY Trademarks. This use of the disputed domain name constitutes an intentional attempt of the Respondent to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's BETWAY Trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website, which is a scenario constituting evidence of the Respondent's bad faith in using the disputed domain name.

Moreover, the Panel finds that, at the date of the decision, the disputed domain name is inactive and reminds that such "passive holding" does not prevent a finding of bad faith, since according to prior UDRP panel

decisions the panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith (See section 3.3 of the [WIPO Overview 3.0](#) and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

In this case, the Panel believes that the passive holding of the disputed domain name proves that the Respondent acts in bad faith, given the particular circumstances listed below:

- the Complainant has provided evidence that the Complainant's Trademarks are widely known,
- the Respondent has not provided any answer to the Complainant's contentions,
- the Respondent has masked its identity by a privacy service when registering the disputed domain name.

Considering all of the above, it is not possible to conceive of any plausible actual or contemplated good faith registration and use of the disputed domain name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the disputed domain name in bad faith according to the Policy, paragraph 4(a)(iii) and 4(b).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names, <royalbetway.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: March 24, 2022