

WIPO Arbitration and Mediation Center
Zaak-/rolnummer: DNL2015-0026
Datum: 5 augustus 2015

1. The Parties

The Complainant is Novomatic AG of Gumpoldskirchen, Austria, represented by Bird & Bird LLP, the Netherlands.

The Respondent is [persoonsnaam], of 's-Hertogenbosch, the Netherlands.

2. The Domain Name and Registrar

The disputed domain name <novomatic-casino.nl> (the "Domain Name") is registered with SIDN through TransIP BV.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 22, 2015. On May 26, 2015, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On May 27, 2015, SIDN 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 Dispute Resolution Regulations for .nl Domain Names (the "Regulations"). In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 29, 2015. In accordance with the Regulations, article 7.1, the due date for Response was June 18, 2015. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 19, 2015. On May 19, 2015, the Respondent filed an email communication with the Center. Subsequently, the Complainant requested a suspension of the proceedings on May 23, 2015. Hereupon, the Center suspended the procedure until July 23, 2015. As no settlement was reached, the Complainant requested the re-institution of the proceedings on July 21, 2015. The proceedings were re-instituted on July 21, 2015. The Respondent filed an email communication with the Center on July 21, 2015.

The Center appointed Willem Hoorneman as the panelist in this matter on July 27, 2015. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

4. Factual Background

The Complainant, Novomatic AG, is part of the Novomatic Group, which is internationally active in the gaming industry, operating machines in casinos worldwide and providing services in the online gaming and entertainment market.

The Complainant is holder of, *inter alia*, the following registrations for its NOVOMATIC trademark (the "Trademark"):

- Community Trademark no. 4135273 NOVOMATIC (word), registered on March 2, 2006 for a range of goods and services in the classes 9, 16, 28, 36, 37, 41, 42 and 43;
- Community Trademark no. 5711461 NOVOMATIC (word), registered on February 8, 2008 for a range of goods and services in the classes 16, 35 and 38;

- International Registration no. 598346 NOVOMATIC (word), designating Benelux and registered on December 17, 1992 for a range of goods and services in the classes 9, 28, 36, 37, 41 and 42.

The Domain Name was registered by the Respondent on August 5, 2012.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is identical or at least confusingly similar to the Complainant's Trademark as the Trademark is entirely incorporated in the Domain Name. The mere addition of the word "casino" after the Trademark and the use of a hyphen should not be taken into consideration since it is merely generic and descriptive. Furthermore, the use of the Domain Name creates the wrongful impression that the Domain Name is related to, commercially affiliated with, or associated with the Complainant.

The Complainant states that the Respondent has no rights or legitimate interests in the Domain Name. The Respondent is not commonly known under the Domain Name and does not have any relevant (trademark) rights in the Domain Name. The Respondent is not making legitimate noncommercial or fair use of the Domain Name, but was merely using it to offer online gaming services and/or information. Moreover, the use of the Domain Name cannot be regarded as *bona fide* as it creates the false impression that the Respondent is either part of the Complainant's organisation or is in some other way authorised by the Complainant when this is not the case. The Complainant contends that the Respondent is using the Domain Name in bad faith. The Respondent registered the Domain Name many years after the registration of Complainant's trademarks. The Respondent was or should have been aware of the Complainant's trademark rights as it previously used the Domain Name to offer information regarding online games, in particular about the Complainant's online games. The Complainant further contends that while the Domain Name is currently passively held, based on its previous use, there is a threat that the Respondent would exploit the Complainant's reputation for unjustified revenues. The Respondent refused to transfer the Domain Name upon request of the Complainant preventing the Complainant from using it.

B. Respondent

The Respondent replied to the Center's notification indicating his default suggesting that he would cooperate with a transfer of the Domain Name. However, parties were not able to reach a settlement. The Respondent did not submit any substantive response to the Complainant's contentions.

6. Discussion and Findings

As the Respondent has not filed a substantive response, the Panel shall rule on the basis of the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or fact. The Panel is entitled to further inform itself by limited reference to matters of public record.

Pursuant to article 2.1 of the Regulations, the Complainant's request to transfer the Domain Name must meet three cumulative conditions:

- the Domain Name is identical or confusingly similar to a trademark or trade name protected under Dutch law in which the Complainant has rights, or other name by means of article 2.1(a) under (II) of the Regulations; and
- the Respondent has no rights to or legitimate interests in the Domain Name; and
- the Domain Name has been registered or is being used in bad faith.

The Complainant may provide evidence that the Domain Name has been registered or is being used in bad faith, *inter alia*, through the circumstances mentioned in article 3.2 of the Regulations. Considering these conditions, the Panel rules as follows:

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the Trademark based on its Community and International trademark registrations.

It is established that the country code Top-Level Domain (“ccTLD”) “.nl” may be generally disregarded in assessing the similarity between a domain name on the one hand, and the relevant trademark on the other hand (see: *Taylor Made Golf Company, Inc. v. Lotom Group S.A.*, WIPO Case No. DNL2010-0067; *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. DNL2008-0008).

The Domain Name is confusingly similar to the Complainant’s Trademark, because the Domain Name incorporates the Trademark in its entirety. The Domain Name differs from the Trademark only in that the Trademark is followed by a generic or descriptive term, namely “casino” and a hyphen. The addition of such a generic or descriptive term does not eliminate the confusing similarity with the Trademark (see, e.g., *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. DNL2010-0024).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trademark. The Complainant has thus established the first element of article 2.1 of the Regulations.

B. Rights or Legitimate Interests

The Complainant alleges that the Respondent has no rights to or legitimate interests in the Domain Name. The Respondent, by failing to file a substantive response, did nothing to dispute this contention or to provide information as to its interests in using the Domain Name. Aside from the fact that no substantive response was filed, there seems to be very little that the Respondent might have relied upon. The word “novomatic” has no common meaning in the Dutch language, and it seems that the Respondent chose the Domain Name primarily to create an impression that the Respondent is either part of the Complainant’s organisation or is in some way authorised by the Complainant when this is not the case. The Panel therefore finds that the Respondent has no rights to or legitimate interests in the Domain Name and that the Complainant has established the second element of article 2.1 of the Regulations.

C. Registered or Used in Bad Faith

The registrations of the Trademark predate the Domain Name’s registration by over twenty years. As the Respondent chose a domain name incorporating the Complainant’s mark with “casino”, a term descriptive of the Complainant’s services and as the Complainant asserts, used the Domain Name to offer information regarding online games, in particular about Complainant’s online games, the Panel assumes that the Respondent was aware of the Complainant’s offerings and Trademark at the time of registration of the Domain Name. Therefore, it is likely that the Respondent registered the Domain Name with the Complainant’s business in mind. This supports a finding of bad faith registration.

The Panel further observes that based on the Complainant’s allegations of the Domain Name use as described above, the Respondent seems to have made a calculated attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, or

endorsement of the Respondent's website or location or of a product or service on the Respondent's website or other online location or otherwise to disrupt the business of the Complainant.

The Respondent has not filed a substantive response, and has therefore not provided any evidence to rebut the Complainant's allegations.

Under these circumstances, and considering article 10.3 of the Regulations cited above, the Panel finds that the Complainant has established the third element of article 2.1 of the Regulations.

7. Decision

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the Domain Name, <novomatic-casino.nl>, be transferred to the Complainant.

Willem Hoorneman
Panelist
Date: August 5, 2015