

ADMINISTRATIVE PANEL DECISION

Novomatic AG v. Evgeniy Zhak
Case No. D2023-0769

1. The Parties

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

The Respondent is Evgeniy Zhak, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <novomatic-game.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2023. On February 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 21, 2023, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 23, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 24, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on March 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 22, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on March 28, 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.

4. Further Procedural Considerations

Under paragraph 10 (b) and 10 (c) of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

The Respondent's mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification. Thus, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10(b) and 10(c) of the Rules, whether the proceeding should continue.

It appears that the Complaint together with the amendment to the Complaint were delivered to the Respondent's email address, as provided by the Registrar.

The Panel also notes that Complainant has specified in the Complaint that any challenge made by Respondent to any decision to transfer or cancel the disputed domain name shall be referred to the jurisdiction of the Courts of the location of the principal office of the concerned registrar. In this case, the principal office of the Registrar of the disputed domain name, NameCheap Inc, is in the United States of America.

The Panel concludes that the Party allegedly located in Ukraine has been given a fair opportunity to present its case, and so that the administrative proceeding takes place with due expedition, the Panel will proceed to a Decision accordingly.

5. Factual Background

The Complainant, Novomatic AG, of Austria, was founded on June 11, 1990 and the Novomatic Group had a turnover of approximately EUR 1.8 billion in 2021. It is one of the largest gaming technology companies in the world and Europe's market leader. The Complainant employs more than 21,200 staff worldwide, is present in 50 countries and exports its gaming technology to over 70 jurisdictions. It operates many gaming and video lottery terminals.

The Complainant owns numerous registered NOVOMATIC trademarks including the Austrian wordmark 145211 registered on December 17, 1992 in classes 9, 28, 37, 41 and 42 (Nice Classification) and the European Union Mark 4135273 registered on March 2, 2006 in classes 9, 16, 28, 36, 37, 41, 42 and 43. The Complainant has registered and operates the domain name <novomatic.com>.

The disputed domain name was registered on January 20, 2023 and resolves to a website with links to third party gaming sites.

6. Parties' Contentions

A. Complainant

The Complainant develops and markets gaming technology and undertakes associated activities including management and intellectual property related ones in many countries. It asserts that it markets and operates casinos of all kinds including online, and by way of betting machines and terminals. It provides services to others in relation to gaming activities of this kind but also related to hospitality management, management of its related intellectual property, real estate management and participation in other businesses.

The Complainant says that it uses the sign NOVOMATIC extensively on its products and services and advertising material for computer, technology, betting records, gaming equipment, rental of casinos and gaming halls, building and fitting out the latter, and providing them management and support services by way of software and computers, as well as providing catering for gambling, betting and gaming establishments.

The Complainant contends that it has used the mark NOVOMATIC to such an extent in relation to these products and services that the mark has acquired the meaning that products and services in the gaming field are derived from the Complainant. The term “novomatic” has no meaning in German and is thus distinctive, which entitles it, the Complainant says, to remedies under Austrian law when a third party makes unauthorized use of it that is likely to cause confusion in commerce. The Complainant stresses that by virtue of the law in a number of jurisdictions it would be entitled to appropriate remedies for the unauthorized use of its NOVOMATIC mark due to the inherent and acquired distinctiveness of that mark, and the exclusive vesting in the Complainant of goodwill in the mark. The Complainant says that it would be entitled to redress under Austrian law wheresoever any deceptive use of its registered or unregistered marks may occur on the Internet.

The Complainant also points out that the trademark NOVOMATIC and the distinctive part “novomatic” of the disputed domain name <novomatic-game.com> are identical. The additional word “game” is purely descriptive, it says, and especially so in relation to the products offered by the Complainant. It is not qualified to exclude confusability.

The Complainant says that the website to which the disputed domain name resolves invite Internet users to play the online games ‘Book Of Ra’, ‘Sizzling Hot’ and others, which are not licensed by the Complainant. Clicking on a game icon in reality directs the user to another Russian website which does not offer the Complainant’s games. The Complainant asserts that its unregistered trademark and company name rights date back to 1980, and its trademarks were first registered in 1990. It says the Respondent has no relationship with or permission to use the trademark NOVOMATIC, and that the Respondent has neither been commonly known by the disputed domain name or the sign NOVOMATIC, nor acquired any trademark or service mark rights in it.

The Complainant points out that the Respondent registered the disputed domain name long after the former registered its trademarks and the domain name <novomatic.com>. In any case, a simple trademark search, which the Respondent had a duty to perform, would have revealed several Austrian and EU trademark registrations for word marks identical to the disputed domain name and also for SIZZLING HOT and BOOK OF RA.

The Complainant says that it is clear that the disputed domain name was registered and is used in bad faith and that the Respondent’s only interest is to attract attention to its website by using the Complainant’s trademarks. The Complainant contends that the Respondent registered the disputed domain name in bad faith with full knowledge of the Complainant and its trademarks because the Respondent uses the disputed domain name to lead members of the public to other companies’ games. The Respondent goes so far as to mislead and poach the Complainant’s clients, the latter maintains. Further proof of bad faith use is the fact that the Respondent explicitly refers to the Complainant’s trademark in the website to which the disputed domain name resolves. The Complainant also points out that previous UDRP panels have found use of a disputed domain name in connection with websites offering counterfeit versions of the Complainant’s goods to be in bad faith, and that it has obtained the transfer of domain names incorporating its NOVOMATIC mark on a number of occasions in UDRP proceedings.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

7. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is not identical to the registered NOVOMATIC trademark of the Complainant. However, that distinctive trademark, separated from the descriptive term “game” by a dash, is immediately visible and recognizable in the disputed domain name. The requirements of paragraph 4(a)(i) of the Policy are thus clearly met.

Therefore the disputed domain name is confusingly similar to the NOVOMATIC trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent failed to reply to any of the contentions of the Complainant or to make any case for the recognition of rights or legitimate interests. The Respondent was not licensed to use the NOVOMATIC trademark in any way nor to include it in a registered domain name. There is no indication before the Panel that the Respondent used or is known by the disputed domain name or the term “novomatic” or has made any legitimate commercial use of that term. The disputed domain name resolves to a website in Russian on which the Internet user is invited to play games of the Complainant, which are not licensed to the Respondent, and where links to other sites with competing or unrelated offerings are displayed. It is clear that the Respondent relies on the very suggestive but misleading composition of the disputed domain name to deceive Internet users into concluding that they will be taken to a website operated by the Complainant. In reality, that is not the case, and they are directed through to other sites, a result that no doubt generates benefits for the Respondent. However, these are based on deception and false representation, and therefore not of a kind to justify the recognition of any legitimate interests or rights in the Respondent.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant is engaged in the business of providing online and other gaming devices and services, and the composition of the disputed domain name makes it abundantly clear that the Respondent was aware of that fact when he registered it. The NOVOMATIC trademark of the Complainant is inherently distinctive and has acquired an extensive reputation through long term and consistent use in relation to gaming. A simple search of the European Union or Austrian trademark registers would in any case have revealed the rights the Complainant holds over the mark.

The disputed domain name resolves to a website that replicated multiple trademarks belonging to the Complainant, and links Internet users to other sites with competing or unrelated offerings. The Respondent thus relies on the deceptive composition of the disputed domain name to gain some advantage by riding on the coattails of the Complainant's extensive goodwill. The Complainant is prevented from reflecting its mark in a domain name with a potentially desirable composition by its unauthorized registration at the behest of the Respondent.

Therefore, the Panel holds that the disputed domain name was registered and used in bad faith.

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <novomatic-game.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: April 11, 2023.