

DISPUTE RESOLUTION SERVICE

D00018254

Decision of Independent Expert

Cosmo Gaming Company Ltd.

and

PRIVATEDNS PROXY REGISTRATION

1. The Parties:

Complainant: Cosmo Gaming Company Ltd.
209 Marina Street
Msida
VLT 12
Malta

Respondent: PRIVATEDNS PROXY REGISTRATION
1st Floor, 2 Woodberry Grove
North Finchley
London
N12 0DR
United Kingdom

2. The Domain Name:

netbetsports.co.uk

3. Procedural History:

I 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 nature as to call in to question my independence in the eyes of one or both of the parties.

14 December 2016 13:14 Dispute received
14 December 2016 13:49 Complaint validated
14 December 2016 13:53 Notification of complaint sent to parties
05 January 2017 01:30 Response reminder sent
10 January 2017 10:38 No Response Received
10 January 2017 10:38 Notification of no response sent to parties
20 January 2017 01:30 Summary/full fee reminder sent
20 January 2017 14:43 Expert decision payment received

4. Factual Background

The Complainant

The Complainant and its related company, BPG SRL, are the operators throughout Europe (including the UK) of an online betting and gaming service. The service operates under the NETBET brand. The Complainant has held a European gaming license since 2006. The NETBET brand offers a variety of games, including multiple variations of games such a blackjack, roulette and poker as well as themed slot machines and arcade games. It also operates a sports betting service. The Complainant was awarded Best Overall Sports Betting Operator at the Central and Eastern Europe Gaming Awards in 2016.

The Complainant has marketed the NETBET brand extensively. It is active on social media websites such as Facebook and YouTube (its Twitter account has over 2,500 followers and its Facebook account has over 100,000 likes). It has also carried out high profile marketing campaigns in Europe, including the UK. For example, in 2015 it ran a London Black Cabs marketing campaign that involved taxi cabs displaying the Complainant's livery, NETBET mark and the words "SPORT" and "CASINO". It also engages in sponsorship deals with football clubs, including, in the UK, West Bromwich Albion. On 30 November 2016, the Complainant's NETBET brand was the first hit on the Google search engines under the search term "netbet"

The Complainant and/or its related company BPG SRL own registered trade marks in the NETBET mark. These include European Union Trade mark 008916314 for the NETBET word mark registered on 16 May 2012 for classes 28, 35, 41 and 41 of the register. The Complainant has also used the NETBET mark in its domain names, including netbet.com and netbet.co.uk.as well as the Italian domain name netbetsport.it

The Domain Name

The Domain Name was registered on 11 November 2013. The Domain Name is being used to direct customers to an online casino website operated by

Casino.com. which is in turn operated by ONISAC Limited, a company incorporated in Gibraltar.

The Respondent

The Respondent has not filed a Response to the Complaint and there is limited information before the Expert.

The Respondent is PRIVATEDNS PROXY REGISTRATION. The address showing for the Respondent on a WHOIS search is that of a company formation and services company. The Respondent may or may not be a privacy service. Its name would suggest that it is. The Respondent could be holding the Domain Name on trust for an unidentified beneficial owner or it may be acting as agent. For the purposes of this Decision, nothing turns on this question. The Respondent is listed on the register as the responsible person for the Domain Name and as registrant it has agreed to be bound by the DRS Policy and Procedure under the Nominet Terms and Conditions of Domain Name Registration.

5. Parties' Contentions

The Complainant submits that it has Rights in a mark which is similar to the Domain Name. In support, it relies on the trade mark registrations owned by it and its related company BPG SRL, and the goodwill generated by its use and marketing of the NETBET mark.

The Complainant submits that the Domain Name is an Abusive Registration for the following reasons:

1. The Complainant was established before the registration of the Domain Name on 11 November 2013. The word NETBET is a made-up name. It is neither generic nor descriptive. There was no legitimate reason why the Respondent chose it for its domain name other than to take advantage of the Complainant's goodwill and valuable reputation.
2. The Respondent is using the Domain Name to unfairly disrupt the Complainant's business and is confusing Internet users into thinking that the Domain Name is authorised or otherwise connected with the Complainant and/or its betting services. This is supported by the following submissions:
 - a. The existence of the registration of the Domain name will cause initial interest confusion. The NETBET mark is associated with the Complainant and the addition of the word "sports" relates to the Complainant's reputation for sports betting. By linking the word "sports" to "netbet" the Respondent creates a strong likelihood of confusion. It is plausible that an internet searcher

would use an initial guess entry of sports as a key word to link to the sportsbook betting service offered by the Complainant under its NETBET brand.

- b. The website to which the Domain Name resolves offers similar online services to those offered by the Complainant such as a selection of slot games, roulette and poker games. This is a clear attempt to take advantage of the NETBET brand by diverting online traffic originally intended for the Complainant.
3. The Respondent has not shown that it has at any time been known or legitimately associated with the NETBET mark and there is no evidence that it has been linked to or associated with the Complainant in the past. The Domain Name is not being used for a legitimate non-commercial or fair use.

6. Discussions and Findings

Under Paragraph 2 of the Nominet Dispute Resolution Service Policy (the Policy), to succeed the Complainant must establish on the balance of probabilities, that:

it has Rights in respect of a name or mark which is identical or similar to the Domain Name, (2.1.1) and

the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in Paragraph 1 of the Policy) (2.1.2).

Rights

Rights are defined in Paragraph 1 of the Policy as follows;

"Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning."

The Complainant has established that it has Rights in the NETBET brand. These are conferred by the registered trademarks which it owns or uses in the course of its business, most significantly the EUTM in the NETBET word mark which is owned by BPG SRL, a company related to the Complainant.

In addition to registered Rights the Complainant's long standing use, and extensive marketing, of the NETBET mark in the UK and elsewhere has generated goodwill in the NETBET mark which confers unregistered Rights on

the Complainant for the purposes of the Policy. Its 2016 leading sports betting operator award confirms its high standing in the European gaming market.

The Expert agrees with the Complainant's submissions that the Domain Name is similar to the NETBET mark. It is customary to disregard the ". co.uk" suffix unless it has a specific trade mark significance which is not the case here.

The word "sports" is descriptive of services which the Complainant offers under its NETBET mark. Indeed, "sport" has been used by the Complainant in conjunction with "NETBET" in its own marketing (for example the London taxi cab campaign in 2015). The words "sport" and "sports" therefore signify the Complainant's services and the addition of the word "sports" in the Domain Name does not displace the significance and impact of the NETBET mark and its association with The Complainant.

The Complainant has accordingly established the first requirement of the Policy. It has Rights in a name which is similar to the Domain Name.

Abusive Registration

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

"Abusive Registration means 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".

Registration

The Complainant relies on the following provisions of the Policy:

5.1 . A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

5.1.1. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

.....

5.1.3 for the purpose of unfairly disrupting the business of the Complainant.

There is no specific evidence about the Respondent's motivation in registering the Domain Name. The Domain name was registered in 2013, at a time when the Complainant's NETBET business was established. There is no obvious legitimate reason why a third party would choose a domain name that is associated with the Complainant. These circumstances give rise to an inference that the motivation in registering the Domain Name was to take advantage of the established NETBET mark and thereby unfairly disrupt the Complainant's business. The Respondent, or those whom it represents, have chosen not to file a Response that could rebut this inference. In the circumstances, the Expert finds that the Complainant has established on the balance of probabilities that the initial registration of the Domain name was an Abusive Registration.

Use

The Complainant relies on the following provision of the Policy:

5.1.2 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;

The Expert accepts the Complainant's submissions that the use of the Domain Name is abusive. The Domain Name is being used to direct traffic to an online gambling site that operates in competition with the Complainant ("the Website"). The Domain Name consists of NETBET in conjunction with a reference to a type of service offered under the mark (sports betting). There is inevitably the potential for customer confusion. As the Complainant submits, a potential customer searching for the Complainant could unwittingly type netbetsports.co.uk into a search engine and she would be directed to the Website. On the balance of probabilities, this could result in diversion of custom away from the Complainant. This kind of confusion is of itself damaging to the Complainant and constitutes an Abusive Registration.

The content of the Website also has the potential to cause confusion. The online consumer who is directed to it could plausibly remain under a mistaken impression that she has reached the Complainant's online casino. The name casino.com features prominently on the Website but this is a generic term, which could apply to online casinos generally, including the Complainant's service. In small font at the bottom of the page there is a reference to the website operators but this is not easy to spot and, in any event, it does not make it clear that the website has no connection to the Complainant. Even if she were to appreciate that the Website is not operated by the Complainant directly, the customer may remain under the impression that the service is indirectly associated or approved by the Complainant.

This activity is taking advantage of the goodwill and brand recognition that the Complainant has established in the NETBET mark. It is unfair because it is parasitical. The association of the NETBET brand with the Website is detrimental to the Complainant. It is likely to result in diversion of business. There is also the potential for the NETBET brand to be tarnished if it is mistakenly linked to a third party and, in such a heavily regulated environment, a loss of trust and confidence can cause it significant detriment.

It therefore follows that the Complainant has established that the registration and use of the Domain Name constitute an Abusive Registration under the Policy.

7. Decision

The Expert finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name is an Abusive Registration. The Expert orders that the Domain Name be transferred to the Complainant.

Signed

Dated 27 February 2017