

ADMINISTRATIVE PANEL DECISION

Pragmaticplay Ltd v. Domains by Proxy, LLC / minsu kim
Case No. D2022-1001

1. The Parties

The Complainant is Pragmaticplay Ltd, Malta, represented by RM Warner P.L.C., United States of America (“United States”).

The Respondent is Domains by Proxy, LLC, United States / minsu kim, Republic of Korea.

2. The Domain Name and Registrar

The disputed domain name <tw-pragmaticplay.net> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 23, 2022. On March 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 24, 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 April 5, 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 April 6, 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 April 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 25, 2022.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on June 2, 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 Complainant is a Maltese corporation incorporated in December 2014. The Complainant was issued a license by the Malta Gaming Authority to develop and supply games. The Complainant is a provider of mobile and desktop casino games for the online gaming industry.

The Complainant registered on September 1, 2018, the European Union Trade Mark ("EUTM") PRAGMATICPLAY (trade mark no. 017891041) for goods and services in Classes 9 and 41.

The Complainant also registered the domain names <pragmaticplay.com> and <pragmaticplay.net>, to redirect consumers to their dominant domain name <pragmaticplay.com>.

The disputed domain name was registered on April 8, 2022, and resolved to a website reproducing Complainant's trademark and purporting to offer Complainant's products. At the moment of drafting this Decision, the disputed domain name resolves to a parking website containing PPC links.

5. Parties' Contentions

A. Complainant

The disputed domain name fully incorporates the Complainant's PRAGMATICPLAY trademark in an identical manner with the sole, but irrelevant, addition of "tw-" preceding it.

On March 23, 2021, a previous UDRP decision ordered the transfer of another confusingly similar domain name, <pragmatlclplay.com>, to the Complainant under similar facts and circumstances, and determined that the Complainant has rights to the Marks based on its EUTM trademark registration.

The Respondent has no rights or legitimate interests in the disputed domain name.

According to the Complaint, the Respondent cannot demonstrate that:

- (i) before any notice of this dispute, the Respondent engaged in any legitimate use or demonstrable preparations to use, the domain name or corresponding name, in connection with a *bona fide* offering of goods or services;
- (ii) the Respondent (as an individual, business, or other organization) has ever been commonly known by the disputed domain name; or
- (iii) 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 the Complaint, the Respondent has engaged in precisely the exact opposite – using the disputed domain name to illegally convince consumers that the Respondent is the Complainant and offering cloned versions of the Complainant's online casino games.

According to the Complaint, the Respondent has demonstrably registered the domain name in bad faith. Given the aforementioned factual history above, the Respondent cannot show that it has registered the domain name for any good faith basis:

- (i) since obtaining the disputed domain name the Respondent has already committed fraud by pretending to be the Complainant and offering stolen versions of Complainant's proprietary games;
- (ii) the Respondent fraudulently represented that the cloned games were being operated by the Complainant through the unlawful and deceptive use of the Complainant trademark;
- (iii) the abusive and fraudulent use of the domain name clearly shows that the Respondent registered the domain name primarily for the purpose of scamming current and future customers of the Complainant; and

(iv) the Respondent appears to have no legitimate use of the domain name but to continue making money off of the goodwill and reputation of the Complainant's trademark PRAGMATICPLAY.

The Complaint stated that the Respondent has used the disputed domain to offer cloned and/or stolen versions of the Complainant's online casino games as demonstrated with the evidence included in the Complaint.

The Complainant request the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (i) the 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 such domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established its trademark rights in PRAGMATICPLAY as evidenced by the trademark registrations submitted with the Complaint, as mentioned above.

The Panel finds that the disputed domain name is confusingly similar to the Complainants' trademark PRAGMATICPLAY. The mark PRAGMATICPLAY is clearly recognizable in the disputed domain name. The Panel has had little difficulty in finding that the disputed domain name is confusingly similar to the trademark PRAGMATICPLAY. The addition of the two letters "tw" and the hyphen "-" does not prevent the finding of confusingly similarity.

Therefore, the Panel finds that the Complainants have satisfied the first requirement of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to you 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 (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 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.

There is no evidence of the existence of any of those rights or legitimate interests. The Complainant has not

authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. The Complainant has prior rights in the trademarks which precede the Respondent's registration of the disputed domain name. The Respondent purportedly offers the Complainant's games without disclosing its lack of relationship with the Complainant, which cannot constitute a *bona fide* offering of goods and services, nor a legitimate noncommercial or fair use. Moreover, per Complainant, the offer of cloned and/or stolen versions of the Complainant's online casino games constitutes an illegal activity, previous UDRP panels have held that an illegal activity can never confer rights or legitimate interests on a respondent. The Complainant has therefore established a *prima facie* case that the Respondent has no rights and legitimate interests in the domain name and thereby shifted the burden to the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to rebut the Complainant's *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second requirement of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Complainant's allegations with regard to the Respondent's registration and use of the domain name in bad faith has been considered by the Panel. These allegations have not been contested by the Respondent because of its default.

The Complaint stated that the Respondent has used the disputed domain to offer cloned and/or stolen versions of the Complainant's online casino games as demonstrated with the evidence included in the Complaint. As mentioned above, the Respondent has not denied this assertions because of its default.

The circumstances in the case before the Panel indicate that the Respondent was aware of the Complainant's trademarks when registering the domain name and that it has intentionally been and is being used in an attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainants' trademarks as to the source, sponsorship, affiliation, or endorsement of the website or of a product or service on a website.

The failure of the Respondent to answer the Complainant's Complaint and take any part in these proceedings also suggests, in combination with other factors, bad faith on the part of the Respondent (*Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#)).

Therefore, taking all the circumstances into account and for all the above reasons, the Panel concludes that the Respondent has registered and is using the domain name in bad faith.

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 name <tw-pragmaticplay.net> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: June 17, 2022