

ADMINISTRATIVE PANEL DECISION

Electronic Arts Inc. v. Oanh Dao

Case No. D2023-2434

1. The Parties

The Complainant is Electronic Arts Inc., United States of America (the “United States”), represented by Norton Rose Fulbright LLP, United States.

The Respondent is Oanh Dao, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <pogo-games.net> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 5, 2023. On June 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 6, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 June 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 28, 2023.

Through June 22, 2023 to June 27, 2023, the Respondent sent informal communications. The Center notified the Commencement of Panel Appointment Process on June 29, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on July 3, 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 an American video game company headquartered in California. Founded in May 1982 by Trip Hawkins, the company was a pioneer of the early home computer game industry.

The Complainant, through its predecessor-in-interest Pogo Corporation, first began using the trademark POGO in 1999 in connection with an online computer game site at "www.pogo.com", registered on May 2, 1995.

The Complainant is the owner of numerous trademark registrations for POGO, including the following, as per trademark certificates submitted in the Complaint:

- United States trademark registration No. 2836746 for POGO (word mark), filed on August 31, 1999 and registered on April 27, 2004 in international classes 9, 41, and 42;
- United States trademark registration No. 3090266 for POGO (word mark), filed on May 27, 2005 and registered on May 9, 2006 in international classes 9 and 41.

The disputed domain name was registered on May 7, 2019 and is pointed to a website that offers online computer games.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the trademark POGO in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of a hyphen, the dictionary term "games" and the generic Top-Level Domain (gTLD) ".net".

The Complainant further states that the Respondent's addition of the term "games" does nothing to distance itself from the Complainant's trademark POGO since such term directly refers to the Complainant's services.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant submits that the Respondent only registered the disputed domain name in May 2019, which is approximately 19 years after the Complainant's first use of the trademark. The Complainant also submits that the Respondent is not commonly known as Pogo and has not used the names "Pogo" or "Pogogames" prior to registering the disputed domain name.

The Complainant further underlines that the Respondent does not appear to own any trademark application or registration containing "pogo" or "pogo-games" for any goods or services.

The Complainant submits that that the Respondent lacks rights or legitimate interests in the disputed domain name and in the trademark POGO, since he is in no way affiliated, licensed or authorized by the Complainant to use the trademark in question in any way, including for the registration and use of the disputed domain name.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent is intentionally attempting to attract Internet users to its website for commercial gain by creating a likelihood of confusion between the disputed domain name and the Complainant's trademark POGO.

The Complainant emphasizes that, considering it developed, built and maintained the trademark POGO and the associated website since 1999, and that the content of the website at the disputed domain name directly reflects the Respondent's knowledge of the trademark POGO and its services, it is highly unlikely that the Respondent would have been unaware of the Complainant and its trademark POGO at the time of

registering the disputed domain name. The Complainant thus submits that the Respondent registered the disputed domain name to trade off the Complainant's well-established trademark POGO.

The Complainant further underlines that using someone else's trademark to confuse customers into visiting a website that is unaffiliated with the trademark owner also constitutes infringement, even if the customer ultimately realizes that there is no connection with the trademark owner. The Complainant also highlights that the Respondent's website appears on the very first page of the search results on Google, causing a higher risk of confusion to the detriment of the Complainant's business.

Lastly, the Complainant contends that the Respondent's use of the disputed domain name in connection with a webpage that contains advertisements to third-party companies and online games similar to those offered by the Complainant, as highlighted in the screenshots in the Complaint, further evidences the bad faith use of the disputed domain name since the Respondent is undoubtedly using his website for commercial gain.

B. Respondent

The Respondent did not file a formal Response but, between June 22 and June 27, 2023, sent informal email communications to the Center.

In his June 23 email communication, he stated that he had removed references to the Complainant's trademark from the home page of his website, including the favicon, but indicated that "use of the Pogo trademark over 400 times in the metadata, hyperlinks, and text of the HTML source code of just the front page of my website because the website domain contains the word Pogo, so it's inevitable". The Respondent also stated having published reviews of some of the Complainant's games, providing links to the Complainant's website, as well as other games containing the word "Pogo" which were not present on the Complainant's website, including games designed by the Respondent.

In his June 23 communication, the Respondent reiterated that he had corrected the content of his website and that he had displayed reviews of some of the Complainant's games but clarified that the images and content published on his website were designed by the Respondent.

In his email communication dated June 26, the Respondent simply requested whether the disputed domain name had been revoked, whilst on June 27, the Respondent highlighted that his website is very different from the Complainant's one and indicated that he did not intend to use the disputed domain name for profit and that he respects the Complainant's brand.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a 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." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed 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 rights over the trademark POGO based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as

annexes to the Complaint.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain names to assess whether the trademark is recognizable within the disputed domain name (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The disputed domain name reproduces the trademark POGO in combination with a hyphen, the term "games" and the gTLD ".net".

As found in a number of prior cases decided under the Policy, where a trademark is recognizable within a domain name, the addition of other terms (generic or descriptive or otherwise) does not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#). Moreover, the applicable TLD in a 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 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed 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) 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."

In the case at hand, the Complainant has made a *prima facie* case and the Respondent has failed to raise any convincing circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name.

The Panel also finds that the Respondent's use of the disputed domain name does not amount to a *bona fide* offering of goods or services, or a legitimate, noncommercial or fair use. Indeed, according to the evidence on record, the disputed domain name has been pointed by the Respondent to a website displaying the Complainant's trademark POGO and promoting online computer games in direct competition with the Complainant's online games.

The Panel also notes that, before the filing of the Complaint, the Respondent also published sponsored advertisements which promoted online games of the Complainant's competitors. At the time of the drafting

of the Decision, the disputed domain name is still redirected to an online website promoting online computer games and publishing several references to the trademark POGO, including in the home page, where the heading “Pogo Games” is displayed. Moreover, no disclaimer of non-affiliation with the Complainant is provided on the website.

Furthermore, the Panel notes that the disputed domain name, encompassing the Complainant’s well-known trademark with the descriptive term “games”, is inherently misleading as it suggests an affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#): “Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.”

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to the bad faith at the time of the registration, the Panel notes that, in light of i) the Complainant’s prior use of the trademark POGO in connection with the online computer games provided by the Complainant via its website “www.pogo.com” since 1999, ii) the composition of the disputed domain name, combining the Complainant’s trademark with the term “games” which is descriptive of the Complainant’s activity; and iii) the fact that the Respondent is acting in the same field of activity as the Complainant, the Respondent was likely aware of the Complainant’s trademarks when he registered the disputed domain name.

Indeed, considering the Respondent made explicit reference to the Complainant’s POGO games on the website corresponding to the disputed domain name, the Panel finds that the Respondent clearly registered the disputed domain name with the Complainant’s trademark in mind.

The Panel also notes that, in view of the use of the disputed domain name to divert users to the website described above, providing online computer games under the trademark POGO and promoting also online games competing with the ones of the Complainant, whilst moreover failing to provide a proper disclaimer of non-affiliation with the Complainant, the Respondent intentionally attempted to attract Internet users to his website for commercial gain, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation or endorsement of his website and the gaming services provided therein, according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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 disputed domain name <pogo-games.net> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: July 19, 2023