

ADMINISTRATIVE PANEL DECISION

Root Ltd. v. Adrian Agaya, L'Ovella Negra Marina
Case No. D2023-4914

1. The Parties

The Complainant is Root Ltd., Malta, represented by Wilmark Oy, Finland.

The Respondent is Adrian Agaya, L'Ovella Negra Marina, Spain.

2. The Domain Names and Registrar

The disputed domain names <wildzcanadagame.com>, <wildzcanadaofficial.com> and <wildzcanadaplay.com> are registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 27, 2023. On November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 28, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for Privacy, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 29, 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 amendment to the Complaint on November 30, 2023.

The Center verified that the Complaint together with the amendment to 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 December 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 24, 2023. The Respondent sent an email communication on December 5, 2023. Accordingly, the Center notified the Parties of the Commencement of Panel appointment process on December 26, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on January 11, 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.

4. Factual Background

The Complainant is a Maltese gaming company which since at least 2020 has offered its online gaming services under the trademark WILDZ. The Complainant offers its services from its website at “www.wildz.com”, registered since May 13, 1999, and has won awards for its Malta-based online casino services.

The Complainant is offering its online casino services under the trademark WILDZ also in Canada following the Complainant’s acquisition of an operating license to Ontario, Canada, in early 2023. The Complainant’s WILDZ casino is one of the top online gaming casinos in Canada.

The Complainant is the owner of several trademark registrations for WILDZ, including the following:

- European Union trademark registration No. 017589813 for WILDZ (word mark), filed on December 12, 2017, and registered on April 25, 2018, in international classes 9, 16, 25, 28, 35, 36, 38, 41, 42 and 45;
- European Union trademark registration No. 018071717 for WILDZ (semi-figurative mark), filed on May 24, 2019, and registered on October 8, 2019, in international classes 9, 16, 25, 28, 35, 36, 38, 41, 42 and 45;
- International trademark registration No. 1443415 for WILDZ (word mark), registered on June 13, 2018, in international class 41;
- Canada trademark registration No. TMA1089482 for WILDZ (word mark), filed on April 20, 2018, and registered on December 10, 2020, in international classes 9, 16, 28, 35, 38, 41, 42 and 45.

The disputed domain names <wildzcanadagame.com>, <wildzcanadaplay.com> and <wildzcanadaofficial.com> were registered on October 31, 2023, and are all currently pointed to inactive websites.

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 names.

Notably, the Complainant contends that the disputed domain names <wildzcanadagame.com>, <wildzcanadaplay.com> and <wildzcanadaofficial.com> are confusingly similar to the trademark WILDZ in which the Complainant has rights as they reproduce the trademark in its entirety with the mere addition of the term “Canada”, the generic terms “game”, “play” and “official”, and the generic Top Level Domain (“gTLD”) “.com”.

The Complainant submits that the term “Canada” only serves to increase the likelihood of confusion, leading Internet users into believing that the disputed domain names are in some way connected to the Complainant’s Canadian operation, since WILDZ is used by the Complainant as the brand of a well-known Canadian online casino featuring numerous games of chance.

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainant states that: i) the Respondent has in no way been licensed, permitted or authorized to use the

Complainant's trademarks in any way; ii) the Respondent is not commonly known by the disputed domain names and does not own corresponding trademarks; iii) the Respondent is not making a legitimate non-commercial or fair use of the disputed domain names; iv) since the Complainant's registered marks long predate the registration of the disputed domain names, the Respondent was well aware of the Complainant at the time of registering the disputed domain names and is opportunistically exploiting the goodwill of the Complainant's trademark in order to attract users to its websites.

With reference to the circumstances evidencing bad faith, the Complainant submits that the Respondent registered all three disputed domain names using the Complainant's WILDZ mark in combination with the descriptive terms "game", "play" and "official" with the intention of misleading potential customers whilst capitalizing on the goodwill and reputation of the Complainant's trademark.

The Complainant also states that the Respondent's use of the disputed domain names creates a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation and/or endorsement of the Respondent's websites, negatively affecting the Complainant's online presence and disrupting the Complainant's business.

B. Respondent

The Respondent did not reply to the Complainant's contentions, but sent an informal communication to the Center, on December 5, 2023, asking whether there would be issues also if they ceased using the disputed domain names.

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

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.

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. Indeed, the Complainant has provided evidence of ownership of trademark registrations for WILDZ in several countries (Annexes 6 and 7 to the Complaint).

The entirety of the WILDZ mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms "canada", "game", "play" and "official" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Therefore, 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 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 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.

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 names. 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 names such as those enumerated in the Policy or otherwise.

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 element from which the Panel could infer the Respondent’s rights and legitimate interests over the disputed domain names, or that the Respondent might be commonly known by the disputed domain names.

Furthermore, according to the records, there is no evidence that the Respondent may have used the disputed domain names – currently not pointed to active websites – in connection with a *bona fide* offering of goods or services of a legitimate non-commercial or fair use without intention to misleadingly divert the consumers or to tarnish the Complainant’s trademark.

In addition, the disputed domain names, incorporating the Complainant’s registered trademark WILDZ in combination with the geographical indicator “Canada” – related to a country where the Complainant’s services are offered - and the descriptive terms “game”, “play” and “official”, undoubtedly suggest sponsorship or endorsement by the Complainant. Even where a domain name consists of a trademark plus additional terms, 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. WIPO overview 3.0, section 2.5.1.

Therefore, 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.

In the present case, the Panel finds that the Respondent must have been aware of the Complainant and its reputation in the trademark WILDZ at the time the Respondent registered the disputed domain names.

The composition of the disputed domain names, encompassing the Complainant's trademark WILDZ in combination with a geographical term ("Canada") referred to a country where the Complainant's casino gaming services are offered in addition to terms directly related to gaming ("game" and "play") or descriptive of the official nature of the Complainant's website, suggests that the Respondent was well aware of the Complainant's trademarks when registering the disputed domain names and acted in opportunistic bad faith. Indeed, the disputed domain names are so obviously connected with the Complainant that its very selection by the Respondent, which has no connection with the Complainant, suggests the disputed domain names were registered with a deliberate intent to create an impression of an association with the Complainant.

The disputed domain names are currently not redirected to active websites. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement) and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, the composition of the disputed domain names and the Respondent's lack of a substantive response and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

Therefore, 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 names <wildzcanadagame.com>, <wildzcanadaofficial.com> and <wildzcanadaplay.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: January 25, 2024