

## **ADMINISTRATIVE PANEL DECISION**

**NOVOMATIC AG v. Stefan Koralewski, Dennis Pfahl**

**Case No. D2022-4248**

### **1. The Parties**

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

The Respondents are Stefan Koralewski (the “First Respondent”) and Dennis Pfahl (the “Second Respondent”), Germany, self-represented.

### **2. The Domain Names and Registrars**

The disputed domain names <bookofra-spielautomat.com> and <book-of-ra-spielen.com> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com and GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 9, 2022. On November 9, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On November 9, 2022 and November 10, 2022, the Registrars transmitted by email to the Center their verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 10, 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 November 17, 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 November 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 8, 2022. Upon the Respondent’s request, the Respondent was granted an automatic four calendar day extension for response under paragraph 5(b) of the Rules. 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 November 14, 2022, the Center received an email from the First Respondent stating that both disputed domain names were under his control.

On December 23, 2022, the Center received an unsolicited supplemental filing from the Complainant.

#### 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 registered trademarks based on "Book of Ra". For present purposes, it is sufficient to note:

- (a) 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.
- (b) European Union Trademark No. 012456828, BOOK OF RA and device, which was entered on the Register on April 25, 2014 with effect from December 9, 2013 in respect of relevant goods and services in International Class 9; and

It is not in dispute between the parties that the First Respondent registered the disputed domain names:

- (1) <book-of-ra-spielen.com> on March 3, 2011; and
- (2) <bookofra-spielautomat.com> on February 16, 2013.

Both disputed domain names resolve to the same website, which appear to offer for play the Complainant's Book of Ra, Book of Ra Deluxe and other games such as Lucky Lady's Charm and Sizzling Hot. (The Panel notes in passing that this appears to be the same website as the website to which another domain name held by the First Respondent, <sofortnovoline.com>, also resolves – see *NOVOMATIC AG v. Stefan Koralewski*, WIPO Case No. [D2022-4226](#).)

#### 5. Discussion and Findings

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

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain names have been registered and are 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.

The Panel notes that the email address and telephone number provided by the Second Respondent, or in the Second Respondent's name, on registration of the disputed domain name <bookofra-spielautomat.com> are the same as those provided by the First Respondent in the Whois record for the disputed domain name <book-of-ra-spielen.com>. An annexure to the First Respondent's email to the Center on November 14, 2022 also includes evidence showing him as controlling the website to which the disputed domain name <bookofra-spielautomat.com> resolves. Given the email of November 14, 2022 and the content of the Response and its annexes, therefore, the Panel considers it is appropriate to proceed on the basis that the First Respondent is in fact the Respondent. In any event, it would be appropriate to order consolidation of the Complaints pursuant to paragraph 10(e) of the Rules. Accordingly, the Panel will refer to the First Respondent as the Respondent unless it becomes necessary to distinguish between him and the Second Respondent.

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 names are 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 names must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the registered trademarks for BOOK OF RA identified in section 4 above.

The second stage of this inquiry simply requires a visual and aural comparison of each 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.

In the case of European Union Trademark No. 012456828, it is also appropriate to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. See for example, [WIPO Overview 3.0](#), section 1.10.

Disregarding the “.com” gTLD and the device element of European Union Trademark No. 012456828, both disputed domain names consists of the Complainant’s registered trademark and either the term “spielautomat” or “spielen”. These are both descriptive words translating from German into English as “slot machine” and “play”. In one case of course the words “book” “of” “ra” are separated by hyphens and in the other without spaces at all. These typographical differences are common ways of dealing with “spaces” in Internet names and can be disregarded as trivial. As this requirement under the Policy is essentially a standing requirement, the addition of these descriptive terms 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 both disputed domain names.

Accordingly, the Panel finds that the Complainant has established that the disputed domain names are confusingly similar with 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 names.

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 both disputed domain names after the Complainant began using its trademark and also after the Complainant had registered its first trademark.

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

The disputed domain names are 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 names could be derived.

Both disputed domain names resolve to a website apparently offering access to the Complainant’s games

online, including the Complainant's Book of Ra games. The Respondent contends that he registered the disputed domain names to participate in an affiliate program for the Complainant's games being offered by Stargames.

When registering to participate in the affiliate program, it was necessary to provide the domain names 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 (Europe Support Ltd.). 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, however, has provided evidence of at least one payment directly to him in 2011 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 names have 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 BOOK OF RA trademark when he registered, or became the registrant of, both disputed domain names.

On the materials provided by the Respondent, however, it appears that he registered, or became the registrant of, the disputed domain names 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 names in bad faith for the purposes of the Policy.

In view of the conjunctive nature of the elements under the third requirement, therefore, the Complainant cannot establish that the disputed domain names have been registered and are 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: December 30, 2022