

**DISPUTE RESOLUTION SERVICE**

**D00013271**

**Decision of Independent Expert**

Safepay Malta Limited

and

Ms Charity King

**1. The Parties**

Complainant: Safepay Malta Limited  
Level 4, Marina Business Centre  
Abate Rigord Street  
Ta' Xbiex  
Malta  
XBX 1127  
Malta

Respondent: Ms Charity King  
Bank House  
Market Square  
Congelton  
Cheshire  
CW12 1ET  
United Kingdom

**2. The Domain Name**

betsafe.co.uk

**3. Procedural History**

- 3.1 On 6 September 2013 the complaint was received. On 9 September 2013 the complaint was validated and notice of it sent to the Respondent. On 20 September 2013 the response was received and notification of it sent to the Complainant. On 25 September 2013 the Complainant was sent a reply reminder notice. On 26 September 2013 the reply was received, notification of it was sent to the Respondent and the mediator was appointed. On 1 October 2013 the mediation started and on 17 October 2013 the mediation failed. On 28 October 2013 the expert decision payment was received.
- 3.2 I, Patricia Jones ("the Expert"), confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

#### **4. Factual Background**

4.1 The Complainant is the owner of the following registered trade marks:

- (a) Community Trade mark no.007214059 for 'betsafe' registered in class 35. The mark was applied for on 5 September 2008, published on 21 October 2010 and registered on 3 February 2011.
- (b) Community Trade mark no. 008585648 for the figurative mark 'betsafe.com' (in black and red) registered in classes 9, 28, 35, 38 and 41. The goods and services covered by this trade mark registration relate to games of chance, gaming and betting. The mark was applied for on 10 September 2009, published on 18 January 2010 and registered on 3 May 2010.
- (c) Community Trade mark no. 011385036 for 'BETSAFE' registered in classes 9, 41 and 42. The mark was applied for on 29 November 2012, published on 8 March 2013 and registered on 17 June 2013.

4.2 The Domain Name was registered on 24 November 2009.

4.3 On 10 May 2013 the site at the Domain Name resolved to a Sedo parking page containing sponsored links, in English and in Swedish. At 3.46pm the links in English included links related to casino and online betting sites. At 3.49pm the links in English related to events, mystery shopping, social networking, ICANN and real estate with a link to an online casino games site. The parking page says (in Swedish) that the Domain Name may be for sale.

4.4 On 13 May 2013 the Swedish legal representatives of BML Group Limited ("BML") wrote to the Respondent. This letter claimed that BML had rights to 'betsafe' through the trade mark registrations set out at paragraphs 4.1 (a) and (b) above; that the sponsored links at the Domain Name were for the same products and services as BML; asserted the Domain Name was registered with the trademark 'betsafe' in mind and to commercially profit from misleading consumers searching for information about the products and services promoted under the 'betsafe' trade mark; alleged the rights of BML had been infringed; and requested the Respondent confirm its agreement to the immediate transfer of the Domain Name to BML. The letter stated that if this confirmation was not received by the stipulated time limit, Betsafe.co.uk AB would seek other remedies to enforce their intellectual property rights and warned the Respondent that it may be forced to cease use of the Domain Name and to pay damages to BML. No response was received to this letter.

4.5 The Complainant has not explained its relationship to BML or Betsafe.co.uk AB nor why the letter of 13 May 2013 asserts that BML owns the trade mark registrations at paragraphs 4.1(a) and (b) when the Complainant has adduced evidence of its ownership of these marks.

#### **5. Parties' Contentions**

5.1 The submissions made by the parties are short. I set out below a summary of what I regard to be the main contentions of the parties.

##### **The Complainant's complaint**

5.2 The Complainant submits it has rights in respect of a name or mark which is identical or similar to the Domain Name. The Complainant relies on its registered trademarks for the word betsafe and contends that this mark is identical to the Domain Name, disregarding the .co.uk suffix.

5.3 The Complainant contends that the Domain Name is an Abusive Registration as follows:

- (a) The Complainant says that the Respondent was well aware of the Complainant's trademarks and business when registering the Domain Name.
- (b) The Complainant says that controls on the site at the Domain Name show that it is being used for sponsored links for products and services which are the same as those provided by the Complainant, namely betting, gaming and gambling. The Complainant also says the Domain Name is available for sale. The Complainant asserts that this use and the availability for sale strongly suggest the Domain Name was registered to commercially profit from misleading consumers searching for information about the Complainant's business or with the primary purpose of selling or renting it to the Complainant (or a competitor) for more than the Respondent paid for it.
- (c) The Complainant states the Respondent does not have any rights in the betsafe mark. The Complainant says it has not licensed the Respondent or given the Respondent permission to register the Domain Name.
- (d) The Complainant says there is no evidence that the Respondent has been commonly known by the Domain Name or is making a legitimate non-commercial or fair use of the Domain Name.
- (e) The Complainant asserts that the Respondent has no rights or legitimate interest in the Domain Name.

**The Respondent's response**

5.4 The Respondent contends that the Domain Name is not an Abusive Registration as follows:

- (a) The Respondent states the Complainant's Rights did not exist when the Domain Name was registered. The Respondent says that the Complainant's trade marks were not published or registered until after registration of the Domain Name.
- (b) The Respondent says the use of the Domain Name for a third party parking page is a legitimate activity used by millions of domain names. The Respondent asserts that the Complainant has not demonstrated any loss of traffic or revenue as a result of the use of the Domain Name.
- (c) The Respondent says that during her four year ownership of the Domain Name the Complainant has not approached her to try to come to an amicable solution.

**The Complainant's reply**

5.5 The Complainant replies to the Respondent's assertion that no Rights existed when the Domain Name was registered as follows:

- (a) The Complainant says a trade mark owner has a right to the trade mark from its filing date.
- (b) The Complainant states that its trade mark applications for 'betsafe' and 'betsafe.com' were filed before the Domain Name was registered. The Complainant says that a filed trade mark application can be found in the

database at [www.ipo.gov.uk](http://www.ipo.gov.uk). The Complainant argues that the Respondent therefore knew or ought to have been aware of its trade mark applications when the Domain Name was registered.

## 6. Discussions and Findings

6.1 Paragraph 2 of the Nominet Dispute Resolution Service Policy (“the Policy”) sets out that for a Complainant’s complaint to succeed it must prove to the Expert that:

- i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.

6.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

6.3 Paragraph 2c of the Policy recommends that the parties use the Nominet guidance and help information which can be found on its website. In this respect, Nominet gives considerable guidance on its website on how to make an effective complaint. Unfortunately in this case the Complainant has adduced little evidence, other than its trade mark registrations, in support of its complaint. I shall turn to the significance of this further in this decision.

6.4 In this respect, in making my decision I have taken into account Paragraph 16a of the Nominet Dispute Resolution Service Procedure (“the Procedure”) which provides that:

*“The Expert will decide a complaint on the basis of the Parties’ submissions, the Policy and this Procedure. The Expert may (but will have no obligation to) look at any web sites referred to in the Parties’ submissions. Moreover, there may be occasions where the Expert is in possession of relevant information, which is not in the case papers and upon which he or she wishes to rely for the purposes of the Decision. In such circumstances the Expert will inform the Parties and invite them to make submissions”.*

6.5 The “Dispute Resolution Service – Experts’ Overview”<sup>1</sup> (“the Overview”) addresses further the issue of whether Experts are permitted to make their own investigations. It states:

*“The basic rule is that Experts should not make any investigations of their own. They should make their decisions “on the basis of the parties’ submissions, the Policy and the Procedure”. The second sentence of paragraph 16(a) enables Experts to view web sites mentioned in the parties’ submissions, but no party should assume that the Expert will necessarily do so. If the content of a web site is important to a Party’s case, the safest course is to exhibit print-outs from the web site.*

*No party should assume that the Expert will make any investigations to support a bare assertion made in a party’s submission. However, there may be occasions where an Expert will find it expedient to conduct a simple online enquiry of a publicly available database, where, for example, an exhibit purporting to support a party’s contention does not do so and it appears that the ‘error’ is a simple*

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<sup>1</sup> The purpose of the Overview is to assist participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts have dealt with those issues.

*oversight and not one of any major significance. In such circumstances, a simple enquiry of that kind may be a proportionate alternative to either ignoring a point made in the submission in question or initiating a further round of submissions by way of requests for further information. See DRS 00658 (chivasbrothers.co.uk). If, however, an Expert comes by material information as a result of any such enquiry (or indeed by any other means) and proposes to rely upon it in coming to a decision, the Expert will so inform the parties and invite them to make submissions as appropriate”.*

- 6.6 In this case the parties have not referred me to any web sites in their submissions, I am not in possession of relevant information which is not in the case papers and I have not made any investigations of my own. As is set out further below I have made this decision on the basis of the complaint, the response and the reply and on the basis of the Policy and Procedure.

### **Complainant’s Rights**

- 6.7 Under Paragraph 1 of the Policy, Rights is defined as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.” It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.
- 6.8 As set out at paragraph 4.1 above, the Complainant is the owner of trade mark registrations for ‘betsafe’ and ‘BETSAFE’. I am therefore satisfied that the Complainant owns Rights in the betsafe mark.
- 6.9 I consider the betsafe mark to be identical to the Domain Name (disregarding the .co.uk suffix). Accordingly, on the basis of the Complainant’s trade mark registrations, I find that the Complainant has Rights in a name or mark, betsafe, which is identical to the Domain Name.

### **Abusive Registration**

- 6.10 It now has to be considered whether the Domain Name, in the hands of the Respondent, is an Abusive Registration. Paragraph 1 of the Policy defines Abusive Registration as a domain name which either:
- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
  - ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.11 It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.
- 6.12 Paragraph 3(a)(i) of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under Paragraph 1(i) of the Policy as follows:
- Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
- A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for

valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

- B. as a blocking registration against a name or mark in which the Complainant has Rights; or
- C. for the purpose of unfairly disrupting the business of the Complainant.

- 6.13 The Complainant relies on Paragraph 3(a)(i)A of the Policy. The Complainant says the availability for sale of the Domain Name on the parking page suggests that it was registered with the primary purpose of selling or renting it to the Complainant (or a competitor) for more than the Respondent paid for it. In this respect there is nothing, in itself, objectionable under paragraph 3(a)(i) of the Policy about trading in domain names so long as the Respondent's motive at the time of registration of the Domain Name was not to sell the Domain Name to the Complainant or to a competitor of the Complainant at a profit.
- 6.14 The Complainant also relies on Paragraph 3(a)(i)C of the Policy. The Complainant says the Respondent registered the Domain Name to profit from misleading consumers searching for information about the Complainant's business. In this respect there may be an Abusive Registration under paragraph 1(i) of the Policy if the Respondent registered the Domain Name for the purpose of attracting users to the Respondent's site who were looking for the Complainant and once there potentially diverting users to third party sites in respect of which the Respondent earns click through revenue.
- 6.15 However, it is important to bear in mind that Paragraph 3(a)(i) of the Policy relates to the Respondent's motives at the time of registration of the Domain Name. It is an intrinsic part of this that for there to be an Abusive Registration under paragraph 1(i) of the Policy it must be established that the Respondent had knowledge of the Complainant and/or its rights at the time of registration of the Domain Name.
- 6.16 In this case, the Complainant's evidence comprises primarily of its trade mark registrations. Despite the guidance given by Nominet on the content of a complaint, the Complainant has not adduced evidence on the nature and extent of its business, other than the bare statement that it is betting, gaming and gambling, or on its use of the betsafe mark. In particular, there is no evidence on the Complainant's business or its use of the betsafe mark prior to November 2009 when the Domain Name was registered.
- 6.17 The Respondent's evidence does not address whether it was aware of the Complainant and/or its rights at the time of registration of the Domain Name nor does the Respondent explain why it registered the Domain Name. Nevertheless, it is for the Complainant to establish on the balance of probabilities that the Respondent was aware of the Complainant and/or its rights at the time of registration of the Domain Name in order for there to be an Abusive Registration under Paragraph 1(i) of the Policy.
- 6.18 The Complainant relies on its Community trade mark applications for 'betsafe' and for the 'betsafe.com' figurative mark at the time of registration of the Domain Name. The Complainant says the Respondent knew of or ought to have been aware of these trade mark applications when the Domain Name was registered. However, I do not consider that these trade mark applications are sufficient to

establish that the Respondent was aware of the Complainant and/or its rights at the time of registration of the Domain Name.

- 6.19 In this respect, the Overview confirms that the mere existence of a trade mark application cannot give rise to a right within the definition of Rights. It states that:

*“The validity of a trade mark application has not yet been determined and ordinarily it affords the proprietor no legal right to prevent others from using the mark. In and of itself an application will not constitute ‘Rights’ under the Policy. Of course in some cases an applicant for a trade mark will also have separate parallel unregistered rights in the mark in question and may be able to show Rights in this way”.*

- 6.20 In my view, for the same reason, the Complainant’s trade mark applications alone do not mean that the Complainant had rights in the betsafe and betsafe.com marks at the time of registration of the Domain Name. I also do not consider it reasonable to expect domain name registrants to conduct searches, prior to registration, on trade mark applications which may or may not proceed to grant. Of course if the Complainant was using the betsafe and/or betsafe.com marks at the time of registration of the Domain Name this would be relevant to whether the Respondent was aware of the Complainant and/or its rights at that time. Unfortunately, there is no evidence on this.

- 6.21 The Complainant has adduced evidence of Sedo parking pages on 10 May 2013 featuring links to gaming and betting sites. The Complainant says that controls on the site at the Domain Name show that it is being used for sponsored links for products and services the same as those of the Complainant, namely betting, gaming and gambling. The Complainant has adduced source code from the site at the Domain Name in support.

- 6.22 If the site at the Domain Name has been set to target the Complainant’s business then this may indicate that the Respondent was aware of the Complainant at the time of registration of the Domain Name. However, the use of the Domain Name for sponsored links is over three years after the Domain Name was registered and it is unclear whether the Domain Name has always been used in this way or some change in use has been made since registration.

- 6.23 Further, the Complainant has not adduced any explanation of the source code or how this controls the site content. I am not a computer code expert but it seems the code is generated by Sedo. In this respect given that the Domain Name incorporates the word ‘bet’ it may be expected that links relating to gaming and betting sites are generated and as noted above other links (for example relating to events) are also generated.

- 6.24 In the circumstances I do not consider that the content of the site at the Domain Name is indicative of the Respondent being aware of the Complainant and/or its rights at the time of registration of the Domain Name

- 6.25 I do not consider that the Complainant has established, on the balance of probabilities, that the Respondent knew of the Complainant and/or its rights at the time of registration of the Domain Name. I therefore do not find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraph 1(i) of the Policy.

### **Abusive Registration under Paragraph 1(ii) of the Policy**

- 6.26 There is a non-exhaustive list of factors under the Policy which may be evidence that the Domain Name is an Abusive Registration including:

Paragraph 3(a)(ii): Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant.

- 6.27 There is also a non-exhaustive list of factors under the Policy which may be evidence that the Domain Name is not an Abusive Registration including:

Paragraph 4(e): Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account: i. the nature of the Domain Name; ii. the nature of the advertising links on any parking pages associated with the Domain Name; and iii. that the use of the Domain Name is ultimately the Respondent's responsibility.

- 6.28 It is generally accepted that Paragraph 3(a)(ii) of the Policy may cover initial interest confusion, where internet users are likely to visit the Respondent's site in the expectation of finding the Complainant, for example in response to a search engine request or an educated guess as to the Complainant's domain name.

- 6.29 In this case the Domain Name is identical to the Complainant's 'betsafe' and 'BETSAFE' trade marks (ignoring the .co.uk suffix). This is suggestive of the possibility of initial interest confusion. However, as discussed above, the Complainant has not provided evidence on its use of the betsafe mark. While the Complainant has a trade mark registration for the figurative mark betsafe.com, the Complainant has not indicated whether it uses this domain name and has not presented evidence on its web sites or adduced any of its web pages in support of its complaint. Indeed, the Complainant's evidence suggests that another entity, BML, may be using the betsafe mark and the Complainant has failed to explain its relationship to BML.

- 6.30 In such circumstances, I am unable to find on the evidence that there is a likelihood, on the balance of probabilities, of users visiting the Respondent's site in response to a search engine request looking for the Complainant or from making an educated guess as to the Complainant's domain name. I do not consider that the Complainant has established on the balance of probabilities circumstances indicating that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant.

- 6.31 Further, I have found that the Respondent was not aware of the Complainant at the time of registration of the Domain Name. In such circumstances the Respondent should be entitled to hold onto the Domain Name and use it, even if it causes initial interest confusion, unless the Respondent has done something to take advantage of or to exploit its position once it became aware of the Complainant's Rights.

- 6.32 I do not consider that the Complainant has established that the Sedo parking page was set up by the Respondent to take advantage of or to exploit its position once it became aware of the Complainants Rights. I do not consider the Complainant



has established that the Respondent was aware of the Complainant's Rights when the parking page was set up. Whilst it is clear the Respondent was aware of the betsafe trade mark registrations after receipt of the letter of 13 May 2013, this was after the Sedo parking page was set up. The Complainant has not shown how the Respondent would have become aware of the betsafe mark prior to then for example by adducing evidence on its use of the mark. As the Respondent points out the use of a domain name for a parking site is not unusual; in my view, given that the Domain Name incorporates 'bet', links to gaming and betting sites are to be expected on a parking page; and the Complainant has not shown any reference to it or to its websites in the source code on the site.

- 6.33 In the circumstances, the Complainant has not shown that the Respondent has made any change to the use of the Domain Name or done something to take advantage of or to exploit its position since it became aware of the Complainant's Rights.
- 6.34 Accordingly I do not consider that Paragraph 3(a)(ii) of the Policy applies and consider that the use of the Domain Name is not objectionable under Paragraph 4(e) of the Policy. I therefore find that the Domain Name, in the hands of the Respondent, is not an Abusive Registration under paragraph 1(ii) of the Policy.

## **7. Decision**

- 7.1 I find that the Complainant has Rights in a name or mark which is identical to the Domain Name.
- 7.2 For the reasons set out above I do not find that the Domain Name in the hands of the Respondent is an Abusive Registration.
- 7.3 I direct that NO ACTION be taken in relation to the Domain Name.

**Dr Patricia Jones**

**Dated 13 November 2013**