

ADMINISTRATIVE PANEL DECISION

Circus Belgium v. Domain Administrator, Online Guru Inc.

Case No. D2016-1208

1. The Parties

The Complainant is Circus Belgium of Seraing, Belgium, represented by De Gaulle Fleurance & Associés, Belgium.

The Respondent is Domain Administrator, Online Guru Inc. of Encinitas, California, United States of America ("United States"), represented by John Berryhill, Ph.d. Esq, United States.

2. The Domain Name and Registrar

The disputed domain name <circus.com> is registered with CSC Corporate Domains, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 14, 2016. On June 15, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 28, 2016, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform 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 June 29, 2016. In accordance with the Rules, paragraph 5, the due date for Response was July 19, 2016. The due date for Response was extended to July 23, 2016, in accordance with the Rules, paragraph 5(b). The Response was filed with the Center July 23, 2016.

The Center appointed James A. Barker, Geert Glas and Richard G. Lyon as panelists in this matter on August 22, 2016. The Panel finds that it was properly constituted. Each member of 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 was founded in 1993 and has its registered office in Belgium. The Complainant employs 205 people. The Complainant operates several "circus-branded" gambling halls across Belgium. It operates 20 gambling halls under the CIRCUS trademark and six online gambling platforms.

The Complainant operates websites via the online platforms "Circus.be" and "Casino777.be", and has a partnership with "Pokerstars.be". The Complainant is active in the European market through its branded platforms in Spain, Portugal, Romania and the Czech Republic.

The Complainant is the owner of the mark CIRCUS registered in the Benelux in 1997. The Complainant also has a trade name registered with the Belgian Crossroads Bank for Enterprises. The Complainant also owns a portfolio of domain names that includes its CIRCUS mark.

5. Parties' Contentions

A. Complainant

The Complaint is brief, and makes the following allegations under paragraph 4(a) of the Policy.

The Complainant says that the disputed domain name is identical to its registered mark. While the Complainant's mark is stylized, such elements in a trademark are typically disregarded for the purpose of assessing identity or confusing similarity.

The Complainant says that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has no trademark or other right in the term "circus", and cannot have rights or legitimate interests as it acquired and used the disputed domain name in bad faith.

The Complainant, lastly, says that the disputed domain name was registered and has been used in bad faith. The Complainant says that the original registrant of the disputed domain, "The Marshmallow Peanut Circus", had a legitimate interest in it, and this is why the Complainant did not challenge that registration. The same does not apply to the Respondent which registered the disputed domain name in early 2010. At that time, the Complainant had been using its tradename for about seven years and its mark for about three years and had built up a strong reputation under its trademark. The Respondent's adoption of the disputed domain name creates a strong likelihood of confusion and is a clear example of bad faith. The Respondent is a domain name broker and, as such, could reasonably have been expected to perform sufficient due diligence to assure itself that its registration would not be subject to ready challenge.

The website at the disputed domain name is used as a blog containing only 28 posts since July 2012. One of those posts redirects Internet users to "online gaming platforms." Therefore the Respondent is using the disputed domain name for commercial gain in the field of gaming, exactly like the Complainant.

According to the Complainant's information, the Respondent has offered to sell the disputed domain name for not less than EUR 3 million. This amount obviously exceeds the Respondent's out-of-pocket expenses.

B. Respondent

The Respondent says that the Complainant has no exclusive or unique rights in the term "circus". This is a common dictionary word generic to one of the oldest and most popular forms of live entertainment, and which the Respondent has used for many years in direct connection with its dictionary meaning.

The Complainant neglects to mention that there are some 139 marks registered in Benelux (or designating Benelux) which include or consist of the word "CIRCUS". Hence, it cannot be said that, even in its home jurisdiction, the Complainant possesses unique rights in the word "circus".

The Respondent says that the Complainant has deliberately withheld from the Panel the status of the Complainant's attempt to claim rights in the word "circus" apart from its stylization. The Respondent provides evidence of the Complainant's attempt to register "CIRCUS" as a word mark in the European Union Intellectual Property Office, which has been opposed by a third party in opposition proceedings. The Respondent says that it is an objective of the Complainant to use this proceeding as a broadening of its limited rights, for use in the pending opposition proceeding.

The Respondent points to past cases under the Policy which found that there was an absence of confusing similarity, even where the letters of a domain name are identical, in the case of a highly stylized mark.

In relation to the second element of the Policy, the Respondent says that it has never used the domain name in association with the operation of gambling casinos, whether offline or online. The Respondent acquired the disputed domain name in 2010 from an affiliated corporate entity.¹ The Respondent provides evidence of various uses of the disputed domain name between 2010 and 2015, indicating that it has used the disputed domain name for the purpose of generating advertising revenue based on the generic word "circus". The Respondent refers to a number of past cases under the Policy which found in favor of respondents who were using terms in connection with their generic meaning.

In relation to the third element of the Policy, the Respondent notes that paragraph 4(a)(i) of the Policy requires specific intent directed toward the Complainant at the time the disputed domain name was registered. However, as noted by the Complainant, the Respondent registered the disputed domain name to extract value due to its attractiveness as a dictionary word.

In relation to the Complainant's allegation that the Respondent has attempted to sell the disputed domain name, the Complainant admits that it hired a broker to attempt to buy the disputed domain name, so that the Respondent would not know who was attempting to buy it. Recent discussions in 2016 are not probative of the Respondent's intent in registering the disputed domain name in 2010. The Respondent provides evidence of earlier approaches to it to purchase the disputed domain name, despite the Respondent's repeated statements that it was not interested in selling it and its repeated "go away" pricing. The Complainant has attempted to anonymously purchase the disputed domain name for USD 650,000 and did not like the broker's misleading reply that the Respondent had "demanded" USD 3 million instead of expressing disinterest in selling it.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

These issues are discussed in turn as follows.

A. Identical or Confusingly Similar

¹ The Respondent asserts that it in fact acquired the disputed domain name "several years prior to 2010," but accepts that latter date for purposes of this proceeding.

The Complainant provides evidence of having a registered trademark for CIRCUS in the Benelux. It is not for the Panel to question the validity of a properly obtained national or regional registration. As such, the Complainant has a registered trademark and is entitled to the rights that are contained in that registration.

The disputed domain name comprises the Complainant's Benelux trade mark and the generic domain suffix. It is now well established under the Policy that, for the purpose of assessing identity (or confusing similarity), the domain suffix may be ignored. Ignoring that suffix, it is plain that the disputed domain name is relevantly identical to the Complainant's mark.

The Respondent argues against such a finding essentially for two reasons.

One is the Respondent's claim that the Complainant's mark is "highly stylized" and so should not be found confusingly similar to the term CIRCUS incorporated in the disputed domain name.

The Respondent cited a number of cases under the Policy to support its argument in this respect. In particular, the Respondent refers to *Tesla Industries, Inc. v. Stu Grossman d/b/a SG Consulting*, NAF Claim No. FA0508000547889. This decision (including the preponderance of the decisions relevantly cited in that one) concerned a comparison between "highly stylized marks" and a domain name.

The position in the *Tesla* case is an exception to the accepted consensus view of UDRP panels. The consensus view as to whether a domain name is identical (or confusingly similar) to a mark is to be judged objectively, against the dominant textual elements of a complainant's mark, rather than graphic or stylized elements. This approach is supported by a voluminous series of prior panel decisions. See *e.g.*, *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*, WIPO Case No. D2001-0031, and the cases cited in that one. In that case, the UDRP panel noted that: "...graphic elements, such as the Sweeps design, not being reproducible in a domain name, need not be considered when assessing identity or confusing similarity."

The Panel considers it appropriate to apply the consensus approach in this case. The Complainant's trademark for CIRCUS is stylized to some extent, but is not in the Panel's opinion, "highly stylized". This is because the term "circus" is easily recognizable in the Complainant's mark. The elements of stylization, such as they are, do not cloud the essential character of the mark as relating to the term "circus".

Secondly, the Respondent argues that the Complainant has no unique or exclusive rights in the term CIRCUS. Whether or not that is the case (the Panel addresses this issue further below), based on the approach set out above, the exclusivity of a complainant's mark is not a factor under the first element.

For these reasons, the Panel finds that the Complainant has established its case under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In light of the Panel's decision under the next heading it is unnecessary for the Panel to consider what the Respondent's current rights and legitimate interests might be in respect of the disputed domain name.

However, because it is relevant to the majority Panel's finding in relation to reverse domain name hijacking, the Panel notes that there is nothing in the evidence to show that the Respondent's motives have at any time been dishonest.

C. Registered and Used in Bad Faith

The Panel finds that the Complainant has failed to establish its case under this element of the Policy. This is for the following reasons.

Bad faith may be found if the Respondent knew or, in appropriate cases, ought to have known of the

Complainant. See, for example, *Moari Television Service v. Damien Sampat*, WIPO Case No. D2005-0524 in which the then panel stated that a finding of bad faith can be made when the respondent “knew or should have known of the registration and use of the trademark prior to registering the domain”, and cited other panel decisions to similar effect.

The Complainant argues that, at the time the disputed domain name was registered, the Complainant had been using its tradename for about seven years and its mark for about three years and had built up a strong reputation under its trademark. The Complainant also says that, as a domain name broker, the Respondent should be expected to have undertaken “due diligence” as to the Complainant’s trademark registration. The Complainant’s inference is that the Respondent knew, or should have known, about its trademark, when it registered the disputed domain name in 2010.

The Panel disagrees that such an inference can reasonably be drawn in this case, for the following reasons.

Firstly, while the Complainant states that it had a “strong reputation” in 2010, it provides no evidence to support this claim, other than pointing to the fact of its trademark registration. Beyond this, the Complainant points for example to the results of a Google search for “circus” that it undertook in May 2016. That search resulted in links to the Complainant among its top results. However, the Panel assumes that the Complainant undertook that search from a location in Belgium, where the Google search engine would have provided links more relevant to servers from that location. By comparison, when the Presiding Panelist undertook the same search using Google from his own jurisdiction, Australia, none of the results related to the Complainant.

As well, the Complainant points to a number of its other domain name registrations – none of which appear to have been created before 2010 (indeed, the majority appear to have been registered in 2015).

And even if the Complainant had given some evidence of its claimed reputation in 2010, what would that show? The Complainant is based in Belgium. The Respondent is based in the United States. There is no evidence of the Complainant’s reputation in the United States or elsewhere in 2010, let alone evidence of the Complainant having a “strong reputation” at that time associated uniquely or even specially with the term “circus”. The Respondent has also used the disputed domain name for a variety of purposes over the years, none of which appears to have any direct reference to the Complainant, any competitor of the Complainant, or gambling.

Secondly, the disputed domain name has an obvious dictionary meaning in English and the Respondent is based in an English-speaking jurisdiction. This fact alone means that it is easily conceivable that the Respondent was not aware of its alternative association with the Complainant’s mark. The term “circus” is not distinctively associated with the Complainant. Apart from its dictionary meaning, the Respondent provides evidence of substantial third party use of that term, in particular that the term is subject to some 139 marks registered in Benelux (or designating Benelux) alone. No doubt there is a larger number of registrations in other jurisdictions that may also contain that term.

Thirdly, the Complainant claims that the Respondent was under an obligation to undertake some “due diligence” on the Complainant’s trademark registration. Although some cases have discussed this obligation for professional registrants, the Policy contains no such express requirement. Even if the Respondent had taken some active steps to conduct a trademark or other search, it is not clear that this would have discovered the Complainant’s trademark rights. The Panel doubts that the Respondent would have had any good reason to undertake such a search given the descriptive character of the term “circus”.

Fourthly, the Complainant claims that the Respondent was “willing to sell” the disputed domain name to the Complainant. The Complainant’s evidence for this is an (untranslated) email apparently from a Sedo domain broker, suggesting that the Respondent would be willing to sell the disputed domain name for USD 3 million. The Respondent itself refers to a series of prior correspondence from others regarding the potential sale of the disputed domain name for a lower value.

Relevantly, paragraph 4(b)(i) provides that there is evidence of bad faith where there are circumstances

indicating that a respondent *registered* a domain name *primarily* for the purpose of selling it to the complainant who is the owner of a trademark, for valuable consideration in excess of the respondent's out-of-pocket costs directly related to the domain name. A mere *willingness* to sell a domain name, as alleged by the Complainant, does not necessarily satisfy this test.

In the circumstances of this case, there is no evidence that the Respondent had the Complainant in mind when it registered the disputed domain name – let alone that the Complainant was the “primary” focus of the registration. The cumulative evidence from the Complainant and the Respondent does not clearly show that the sale of the disputed domain name to the Complainant was a primary motive of the Respondent when it registered the disputed domain name in 2010.

Even if the Complainant had shown some willingness to sell the disputed domain name to the Complainant, this by itself would not be evidence of bad faith. As relevantly noted by the Panel in *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. D2005-1304, “where a respondent has registered a domain name consisting of a dictionary term because the respondent has a good faith belief that the domain name's value derives from its generic qualities, that may constitute a legitimate interest and the offer to sell such a domain name is not necessarily a sign of bad faith.”

For completeness, the Panel notes that there is some dispute between the Parties about the content of the Respondent's website, and whether that website contained references to gambling, which is the focus of the Complainant's business. For some period, the Respondent's website has been used for blog posts. The Complainant states that “one of the posts is directly redirecting Internet users to online gaming platforms. Therefore, the Respondent is using the disputed domain name for a commercial gain in the field of gaming, exactly like the Complainant.”

On the contrary, the Respondent states “The Complainant's contention that the Respondent's blog directs to a ‘gaming website’ in competition with the Complainant's gambling enterprise is flatly false, as shown in the Complainant's evidence itself... According to Complainant's Annex L, one of the links on Respondent's blog goes to a ‘Circus Game’. As described by the Complainant, that link does in fact proceed directly to a children's circus-themed Flash game (named after the Adobe Flash content format) named ‘Circus Ride’ shown on page 16 of Annex L. Then, the Complainant apparently clicked a link provided in the game by the publisher, which then took the Complainant to a site named ‘UBBX Games’ which is (a) not operated by the Respondent, and (b) a collection of other children's Flash games. Not only is the Complainant two clicks away from the Respondent's content at this point, but the content in question has nothing to do with online casino gambling. A link from one advertisement on the Respondent's blog, which goes to a circus themed children's game cannot be considered in competition with the Complainant's online gambling services, in any sane interpretation of the word ‘compete’.”

The Panel does not consider that the content of the Respondent's website substantially relates to the nature of the Complainant's business. The reference in one such post to “gaming” does not strongly indicate a connection with gambling *per se*. On balance, the Panel also agrees with the Respondent that such links in a blog post are, in the circumstances of this case, indirect. As the post was also apparently put up by third parties, it would be drawing a long bow to suggest that it implies some bad faith intention by the Respondent.

For all these reasons, the Panel finds that the Complainant has failed to establish its case under paragraph 4(a)(iii) of the Policy.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that: “If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.”

Under the Rules reverse domain name hijacking is defined as “using the Policy in bad faith to attempt to

deprive a registered domain-name holder of a domain name”.

“Allegations of reverse domain name hijacking have been upheld in circumstances where a respondent’s use of a domain name could not, under any fair interpretation of the facts, have constituted bad faith, and where a reasonable investigation would have revealed the weaknesses in any potential complaint under the Policy.” *Rohl, LLC v. ROHL SA*, WIPO Case No. D2006-0645.

Majority view

The majority of the Panel would make such a finding in this case. The facts of this case suggest that it should have been clearly apparent to the Complainant, on the basis of its own investigations, that it could not reasonably succeed in this proceeding.

The disputed domain name is a single and common generic English term. As such, it is subject to an obviously large range of third party interests. The Respondent has held the disputed domain name for more than 6 years and used it for a variety of purposes, none of which related to the Complainant’s business. The Complaint does not show any “reasonable investigation” on these points. Rather, the Complainant made no effort to address these obvious points of substantial weakness in its case.

The Complainant is represented by counsel. The majority cannot see how any responsible practitioner could see how to prove bad faith in registration and use when there is no evidence of targeting or otherwise taking advantage of any value attached to the Complainant’s mark. As the panel noted in *Urban Logic, Inc. v. Urban Logic, Peter Holland*, WIPO Case No. D2009-0862: “The fact remains, however, that Respondent has been put to considerable expense, of his own time and paying outside counsel, to defend this proceeding – a proceeding that the Panel has found to be groundless on the face of the Complaint.” In this case the Respondent’s expense included paying the additional fee required for a three-member panel.

For these reasons, the Panel majority makes a finding of reverse domain name hijacking against the Complainant.

Minority view (Panelist Geert Glas)

One member of the Panel would however stop short of such a finding. Having a weak and poorly motivated Complaint, does not in itself constitute evidence the Complainant having acted in bad faith. In the present case, there is no indication that the Complainant knew or should have known it would not succeed. Indeed, there is no basis to find that the Complainant did not genuinely believe that a domain name entirely incorporating the Complainant’s trademark CIRCUS would not result in some degree of confusion, having regard to the existence of the Complainant’s circus-branded gaming halls. This case appears to be a *bona fide* dispute between a trademark owner and a domain name broker. See WIPO case *Mondial Assistance SAS v. Compana LLC*, Case No. D2007-0965; *Gorstew Limited v. Worldwidewebsales.com*, Case No. D2002-0744

In this case Respondent is a domain name broker who offered to sell the domain name to Complainant for USD 3 million. While it is true and relevant that it is the Complainant who solicited that offer, the amount asked is one that would in other circumstances hint to a registration in bad faith. The Panel is in agreement that this is not the case here but the minority thinks that it should take this element into account when assessing whether this is a case of reverse domain name hijacking: See *The Medicis Pharmaceutical Corporation v. MRX Technologies, Inc and Neil Gerardo*, WIPO Case No. D2002-0462.

The Complainant first registered the trademark CIRCUS in the Benelux in 1997. Given that the Respondent acquired the domain name in early 2010, 13 years after the Complainant’s trademark was registered, this may have contributed to a belief by the Complainant that it was in a strong position and had legitimate grounds to start these proceedings. See *Nathalie and Jacques Ariggo, Couteiierie du petit-Chêne et Heidi-shop v. Gerard Praplan*, WIPO Case No. D20003-0672.

7.Decision

For the foregoing reasons, the Complaint is denied.

James A. Barker
Presiding Panelist

Geert Glas
Panelist

Richard G. Lyon
Panelist
Date: September 5, 2016