

DISPUTE RESOLUTION SERVICE

D00009552

Decision of Independent Expert

Sportingbet Plc

and

Mr Gavin Murphy

1. The Parties:

Lead Complainant: Sportingbet Plc
4th Floor
45 Moorfields
London
EC2Y 9AE
United Kingdom

Complainant: Internet Opportunity Entertainment (Sports) Limited ("IOEL")
C/O Corporate & Trust Services (Caribbean) Limited
PO Box 990
FD ICIC Building
Lower Factory Road
St Johns
Antigua and Barbuda

Respondent: Mr Gavin Murphy
22 John Walker House, Dixons Yard
York
North Yorkshire
YO1 9SX
United Kingdom

2. The Domain Name(s):

paradisecasino.co.uk

3. Procedural History:

14 March 2011 16:33 Dispute received
15 March 2011 13:14 Complaint validated
16 March 2011 12:56 Complaint validated
16 March 2011 13:13 Notification of complaint sent to parties
05 April 2011 09:08 Response received
05 April 2011 09:08 Notification of response sent to parties
07 April 2011 15:26 Reply received
07 April 2011 15:26 Notification of reply sent to parties
07 April 2011 15:27 Mediator appointed
13 April 2011 17:23 Mediation started
09 June 2011 09:15 Mediation failed
09 June 2011 09:22 Close of mediation documents sent
21 June 2011 02:30 Complainant full fee reminder sent
22 June 2011 11:52 Expert decision payment received
23 June 2011 10:19 Sent expert decision pack, expert appointment and conflict check documents
11 July 2011 Expert requests Further Statements from each Party pursuant to 13a of the DRS Procedure
11 July 2011 Response to 13a request received from Respondent
12 July 2011 Response to 13a request received from Complainants

4. Factual Background

The Complainants

The Complainants are members of the Sportingbet plc group (“the Group”). The Lead Complainant trades on the Official List of the London Stock Exchange. The Group is a well established online betting and gaming group operating over 30 online betting and gaming websites across the world utilising a number of brands (or marks). One of those marks that the Group trades under is the PARADISE CASINO mark. The Second Complainant owns Community Trade Mark registrations featuring the PARADISECASINO mark (registration numbers E5810403 and E5810353 respectively each with the registration date 28 February 2008). The Group operates a website at www.sportingbet.com. Screen shots of this website are included at Annex 3 to the Complaint. The PARADISECASINO mark features prominently on this website. Annex 3 also shows examples of merchandising featuring the PARADISECASINO mark as well as third party references to and reviews of the service operated at PARADISECASINO.

The Group also operates a gaming website at the Internet address www.paradisepoker.com, a business that the Lead Complainant purchased on 28 October 2004 and which the Group has operated since that date. Examples of marketing and merchandising activities under the PARADISE POKER mark are

included at Annex 1 of the Complaint. Annex 1 also includes screen shots of the paradisepoker.com website on which the paradisepoker brand features prominently.

Ownership of the Domain Name

The Domain Name was registered by Murphy Management Limited on 28 October 2004. The Respondent was a director of the registrant company (confirmed by the Respondent in his response of 11 July to the Expert's request for a Further Statement under paragraph 13a of the DRS Procedure). Murphy Management Limited was incorporated on 26 June 2003 and dissolved on 7 May 2008 (confirmed by the Respondent in his response of 11 July to the Expert's request for a Further Statement under paragraph 13a of the DRS Procedure). A WHOIS printout dated 26 July 2010 supplied by the Complainants as an Annex to the Reply shows that at that time the Domain Name was registered to the dissolved Murphy Management Limited at the same address as the Respondent's current address.

The Domain Name was transferred to the Respondent on 11 December 2010 (confirmed by the Respondent in his response of 11 July to the Expert's request for a Further Statement under paragraph 13a of the DRS Procedure).

Previous correspondence

The Expert has been supplied with copy correspondence from August 2010 between lawyers for the Complainants and "Murphy Management Limited" (although the company had by then been dissolved) concerning the Domain Name. The correspondence proved inconclusive between the Parties, presumably leading to this Complaint.

5. Parties' Contentions

The Complaint

The Complainants assert Rights in a mark that is identical or similar to the Domain Name. They rely on the Community Trade Mark Registrations featuring the PARADISE CASINO marks as well and the goodwill and reputation acquired through use of the PARADISE CASINO and PARADISE POKER marks in the course of trade.

The Complainants assert that the Domain Name is an Abusive Registration. They point out that there is no evidence of any actual or contemplated good faith use by the Respondent of the Domain Name and that he has no rights or legitimate interest in the PARADISE CASINO mark. They rely on the fact that the Domain Name was registered in on 28 October 2004 on the same day that the Group announced the purchase of www.paradisepoker.com. The Complainants assert that the timing of the registration of the Domain Name is no coincidence and that

the domain registration was made in bad faith in an attempt to take advantage of the goodwill and reputation that the Complainants had generated in its marks with a view to encouraging the Complainants to purchase the Domain Name from the Respondent.

The Response

The Respondent states that he could not reasonably be expected to know of the Complainants' purchase of the paradisepoker.com business when the Domain Name was registered in October 2004 and that he had never heard of paradisecasino.com before the dispute was raised.

He states that he registered the Domain Name before the Second Complainant registered its Community Trade Marks and sometime after the original registration of the paradisecasino.com domain name by the Complainants in December 1997.

He states that the Domain Name was registered in good faith. He has never tried to sell or transfer the Domain Name nor has he posted any website content or had any links or traffic directed from it. Therefore, on the Respondent's case, there is nothing that can be considered to be misleading or as seeking to take advantage of the Complainants' goodwill. He submits that lack of use of the Domain Name is not evidence of Abusive Registration under the provisions of the Dispute Resolution Policy ("the Policy").

In the Respondent's view the terms "Paradise" and "Casino" are generic. There are a number of casinos operating around the world under the name "Paradise Casino" (the Respondent supplies examples from the USA and Kenya). After receipt of the Complaint the Respondent googled "Paradise Casino" and the domain "paradisecasino.com" did not appear on the first page of search results (a screen shot is supplied to support this submission). For this reason, according to the Respondent, the Domain Name would not therefore be misleading to the public.

Finally the Respondent submits that the Domain Name was envisaged to be used in connection with a website that would act as a tribute site to the Paradise Casino in Nairobi. This use would not infringe the Second Complainant's Community Trade Marks. The Respondent has made preparations to use the Domain Name for legitimate non-commercial reasons.

The Reply

The Complainants refute the Respondent's submission that he was unaware of the purchase of Paradise Poker. They point out that the acquisition generated media attention. A selection of press cuttings is supplied as an Annex to the Reply. They submit that the Respondent is likely to have seen the coverage and the date of registration of the Domain Name could not be a coincidence. On the Complainants' case, the Respondent registered the Domain Name to block its acquisition by the Complainant and to prevent legitimate use.

The Complainants acknowledge that the Respondent has posted no content but point out that he is responsible for the Domain Name. In Annex 2 to the Reply the

Complainants provide screen prints which show that when the Domain Name was viewed on 6 April 2011 it diverted to a website headed “123-reg.co.uk” (the date was confirmed on behalf of the Complainants in their response of 12 July 2011 to the Expert’s request for a Further Statement under paragraph 13a of the DRS Procedure). The “123-reg.co.uk” site is linked to various gambling websites. These do not include sites operated by the Complainants but they do include their competitors. The Complainants submit that the Domain Name has therefore been used in a manner which infringes the Second Complainant’s trade marks and is likely to divert custom from the Complainants to their competitors.

The Complainants assert that the fact that the Respondent refers to businesses trading under the Paradise Casino mark in the USA and Kenya does not affect the validity of the Second Complainant’s Community Trade Marks.

Finally the Complainants submit that the Respondent has provided no evidence of preparations to use the Domain Name whether as a tribute site or otherwise. In correspondence in August 2010 with the Complainants’ lawyers, the Respondent was asked to provide evidence of such preparations but no information was forthcoming.

6. Discussions and Findings

Preliminary Issue

Before applying the substantive provisions of the DRS Policy to this matter, the extent of the Respondent’s responsibility for the registration and use of the Domain Name must be established. The Respondent is an individual. The Domain Name was originally registered by a company, Murphy Management limited (“the Company”), of which the Respondent was a director. In law, the Company and the Respondent are separate entities. The Company ceased to exist in 2008 but it would seem that Nominet were not informed and the Domain Name registration was kept in its name. The Domain Name was not transferred to the Respondent until December 2010.

This raises the question of whether the Respondent is responsible for the registration and use of the Domain Name from its registration in 2004 up to the date of transfer in 2010. The Expert has decided that he does have responsibility. This decision is based on the following grounds:

1. The Respondent himself draws no distinction between the Company and himself in the Response.
2. In the correspondence of August 2010 with the Complainants’ lawyers the Respondent (incorrectly) signs letters in the Company’s name but refers to the registration and use of the Domain Name in the first person (for example; “My domain name was registered in 2004, in good faith, without any intention of selling and I have not ever made any attempt to sell it” (letter dated 11 August 2010 in Annex 2 to the Response). This indicates that the Respondent considers the Company to be interchangeable with himself.

3. The Respondent and the Company have the same address.

The consequence of the Expert's finding is that for the purposes of this Decision under the DRS Policy the Respondent will be treated as if he were the original registrant of the Domain Name and responsible for any use to which it has been put.

Even if this finding were incorrect, it would make no difference to the outcome of this Decision. The Expert's finding of Abusive Registration is based on use of the Domain Name after it had been transferred to the Respondent.

The Provisions of the Policy

Under clause 2 of the Policy a Complainant must establish on the balance of probabilities that:

- i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Considering each of these requirements in turn:

Rights

Rights are defined in clause 1 of the Policy as including, but not limited to, "rights enforceable by the Complainant whether under English law or otherwise".

The Complaint specifies two types of Rights; (i) the unregistered Rights in the goodwill and reputation that has been generated through the Complainants' use of its PARADISE CASINO and PARADISE POKER marks and (ii) The Second Complainant's registered Rights in the PARADISE CASINO mark via its Community Trade Mark registrations.

Paradise Casino

Annex 3 to the Complaint provides information about the Complainants' marketing of the PARADISE CASINO mark. The information provided shows extensive and consistent marketing and leads the Expert to find that the Complainants own Rights under the Policy through the goodwill that has been generated in the PARADISE CASINO mark. This mark is identical to the Domain Name (it being customary to disregard the .co.uk suffix).

In addition to the unregistered Rights the Second Complainant also own Rights in two Community Trade Marks which feature the PARADISE CASINO mark. The first of these (E5810403) consists of text only. This mark is identical to the Domain Name (it being customary to disregard the .co.uk suffix). The second registration (E5810353) is a device mark. The PARADISE CASINO word mark is a dominant component of this mark and renders the mark similar to the Domain Name.

The Complainants have therefore established that they own Rights under the Policy by virtue of (i) unregistered Rights generated by the use of the PARADISE CASINO mark in the course of trade and (ii) Community Trade Marks featuring the PARADISE CASINO mark. These Rights are identical or similar to the Domain Name. The first requirement of the Policy has accordingly been met.

Paradise Poker

Annex 1 to the Complaint provides information about the Complainants' marketing of the PARADISE POKER mark. The information provided shows extensive and consistent marketing and leads the Expert to find that the Complainants own Rights through the goodwill their use has generated.

But the Policy requires the Rights to be in a mark that is identical or similar to the Domain Name. Obviously the marks are not identical. The Domain Name ends in the word "Casino" rather than "Poker". Both marks feature the word "Paradise" but in the Expert's view this is not sufficiently dominant to displace the significance of the second component word; respectively "poker" and "casino". The two marks have obvious conceptual similarities, relating as they go to gambling activities, but their overall impact is both visually and aurally different. The Expert therefore finds that the PARADISE POKER mark is not sufficiently similar to the Domain Name to meet the first requirement of the Policy. This finding is however academic given that the Complainants have already established the requisite Rights through their PARADISE CASINO mark.

Abusive Registration

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

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 has been used in a manner which took unfair advantage or was unfairly detrimental to the Complainant's Rights.

The Complainant seeks to establish that the Domain Name is an Abusive Registration on both of these grounds.

Clause 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Of relevance to this matter are the following factors:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant;
- ii. 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 by or authorised by, or otherwise connected with the Complainant;

Under clause 4 of the Policy a Respondent may demonstrate that the Domain Name is not an Abusive Registration by establishing, among other matters, that he has used or made demonstrable preparations to use the Domain Name... in connection with a genuine offering of goods or services (clause 4aiA) or has made legitimate non-commercial or fair use of the Domain Name (clause 4aiC). Clause 4b clarifies that fair use may include sites operated solely in tribute to a person or business.

Registration

The Complainants assert that the Respondent registered the Domain Name in circumstances that took advantage of the Complainant's Rights. This submission is based on the fact that the Domain Name was registered on the same day that the Complainants purchased the Paradise Poker Internet poker site (28 October 2004), a transaction that generated publicity. They supply copies of the publicity in support of this submission. On reviewing the documents supplied the Expert notes that all but one item is dated *after* registration of the Domain Name (being dated 29 October). Only one item is dated 28 October (headed "Party Poker Blog") and it refers to a press release issued by the Complainants on 28 October 2004. Essentially the Complainants' submissions are based on the supposition that the Respondent became aware of the press release, or whatever other publicity was published that day, and decided to register the Domain Name. In contrast, the Respondent denies knowledge of the acquisition.

The Complainants are required to prove their case on the balance of probabilities. It is the Expert's view that they have not done so in relation to the original registration of the Domain Name. This finding is based on the following grounds;

1. The evidence supplied by the Complainants does not establish that their acquisition was widely reported on 28 October. It is therefore insufficient to establish a finding on the balance of probabilities that the Complainant was aware of the purchase of Paradise Poker on or before 28 October 2004. If the Respondent did not have that knowledge, he could not reasonably be

said to have been taking advantage of the Complainants when he secured the registration.

2. The Respondent did not register a domain name that was obviously connected to Paradise Poker. The Domain Name is “paradise casino”. The Expert has looked carefully at the copy publicity supplied by the Complainant in Annex 1 to the Reply. There is no mention of the mark “PARADISE CASINO”.
3. Despite owning the registration for over 6 years there is no evidence that the Respondent has tried to take advantage of its registration, for example by offering to sell it to the Complainants or a competitor at an inflated price.
4. The Respondent has disclosed a reason for registration of the Domain Name (the establishment of a tribute site for an African casino). Although there is no corroboration of this statement.

For all of these reasons the Complainants have not established on the balance of probabilities that the registration of the Domain Name was an Abusive Registration.

Use

The Complainants have established that there has been use of the Domain Name. This is evidenced by the copy screen shots dated 6 April 2011 (Annex 2 to the Reply). The screen shots show the Domain Name to be connected to a parking page, presumably earning pay per click income. This is not in itself objectionable under the Policy but clause 4e of the Policy requires the Expert to take into account the following factors in considering whether such sale of traffic activity constitutes an Abusive Registration in any particular case;

- i. The nature of the domain name
- ii. The nature of the advertising links on any parking page associated with the Domain Name, and
- iii. That the use of the Domain Name is ultimately the Respondent’s responsibility.

Here the Domain Name signifies gambling activities. It is identical to the Complainants’ well established PARADISE CASINO mark. The Complainants’ use of their mark has generated goodwill such that it may be expected that consumers of online gambling services would associate the mark with the Complainants. The parking page to which the Domain Name is directed contains advertising links to competitors of the Complainants. In these circumstances, it is clear that the link of the Domain Name to the parking page is taking unfair advantage of the Complainants’ Rights by exploiting the connection between the Complainants and the PARADISE CASINO mark to generate Internet traffic. In exposing potential customers to the services of competitors of the Complainants the parking page is, on the balance of probabilities, also causing unfair financial detriment to the Complainants. This amounts to abusive use.

The use of the Domain Name occurred after the Respondent had been made aware of the Complainants' objection to his registration, and indeed after the Complaint and Response had been lodged. It does not matter that the Respondent may not have been directly responsible for the content of the parking page. As the Policy makes clear it is his responsibility to ensure that the Domain Name is used legitimately.

The use appears now to have ceased. A confirmatory search for the Domain Name carried out by the Expert on 7 July 2011 did not revert to the "123-reg.co.uk" site or indeed to any other website. But the fact that the link to the parking page has apparently stopped does not however neutralise the previous abusive use of the Domain Name.

The Respondent seeks to displace a finding of Abusive Use by establishing that he has made preparations to use the Domain Name for a legitimate purpose (presumably for the casino tribute site, although this is unclear). But clause 4aiB requires "demonstrable" preparations to be established to enable a Respondent to establish that a registration is not abusive. The Respondent has provided no details of what his preparations have involved and his submission is not made out.

7. Decision

The Expert finds that the Complainants have proved on the balance of probabilities that they own Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration.

Accordingly, the Expert finds in favour of the Complainants and directs that the Domain Name be transferred to the Complainants.

Signed Sallie Spilsbury

Dated 18 July 2011