

ADMINISTRATIVE PANEL DECISION

VOODOO v. Anup Surendran, ContractBrains Consulting Solutions Case No. DIO2023-0002

1. The Parties

The Complainant is VOODOO, France, represented Jones Day, France.

The Respondent is Anup Surendran, ContractBrains Consulting Solutions, Canada, represented by Internet & Law, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <paper.io> (the “Domain Name”) is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 6, 2023. On January 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 9, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 13, 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 January 13, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 January 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2023. The Response was filed with the Center on February 2, 2023. Both parties subsequently submitted multiple unsolicited supplemental filings after the Response was filed.

The Center appointed Jeremy Speres, William Lobelson, and Assen Alexiev as panelists in this matter on March 1, 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. Factual Background

The Complainant, a French company incorporated in 2013, is an interactive game publisher specialised in hyper-casual games for smartphones. Amongst the Complainant's most successful games is "Paper.io", launched on November 25, 2016, notably on the Android Play Store, consisting of a directional game aimed at gaining a coloured territory and preventing other players from doing so by moving a block around a map. The first version was followed by a second version launched in 2018. The game has been highly successful.

The Complainant owns trade mark registrations for this game, including French trade mark registration no. 4417545 for PAPER.IO registered on January 5, 2018, in classes 9, 28, 38, 41, and 42.

The named Respondent, as reflected in the Domain Name's Whois record, is ostensibly a dissolved Canadian company. However, per the Response and subsequent correspondence received from the Respondent's representative, the underlying beneficial owner of the Domain Name is Creobits LLC, a Russian company that develops web browser games, which will hereinafter be referred to as the Respondent.

The Respondent owns Russian trade mark registration No. 677788 for PAPER-IO (stylised) registered on October 25, 2018, in class 9. The Respondent also owns a software copyright registration in the Russian Federation for a software program entitled "PAPER-IO" dated April 6, 2018.

The Domain Name was registered on October 4, 2009, and presently redirects to <paper-io.com>. That domain name in turn resolves to a website offering a browser game entitled "Paper.io 2" in which the user manoeuvres a block around a map in order to capture territory. The website features commercial advertising through an affiliate network.

5. Parties' Contentions

A. Complainant

The Complainant contends as follows. The Domain Name is identical or at least confusingly similar to the Complainant's registered and well-known trade marks.

The Respondent does not have any rights or legitimate interests in the Domain Name given that the Complainant has not authorised the Respondent to use its trade marks, and the use made of the Domain Name has been to imitate the Complainant's game and take advantage of the Complainant's trade marks for financial gain.

The Respondent registered and has used the Domain Name in bad faith given that it has been used for a game that imitates the Complainant's game using the same name, and the Respondent has adopted the same *modus operandi* in respect of two of the Complainant's other games and it is unlikely that the Respondent could have independently and in good faith developed three different games that imitate the gameplay and graphics of the Complainant's games using identical names to those used by the Complainant.

B. Respondent

The Respondent objects that this dispute is beyond the competence of the Panel given that it concerns software copyright and factual and legal questions that the Panel is not authorised to resolve.

The Respondent objects to the appointment of a French panellist on the basis that the Complainant is a large French company and this raises doubts about that panellist's impartiality.

The Respondent has requested that the Panel suspend these proceedings in light of the Respondent instituting court proceedings in Russia concerning the Domain Name after the Complaint and Response were filed.

The Respondent denies that the Domain Name is identical or confusingly similar to the Complainant's trade mark given that the Top-Level Domain ("TLD") of the Domain Name must be disregarded and the comparison is therefore between the trade mark PAPER.IO and the Domain Name in the form of "paper".

The Respondent claims rights and legitimate interests based on its own trade mark and software registrations, and the use of the Domain Name for its own game.

The Respondent denies bad faith for the following reasons. The Complainant has not proven unregistered rights predating registration of the Domain Name. The Respondent applied for its trade mark and software registrations prior to the Complainant's own trade mark applications. The Respondent's game was developed independently, exhibits numerous material differences to the Complainant's game, and to the extent that there are similarities, these derive from common features in the genre.

6. Discussion and Findings

6.1 Preliminary Matters

A. Competence of the Panel

The Panel rejects the Respondent's objection to its competence. The Panel does not need to make any findings concerning software copyright in order to decide the issues raised in the Complaint concerning, primarily, bad faith targeting under the Policy. This is particularly so given that the issues concerning software copyright were introduced by the Respondent. Regarding any factual differences between the Parties, the Panel considers that the evidence before it is sufficient to determine those on the applicable standard of balance of probabilities.

B. Supplemental Filings

Both Parties filed a number of unsolicited supplemental filings after the Response was filed. Under the Rules no express provision is made for supplemental filings by either Party, except in response to a deficiency notification or if requested by the Center or the Administrative Panel. Paragraphs 10 and 12 of the Rules in effect grant the Panel sole discretion to determine the admissibility of unsolicited supplemental filings. Admissibility of supplemental filings is to be assessed based on relevance and foreseeability (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 4.6).

The Panel admits the Parties' supplemental filings only to the extent that they address new information, the necessity of which could not have been foreseen in either Party's primary filing. In particular, the Panel admits the supplemental information concerning the underlying beneficial owner of the Domain Name, Creobits LLC, and the recently instituted Russian court proceedings.

C. Effect of Court Proceedings

The Respondent instituted court proceedings before the Arbitration Court of the City of Moscow on February 20, 2023, citing Creobits LLC, the Registrar, and the Complainant as parties. The Respondent claims that the proceedings relate to the Domain Name, although this is not apparent from the court filing documents supplied by the Respondent. In light of the finding below, however, nothing turns on this.

The Panel has the discretion to decide whether to suspend, terminate or proceed to a decision where court proceedings are instituted during administrative proceedings under the Policy (paragraph 18 of the Rules). Appointed panels are generally reluctant to suspend a UDRP case due to concurrent court proceedings, most notably because of the potential for indeterminate delay. Panels generally issue a UDRP decision on the merits even in an overlapping court-UDRP proceeding scenario where, notwithstanding the fact that a UDRP decision would not be binding on the court, the relative expediency of the UDRP versus courts is seen as a benefit to the parties. Panel reluctance to terminate a UDRP case on this basis often also takes account of, and respects, the potential for a court action to address causes of action separate from that being addressed in the UDRP proceeding ([WIPO Overview 3.0](#) at section 4.14).

The Panel considers that the issues and evidence before it fall squarely within the Policy and are readily capable of resolution under the Policy. Noting the rationale for the Policy to be an expeditious and relatively inexpensive procedure for resolving domain name disputes, and noting that the Respondent could have instituted court proceedings prior to the Complaint being filed upon receipt of the Complainant's cease and desist correspondence, the Panel declines the Respondent's request to suspend these proceedings.

6.2 Substantive Matters

A. Identical or Confusingly Similar

The Complainant has a registered right for a trade mark that is identical to the Domain Name. Where the applicable TLD and the second-level portion of the domain name in combination contain the relevant trade mark, panels may consider the domain name in its entirety, including the TLD, for purposes of assessing confusing similarity ([WIPO Overview 3.0](#) at section 1.11.3). Viewed in this way, the Domain Name is identical to the Complainant's registered PAPER.IO trade mark. The Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Respondent owns trade mark and software copyright registrations corresponding to the Domain Name. However, the existence of a respondent trade mark does not automatically confer rights or legitimate interests on the respondent. For example, panels have generally declined to find respondent rights or legitimate interests in a domain name on the basis of a corresponding trade mark registration where the overall circumstances demonstrate that such trade mark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant's exercise of its rights (even if only in a particular jurisdiction) ([WIPO Overview 3.0](#) at section 2.12.2).

In *Madonna Ciccone, p/k/a Madonna Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#), the panel held as follows:

"However, it would be a mistake to conclude that mere registration of a trademark creates a legitimate interest under the Policy...To establish cognizable rights, the overall circumstances should demonstrate that the registration was obtained in good faith for the purpose of making *bona fide* use of the mark in the jurisdiction where the mark is registered, and not obtained merely to circumvent the application of the Policy."

In light of what is discussed below in relation to bad faith, it is highly probable that the Respondent's intention was to take advantage of the Complainant's trade mark for its own financial gain. The Panel's view is that the Respondent's registered trade mark and software rights were likely acquired to provide the Respondent with an apparent defence against Complainant's enforcement of its rights, in full knowledge of the Complainant's game, in order to circumvent the Policy or to frustrate the Complainant's use or registration of its trade mark in the Russian Federation.

The Respondent's usage of the Domain Name to take advantage of the Complainant's trade mark plainly cannot represent a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy and cannot confer rights or legitimate interests under the Policy (*Sistema de Ensino Poliedro Vestibulares Ltda., Editora Poliedro Ltda. v. Anonymize, Inc. / STANLEY PACE*, WIPO Case No. [D2022-1981](#)). The Policy would be self-defeating if bad faith use of a domain name, or trade mark registrations to prevent Complainant's exercise of its rights, could simultaneously confer rights or legitimate interests. The Complainant has satisfied paragraph 4(a)(ii) of the Policy.

The Domain Name was registered in 2009, long prior to the Complainant launching its game or acquiring its own trade mark rights. However, there is strong evidence indicating that the Respondent (being the Russian company Creobits LLC) was not the original registrant of the Domain Name in 2009 and did not come to own or control it until after dissolution of the named Respondent – the dissolved Canadian company ContractBrains Consulting Solutions. Firstly, the Wayback Machine evidence included in the record shows that the Domain Name was, until sometime after dissolution of the Canadian company in 2015, used for purposes of a data science website for a number of years. Its usage then subsequently changed drastically towards mobile games and the current (bad faith, as shown below) redirection to <paper-io.com>. Data science is highly different to mobile games, suggesting a different controlling entity.

Secondly, the Panel has independently viewed historical Whois records for the Domain Name, which indicate that at roughly the same time as the foregoing change in usage, the name servers for the Domain Name changed, indicating a new underlying beneficial registrant being in control of the Domain Name using a different Domain Name System ("DNS") provider.

Thirdly, the Respondent has been coy in the extreme about its relationship with the Canadian company, simply stating that it is its "partner". No details have been provided about the nature of the partnership. No confirmatory correspondence nor affidavit from the Canadian company has been provided. The Respondent has also been shown below to have acted in clear bad faith, thus its credibility on this point is somewhat tenuous.

All of this indicates that the Respondent (Creobits LLC) came to acquire the Domain Name after the original registrant – the Canadian company – was dissolved. The preceding usage of the Domain Name for a data science website etc. was therefore, on balance of probabilities, not made by the Respondent and cannot, therefore, confer any rights or legitimate interests upon it.

C. Registered or Used in Bad Faith

The Panel is, simultaneously with this case, also adjudicating *VOODOO v. CreoBits LLC*, WIPO Case No. [D2023-0071](#) also involving the Complainant and the Respondent. That case concerns, in part, the domain name <paper-io.com>, which is owned by the Respondent and is the domain name to which the Domain Name in this case redirects. The two cases are therefore intrinsically linked.

In WIPO Case No. [D2023-0071](#), the Respondent presented a screenshot from the Wayback Machine depicting the website to which <paper-io.com> resolved as at December 2, 2016 – three days after that Domain Name was registered by the Respondent. The Respondent's evidence excluded the first part of the Wayback Machine screenshot and only depicted the latter part. Further to a panel's general powers under paragraphs 10 and 12 of the Rules to conduct limited factual research, the Panel independently viewed the same screenshot directly on the Wayback Machine and noted that the website stated as follows at the top:

“Paper.io play online

More! More! More territory! Take it all with new game from Voodoo - Paper.io”

Taken together with the fact that the game depicted at the website featured gameplay and graphics highly similar to those of the Complainant’s “Paper.io” game and used an identical name, the statement quoted above shows a clear intention to impersonate the Complainant and its game. The Respondent in this case chose to redirect the Domain Name to the same website, and its intentions for the Domain Name were, therefore, clearly the same. This is supported by the fact that the Complainant’s evidence establishes that, in addition to the Domain Name and the two domain names at issue in WIPO Case No. [D2023-0071](#), the Respondent has also registered a fourth domain name - <aquapark.io> - which follows a similar pattern. That domain name’s website also features a game with striking similarities to the corresponding game of the Complainant, using an identical name, namely “Aquapark.io”. It is highly improbable that the Respondent independently developed three different games, in good faith without intending to target the Complainant, in circumstances where all three games exhibit strong gameplay and graphical similarities with the Complainant’s corresponding games and use nearly identical or identical names.

As the Policy has no conjunctive requirement in respect of bad faith, it is sufficient for a finding under the third element for the Respondent to have used the Domain Name in bad faith. The fact that the Domain Name may have been registered prior to the Complainant obtaining trade mark rights and launching its own corresponding game is therefore no bar to finding in favour of the Complainant on the third element. It is abundantly clear that the Respondent has used the Domain Name with a view to deceiving users into believing that the game offered via the Domain Name is that of the Complainant, for the purpose of generating revenue through the commercial advertisements displayed on the website concerned. This falls squarely within paragraph 4(b)(iv) of the Policy. The Complainant has satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <paper.io>, be transferred to the Complainant.

/Jeremy Speres/
Jeremy Speres
Presiding Panelist

/Assen Alexiev/
Assen Alexiev
Panelist

/William Lobelson/
William Lobelson
Panelist
Date: March 15, 2023