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Online gaming company victorious in typosquatting cases International - Hogan Lovells

Typosquatting

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bwin.party services (Austria) GmbH, an Austrian company belonging to the [bwin group](#), has won two separate complaints under the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#). The complaints concerned the domain names 'bwlin.com', 'bwsin.com' (*bwin.party services (Austria) GmbH v Cifagro enterprises ua* (Case D2011-1146)) and 'bwion.com' (*bwin.party services (Austria) GmbH v Interagentur AG* (Case D2011-1079)).

The domain name 'bwion.com' was registered to a Swiss company, [Interagentur AG](#) (the first respondent) and had never been used. The domain names 'bwlin.com' and 'bwsin.com' were registered to a Ukrainian company, Cifagro enterprises ua (the second respondent) and pointed to web pages displaying sponsored links.

The complainant's group is engaged in online gaming, and some of the complainant's goods and services are offered on the website 'bwin.com'. The complainant contended that, as of October 2010, the bwin group had about 20 million registered customers, in more than 25 core markets all over the world. It maintained that the trademark BWIN was very famous.

The complainant owned the international and Community trademarks BWIN, which were registered in 2006 and 2009, respectively. 'bwion.com' was registered on August 11 2006, while 'bwlin.com' and 'bwsin.com' were registered on May 13 2008.

The complainant filed complaints against the first respondent and the second respondent on June 24 and July 7 2011, respectively, requesting a transfer of the domain names. The complainant's group has, to date, already recovered about 20 domain names in UDRP procedures.

To be successful in a UDRP procedure, a complainant must evidence that:

- the domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- the respondent has no rights or legitimate interests in respect of the domain name; and
- the domain name has been registered and is being used in bad faith.

As for the first limb of the UDRP, the complainant evidenced that the domain names were identical or confusingly similar to its BWIN mark and stated that the domain names contained common misspellings of the mark.

The first respondent did not reply to any of the complainant's contentions. In response to the complainant's allegations, the second respondent stated that the domain names did not sound like the BWIN mark and were thus not identical, or confusingly similar, to the latter.

In both cases, the panels considered that the addition of a letter to the BWIN mark was not sufficient to change the overall impression created by the domain names and found that they were confusingly similar to the complainant's mark. The complainant had thus established the first element of the UDRP.

Despite the confusing similarity, the complainant still had to prove that the respondents had no rights or legitimate interests in the domain names under the second limb. In general, while the overall burden of proof rests with complainants, panels have recognised that this may result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore, complainants are simply required to make out a *prima facie* case that respondents lack rights or legitimate interests. Once such *prima facie* case is made, it is the respondent who carries the burden of demonstrating rights or legitimate interests in the domain name.

The complainant asserted that the respondents had never been commonly known by the terms 'bwion', 'bwlin' or 'bwsin'. The complainant further stated that 'bwlin.com' and 'bwsin.com' were pointing to web pages displaying sponsored links which allowed the second respondent to earn pay-per-click revenues.

The fact that the first respondent had never used the domain name 'bwion.com' and had not responded to the complaint was sufficient for the panel to find that the first respondent lacked rights and/or legitimate interests in the domain name.

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The second respondent decided to stretch its credibility to the limit by responding that it had bought 'bwlin.com' and 'bwsin.com' for different projects which were to be set up later that year and would have been used for information websites regarding, respectively, Linate Airport ('lin' being the official IATA Code for Milan Airport Linate) and Singapore Changi Airport ('sin' corresponding to the official IATA Code for Singapore). It submitted that this did not interfere with the complainant or its trademarks and that the letters 'bw' would be the abbreviation for 'best way (to)'. Therefore, 'bwsin' and 'bwlin' would be the abbreviations of 'best way to Linate' and 'best way to Singapore'.

According to the panel, the second respondent's bare assertion that it intended one day to use the websites at 'bwlin.com' and 'bwsin.com' for information websites about Linate Airport and Singapore Changi Airport did not establish a legitimate interest because:

- it had not provided evidence that could prove the seriousness of its intent; and
- it did not explain why it did not opt for the real acronym of the alleged intended meaning, namely 'bwt'.

Neither of the respondents was therefore found to have rights or legitimate interests in the domain names.

Thirdly, to establish bad faith on the respondents' part, the complainant referred to past facts: previous UDRP procedures involving the respondents and the previous use of the 'bwlin.com' and 'bwsin.com'. The first respondent had been involved in a previous UDRP procedure filed by bwin Interactive Entertainment AG, the complainant's predecessor. Thus, according to the complainant, the first respondent must have been aware of the complainant's trademark, particularly given that the term 'bwion' has no meaning in itself.

The panel assumed that the first respondent was, or should have been, aware of the complainant's well-known marks and thus had registered and used the 'bwion.com' in bad faith given:

- the prior proceeding involving the first respondent and the complainant's predecessor;
- the lack of use of 'bwion.com'; and
- the typosquatting of the complainant's mark,

Concerning 'bwlin.com' and 'bwsin.com', the complainant alleged that these had been transferred to the second respondent further to a cease and desist letter addressed by the complainant's representatives to their owner at that time, but that, before such transfer, the domain names had been used for phishing purposes. In addition, the second respondent had previously been involved in a UDRP procedure where it had reproduced a third party's trademark. Therefore, according to the complainant, the second respondent had shown a pattern of behaviour.

In addition, the complainant submitted that the unauthorised use of its trademark by the second respondent to generate pay-per-click revenues constituted bad faith, as it showed that the second respondent had acquired the 'bwlin.com' and 'bwsin.com' primarily for the purpose of intentionally attempting to attract, for commercial gain, users to its websites or other online locations, by creating a likelihood of confusion with the complainant's mark.

In its defence, the second respondent explained that, until *"the project will go live, [they] ha[d] the domains parked and [we]re not using them"* and that, on the websites at 'bwlin.com' and 'bwsin.com', there were no advertisements relating to the complainant's business. Indeed, it had been held in several decisions under the UDRP that operation of pay-per-click websites could amount to a good-faith offering of goods or services.

However, the panel decided that 'bwlin.com' and 'bwsin.com' had been registered and used in bad faith in light of the circumstances of this case, including:

- the complainant's extensive promotion and use of the trademark BWIN;
- the previous redirection of 'bwlin.com' and 'bwsin.com', which the second respondent was certainly aware of;
- the typosquatting of the complainant's mark; and
- the prior UDRP proceeding involving the second respondent.

In view of the above, the panels in both cases ordered the transfer of the domain names to the complainant.

These two cases are similar to the extent that they both involve typosquatting of a well-known trademark,

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but the circumstances of both cases are rather different: non-use of the domain name and failure to respond to the complaint in one case; use of the domain names to resolve to parking pages and an attempt to show a legitimate interest in the domain names in the second case. The respondents' intentions were, however, clear and these decisions show that the UDRP remains the most appropriate forum for deciding cases where respondents have tried to profit from the fame of a trademark to generate pay-per-click revenues or hope to resell their domain name at a high price because it relates to a well-known trademark.

David Taylor, Sarah Taieb and Jane Seager, Hogan Lovells LLP, Paris

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