

## **ADMINISTRATIVE PANEL DECISION**

### **NOVOMATIC AG v. Stefan Koralewski**

#### **Case No. D2022-4226**

#### **1. The Parties**

The Complainant is NOVOMATIC AG, Austria, represented by Simmons & Simmons, Germany.

The Respondent is Stefan Koralewski, United States of America (United States), self-represented.

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

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

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2022. On November 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 November 9, 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 amendment to the Complaint on November 14, 2022.

The Center verified that the Complaint together with the amendment to 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 the Respondent of the Complaint, and the proceedings commenced on November 18, 2022. In accordance with the Rules, paragraph 5, the initial due date for Response was December 8, 2022, however was extended to December 12, 2022, upon the request of the Respondent. The Response was filed with the Center on December 12, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on December 21, 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.

On December 22, 2022, the Complainant submitted an unsolicited supplemental filing.

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

The Complainant was founded in 1990. It produces, operates and distributes gaming technologies around the world. According to the Complaint, it employs more than 30,000 staff worldwide with offices in more than 50 countries and exports its gaming machines to more than 70 countries. It has some 255,000 gaming terminals and video lottery terminals in its own approximately 2,100 gaming operations or rental arrangements.

In addition to physical premises, it also offers its games online.

In 2018, the Complainant's annual turnover was EUR 5 billion making it, according to the Complaint, one of the largest high-tech gaming technology companies worldwide and Europe's market leader.

The Complaint includes evidence that the Complainant owns at least 41 registered trademarks beginning with "NOVO". For present purposes, it is sufficient to note:

- (a) European Union Trademark No. 005839915, NOVO LINE, which was entered on the Register on March 26, 2008 with effect from April 18, 2007 in respect of relevant goods and services in International Classes 9, 28 and 41; and
- (b) European Union Trademark No. 011184272, NOVOLINE, which was entered on the Register on January 25, 2013 with effect from September 13, 2012 in respect of relevant goods and services in International Classes 9, 28 and 41.

The Panel also notes that the Complainant is the owner of European Union Trademark No. 004451431, BOOK OF RA, which has been registered since May 24, 2006, with effect from May 23, 2005 in respect of computer software for casinos and amusement arcades, in particular for slot machines, gaming machines or video lottery games in International Class 9.

The disputed domain name was registered on March 4, 2015.

The disputed domain name resolves to a website from which what appear to be the Complainant's games such as "Book of Ra", "Book of Ra Deluxe" and "Columbus Deluxe" can be played.

Although the Whois record records that the Respondent is based in the United States, the website to which the disputed domain name resolves is in German.

It appears from the materials included in the Response and the Respondent's website that there was a period, possibly from 2017 until 2022, when it was not legal in Germany to play gaming machines online for "real" money.

#### **5. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

While the Complainant has submitted a brief unsolicited supplemental filing, the proposed supplemental filing directly addresses matters arising out of the Response which, at least arguably, could not reasonably have been anticipated in advance. Accordingly, in the exercise of its powers under paragraph 12 of the Rules the Panel will accept the supplemental filing as part of the record.

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

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of at least the registered trademarks for NOVOLINE and NOVO LINE identified in section 4 above.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level-Domain (gTLD) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".com" gTLD, the disputed domain name consists of the Complainant's registered trademark and the term "sofort". According to the Google Translate function, "sofort" translates from German into English as "right away". As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g. [WIPO Overview 3.0](#), section 1.8. Apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

#### **B. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

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

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name after the Complainant registered its NOVO LINE trademark and also after the Complainant had applied to register its NOVOLINE trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived.

The disputed domain name resolves to a website apparently offering access to the Complainant's games online. The Respondent contends that he registered the disputed domain name in 2015 to participate in an affiliate program being offered for the Complainant's games by Stargames.

When registering to participate in the affiliate program, it was necessary to provide the domain name(s) that would be used to provide the affiliate services.

In support of his contention, the Response includes information that indicates that Stargames is part of the Complainant's corporate group and public media information indicating that Stargames is some sort of licensee or providing and marketing the Complainant's games online. An example is the media release dated July 1, 2021 "Greentube-owned StarGames live throughout Germany". As a result of mergers and other activity, it appears that the, or an, affiliate program is now operated by <CasinoAffiliateProgramm.de>.

The Response also includes emails from 2011, 2012 and later involving either the Respondent or a Mr. Eilers, whom the Respondent describes as his business partner or former business partner, and Stargames. According to the Response, the affiliate account in question having first been registered in Mr. Eilers' name was transferred to the Respondent in 2016.

The Complainant's supplemental filing states that neither Mr. Eilers nor the Respondent are known to the officers of the Complainant who are providing instructions to its representative in this proceeding. The supplemental filing also contends that transfers of affiliate accounts were not permitted under the General Terms and Conditions applicable to such accounts.

The Distribution contract included in the Response is with Mr. Eilers named as the affiliate, not the Respondent. The Respondent has provided evidence of at least one payment directly to him, however it was made before the date of the Distribution contract. According to the Response, this was just the first payment. The Response does allege that there have been subsequent payments to the Respondent. There is a more recent email directly to the Respondent from the person the Respondent describes as "our" affiliate manager.

It is not entirely clear from the Response or the text of the email what the subject matter is. It does not appear to suggest that the Respondent is not an affiliate. As noted above, however, the Respondent describes Mr. Eilers as his business partner or, possibly, former partner. Whether this means they were partners in the legal sense is not clear but it does appear from the material before the Panel that the Respondent and Mr. Eilers were not dealing with each other at arm's length as strangers.

It also appears that some sort of relationship, or good terms, still exists between the Respondent and Mr. Eilers as Mr. Eilers has forwarded to the Respondent material for inclusion in the Response.

While the Complainant's supplemental filing disclaims knowledge of either the Respondent or Mr. Eilers, the supplemental filing does not dispute that Stargames and <CasinoAffiliateProgramm.de> are part of the Complainant's corporate group.

While the Complainant has raised a *prima facie* case against the Respondent, the Response provides information that goes a considerable way towards rebutting that *prima facie* case. The relationship (if any) between the Respondent and the Complainant through Stargames and the affiliate manager <CasinoAffiliateProgramm.de> does not emerge with any clarity on the materials before the Panel. Indeed, it might be doubted whether a proceeding such as the present proceeding under the Policy is well-suited to this kind of dispute. Ultimately, it is not necessary for the Panel to reach a final decision on this point in view of the conclusion the Panel would reach under the third requirement; to which the Panel now turns.

### **C. Registered and Used in Bad Faith**

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: See *e.g.*, *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

There is no dispute between the parties that the Respondent was well aware of the Complainant's NOVOLINE trademark when he registered, or became the registrant of, the disputed domain name.

On the materials provided by the Respondent, however, it appears that he registered, or became the registrant of, the disputed domain name in the belief that he was doing so to participate in an affiliate program being operated for the Complainant by Stargames.

In this regard, the Respondent points out that his acceptance in the affiliate program required him to nominate the domain names that he would be using and so Stargames agreed to the use of the disputed domain names.

As noted above, the Complainant has not disputed that Stargames is part of the Complainant's corporate group or operating an affiliate program on the Complainant's behalf. The extent of Stargames authority, if any, to authorise the use of the Complainant's trademark is unclear on the record in this case but does not appear to have been challenged by the Complainant.

Nonetheless, as Stargames was (and is) a member of the Complainant's corporate group and appears to have been responsible for promoting the Complainant's group's products at least until recently, the Respondent can hardly be criticised for believing his registration and use of the disputed domain name was undertaken with the Complainant's authority.

In these circumstances, the Panel does not think the Complainant has sufficiently proven that the Respondent registered the disputed domain name in bad faith for the purposes of the Policy whether he was the original registrant or became the registrant as a result of the transfer of the affiliate account from his business partner in 2016 (bearing in mind the relationship with Stargames appears to have continued for several years after that transfer without objection).

In view of the conjunctive nature of the elements under the third requirement, therefore, the Complainant cannot establish that the disputed domain name has been registered and is being used in bad faith.

Accordingly, the Complaint must fail.

## **6. Decision**

For the foregoing reasons, the Complaint is denied.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: January 4, 2023