

ADMINISTRATIVE PANEL DECISION

Novomatic AG v. Rom Fir
Case No. D2023-4895

1. The Parties

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

The Respondent is Rom Fir, Belize.

2. The Domain Name and Registrar

The disputed domain name <gaminator-system.com> (the “Disputed Domain Name”) 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 24, 2023. On November 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 27, 2023, 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 (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 4, 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 December 4, 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 December 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 4, 2024.

The Center appointed Nicholas Weston as the sole panelist in this matter on February 8, 2024. 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.

The language of the proceeding is the language of the registration agreement, English.

4. Factual Background

The Complainant is a company registered in Austria founded in 1980 which operates gaming technology business with more than 24,500 staff worldwide and a turnover of around EUR 2.9 billion in 2022. The Complainant holds registrations for the trademark GAMINATOR, and variations of it, in several countries, including European Union Trade mark registration No. 003602596 for the mark GAMINATOR registered on June 22, 2005.

The Complainant is also the owner of, inter alia, the domain name <gaminator.com>.

The Disputed Domain Name <gaminator-system.com> was registered on January 14, 2019. The Complainant has supplied uncontested evidence that the Disputed Domain Name also resolves to an online casino website in Russian.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant cites its trademark registrations of the trademark GAMINATOR in various countries as prima facie evidence of ownership.

The Complainant contends that it is "one of the biggest international producers and operators of gaming technologies ...[and]... "offers a diversified Omni-channel product portfolio to its partners and clients around the world" with rights in the mark GAMINATOR that predate the Respondent's registration of the Disputed Domain Name and gives it secondary meaning in the name as well as registered rights. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the GAMINATOR trademark and infers that the similarity is not removed by the addition of an apostrophe or the word "system", or the generic Top-Level Domain ("gTLD") ".com".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the "Respondent has no relationship with or permission from Complainant for the use of the Trademarks "GAMINATOR". Respondent has neither been commonly known by the domain name or the sign "GAMINATOR" nor has acquired any trademark or service mark rights" (and submits that) "Respondent uses the domain for a website which content consists exclusively of counterfeit games of Complainant" with the inference that this is not bona fide use.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules having regard to the widespread prior use of the Complainant's trademark, and that given "Respondent registered the Domain Name in bad faith with full knowledge of the Complainant and its trademarks because there is no other reason than to lead the public to online games which may be counterfeits of Complainant's games" and used the trademark GAMINATOR with the word "system" "to increase the confusability with Complainant's original sites".

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 has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the GAMINATOR mark in several countries.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the GAMINATOR trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant's trademark GAMINATOR; (b) followed by a hyphen; (c) followed by the word "system"; (d) followed by the generic Top-Level Domain ("gTLD") ".com".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: "gaminator-system".

The Panel finds the entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the hyphen and the word "system" may bear on assessment of the second and third elements, the Panel finds the addition of the hyphen and the word "system" does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a Disputed Domain Name may result in the

difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out 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 Disputed Domain Name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

[WIPO Overview 3.0](#), section 2.1.

The Panel finds that the combined terms “gaminator-system” has no ordinary meaning other than in connection with the Complainant. Furthermore, there is no indication that the Respondent was commonly known by the terms “gaminator-system” prior to registration of the Disputed Domain Name and the Complainant also contends that it has not licensed, permitted, or authorized the Respondent to use the trademarks. The Panel also notes that the composition of the Disputed Domain Name carries a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1).

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

The Panel finds that the Respondent has not used the Disputed Domain Name in connection with a bona fide offering of goods or services, since the Respondent is using the Disputed Domain Name to attract users to a website offering competing services to those of the Complainant.

Moreover, the Panel finds that the composition of the Disputed Domain Name carries a high risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

[WIPO Overview 3.0](#), section 2.5.1.

Panels have held that the use of a Disputed Domain Name for illegal activity here, impersonation of the Complainant and passing off, which can never confer rights or legitimate interests on a respondent.

[WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, given the composition of the Disputed Domain Name, and the distinctiveness of the Complainant’s GAMINATOR trademark, the Panel is satisfied that the Respondent targeted the Complainant’s trademark when it registered the Disputed Domain Name (see *Novomatic AG v. Aleksandr Eremeev*, WIPO Case No. [D2021-1190](#) (“the Complainant’s Trademark is original, highly distinctive, and it is most unlikely that the Respondent could have registered the Disputed Domain Name, which incorporates the GAMINATOR Trademark in its entirety, accidentally”); *Novomatic AG v. WhoisGuard, Inc. / Alexey Ivanov*, WIPO Case No. [D2020-2043](#) (“[t]he term “gaminator” is purely imaginative. It is therefore unlikely that the

Respondent chose the disputed domain name without the intention of invoking a misleading association with the Complainant"); *Novomatic AG v. Pop Marius*, WIPO Case No. [D2023-0318](#) ("Given the circumstances of the case, including the well-known status of the Complainant's trademark GAMINATOR and the way that the [D]isputed [D]omain [N]ame has been and is still used, it is obvious to the Panel in the current circumstances that the Respondent registered the [D]isputed [D]omain [N]ame in bad faith"). The Panel is prepared to infer that the Respondent knew, or should have known, that its registration would be confusingly similar to the Complainant's trademark. [WIPO Overview 3.0](#), section 3.2.2.

On the issue of use, the uncontradicted evidence of record is that the Disputed Domain Name was used to resolve to online gaming content that either competes with the products and services of the Complainant or is designed to suggest some sort of authorized connection with the Complainant that is, in fact, non-existent.

Panels have held that the use of a Disputed Domain Name for illegal activity here, impersonation of the Complainant and passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <gaminator-system.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: February 21, 2024