



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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| Decision ID | DE-0200003 |
| Case ID | HK-0200003 |
| Disputed Domain Name | www.sportingbet.net |
| Case Administrator | natalielee |
| Submitted By | Hong Xue |
| Participated Panelist | Hong Xue |
| Date of Decision | 06-08-2002 |

The Parties Information

| | |
|-------------------|-----------------|
| Claimant | Sportingbet plc |
| Respondent | OEX Trader |

Procedural History

On 24 May 2002, the Complainant submitted its Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the "ADNDRC" or the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "Rules"), and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the "ADNDRC Supplemental Rules"). The Complainant sought a one-person Administrative Panel.

On 25 May 2002, the Centre received the required filing fee from the Complainant and confirmed the receipt of the Complainant and on the same day the Centre forwarded a copy of the Complaint to the Respondent by on-line system and email as well as a copy of the Complaint by on-line system and email to the Registrar of the domain name in dispute, Intercosmos Media Group, Inc., 650 Poydras Street, Suite 2311, New Orleans, Louisiana 70130, United States of America.

On 12 June 2002, the Respondent filed a Response with the Centre, and on 14 June 2002, the Centre confirmed to the Respondent the receipt of the Response. The Response did not contain a request for a three-person Administrative Panel.

Having received on 30 June 2002, a Declaration of Impartiality and Independence and a Statement of Acceptance from Dr. Hong Xue, on 6 July 2002, the Centre informed the Complainant and the Respondent that Dr. Hong Xue was appointed as the sole Panelist in this matter.

On 6 July 2002, the Centre transferred the case file to the Panelist by post, and on 17 July 2002, the Panelist confirmed the receipt of the file.

The Panelist finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the Supplemental Rules.

The Panelist has not received any further requests from the Complainant or the Respondent regarding other submissions, waivers or extensions of deadlines. There is no need, as an exceptional matter, to hold any in-person hearings as necessary for deciding the Complaint, as provided for in Paragraphs 12 and 13 of the Rules.

The language of the proceeding is English, it being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and there being no express agreement to the contrary by the parties.

Factual Background

For Claimant

The Complainant is a public company, incorporated and organized under the laws of England and Wales, listed on the Alternative Investment Market of the London Stock Exchange since 30 January 2001. Through its trading subsidiaries, it does business under the name of "sportingbet.com". The Complainant is the holder of the "sportingbet.com" domain name and it applies the mark "sportingbet.com" to its business which consists the transmission of information pertaining to sporting events, gaming and betting, and the provision of online casino and bookmaking services, all via the Internet. The mark "sportingbet.com" is included in the Complainant's logo which appears on its websites, publicity materials, institutional investor materials and brochures.

On 22 December 2000, the Complainant filed an application for a trademark "sportingbet.com GLOBAL SPORTSBOOK" in the Nice Classifications 9, 35, 38, 41 and 42 with the European Community Office for Harmonization in the Internal Market. On 13 May 2002, the trademark application was published with the Office for Harmonization in the Internal Market. Neither as of the date of the Complaint nor the date of this decision has the trademark applied for by the Complainant been accepted for registration as a Community trademark.

For Respondent

The Respondent is based in Vancouver, Canada, and owns several sportsbook and casino websites, such as www.go2gamble.com. On 5 February 2002, the Respondent registered the domain name "sportingbet.net" with Intercom Media Group, Inc. and uses www.sportingbet.net as a gateway page for www.go2gamble.com.

Parties' Contentions

Claimant

The Complainant in its Complaint argued that it was the initial publisher of the name "sportingbet" and the complaint views it as "has the protected right to the name and mark". Moreover, according to the Complainant, "significant commerce and goodwill have been developed in the marketplace by the Complainant with its use of the name and services it offers." The Complainant contends that it "has expended substantial time, effort and money to legitimately use the name in commercial activity."

The Complainant alleges that it has taken significant steps to implement and protect the mark "sportingbet", including filing an application for the trademark "sportingbet.com GLOBAL SPORTSBOOK" with the European Community Office for Harmonization in the Internal Market on 22 December 2000 claiming "first use of the mark" in November 1998, using "the mark 'sportingbet' in its website to advertise its goods and services" and pointing to "the considerable activity by the Complainant 'in its website 'sportingbet.com'."

The Complainant goes on to say that the Respondent's domain name "sportingbet.net" is identical and confusingly similar to the Complainant's "protected trademark of 'sportingbet.com'" and that the Respondent "it would appear...has no legitimate rights or interests in the domain name (which is the object of the dispute in this proceeding) ... and is not making legitimate non commercial or fair use of the domain name; and further for commercial gain, the Respondent is misleading customers to use (sic) the trade and service mark at issue." According to the Claimant "it clearly appears that the Respondent has not had any activity associated with the domain name and the name itself is issued as a potential sales object. Thus, there is no legitimate interest in the domain name and it is not being used in connection with a bona fide offering of goods or services."

The Complainant argues that the Respondent is using the "sportingbet.net" domain name for commercial gain through re-direction to its www.go2gamble.com website, and as presented to the Respondent, visitors to the "sportingbet.net" website are presented with advertisements and hyperlinks to other websites providing goods and services." "By way of illustration," the Complainant claims "if a website user enters "sportingbet.net" into the web browser, the web user is transported to the "sportingbet.net" website." The Complainant goes on to say that "if the web user then clicks onto one of the icons on the web page at the "sportingbet.net" website, e.g. "on-line sporting bet", the user is automatically re-routed to the Respondent's website www.go2gamble.com." "Essentially," the Complainant argues, "there is no back end to www.sportingbet.net. A web user to www.sportingbet.net cannot receive services directly without being redirected to www.go2gamble.com. " This act in the Complainant's view "demonstrates how the Respondent is using the Complainant's registered trade name for no legitimate reason and in effect is doing so with bad faith for a commercial gain and purpose."

In conclusion the Complainant puts forward the view that "the sportingbet.net" domain "creates significant

confusion in the marketplace to the detriment of the Complainant and potential customers” and that “the Respondent did register and use the domain name (sportingbet.net) in bad faith in accordance with the definition of such term outlined in the UDRP.”

The Complainant, therefore, requests the domain name "sportingbet.net" be transferred from the Respondent to the Complainant.

Respondent

The Respondent in its Response explains that it owns several online sportsbook and casino websites and purchased the domain name "sportingbet.net" with the intent of putting up a sports book-casino gateway page for www.go2gamble.com. The Respondent defends itself by saying that there was no intention of cyber-squatting as the Complainant alleges. According to the Respondent, gateway pages are a common practice on the Internet, pointing out that the Complainant also has one namely www.sporting-bet.co.uk, which according to the Respondent currently is nothing more than a page with key search words that automatically redirects a user to sportingbet.com. The Respondent goes on to say that it has slated "sportingbet.net" for future development.

It is the Respondent's contention that the term “sporting bet” is a common term and that it and the term "sporting bet" are generic and as such, according to the Respondent, it has “as much right to use the term” as the Complainant does. The Respondent states that it was of the belief that the Complainant “only” has “the Trademark ‘Sportingbet.com’ not ‘Sporting bet’ as it (i.e., the latter) is generic and that is in the UK only.”

The Respondent also puts forward the statement that the Complainant “had been squatting on the domain for years before we (i.e., the Respondent) purchased it, and had put the domain to no use, as they (i.e., the Complainant) have not, with the other sporting bet domains they own” .

We have also raised the search ranking of "sportingbet.net" by cross-linking it with some of our other high traffic sites.

In conclusion, the Respondent says that the site found at www.Sportingbet.net is being used as a "sporting bet site" and will be further developed in the future. In support of this the Respondent filed what purports to be an “old Business Proposal” which is undated but which the Respondent says “made up last year before dot com went bust” (sic). In addition, the Respondent argues that it has “in no way acted in bad faith as the Complainant has alleged.” The Complainant, according to the Respondent, “could have easily trademarked ‘sportingbet.net’ when they (i.e., the Respondent) had owned it, instead of waiting almost five months to file this complaint after we (i.e. the Respondent) had purchased "sportingbet.net", and put the domain to legitimate use.” Lastly, the Respondent contends the sportingbet.net website “in no way resembles "sportingbet.com", or could be confused with it” and in support of this contention filed with the Panelist a graphic of "sportingbet.net" web page. According to the Respondent the “sportingbet.net” website has "go2gamble.com" in very bold letters near the very top and has no logo as yet. The graphics of the site in question, according to the Respondent, utilises the same template the Respondent use on dozens of other gate-way pages it uses such as <http://virtualcasino.st/> and <http://freecasino.st/>

The Respondent contends that “ ‘bad faith’ has been defined as grabbing a domain with the intent to sell it to a trademark holder, or wielding the address in hopes of luring unsuspecting consumers for commercial gain.” In the Respondent's view the Complainant has failed to prove any of their allegations. Lastly, the Respondent asks the Panelist to bear in mind that “the Complainant owns the .com name so we (i.e., the Respondent) would not be stealing any customers but we would be could be (sic) competing with them.” “In fact,” the Respondent argues, that its “domain (i.e. sportingbet.net) provides free adverting (sic) for the ‘sportingbet.com’ (website) right now, as we (i.e., the Respondent) do get other key word searches to ‘sportingbet.net’ ” . “Most surfers” , according to the Respondent “look to see what is at the .com address as well” .

Finally, the Respondent refers to an online news article in connection with a WIPO UDRP proceeding regarding the www.Ralph-Lauren-Polo.com and www.Polo-Style.com domain names.

Findings

Identical / Confusingly Similar

It is both customary and useful in cases such as this to refer to the three (3) criteria set out Paragraph 4a of the Policy, which a Complainant must meet in order to be successful in a dispute under the Policy and the Rules. These criteria are: (i) the domain name which is the subject of the dispute is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the registered holder of the disputed domain name has no rights or legitimate interests in respect of the domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

I will now deal with the evidence presented in this proceeding in the context of each of these three (3) criteria.

Identical/Confusingly Similar to Trademark or Service Mark in which the Complainant has Rights

Paragraph 4(a)(i) of the Policy requires the Complainant to satisfy the Panel that the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. That is, the Complainant has the burden of proving two (2) things—firstly, the identical or confusingly similar nature of the disputed domain name to the mark in which the Complainant claims it has rights; and secondly, the Complainant must demonstrate that it does indeed have rights in the mark relied upon.

The first point may be established by comparison of the domain name and the claimed mark. In the present case, the Complainant lays claim to rights in the mark "sportingbet" and "sportingbet.com" and "sportingbet.com GLOBAL SPORTSBOOK". The Respondent's domain name is "sportingbet.net". The Panel finds that the Respondent's domain name is confusingly similar to the marks to which the Complainant lays claim.

Such finding, however, does not address the second point required by Paragraph 4(a)(i) of the Policy, namely:- what rights does the Complainant have in the marks upon which it relies in its Complaint? The Panel finds that no evidence has been presented by the Complainant that any of the trademarks claimed by the Complainant is a registered trademark or service mark. The Panel recognises that the Complainant did file an application for the trademark "sportingbet.com GLOBAL SPORTSBOOK" on 22 December 2000 with the Office for Harmonization in the Internal Market of the European Community. Particularly, but has not yet acquired the registration. Accordingly, the Complainant has not proven that it has the trademark registration for the marks "sportingbet" or "sportingbet.com" or even "sportingbet.com GLOBAL SPORTSBOOK".

Beside the trademark "sportingbet.com GLOBAL SPORTSBOOK" in respect of which, as stated above, the Complainant has applied for registration, the Complainant claims that it has the "protected rights" in the unregistered marks "sportingbet" and "sportingbet.com". It would have been very helpful to the Panel if the Complainant had presented precise evidence as to the basis of such claims, but unfortunately, the Complainant did not provide any such evidence. It did however refer to the English case of *British Telecommunications plc, Virgin Enterprises Ltd., J. Sainsbury plc, Marks & Spencer plc v One in a Million Ltd and Others*, Court of Appeal 1998. This having been said, it is apparent that such rights are claimed by the Complainant based on the common law, i.e. based on the uses of these trademarks in the marketplace: Since both the Complainant and the Respondent are established in common law jurisdictions, it is appropriate for the Panel to consider whether the Complainant enjoys the common law rights in the marks claimed. This issue has been previously addressed in relation to disputing parties based in the United Kingdom in the decision in the case of *Jeanette Winterson v. Mark Hogarth*, WIPO Case D2000-0235, which can be found at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0235.html>. In that case the Panel concluded that "where the Policy refers to trademark without requiring registration it clearly includes unregistered common law rights."

The question then becomes - does the Complainant have sufficient common law rights in the terms "sportingbet" and/or "sportingbet.com" so as to constitute either or both of them as trademarks or service marks for purposes of Paragraph 4a(i) of the Policy?

In English, "sporting bet" is a commonly used term meaning sports betting or wagering. The fact that "sportingbet", as used and claimed by the Complainant, is not one word does not make the term fanciful or distinctive. Rather, "sportingbet" can easily be regarded as the combination of the word "sporting" and the word "bet" without the space between them. Indeed, it is common practice to combine two words into one in the creation of second-level domain names. For example, the domain name "genexpert.com" was held to be either two words combined ("gene" and "expert") or the combination of the root of a word and another word ("gen-" and "expert") (see the decision in *Cepheid Corporation v. Healthexpert LLC and John Johnson*, WIPO case D2001-1272, found at <http://arbiter.wipo.int/domains/decisions/html/2001/d2001-1272.html>).

As for "sportingbet.com", the generic Top Level Domain suffix does not make it substantially different from the term "sportingbet".

It is true that a generic term may be successfully used as a trademark. For example, "CAT" has been used and registered in regard to machines. However, the terms claimed in this case are not only generic, but also directly descriptive of the services in respect of which the terms are used. As the Complainant itself asserts, the domain name of

"SPORTINGBET .COM" is the term the Complainant applies to its activities in the "transmission of information over a global computer network, namely the Internet; casino services and bookmaking services including messages, images and information pertaining to the sporting events such as gaming and betting".

This in itself, however, does not necessarily mean that the Complainant cannot have any rights in the terms so as to make them common law marks and therefore, proprietary. To do so the terms must be or become distinctive. Such terms can become distinctive on evidence that they have in fact acquired a distinctive character as a result of the use made of them. For a mark as inherently descriptive as "sporting bet", however, the evidence required to demonstrate that the term or mark has acquired sufficient distinctiveness should be substantial. Moreover, in order to prevail in the current case the Complainant has to prove the distinctiveness of the term or mark in plain text. Even if the Complainant's mark is distinctive in graphic form or in designated colours, it may still lack distinctiveness in plain text.

In light of the foregoing, the Panelist will now review the evidence provided by the Complainant, which may be summarised as follows:

- "Sportingbet plc" is the legal registered corporate name of the Complainant, and the Complainant has been listed on the Alternative Investment Market of the London Stock Exchange under such name since 30 January 2001;
- The Complainant is the registered holder of the "sportingbet.com" domain name and began using the mark "sportingbet.com" in November 1998;
- The mark "sportingbet" is used in the Complainant's website to advertise its goods and services and appears on the publicity materials and other business documents of the Complainant;
- The Complainant filed an application for registration of the trademark "sportingbet.com GLOBAL SPORTSBOOK" on 22 December 2000.

The Panel finds that such evidence is not sufficient to prove that the mark "sportingbet.com" in plain text as used by the Complainant has acquired distinctiveness so as to make them common law marks and therefore, proprietary to the Complainant.

The reason for this is, that although the Complainant claims that it has expended substantial time, effort and money to legitimately use the name in commercial activity, and that goodwill have been developed in the marketplace by the Complainant with its use of the name and services it offers, it actually provides no evidence to prove the extent of use of the mark, expenditures incurred in establishing the goodwill of the mark and the subsistence of the reputation of the mark in the relevant business. Mere assertions of these activities and alleged facts is not proof, and certainly not sufficient to meet the substantial burden required to prove distinctiveness. This is particularly true in the present case, where the Complainant and the Respondent are located in different jurisdictions and the Complainant clearly does not provide any evidence to show how the claimed mark is used in the Canadian market and whether it has become distinctive in the relevant business in that market.

The decision in the case of County Bookshops Limited v. Guy Loveday, WIPO Case D2000-0655 which can be found at <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0655.html>, supports the conclusion reached by this Panel. In County Bookshops Limited v Guy Loveday, the Panel found that the evidence presented by the Complainant fell well short of that which would be desirable to support the claims to proprietary rights in the descriptive mark "County Bookshops". in this case. Particular deficiencies that are apparent include:

- no evidence of the form in which the mark is actually used (e.g. whether in a stylised logo or in plain text) or to confirm whether or not the mark has been used in the same form throughout the twenty years' alleged use;
- no evidence to show how the Complainant acquired any purported rights or goodwill from the unidentified earlier "partnership";
- no evidence to confirm the extent of use or the actual expenditure incurred in establishing the claimed goodwill in the mark;
- no evidence to support the assertion that the mark is now synonymous with the goods and services of the Complainant.

The Panel has been cautious in reaching the conclusion that the Complainant has no right in the descriptive mark. The Panel has visited the Complainant's website and used the popular search engines such as "google.com" and "goto.com" to search the usage of the mark. The Panel genuinely notes the substantial existence of the Complainant's business in the on-line sports betting market, however, the Panel equally notes that "sportingbet" has not become a synonym for the Complainant's services.

In conclusion, the Panel therefore concludes that the Complainant does not meet the requirement of Paragraph 4(a)(i) of the Policy.

Having reached the foregoing conclusion, it is not necessary for the Panel to consider whether or not the Respondent has no rights or legitimate interests in respect of the domain name “sportingbet.net” (see Paragraphs 4(a)(ii) and 4(c) of the Policy) or whether the Respondent was or is acting in bad faith in regard to its use of the “sportingbet.net” domain name (see Paragraphs 4 (a)(iii) and 4(b) of the Policy).

Rights and Legitimate Interests

Not applicable

Bad Faith

Not applicable

Status

www.sportingbet.net Complaint Rejected

Decision

In conclusion, the Complainant fails to satisfy the requirements of Paragraph 4(a)(i) of the Policy and accordingly, pursuant to Paragraph 15 of the Rule, the Panel decides that the Complaint should be dismissed.

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