

ADMINISTRATIVE PANEL DECISION

Novomatic AG v. Archie Rolland, PrivacyYes.com
Case No. D2023-1677

1. The Parties

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

The Respondent is Archie Rolland, PrivacyYes.com, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <bookofracanada.com> (the “Domain Name”) is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2023. On April 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 19, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Key-Systems GmbH, Germany) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 2023, 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 20, 2023.

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 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2023. The Respondent did not submit Response within this deadline. Accordingly, the Center notified the Respondent’s default on May 12, 2023. The Respondent submitted its late Response on May 15, 2023.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on May 17, 2023. 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 high-tech gaming technology company. It was founded in 1980. Currently, the Complainant exports its high-tech electronic gaming equipment and solutions to around 100 countries. One of the Complainant's products is the game under the BOOK OF RA trademark.

The Complainant is the owner of several BOOK OF RA trademark registrations, including:

- the European Union Trade Mark Registration BOOK OF RA (word) No. 4451431 registered on May 24, 2006; and
- the European Union Trade Mark Registration BOOK OF RA (figurative) No. 012456828 registered on April 23, 2014.

The Domain Name was registered on December 26, 2019.

At the time of submitting the Complaint the Domain Name resolved to the website inviting Internet users to play an online game imitating the Complainant's game under the BOOK OF RA trademark. As of the date of this Decision, the Domain Name resolved to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant requests that the Domain Name be transferred to the Complainant. According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant submits that the Domain Name was registered and is being used in bad faith.

B. Respondent

The Respondent submitted in its late Response that it is "deeply concerned about the situation" regarding the Domain Name. The Respondent informed that it has stopped all activity connected to the Domain Name. Moreover, the Respondent informed that at the end of the domain registration period, it will not renew, sell or transfer the Domain Name to a third party.

6. Discussion and Findings

6.1. Preliminary Matters – late Response

The due date for the Response was May 11, 2023. The Response was filed with the Center on May 15, 2023.

Pursuant to paragraph 14(a) of the Rules, in the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint. The Panel may therefore consider the Respondent's late Response in its discretion if it finds that exceptional circumstances are present.

Moreover, paragraph 14(a) of the Rules is counterbalanced by paragraph 10(b) of the Rules, which provides that the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

In the present case, notwithstanding the fact that the Respondent has not claimed any exceptional circumstances, the lateness of the filing of the Response has not prejudiced the Complainant nor has it delayed the Panel's decision. The Panel therefore deems it appropriate to admit the Respondent's late Response.

6.2. Substantive Matters – Three Elements

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

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

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". See section 4.2, [WIPO Overview 3.0](#).

A. Identical or Confusingly Similar

The first element requires that the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid BOOK OF RA trademark registrations. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term "canada" in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant's BOOK OF RA trademark. UDRP panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See section 1.8, [WIPO Overview 3.0](#).

The Top-Level Domain ("TLD") ".com" in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant's BOOK OF RA trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or
- (iii) that it 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.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainant's BOOK OF RA trademark registrations predate the Respondent's registration of the Domain Name. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the BOOK OF RA trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence in the record that the Respondent does not make use of the Domain Name in connection with a *bona fide* offering of goods or services, nor does it make a legitimate, noncommercial or fair use of the Domain Name without intent for commercial gain. On the contrary, the Domain Name resolved to the Website inviting Internet users to play the online game bearing the BOOK OF RA trademark. As of the date of this Decision, the Domain Name resolves to an inactive website. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or

- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the BOOK OF RA trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration. Such a finding is supported by the content of the Domain Name which resolved to the Website mimicking the Complainant's original game under the BOOK OF RA trademark. Moreover, it has been proven to the Panel's satisfaction that the Complainant's BOOK OF RA trademark is well known and unique to the Complainant. Thus, the Respondent could not likely reasonably ignore the reputation of the product under this trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's BOOK OF RA trademark.

Moreover, the Domain Name was used in bad faith by the Respondent to attract Internet users to the Website inviting Internet users to play an online game imitating the Complainant's original game under the BOOK OF RA trademark. The Panel considers that by reproducing the BOOK OF RA trademark in the Domain Name and featuring its online game at the Website connected to this Domain Name, the Respondent intended to profit from the confusion created with Internet users. In consequence, the Panel finds that the evidence in the record demonstrates that the Respondent uses the Domain Name deliberately in order to take advantage of the Complainant's reputation and to give credibility to its services.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements under paragraph 4(a)(iii) of the Policy.

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 <bookofracanada.com> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: May 26, 2023