

## **ADMINISTRATIVE PANEL DECISION**

Playdead ApS v. Dino Patti

Case No. D2022-3777

### **1. The Parties**

Complainant is Playdead ApS, Denmark, represented by Bugge Valentin Law Firm, Denmark.

Respondent is Dino Patti, Denmark, represented by Kim G. Hansen – IT Law, Denmark.

### **2. The Domain Name and Registrar**

The disputed domain name <playdead.com> (the “Domain Name”) is registered with CSL Computer Service Langenbach GmbH dba Joker.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2022. On October 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 11, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced on October 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2022. On October 19, 2022, the Center received an email from Respondent. The Response was filed with the Center November 7, 2022. Complainant submitted an unsolicited supplemental filing on November 25, 2022.

The Center appointed Robert A. Badgley, Lone Prehn, and Knud Wallberg as panelists in this matter on December 1, 2022. The Panel finds that it was properly constituted. Each member of 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.

On December 2, 2022, Respondent submitted a response to Complainant's unsolicited supplemental filing. In its discretion, the Panel has considered both Parties' supplemental submissions.

#### **4. Factual Background**

Complainant Playdead ApS develops and manufactures computer video games. Complainant holds various trademark registrations in several jurisdictions for the word mark PLAYDEAD, including European Union trademark 010875102, registered on September 21, 2012, in connection with computer games, software, entertainment services, computer software development and design in Classes 9, 41, and 42, as well as United States of America trademark 4,711,025, registered on March 31, 2015, in connection with computer games, software, entertainment services, computer software development and design in Classes 9, 41, and 42.

Complainant was formed in 2008 by a firm called Underholdningsbranchen ApS ("Underhold"), which firm had been founded in 2006 by Arnt Jensen. According to the Complaint, Respondent Dino Patti became a member of Underhold's management in 2007. At the time Complainant was formed, its name was Limbo ApS. In July 2012, Complainant changed its name from Limbo ApS to its current name, Playdead ApS.

On February 2, 2009, Respondent was employed by Complainant. While an employee of Complainant (and a 49 per cent shareholder in Underhold), Respondent acquired the Domain Name from its previous owner (about whom nothing is known from the record). Respondent registered the Domain Name in his own name, and not in the name of Complainant.

According to Complainant, in 2015 Arnt Jensen and Respondent had "severe disagreements". In January 2016, Jensen and Respondent reached an agreement whereby Respondent sold his 49 per cent stake in Underhold to Jensen. Under the agreement, Respondent stayed on as a consultant until July 2016.

Respondent is currently a director of the United Kingdom firm Jumpship Ltd., which firm Complainant describes as a "competitor" of Complainant.

The Domain Name was first created/registered on April 4, 2001. It is not clear from the record whether and how the Domain Name was used by its initial owner. Respondent acquired the Domain Name on June 20, 2013. The Domain Name apparently has been redirected to Complainant's main website since Respondent acquired it.

According to Complainant, Respondent had no right to register the Domain Name in his own name, as opposed to Complainant's name, and Respondent has wrongfully refused to transfer ownership of the Domain Name to Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

##### **B. Respondent**

Respondent raises many arguments in opposition to Complainant's request for a transfer of the Domain Name. The Panel will address some of these arguments, but will disregard some of them as being irrelevant.

Above all else, Respondent appears to argue that this dispute should not be decided by this Panel in a UDRP proceeding, because the Parties had previously agreed contractually to waive and release any and all claims they may have against each other. Further, Respondent asserts, if the Parties' contract must be construed to resolve their current dispute, that contract construction should be performed by a court or arbitration panel under Danish law, not by this Panel under the auspices of the UDRP.

Respondent claims that he is not acting in bad faith because the Domain Name actually redirects to Complainant's website, and hence there is no possible harm to Complainant.

In addition, Respondent asserts, with respect to the first element of the Policy (whether the Domain Name is identical or confusingly similar to a trademark in which Complainant has rights), that the registered trademark in force at the time Respondent acquired the Domain Name in 2013 had "legal effect" for the European Union only.

Respondent also asserts that Complainant's trademark rights did not accrue until 2012, which is after the original creation/registration of the Domain Name in 2001, and therefore Complainant somehow does not have a case.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Panel concludes that Complainant has rights in the trademark PLAYDEAD through registration proven in the record. The Panel concludes that the Domain Name is identical to Complainant's trademark.

As noted above, Respondent asserts that the registered trademark that Complainant held at the time Respondent acquired the Domain Name in 2013 had "legal effect" for the European Union only. Respondent, represented by counsel, should know that, for purposes of the first element of the UDRP, a complainant must establish rights in a trademark in any jurisdiction, and need not show rights in a trademark in a particular jurisdiction of interest to the respondent.

Respondent also asserts that Complainant's trademark rights did not accrue until 2012, which is after the original creation/registration of the Domain Name in 2001, and therefore Complainant somehow does not have a case. First, this point is not germane to the first element of the Policy. Second, what matters in this case is Respondent's acquisition of the Domain Name, not the previous registration by someone not involved in this case. It is undisputed in this case that Respondent (an employee of the Complainant; so aware of its intellectual property) did not acquire the Domain Name until 2013, after Complainant already had at least one registered trademark for PLAYDEAD. Again, Respondent, represented by counsel, ought to know that the initial registration of the Domain Name in 2001 by an unrelated third party is irrelevant to this dispute. In the Panel's view, raising a spurious argument like this has undermined Respondent's overall credibility in this case.

Complainant has established Policy paragraph 4(a)(i).

## B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. None of the above-quoted “safe harbors” applies here, based on the record presented.

Respondent, as an employee of Complainant (and a minority shareholder of Complainant’s parent company), knew perfectly well that Complainant was using PLAYDEAD as its brand and had at least one registered trademark for PLAYDEAD at the time Respondent registered the Domain Name in 2013. Respondent had no right to register the Domain Name in his own name; he should have registered it on behalf of his employer, Complainant, and should not have refused to transfer the Domain Name to his employer after the Parties parted ways.

Respondent does not assert any good-faith basis for having registered the Domain Name in his own name and having retained it after leaving Complainant’s employ. Respondent’s chief argument is that the Parties reached a comprehensive contractual settlement of all their disputes in 2016. In that contract, Respondent asserts, a transfer of the Domain Name was not required, and the Parties mutually agreed to waive and release all possible future claims against each other. As such, Respondent argues, the UDRP process may not be used to circumvent a contractually-agreed waiver of rights. In Respondent’s words, “according to the Settlement Agreement, [...], Complainant cannot bring any claims against Respondent as to events, including Respondents acquisition of the trademark, [...] and Respondents ownership of the domain name shall be deemed a part of the settlement agreed upon by Complainants parent company...”.

The Panel rejects this argument. First, although Respondent describes the Parties’ 2016 contract as a “Settlement Agreement”, that is not the actual title of the contract. Rather, as translated from Danish, the contract is entitled “Share Transfer Agreement”. Second, the principal focus of the agreement is to effectuate the transfer of Respondent’s 49 per cent stake in Underhold to Arnt Jensen.

The Panel does not in any event interpret the supposed release language in the Share Transfer Agreement as applying to bar this UDRP proceeding.

Moreover, the Panel takes the view that the Domain Name was never legitimately Respondent’s “property”, and hence the disposition of the Domain Name properly lies outside the scope of the 2016 Share Transfer Agreement. (It bears noting that the Share Transfer Agreement does not mention the Domain Name or any trademark issues.)

Finally, the Panel notes that Respondent has always directed the Domain Name to Complainant’s website, which the Panel regards as an admission that Respondent has no rights or legitimate interests in the Domain Name.

Complainant has established Policy paragraph 4(a)(ii).

### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the “Rights or Legitimate Interests” section.

It is undisputed that Respondent, while an employee of Complainant and fully aware of Complainant’s rights in the trademark PLAYDEAD, registered the Domain Name in his own name. In these circumstances, that unauthorized act was in bad faith as far as the present proceeding is concerned. The bad faith underlying Respondent’s acquisition of the Domain Name in his own name became manifest when Respondent refused to transfer the Domain Name to his former employer. See, e.g., *INTERTEX, Inc. v. Shant Moughalian Contess, Inc.*, WIPO Case No. [D2017-0480](#) (“Respondent violated his duty as an employee of Complainant when, without authorization, he registered the Domain Names in his own name – or later shifted the registrations into his own name – thereby taking advantage of Complainant’s potential or existing rights.”).

The Panel also finds Respondent’s ongoing retention of the Domain Name, and its redirection to Complainant’s website, to be bad faith use in these circumstances. Respondent is essentially holding the Domain Name hostage for no conceivable purpose other than to spite Complainant or to exercise leverage over Complainant, a competitor of Respondent at this time.

Complainant has established Policy paragraph 4(a)(iii).

## 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 Domain Name <playdead.com> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Presiding Panelist

*/Lone Prehn/*

**Lone Prehn**

Panelist

*/Knud Wallberg/*

**Knud Wallberg**

Panelist

Date: December 15, 2022