

## **ADMINISTRATIVE PANEL DECISION**

### **Novomatic AG v. DomainClip Domains Inc**

### **Case No. D2022-4590**

#### **1. The Parties**

Complainant is Novomatic AG, Austria, represented by GEISTWERT Kletzer Messner Mosing Schnider Schultes Rechtsanwälte OG, Austria.

Respondent is DomainClip Domains Inc, Canada, represented by Gowling WLG LLP, Canada.

#### **2. The Domain Name and Registrar**

The disputed domain name <slots.net> is registered with Safenames Ltd. (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 1, 2022. On December 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent, also from the registrant’s name and organization (“Your Whois Privacy Ltd”) identified by reference to the Whois provided as Annex 2.1 to the Complaint, and contact information in the Complaint. The Complainant indicated in the section of the Complaint regarding the Respondent that “Information to be amended upon information of the Respondant’s contact details by Registrar Safenames”. The Center sent an email communication to Complainant on December 9, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed a first amended Complaint on December 9, 2022, and a second amended Complaint on December 23, 2022.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on December 14, 2022. In accordance with the Rules, paragraph 5, the due date for the Response was January 3, 2023 and was extended to January 22, 2023. The Response was filed with the Center on January 21, 2023.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on January 30, 2023. 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.

On February 13, 2023, the Panel issued Procedural Order No. 1 inviting Respondent to clarify the date on which it became the registrant of the disputed domain name, the means by which Respondent acquired the disputed domain name, and to identify the original registrant of the disputed domain name and the party from which Respondent obtained the disputed domain name, if known.

Respondent provided a response on February 19, 2023.

Complainant did not submit comments thereto.

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

Complainant is an international gaming technology company that produces gaming equipment, operates electronic and regular casinos and sports betting outlets, and offers services related to gaming and lotteries. It is the proprietor of several trademark registrations, including the following:

- European Union Trade mark No. 006235543 for PARTY SLOTS (word mark), registered on August 7, 2008 for goods and services in classes 9, 28 and 41;
- European Union Trade mark No. 012552873 for CLEOPATRA QUEEN OF SLOTS (word mark), registered on June 11, 2014 for goods and services in classes 9, 28 and 41;
- European Union Trade mark No. 013573555 for SLOTS PHAROAH'S FIRE (device mark), registered on April 8, 2015 for goods and services in classes 9 and 28;
- European Union Trade mark No. 014151336 for N WORLD CHAMPIONSHIP OF SLOTS (device mark), registered on September 28, 2015 for goods and services in classes 28 and 41.

Respondent is a Canadian corporation engaged in the business of licensing domain names.

The disputed domain name was registered on May 13, 1997. Complainant submits evidence that it did not resolve to an active website. At the time of this Decision, the Panel verified that the disputed domain name redirects Internet users to a website at <slots.ca>, which appears to promote online gaming sites for Canadian users.

Respondent has provided screen shots of websites to which the disputed domain name has resolved. An image dated June 25, 2013 depicts a website with the header "slots.com", corresponding to Respondent's statements that its licensee enabled such a redirection at that time. An image dated March 17, 2018 depicts a site similar to the website at <slots.ca> to which the disputed domain name redirected at the time of this Decision.

According to information provided by Respondent and unchallenged by Complainant, the disputed domain name has changed hands numerous times since its original registration date. Respondent states that it acquired the disputed domain name on January 18, 2011. A third-party report of the history of the disputed domain name lists a privacy service as the registrant at that time. Complainant alleges that Respondent became the registrant only in 2017.

## 5. Parties' Contentions

### A. Complainant

Complainant's contentions may be summarized as follows:

Complainant states that it was founded in 1980 and is one of the largest high-tech gaming technology companies worldwide and is Europe's market leader. Complainant has a turnover of EUR 1.8 billion in 2021 and employs more than 21,000 staff worldwide. It operates around 212,000 gaming terminals and video lottery terminals, and operates across the gaming industry including offering various services and management systems.

Under the first element, Complainant states that it owns four trademarks containing the term "slots" (the "SLOTS trademarks") and also registrations for the mark GAMINATOR. The disputed domain name is confusingly similar to Complainant's marks containing the term "slots". A third-level domain, <gaminator.slots.net>, is confusingly similar to Complainant's GAMINATOR mark.

Under the second element, Complainant states that Respondent registered the disputed domain name on May 13, 2017, and there is no content linked to the disputed domain name or to the third-level domain <gaminator.slots.net>. Respondent has no relationship to Complainant for the use of the SLOTS trademarks or the GAMINATOR trademarks.

Under the third element, Complainant states that Respondent registered the disputed domain name long after Complainant had registered the respective trademarks and long after Complainant's affiliate had installed a website under the domain names <gaminator.at> and <gaminator.com>. The disputed domain name combines the descriptive part of Complainant's SLOTS trademarks with Complainant's GAMINATOR mark at the third-level domain. The use of the third-level domain <gaminator.slots.net> misleads and poaches Complainant's clients. "Slots" is a clear reference to slot-machines and therefore to Complainant's products. Respondent registered the disputed domain name in full knowledge of Complainant and its trademarks because there is no other reason than to lead the public to online games which may be counterfeits of Complainant's games. The disputed domain name is being passively held in bad faith. Respondent is preventing Complainant from reflecting its trademark in a corresponding domain name.

Complainant requests transfer of the disputed domain name.

### B. Respondent

Respondent's contentions may be summarized as follows:

Respondent has been engaged in the domain name business since at least as early as 2004. It acquired the disputed domain name in 2011 and has licensed it to a digital marketing company called AG Marketing Solutions from that time. From 2011 to 2017, AG Marketing Solutions used the disputed domain name to redirect users to the website "www.slots.com", which operated games of chance. From 2017 to the present time, the disputed domain name has been used by AG Marketing Solutions to redirect Internet users to the domain name <slots.ca>, an information website which provides links to commercial online gaming websites not connected to Complainant or its marks.

Respondent was unaware of Complainant or of the subdomain <gaminator.slots.net> until it received notice of these proceedings in December 2022.

Respondent has never registered, used, operated or licensed, or otherwise authorized any person to register, use or operate a sub-domain at <gaminator.slots.net>. Respondent states that this subdomain does not return an IP record associated with the disputed domain name, indicating that it does not exist.

Responding to Complainant's contentions under the first element, Respondent states that the disputed domain name is not identical nor confusingly similar to Complainant's trademarks. There is no similarity

between Complainant's GAMINATOR trademark and the disputed domain name. The only similarity between Complainant's other trademarks and the disputed domain name is the word "slots", which, by Complainant's own admission, is a descriptive element. The word "slots" is a generic or clearly descriptive term, and Complainant has not demonstrated its acquisition of secondary meaning in this term. Complainant registered the first of its trademarks containing the term "slots" in 2008, ten years after the registration of the disputed domain name.

Responding to Complainant's contentions under the second element, Respondent states that it has a legitimate interest due to the fact that the disputed domain name consists of a dictionary word and it is used in association with a website relating to services connected to the dictionary meaning of the word "slots", without any reference to Complainant or its marks. Complainant has not provided any evidence indicating that Respondent's aim in registering and using the disputed domain name was to profit from or exploit Complainant's trademark. Respondent's use of the disputed domain name cannot be said to have the effect of misleadingly diverting consumers or tarnishing Complainant's trademark rights. Respondent has provided evidence of long-standing use of the disputed domain name in connection with a *bona fide* offering of services by licensing the disputed domain name continually since 2011. The disputed domain name was registered in 1997, well before Complainant claims to have obtained any relevant trademark rights. Respondent is engaged in discussions to transfer the disputed domain name to its licensee.

Responding to Complainant's contentions under the third element, Respondent states that the disputed domain name was registered 10 years before Complainant alleges it obtained trademark rights. There is no evidence of Complainant having or using any reputation in the word "slots" at the time of the registration of the disputed domain name in 1997, at the time Respondent acquired the disputed domain name in 2011, or now. Complainant has not provided any evidence to support its statement that Respondent registered and used the disputed domain name in bad faith. Respondent uses the term "slots" descriptively to provide the public with information that is connected to the dictionary meaning of that term. The disputed domain name has not been held passively in bad faith, as it has been actively used from time to time for many years. Respondent has not used the disputed domain name to confuse or mislead Internet users nor has it provided infringing content. Complainant's allegations are not supported by the evidence provided.

Respondent contends that Complainant has engaged in Reverse Domain-Name Hijacking ("RDNH") for the following reasons: The disputed domain name was registered prior to the date that Complainant acquired trademark rights. Complainant has not demonstrated secondary meaning of a descriptive term. The disputed domain name has not been used for any bad-faith purpose. The subdomain <gaminator.slots.net> is not in existence and does not retrieve an IP record. The Complaint is based on only the barest of allegations without any supporting evidence. Complainant is represented by specialized counsel and should be held to a higher standard. Complainant bases its Complaint on completely unrelated trademarks that share one word in common with the disputed domain name. The Complaint was brought in bad faith and constitutes an abuse of this administrative proceeding.

## **6. Discussion and Findings**

### **6.1 Limitation of Decision to Second-Level Domain**

As a threshold matter, the Panel notes Complainant's references to its rights in the GAMINATOR trademark, which is or has been reflected in a third-level domain (subdomain) at <gaminator.slots.net>. The Panel notes that the UDRP is solely intended to resolve disputes between trademark owners and holders of second-level domain names which are identical or confusingly similar to the trademarks of the right holders. The UDRP applies to disputes involving second-level domain names because the ICANN Registrar Accreditation agreement requires ICANN accredited registrars to require second-level domain name registrants to agree to the UDRP. This is not (or at least not currently) the case in relation to third-level domains under the <slots.net> domain name. For that reason, Complainant's arguments relating to any third-level domains will not be further treated in this Decision.

## 6.2 Substantive Issues

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) Respondent has registered and is using the disputed domain name in bad faith.

Under 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”.

### A. Identical or Confusingly Similar

Complainant has provided evidence establishing that it has trademark rights in the PARTY SLOTS and SLOTS PHAROAH’S FIRE marks through registration in the European Union. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.2.1.

In comparing Complainant’s marks with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to Complainant’s marks, as it comprises the word “slots”, which is a recognizable element of the PARTY SLOTS and SLOTS PHAROAH’S FIRE marks. It is the consensus view of UDRP panels that where a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. The extent to which the “slots” component could be said to be dominant is not an issue the Panel needs to resolve in light of the overall findings. See [WIPO Overview 3.0](#), section 1.7.

It is the well-established view of UDRP panels that a generic Top-Level Domain such as “.net” is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel would be prepared to find that Complainant has established the first element under paragraph 4(a) of the Policy for standing purposes, but such a finding is not necessary here in light of the third element discussion.

### B. Rights or Legitimate Interests and Registered and Used in Bad Faith

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, respondent’s use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Complainant states that Respondent has no rights or legitimate interests in the disputed domain name based on the fact that it was registered after Complainant's registration of trademark rights and that the disputed domain name does not resolve to an active website. Respondent states that it had no knowledge of Complainant and has used the disputed domain name since 2011 in connection with a website related to online gaming without any reference to Complainant.

The Panel finds that Respondent has not been known by the disputed domain name, and that Respondent has not established rights or legitimate interests based on a legitimate noncommercial use of the disputed domain name. The evidence clearly shows that the disputed domain name is being used for commercial purposes, namely, to attract traffic to a website promoting online gaming websites.

The remaining issue is whether, prior to these proceedings, Respondent used the disputed domain name in connection with a *bona fide* offering of goods or services. In accordance with UDRP practice, the Panel shall assess Respondent's conduct with a view to the circumstances prevailing at the time of the filing of the Complaint. See [WIPO Overview 3.0](#), section 2.11.

The Panel notes that the disputed domain name, which comprises the word "slots", is a dictionary word. The evidence demonstrates Respondent registered a domain name comprised of a dictionary word and has, over a period of several years, used it to redirect to a website displaying information about online gaming, including slot machines, thereby using it in connection with the relied-upon dictionary meaning of "slots." The content of Respondent's website, while clearly of a commercial nature, does not reflect any connection to Complainant or any of Complainant's trademarks. See [WIPO Overview 3.0](#), section 2.10.

At the same time, however, given the ambiguous and contradictory nature of the evidence in the record, the Panel finds there is indeed some doubt as to how the disputed domain name was being used at the time of the filing of the Complaint. Complainant submits evidence that the disputed domain name did not resolve to any website. Given that Respondent is not known by the name "slots", and its control of the domain name <slots.ca> cannot be dated with certainty, and there is insufficient evidence to establish how Respondent has used the disputed domain name at the relevant time. Therefore, the Panel finds that Respondent has not clearly demonstrated its rights or legitimate interests in the disputed domain name.

As above, the Panel need not come to a determination as to the second element under paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

The Policy, paragraph 4(b) provides that for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark 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 location. (Policy, paragraph 4(b)).

The Panel does not conclude, on the evidence submitted by the Parties, that Respondent has registered the disputed domain name in bad faith primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant. The Panel notes the disputed domain name has been registered for over 25 years and during that time, Respondent at no point contacted the Complainant to offer the disputed domain name for sale. Similarly, the Panel finds that Complainant has not brought forth any evidence that Respondent has engaged in a pattern of conduct of registering domain names (including the disputed domain name) to prevent trademark owners from registering a corresponding domain name.

The Panel finds that the Complainant has not satisfied its burden to show that Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor. While the evidence demonstrates that the Parties are engaged in the online gaming industry, the Panel is unable to find that Complainant has established that Respondent has registered and used the disputed domain name in bad faith on that basis, since the disputed domain name comprises but one element of Complainant's trademarks and is identical to none of those marks. The Panel is not persuaded that, by registering the disputed domain name, Respondent has prevented Complainant from registering its own trademark or trademarks as a domain name. See [WIPO Overview 3.0](#), section 3.1.3, and cases cited thereunder.

Complainant cites Austrian law for the proposition that use of a third-party trademark in a third-level domain is trademark infringement. However, UDRP paragraph 15(a) provides that a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP, the UDRP Rules, and any rules and principles of law that it deems applicable. According to established UDRP practice, reference to national law would be made exceptionally, and the Panel does not find that any circumstances in this case that would warrant such an approach. The Parties do not share a common nationality that would justify the import of a specific national law concept, nor are there any other circumstances that would warrant the application of national law. Therefore, as noted above, the Panel sees no reason to depart from the principle that the UDRP governs disputes concerned with second-level domains. See [WIPO Overview 3.0](#), section 4.15.

The disputed domain name was registered in 1997, predating Complainant's establishment of trademark rights by a decade or more. The evidence on record does not pinpoint the precise date of Respondent's control of the disputed domain name, and it does support Complainant's contention that the transfer of control to Respondent post-dates Complainant's establishment of some of its relied-upon trademark rights. In accordance with UDRP practice, if a respondent acquires a domain name after the complainant's rights accrue, the panel will look to the circumstances at the date the UDRP respondent itself acquired the domain name. See [WIPO Overview 3.0](#), section 3.8.1.

However, on this record, the Panel is unable to find that Respondent's conduct amounts to bad faith. As mentioned, the Panel notes that the disputed domain name comprises a dictionary term. Respondent provides credible evidence that the disputed domain name was used to resolve to websites at the domain names <slots.com> and <slots.ca> with content corresponding to a dictionary meaning of the term "slots" Coupled with the lack of any evidence that Respondent targeted or even mentioned Complainant, the Panel finds that Complainant's allegations of such targeting of its trademarks are not made out. In reaching this conclusion, the Panel notes the differences between the disputed domain name and Complainant's marks. Complainant has not established that attractiveness of the disputed domain name derives from Complainant's trademarks rather than from other factors. See [WIPO Overview 3.0](#), section 3.1.1.

Further, if indeed Respondent's website is or has been inactive at some point, the Panel does not find that Respondent engaged in passive holding as alleged by Complainant. Notably, the Panel finds that Respondent has provided sufficient evidence of good-faith use of the disputed domain name over a number of years by using it to redirect to websites providing information about online gaming. See [WIPO Overview 3.0](#), section 3.3.

Complainant does not provide any evidence to support its allegation that Respondent's website leads Internet users to online games which may be counterfeits of Complainant's games. See [WIPO Overview 3.0](#), section 3.1.4.

Accordingly, the Panel finds that Complainant has not established the third element under paragraph 4(a) of the Policy.

#### **D. Reverse Domain-Name Hijacking**

Paragraph 15(e) of the Rules provides that, “[i]f after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.”

Section 4.16 of the [WIPO Overview 3.0](#) notes that a panel may find Reverse Domain Name Hijacking when there are “facts which demonstrate that Complainant knew it could not succeed as to any of the required elements—such as Complainant’s lack of relevant trademark rights, clear knowledge of Respondent rights or legitimate interests, or clear knowledge of Respondent bad faith such as [...] facts which demonstrate that Complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint.”

The conduct in this case does not fall under the category of Reverse Domain Name Hijacking. While Complainant did not succeed in establishing the three elements as required under the Policy, the Panel does not find that the Complaint was completely devoid of any facts or arguments that could support a finding that Respondent lacked rights or legitimate interests in the disputed domain name, nor its argument that Respondent must have registered and used the disputed domain name in bad faith. Rather, the Complaint put forward arguments that Complainant’s rights in a GAMINATOR mark could be linked to the disputed domain name through a third-level domain relying on evidence that was disputed as between the Parties and therefore inconclusive.

In the Panel’s view, this approach, while unsupported by UDRP practice, does not amount to abuse of process. As explained above, the Policy applies to disputes concerning second-level domains. For that reason, the Panel did not treat Complainant’s arguments related to an alleged third-level domain. The remaining arguments, while some of them could be considered conclusory and speculative, were not so weak as to render the filing of the Complaint as an act of bad faith. See [WIPO Overview 3.0](#), section 4.16. See also *Billy Bob’s Texas IP Holding LLC v. Domain Administrator, Name Administration Inc. (BVI)*, WIPO Case No. [D2016-1221](#); *NYLSTAR S.A. v. Domain Administrator, Meryl Blog*, WIPO Case No. [D2016-0561](#); *Interbasic Holding S.A. v. Francois Carrillo*, WIPO Case No. [D2012-0656](#).

As such, the Panel finds that Complainant has not engaged in Reverse Domain Name Hijacking.

#### **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: March 6, 2023