

eRESOLUTION

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**ADMINISTRATIVE PANEL DECISION**

Under the ICANN Uniform Domain Name Dispute Resolution

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Complainant: Safari Casino A.G .

Respondent: Global Interactive Ltd

Case Number: AF-0288

Contested Domain Name: *safaricasino.com*

Panel Members: Maurice Wolf, President,  
Peter Michaelson, Co-Panelist,  
Sarah Cole, Co-Panelist.

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1 Parties and Contested Domain Name

. A Complaint was filed by the Complainant, SAFARI CASINO A.G. of St. Johns, Antigua, with eResolution naming as the Respondent, GLOBAL INTERACTIVE, LTD of Basseterre, St Kitts, the registered owner of the disputed domain name - *safaricasino.com*.

2 Procedural History

. The procedural history of this case is set out in detail in the letter dated September 10, 2000, sent by the Clerk, eResolution, to the Panel appointed to hear this case. A copy of this letter is attached to this decision as Exhibit I.

3. Factual Background

A. The Complainant states that a United States Service Mark - *Safari Casino* - was issued by the U.S. Patent and Trademark Office on October 27, 1998, with the filing date shown as December 1, 1997. The registrant and owner of this trademark is shown on the Certificate to be Oyster Bay Holdings, Ltd.

It is noted by the Panel that neither the copy of the Certificate tendered by the Complainant in support of the Complaint nor a search of the Patent and Trademark Office on-line archives show any indication of an assignment of this Service Mark to Safari Casino A.G., the Complainant in this case.

The Complainant further states that it established a web site in May 1997 using the name Safari Casino which was intended to be used for on-line gaming or gambling. Shortly thereafter Safari Casino was incorporated as Safari Casino A.G. A gaming licence was issued on September 22, 1997 to Safari Casino

AG by the Government of Antigua and on December 1, 1997, an affiliated company by the name of Oyster Bay Holdings Ltd. applied for the service mark - *Safari Casino*. Complainant also states that it opened its on-line business on February 21, 1998 and registered the domain name *safari-casino.com* on May 28, 1997.

B. The Respondent states that it registered its domain name - *safaricasino.com*<sup>1</sup> - on April 25, 1998 and has a gaming sub-licence under that name for its web site issued by the Government of Antigua. It has used the words *Safari Casino* as its unregistered trademark continuously since July 1998. Respondent also claims that it had no knowledge of any company by the name of Safari Casino A.G. nor of the domain name - *Safari-Casino.com* - the Complainant's web site. Respondent further claims that it began preparation of its own web site under the domain name - *safaricasino.com* - immediately after registering that domain name on April 25, 1998, and that it was up and ready in July, 1998.

#### 4. Parties' Contentions

A. The Complainant claims that it uses the service mark - *Safari Casino* - both as its corporate name and to identify its services - on-line gaming or gambling. It further claims that it is the 'exclusive' licensee of the mark *Safari Casino* in the United States and that '*. . . the use of the domain name by others would mislead the US public as to the source of their online gaming experience.*'

The Complainant also alleges that the Respondent started its operations and obtained a licence to operate online gaming subsequent to the time when the Complainant was already in business and advertising its operations under the name of *safaricasino*.

The Complainant also alleges that the Respondent registered its similar mark - *safaricasino* - in bad faith and that it has no legitimate interest in the name. On the other hand, the Complainant claims that it waited to register its domain name until it had a legitimate interest in using the name.

The Complainant further contends that the Respondent registered its name before it could begin operations but at a time when it already knew that Safari Casino A.G. was instituting online operations and that it acquired the mark '*. . . to attract the initial interest of consumers looking for the Complainant's Safari-Casino site.*'

Complainant also contends that talks

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1. It is to be noted that the only difference between the two domain names is that the Complainant's domain name contains a hyphen between the words '*safari* and '*casino*' while the Respondent's does not.

*' . . . with Global or its licensee led to an offer to sell for a price far in excess of the registration and carrying costs, implying that the name was acquired with knowledge of its value to Safari Casino A.G.'*

The Complainant further alleges that the Respondent and its licensor have unsavory reputations. By using a similar domain name the public may be led to believe that the bad reputation referred to is that of Safari Casino A.G.

B. The Respondent denies all of the Complainant's allegations.

The Respondent contends that it has used its domain name and common law trademark continuously since July 1998 and thus has a legitimate interest in the continued use of the domain name *safaricasino.com*.

Respondent notes that it started to use its domain name several months before the Complainant's service mark was registered by the US Patent and Trademark Office and that it had no knowledge of the then pending application for such a service mark.

Furthermore, Respondent, when it registered its domain name - *safaricasino*- in April 1998, was unaware that the Complainant had previously registered a similar domain name and only learned of the Complainant's web site and trade mark when it received the Complaint in July 2000.

Respondent contends that there is no evidence in the record to substantiate the claim by the Complainant that the domain name *safaricasino.com* was registered in bad faith or that it is being used in bad faith.

Respondent raises the issue of whether the Complainant is entitled to file this action as there is no evidence in the record that the Complainant - Safari Casino A.G. has any interest in the domain name *safaricasino.com* which is registered to an organization called Oyster Bay Holdings Ltd.

Furthermore, there is no evidence in the record that links Oyster Bay Holdings, Ltd to the Complainant or that shows that the Complainant is a licensee or assignee of the registered owner of the domain name. The Respondent states that:

*' . . . Nothing in the record substantiates complainant's allegations that Oyster Bay Holdings is an affiliated holding company of Safari Casino A.G. . . . '*

Furthermore, the trademark is also registered in the name of Oyster Bay Holdings and does not show that it has been licensed or assigned to Safari Casino A.G. *Therefore, the Complainant has no standing to assert rights in a mark that it does not own.'*

The Respondent further contends that:

the Complainant's contention that its domain name would be misleading to the U.S. public is unsubstantiated and irrelevant;

Respondent has no physical presence in the US and conducts no business or advertising in the US;

the Complainant is aware that gambling by US residents on the Internet is prohibited by US law, thus, there could not possibly be any confusion.

Respondent also claims that the Complainant's allegation that it attempted to sell its domain name to the Complainant is untrue and is unsubstantiated by any of the evidence presented by the Complainant. There were no talks on this matter between the parties and such a claim

*' . . . Indicates bad faith intent on the part of Complainant in order to use this procedure to orchestrate a reverse domain name hijacking.'*

The Respondent responds to the claims by the Complainant that the Respondent has an unsavory reputation by stating that this has no bearing on whether the Respondent registered or used the domain name in bad faith

## 5. Discussion and Findings

*The Uniform Domain Name Dispute Resolution Policy* [hereafter the ICANN Policy], Paragraph 1, makes it clear that the ICANN Policy is incorporated in each Registration Statement by reference and that the Registrant is considered to know its contents. The ICANN Policy further states that a Registrant is bound by this Policy and that disputes between the Registrant and a third party over a domain name must be resolved by the system of arbitration conducted under the ICANN Rules called a 'mandatory administrative proceeding'. [See Paragraph 4 of the ICANN Policy]. [All references to Paragraph numbers are to the respective paragraphs in the ICANN Policy, unless otherwise noted.]

The ICANN Policy was adopted in order to ensure that disputes arising from domain names could be resolved in an efficient manner that is fair to the parties to the dispute. Such parties are given the opportunity to present evidence to an independent and impartial panel to support the claims made by the Complainant on the one hand, and for the Respondent, on the other, to demonstrate that the use of the disputed domain name is proper and in accordance with the ICANN Policy. [See Paragraph 4].

In the instant case, as noted above, the Complainant alleges that the Respondent registered and uses the disputed domain name in a manner prohibited by the ICANN Policy. Paragraph 4a requires the Complainant to demonstrate that three elements of a case are present for either cancellation or transfer of the disputed domain name. These are:

- a. That the domain name in question is identical or confusingly similar to a trademark or service mark in which the complainant has rights.
- b. That the Respondent has no rights or legitimate interests in respect of the domain name, and
- c. The domain name was registered and is being used in bad faith.

The question before this Panel, therefore, is whether the Complainant has satisfied the requirements of Paragraph 4a with respect to these three elements..

- (i). Is the disputed domain name identical or confusingly similar to the Complainant's trademark?

Before proceeding to determine this issue, it is important to note that in this particular case, this issue is complicated by several factors, discussed below, that are not usually present in these domain name dispute proceedings. .

The panel is of the view that the domain name registered by the Respondent -*safaricasino-com*, is, on its face, substantially identical to and thus and potentially confusingly similar to the service mark claimed by the Complainant - *Safari Casino*. [Paragraph 4a(i).]

The only difference between the service mark and the disputed domain name is the use of two words by the service mark and the single joined word by the domain name. The addition in the domain name of '.com' does not alter its potentially confusing similarity to the service mark. In this context, the fact that in Complainant's domain name the two words identical to those in the Respondent's domain name are linked by a hyphen [*safari-casino.com*] rather than joined [*safaricasino.com*] is a *de minimus* difference.

Thus, we find that, on its face, the disputed domain name - *safaricasino.com* is substantially identical to that of the service mark - *Safari Casino*.

This finding leads us to question whether it is possible for a domain name for a web site which is employed to service an activity that is prohibited by law in the United States, even if substantially identical, could be confused with a service mark registered at the United States Patent and Trademark Office when US residents may not legally use the facilities offered by the web site bearing the disputed domain name.

There is no doubt that the reason why a disputed domain name should be canceled or transferred to the Complainant when it is identical to a registered service mark is avoid the risk that consumers would confuse the disputed domain name with that of the registered service mark and thus dilute the service mark, taking away the exclusivity in the name to which the owner of the registered service mark is entitled.

There is no indication in the record that the disputed domain name is also identical to registered service marks in other countries. Thus, it would seem that the only possible confusing element would be its similarity to the US registered service mark.

It is difficult to see how the disputed domain name could be confused with the US registered service mark when the services offered by the web site bearing the disputed name are legally out of bounds to US clients. The Panel is of the opinion that confusion can only exist between customers who may reasonably be expected to use the facilities offered. If US customers are banned from using these facilities than we have no reason to believe that confusion could exist. We are not raising any issue as to the applicability of US law to the operation of web sites on the Internet but questioning whether there is any issue of confusion when national laws impact on the ability of customers to use the offered Internet facilities.

Accordingly, we are of the view that although the disputed domain name is substantially identical to the registered service mark, no confusion can be inferred.

The Respondent also raises an issue of whether, as required by the ICANN Policy [Paragraph 4a(i).], the Complainant has any rights to the service mark which it claims is affected by the disputed domain name.

While we have found that the disputed domain name is substantially identical to the service mark, it is not so clear that the Complainant has any rights which it may assert to this service mark.

The service mark is registered to a company by the name of Oyster Bay Holdings Ltd., not to the Complainant.

The Respondent correctly points out that there is nothing in the record, except for the unsubstantiated statement of the Complainant, showing any linkage between Oyster Bay Holdings and the Complainant.

A search of the US Patent and Trademark Office online archives on September 27, 2000 does not show that the ownership of the service mark was transferred or that it has been assigned or licensed to Safari Casino A.G. or any other entity. On the contrary, it shows that the owner of record was and remains Oyster Bay Holdings.

This Panel is entitled to assume that if the Complainant could have shown that there was linkage between Oyster Bay Holdings and Safari Casino A.G, for example by the introduction in the record of a properly documented license agreement, it would have done so. Absent such evidence in the record, we may properly conclude that there is no such linkage and that the actual owner of the service mark is Oyster Bay Holdings and not the Complainant.

The Panel is of the view that a complainant may only assert rights in a registered service mark for the purposes of disputing the legitimacy of a domain name held by another party when that complainant

demonstrates that it has rights in such service mark. We further opine that the record in this case does not even show that the domain name - *safari-casino.com* - is owned by the Complainant as that domain name is also registered by Oyster Bay Holdings Ltd.

It is, therefore, adjudged that the Complainant has no standing in this case and is not entitled to bring this action against the disputed domain name.

Whether Oyster Bay Holdings Ltd. would be entitled to bring an action against the disputed domain name is not before us and we do not render any opinion on that issue.

Normally, if an arbitral panel finds that the Complainant has no standing to bring the action, that is the end of the case. However, this is a procedural issue and has no direct bearing on whether the disputed domain name is or is not in violation of ICANN policy. In our view the Parties are entitled to a full determination as to the merits of the Complainant's case which requires the Panel to go beyond this procedural issue and to reach a decision on whether the Complainant's charges may be sustained. Accordingly, we have continued our analysis of the contentions and facts presented in this case and have arrived at a decision based on the merits.

(ii). Does the Respondent have any rights or legitimate interests in the domain name?

Undoubtedly, the registrant of a domain name acquires certain rights and interests in such a domain name by virtue of its registration. The ICANN Policy requires the Complainant to be able to demonstrate that the Respondent has not acquired any other interest or right in the domain name [Paragraph 4c] if the Panel is to order its transfer or cancellation. Thus, the Registrant may show in its defense that the domain name is properly being used in the course of a business or other endeavor which is furthered by the use of the domain name. [Paragraph 4c(i)]

For example, a plumber, having registered the domain name, *pipesfixed.com*, may be said to have acquired rights or legitimate interests in the domain name if the name is being used in furtherance of his plumbing business, even if another party claims that this domain name is identical or confusingly similar to that of a previously registered trademark. See e.g. *Infospace.com Inc. v. Infospace Technology Co. Ltd.*, [Case No. D2000-0074, March 28, 2000].

In this particular case we find that the Respondent has demonstrated that the domain name was used in furtherance of its business activities. The Respondent is in the gambling business and offers an online casino under the disputed domain name. It has used this name in its business operation since July 1998 well before October 28, 1998 when the Complainant obtained registration of the service mark it claims as its own.

Accordingly, the Panel finds that the Respondent has met the requirement that it show that it has legitimate interests in the disputed domain and is using this name in the furtherance of its business activities.

(iii). Was the domain name registered and is it being operated in bad faith?

The Complainant is required to demonstrate that at least one of the four situations detailed in Paragraph 4 b is applicable to *both* the registration and use of the disputed domain name. Proving bad faith in just one of these two situations is not sufficient.

In the instant case the record upholds the Respondent's claim that he had no knowledge of the existence of the Complainant's service mark at the time the disputed domain name was registered. There is no evidence to the contrary.

The service mark was registered on October 27, 1998, while the disputed domain name was registered on April 25, 1998, eight months before.

While the application for the service mark was filed on December 1, 1997, we find that there is nothing in the ICANN Policy that requires this Panel to determine that the Respondent had a duty to investigate whether an application was pending for an identical or similar domain name.

Unlike actual or presumptive knowledge of an existing service or trademark, especially one that is well known or notorious, from which registration of an identical or confusingly similar domain name may be inferred to be in bad faith, no such similar inference may be drawn from registering a domain name that is identical to a service mark whose application is pending.

Thus, the Complainant has failed to show bad faith in the acquisition of the disputed domain name by the Respondent

The Complainant alleges that the Respondent offered to sell its name to the Complainant and that this constitutes use of the domain name in bad faith. While cyber squatting, that is the acquisition of one or more domain names with the intention of reselling them at a profit, may constitute bad faith and a violation of the ICANN Policy, bad faith in the use of the domain name may not be inferred merely from the domain name holder offering to sell its name as part of an offer to sell its entire business.

However, in this case, the Respondent refutes the charge that it offered to sell the Complainant the disputed domain name, pointing out that there is no evidence to that effect, except for the Complainant's unsubstantiated declaration, that the Respondent ever offered to sell its domain name

We are also struck by the odd syntax and content of the statement set out by the Complainant in support of this allegation.

This statement declares that:

*'Talks with Global [the Respondent] or its licensee led to an offer to sell for a price far in excess of its registration and carrying costs. . . '*

We are supposed to infer from this statement that the talks were initiated by the Respondent. If this is the case, the statement should have so stated. Furthermore, are we supposed to infer that actions of the licensee, who is not otherwise identified, could or should be attributed to the Respondent? This is not a permissible inference from the scant information given us. We also cannot determine by this statement which of the two parties made the offer.

6. Conclusions

The Panel unanimously finds that the registration and the utilization of the disputed domain name - *safaricasino* - were not in bad faith and thus not in violation of ICANN Policy. Accordingly, the Complainant's request for transfer to it of the disputed domain name is denied.

7. Other

There remains an issue which the Panel believes should be resolved if the ICANN Policy is to be properly implemented.

In this case, we have found that the two domain names are substantially identical. Thus our decision leaves these two domain names in operation. If there is confusion in fact between the two names, our decision does nothing to ameliorate that confusion. We concur that, as the Respondent alleges, the intent of the Complainant in bringing this action appears to indicate

*. . . bad faith intent on the part of Complainant in order to use this procedure to orchestrate a reverse domain name hijacking.'*

To avoid such a situation pertaining, in cases such as this where the Complainant has brought a domain name into question as violative of ICANN policy, the panel should either be authorized to determine whether the Complainant's registration or use of the domain name is itself violative of that policy and/or to allow the Respondent to file a counterclaim against the domain used by the Complainant.

This decision of the Administrative Panel in Case No. AF-0288 was rendered on the 4<sup>th</sup> of October, 2000.

Signed:-

ss/ Sarah Cole..... . . .ss /Maurice Wolf.....ss/.Peter L. Michaelson

Professor Sarah Cole  
Co-Panelist

Maurice Wolf  
President of the Panel

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