

## **ADMINISTRATIVE PANEL DECISION**

Novomatic AG v. Jose Morquel

Case No. D2022-4546

### **1. The Parties**

The Complainant is Novomatic AG, Austria, represented by GEISTWERT Kletzer Messner Mosing Schnider Schultes Rechtsanwälte OG, Austria.

The Respondent is Jose Morquel, Kazakhstan.

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

The disputed domain name <gaminator.cash> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 29, 2022. On November 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 29, 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 (who was initially named on the Whois simply as "REDACTED FOR PRIVACY, Privacy service provided by Withheld for Privacy ehf") and contact information in the Complaint. The Center sent an email communication to the Complainant on December 1, 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 December 1, 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 December 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 17, 2023.

The Center appointed Gareth Dickson as the sole panelist in this matter on January 30, 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 an Austrian high-tech gaming technology founded in 1990. The group of which it forms part employs more than 21,000 people across 50 countries and it has a worldwide turnover of approximately EUR1.8bn.

The Complainant is the owner of a number of trade mark registrations for GAMINATOR (the “Mark”) around the world, including:

- European Union Trade Mark registration number 003602596, registered on June 22, 2005; and
- European Union Trade Mark registration number 009655441, registered on May 25, 2011.

The disputed domain name was registered on November 1, 2017. It is currently inactive and does not point to any active website.

#### **5. Parties’ Contentions**

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

The Complainant argues that it has rights in the Mark by virtue of its ownership of various trade mark registrations for and reputation in the Mark around the world. It contends that the disputed domain name is confusingly similar to the Mark since it is comprised exclusively of the Mark, under the generic new Top-Level Domain (“gTLD”) “.cash”.

The Complainant confirms that the disputed domain name was registered by the Respondent without its permission and that the Respondent has no relationship with the Complainant. It alleges that the Respondent has not been commonly known by the disputed domain name nor has the Respondent acquired any trade mark or service mark rights in relation to it.

The Complainant submits that the Respondent must have known of the Complainant and the Mark when it registered the disputed domain name. The Mark, according to the Complainant, is inherently distinctive and has a reputation. The Complainant submits that prior to the registration of the disputed domain name one of its affiliates had begun operating websites under the domain names <gaminator.com> and <gaminator.at>.

The Complainant also argues that although the disputed domain name does not resolve to an active website, the Respondent is nonetheless using the disputed domain name “to attract, for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with the Complainant’s marks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or products on the Respondent’s websites”, contrary to the Policy, and that “its evident scope is to be prepared for being used for infringing content”, in particular “counterfeits of the Complainant’s games”. It also argues, that the passive holding of the (inactive) disputed domain name is in bad faith. The Complainant submits that the Respondent’s registration of the disputed domain name prevents the Complainant from reflecting the Mark in a corresponding domain name.

Together, the Complainant submits that the disputed domain name has been registered and is being used in bad faith.

## B. Respondent

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

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant bears the burden of proving that:

- a) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- b) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- c) the disputed domain name has been registered and is being used in bad faith.

These criteria are cumulative. The failure of the Complainant to prove any one of these elements means the Complaint must be denied.

### A. Identical or Confusingly Similar

The Panel accepts that the Complainant is the owner of, and therefore has rights in, the Mark.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)") provides that: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The Panel therefore finds that the disputed domain name is identical to the Mark, since the disputed domain name incorporates the Mark in its entirety.

The use of the gTLD ".cash" does not prevent a finding of identity.

Accordingly, the Panel finds that the disputed domain name is identical to a trade mark in which the Complainant has rights.

### B. Rights or Legitimate Interests

Although a complainant is required to demonstrate that a respondent has no rights or legitimate interests in respect of the domain name, as explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view of previous UDRP panels is that where a complainant establishes a *prima facie* case 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.

In the current proceeding, the Complainant has established its *prima facie* case. The evidence before the Panel is that the Mark is inherently distinctive which, combined with the Complainant's existing use of the Mark and of the websites developed by its affiliate under the domain names <gaminator.com> and <gaminator.at> makes a coincidental adoption by the Respondent highly unlikely. The Complainant states that it has not given the Respondent permission to use the Mark, in a domain name or otherwise, and the Panel has no reason to doubt the veracity of that submission.

There is no evidence that the Respondent has acquired any common law rights to use the Mark, is commonly known by the Mark or has chosen to use the Mark in the disputed domain name in any descriptive manner or is making any use of the disputed domain name that would establish rights or legitimate interests as a result of a noncommercial or fair use of it.

By not participating in these proceedings, the Respondent has failed to refute the Complainant's *prima facie* case that it has met its burden under the second UDRP element.

As clearly stated in section 2.1 of the [WIPO Overview 3.0](#), "a panel's assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed". Having reviewed and weighed the available evidence, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

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

The Panel notes that the disputed domain name was registered many years after the Mark was registered and accepts that the disputed domain name was chosen by reference to the Mark.

As a result, and in the absence of evidence from the Respondent that the similarity of the disputed domain name to the Mark is coincidental, the Panel must conclude that the Respondent knew of the Complainant's rights in the Mark when it registered the disputed domain name.

The Panel therefore finds that the Respondent's registration of the disputed domain name was in bad faith since it attempted to appropriate for the Respondent, without the consent or authorisation of the Complainant, rights in the Complainant's Mark; and it prevents the Complainant from reflecting its Mark in the gTLD ".cash".

The Panel is unable to accept the Complainant's submissions that the disputed domain name is being used "to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or products on the Respondent's websites", or that "its evident scope is to be prepared for being used for infringing content", in particular "counterfeits of the Complainant's games"; but does find that it is being used in bad faith under the doctrine of passive holding.

Section 3.3 of the [WIPO Overview 3.0](#) states that relevant factors to finding bad faith in passive holding include:

- "(i) the degree of distinctiveness or reputation of the complainant's mark;
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- (iii) the respondent's concealing its identity [...], and
- (iv) the implausibility of any good faith use to which the domain name may be put."

The Panel notes that the Mark is distinctive of the Complainant and further notes that the Respondent has not participated in these proceedings or sought to explain its registration and use of the disputed domain name. Furthermore, the Panel notes that the postal address submitted by the Respondent upon the registration of the disputed domain name is not a genuine address, which tends to support a finding of bad faith.

Therefore, and on the basis of the information available to it, the Panel finds that the Respondent has registered and is using the disputed 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 <gaminator.cash> be transferred to the Complainant.

*/Gareth Dickson/*

**Gareth Dickson**

Sole Panelist

Date: February 21, 2023