WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Internet Opportunity Entertainment Limited v. Zubee.com Networks Inc.

Case No. D2006-1086

1. The Parties

The Complainant is Internet Opportunity Entertainment Limited, Corporate & Trust Services (Caribbean) Limited, of Antigua and Barbuda, represented by Daniel Talisman, United Kingdom of Great Britain and Northern Ireland.

The Respondent is Zubee.com Networks Inc., of Canada.

2. The Domain Names and Registrars

The disputed domain name <sportingbet.net> is registered with eNom.

The disputed domain name <sportingbets.biz> is registered with Intercosmos Media Group d/b/a directNIC.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 25, 2006. On

August 26, 2006, the Center transmitted by email to eNom and to Intercosmos Media Group d/b/a directNIC.com a request for registrar verification in connection with the domain names at issue. On August 30, 2006, Intercosmos Media Group d/b/a directNIC.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of <sportingbets.biz> and providing the contact details for the administrative, billing, and technical contact. On August 31, 2006, eNom transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of <sportingbet.net> and providing the contact details for the administrative, billing, and technical contact.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 6, 2006. In accordance with the Rules, paragraph 5(a), the due date for Response was September 26, 2006. The Response was filed with the Center on September 11, 2006, along with further email communications from the Respondent on September 12 and September 18, 2006.

The Center appointed Peter G. Nitter as the sole panelist in this matter on November 9, 2006. 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 wholly owned subsidiary of Sportingbet Plc. The Sportingbet Group is an online sports and gambling group. It was founded in November 1997 and now operates in more than 26 markets and 21 languages in Europe alone. Through its trading subsidiaries, it does business under the name of "sportinbet.com". The business consists in the transmission of information pertaining to sporting events, gaming and betting, and the provision of online casino and bookmaking services, all via the Internet. The mark SPORTINGBET.COM is included in the Complainant's logo which appears on its websites, publicity materials, institutional investor materials and brochures. The Complainant has operated a gaming website at the internet address "sportingbet.com" since 1997.

On December 22, 2000, the Complainant filed an application for a trademark "SPORTINGBET.COM GLOBAL SPORTSBOOK" in the Nice Classifications 9, 35, 38, 41 and 42 with the European Community Office for Harmonization in the Internal Market. On May 13, 2002, the trademark application was published with the Office for Harmonization the Internal Market. As per today, the Complainant has several worldwide trademark registrations and applications for the mark SPORTINGBET.

The Respondent is based in Vancouver, Canada, and owns several sport books and casino websites, such as "go2gamble.com". On February 5, 2002, the Respondent registered the domain name <sportingbet.net> as gateway page for "go2gamble.com" The domain name <sportingbets.biz> was registered by the Respondent on May 29, 2002.

5. Parties' Contentions

A. Complainant

The Complainant is one of the world's largest online sports betting and gambling group, and has a large portfolio of trademark registrations or applications for SPORTINGBET trademarks worldwide. In addition the Complainant has invested and continues to invest very significantly in media promotion of its brands throughout the world, including SPORTINGBET and SPORTINGGOODS. The Complainant has received extensive press coverage in both general and trade newspapers/publications. As a result of the extensive reputation and investment in the promotion of the SPORTINGBET trademarks, the Complainant has the benefit of worldwide goodwill in the mark in relating to betting and gambling services. Any use of this word or any variation is likely to lead to confusion with, and cause damage to, the Complainant's SPORTINGBET brand.

The domain name <sportingbet.net> is identical to the Complainant's SPORTINGBET trademark applications and registrations, while the domain name <sportingbets.biz> is confusingly similar to the SPORTINGBET trademark in which the Complainant has rights.

Approximately in April 2002, the Complainant became aware that the Respondent had registered the domain name <sportingbet.net> on January 25, 2002. The Complainant filed proceedings with ADNDRC (Asian Domain Name Dispute Resolution Centre) requesting the transfer of the domain name. These proceedings were unsuccessful. It is the Complainant's belief that the circumstances concerning this matter have changed significantly and that, not only does the Complainant have adequate goodwill in the word <sportingbet> but that the Respondent's actions both during and after the ADNDRC proceedings amount to bad faith and necessitates a reassessment of the previous ADNDRC decision.

The Complaint maintains that, as a result of the activities and marketing efforts of the Sportingbet Group, as well as the global nature of the Internet, the <sportingbet> name is a highly visible brand throughout the world, including Canada. The Complainant also notes that the domain names are both gTLDs, which do not have geographical connotations and can be registered and accessed from anywhere in the world.

During the course of the ADNDRC proceedings, the Respondent registered the domain name <sportingbets.biz> on May 29, 2002. This registration was made with full knowledge of the Complainant's claimed rights in the name SPORTINGBET.

Around the date of the judgment of the ADNDRC on August 6, 2002, the Respondent signed up to the Complainant's affiliate program for the website "sportingbet.com" until the closure of the program on September 30, 2005, following the establishment of a new affiliate program for another SPORTINGBET Group website, "www.sportingodds.com". In April 2006, the Complainant's legal department became aware that the Respondent was using both the Complainant's SPORTINGBET trademark on its website in contravention of the terms and conditions of the Affiliate Program. As a result of this misuse, the Complainant suspended the Respondent from the affiliate program on May 18, 2006, when it became clear that the Respondent would not transfer the domain names without substantial payment. The Respondent still continues to use the SPORTINGBET trademark and refuses to transfer the domain names to the Complainant.

The Respondent has no rights in the trademark SPORTINGBET. Furthermore, the Respondent is no longer affiliated to the Complainant in any way, nor has the Complainant granted the Respondent a license to use the domain names or trademark.

Visitors to the websites located at the domain names are taken to directory style portal pages which have the domain name in question at the top of the page and links to other websites offering gambling services beneath. The Respondent is clearly not making fair use of the domain names and has no rights or legitimate interests in the trademark or in the domain names. Instead, the Respondent is using the Complainant's worldwide rights to exploit

illegitimately the reputation and goodwill the Complainant owns in the domain names for its own commercial gain and to mislead customers, and thereby damaging the reputation of the SPORTINGBET trademarks.

The Respondent is in the business of generating traffic to various websites using the SPORTINGBET trademark. The domain names are therefore clearly intended to be used for commercial gain.

There has been some e-mail correspondence between the parties and the Complainant offered to buy the domain names. After some discussions back and forth regarding price, the Respondent rejected the Complainant's offer. In the Respondents last e-mail it stated that it had the right to use "SPORTINGBET" in accordance with the ADNDRC decision. The conduct of the Respondent demonstrates the Complainant's belief that the Respondent is using the domain names in bad faith and with the deliberate aim of extracting money from the Complainant by threatening to exploit the Complainant's goodwill by its continued ownership and use of the domain names. With regard to <sportingbets.biz> in particular, it is clear that the Respondent registered the domain name with full knowledge of the Complainant's assertion of rights in the name SPORTINGBET.

B. Respondent

The Respondent refers to the ADNDRC decision. The Respondent contends that the Complainant has still failed to provide any evidence that they have trademarked the terms "sportingbet" or "sportingbets".

The Respondent has not changed the way they are using the domain(s). The Complainant has just not been able to purchase the domain name(s) from the Respondent, as some of the conditions for a possible sale were not agreed to by all parties involved.

The Respondent further contends that it has the copyright to both website domains under Canadian law, and that the Complainant is using the WIPO to create further dialogue, as the purchase of the domain names has failed.

6. Discussion and Findings

A. Procedural Aspects

Formal Deficiencies of the Response

There are no provisions regulating the consequences for responses that do not meet the formal requirements comparable to paragraph 5 (b) of the Rules for complaints. Whether and under what conditions responses are to be taken into account if they do not satisfy the formal requirements of paragraph 5 of the Rules has been determined differently by different Panels. The majority of the panelists assume that they are entitled at their discretion to determine whether to consider responses which are formally incorrect, see *Young Genius Software AB v. MWD, James Vargas,* WIPO Case No. D2000-0591.

A response has been taken into account *inter alia* if:

- the Respondent wrongly submitted the response to the Complainant and ICANN but not to the dispute resolution provider, see *Oberoi Hotels Pvt. Ltd. v. Aurun Jose,* WIPO Case No. D2000-0263;

- the response was on time but was submitted in handwriting, see *Cable News network LP, LLP v. Manchester*

Trading, National Arbitration Forum Case No. FA 93634;

- the response exceeded the limit on the number of words imposed by the Supplement Rules, see *Süd-Chemie AG v. tonsil.com*, WIPO Case No. D2000-0376;

- the response was submitted by fax, see *Veritas DGC Inc. v. The Collectors Source,* National Arbitration Forum Case No. FA 94425.

Account in certain cases has not been taken of a response that was merely submitted by email, See *William Hill organization Limited v. Seven Oaks Motoring Centre,* WIPO Case No. D2000-0824.

In this case, the Respondent sent an email as response to the Complaint. This does not meet the formal requirements in paragraph 5(b) of the Rules for a response. The Respondent does not respond specifically to the statements and allegations contained in the Complaint including any and all bases for the Respondent to retain registration and use of the disputed domain names.

As a panelist it is important to make a decision based on the information and documentation from the parties. One of the reasons behind the formal requirements of the Rules for complaints and responses, is to ensure that the Panel can make the right decision. This task is made difficult when one of the parties does not make an effort to follow the requirements set out.

By following the requirements set out in the Rules for responses, Respondent gets the opportunity to contradict the allegations made by Complainant. The Respondent has not made an effort to document any possible rights in the domain name, and has not followed the requirements as to form.

On the bases of the above, the Panel finds that the Respondent is formally in default. However to the extent that the material submitted by the Respondent informally is of relevance, it has been taken into account by the Panel in the interests of ensuring the decision is based on all available information.

Other proceedings

One of the disputed domain names, <sportingbet.net>, has previously been the subject of a UDRP proceeding, namely ADNDRC (the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre) Case No. HK-0200003. Both parties have referred to the said case in their argumentation. The Panel in that case dismissed the Complaint essentially on the basis that the Complainant had not succeeded in establishing either registered or unregistered rights in “sporting bet” or “sportingbet.com”, and had therefore failed to meet the requirements of paragraph 4(a)(i) of the Policy.

The issue of refiled complaints and the circumstances in which these should be considered has been comprehensively discussed by previous UDRP panels, notably in the case of *Creo Products Inc. v. Website In Development*, WIPO Case No. D2000-1490.

While in light of subsequent findings it is not necessary for the Panel to make a substantive decision on the issue in the present case, in relation to the preliminary procedural issue of the acceptance of the case, the Panel is satisfied that *prima facie* the Complainant has pleaded grounds which when taken together could justify entertaining a refiled complaint in relation to the domain name <sportingbets.net>. Accordingly, the Panel considers the initial acceptance of the case by the Center and subsequent appointment of a panel to consider it to have been the appropriate course in the circumstances.

A. Identical or Confusingly Similar

The relevant part of the disputed domain name <sportingbet.net> is “sportingbet”, which is identical to the Complainant’s Community trademark No 3389897 SPORTINGBET, registered June 20, 2005 and US registration No 78802215, registered June 20, 2005.

The Complainant also has rights in the marks SPORTINGBET PLC, Community Trademark No 2706075 and 2706067, both registered March 15, 2004, SPORTINGBET, Community Trade Mark 3389897, registered June 20, 2005, SPORTINGBET 121, Community trade mark No 2876878, registered December 12, 2005, SPORTINGBET.COM, Community trademark No. 4997714, registered March 31, 2006, SPORTINGBET PLC and US registration No. 78802167 and 78802198, registered March 15, 2004.

The disputed domain name <sportingbets.biz> is not identical to the Complainant’s trademarks. The mere addition of the letter “s” to the mark does however nothing to dispel a connection in the public’s mind between the website’s name and its owner, the Complainant. The Panel finds that the disputed domain name <sportingbets.biz> is confusingly similar to the Complainant’s marks.

The domain name <sportingbet.net> was registered in February 2002, and the domain name <sportingbets.biz> was registered in May 2002. However, as stated in *Digital Vision, Ltd v. Advanced Chemill Systems,* WIPO Case No. D2001-0827 and other cases, paragraph 4(a) (i) of the Policy does not require that the trademark was registered prior to the domain name. The fact that the disputed domain name predates the Complainant’s trademark registration may only be relevant to the assessment of bad faith, pursuant to Paragraph 4(a)(iii).

The Panel therefore concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(i) of the Policy in relation to both disputed domain names.

B. Rights or Legitimate Interests

The Panel notes that Complainant bears the burden of proof under paragraph 4(a)(ii) of the Policy, which burden shifts to the Respondent once Complainant makes a *prima facie* showing that the Respondent lacks rights or legitimate interests. See for instance *Neusidler Akttiengesellshaft v. Kulkarni,* WIPO Case No. D2000-1769 and *Dow Jones LP v. The Hephzibah Intro-Net Project Limited,* WIPO case No. D2000-0704.

Since it is difficult to prove the negative (i.e. that respondent lacks any rights or legitimate interests in the mark) – especially where the respondent, rather than the complainant, would be best placed to have specific knowledge of such rights or interests – and since paragraph 4(c) of the Policy describes how a Respondent can demonstrate rights and legitimate interests, a Complainant’s burden of proof on this element is relatively light, see *De Agostini S. p.A v. Marco Cialone,* WIPO Case No. DTV2002-0005. Hence, Complainant must make at least a *prima facie* showing that Respondent has no rights or legitimate interests in the mark. If Complainant has met its initial burden of proof which the Respondent fails to rebut, Complainant will be deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the present case, the Panel finds that the Complainant has not made a *prima facie* showing that Respondent does not have rights or legitimate interests in the domain names within the meaning of paragraph 4(a) of the Policy. The Panel notes that Complainant has not presented any evidence of its rights in the trademarks SPORTINGBET at the time of the registration of the contested domain names <sportingbet.net> and <sportingbets.biz>.

Furthermore, the Complainant has not provided any evidence of any rights in the unregistered marks SPORTINGBET or SPORTINGBET.COM, at the time of the Respondent’s registration of the domain names

<sportingbet.net> and sportingbets.biz>.

The Respondent registered the disputed domain name prior to Complainant's registration of the various SPORTINGBET trademarks and prior to its submission of an application for trademark application. The Complainant and the Respondent are located in different jurisdictions and the Complainant has not provided any evidence to show how the mark was used in the Canadian market and whether it had become distinctive in the relevant business in that market at the time of Respondent's registration of the domain name <sportingbet.net>.

Respondent's default notwithstanding, the material before the Panel indicates that the Respondent owns several sport books and casino websites, and that it is offering what appear to be *bona fide* services through the domain names. By using the domain names in conjunction with it's business, the Panel finds it more likely than not that Respondent has rights and legitimate interests in the domain names at question.

As a result the Panel finds that the Complainant, who has the burden of proof, has failed to show that the Respondent lacks rights or legitimate interests in the contested domain names, and accordingly the Panel finds that Complainant has not met the requirement of paragraph 4(a)(ii) of the Policy.

Having reached the foregoing conclusion, it is not necessary for the Panel to consider whether or not the Respondent was and is acting in bad faith in regard to its use of the <sportingbet.net> and <sportingbets.biz> domain names. Nor is it necessary for the Panel to consider the Complainant's contention that the circumstances concerning this matter have changed significantly since the previous ADNDRC decision such that the Respondent's actions since then amount to bad faith.

7. Decision

For all the foregoing reasons, the Complaint is denied.

Peter G Nitter
Sole Panelist

Dated: December 5, 2006