



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE
DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL
DECISION

CIIDRC case number:	17468-CDRP	Decision date: July 22, 2022
Domain Name:	jackpotcitygaming.ca	
Panel:	Chair - R. John Rogers Panel Member – Claude Freeman, LL.M., C. Med., C. Arb. Panel Member – Richard Levin	
Complainant:	Stanworth Development Limited	
Complainant's representative:	Antonio Turco	
Registrant:	Net Shift Media Inc.	
Registrar:	Go Daddy Domains Canada, Inc.	

1. PROCEDURAL HISTORY

The Canadian International Dispute Resolution Centre (“CIIDRC”) is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (the “Policy”) and Rules (the “Rules”) of the Canadian Internet Registration Authority (“CIRA”).

On June 6, 2022, the Complainant filed a complaint (the “Complaint”) with CIIDRC. In the Complaint, the Complainant sought an order in accordance with the Policy and the Rules directing that the registration of the domain name <jackpotcitygaming.ca> (the “Domain Name”) be transferred to the Complainant.

CIIDRC determined the Complaint to be in administrative compliance with the requirements of Paragraph 3.2 of the Rules and by way of an emailed letter dated June 10, 2022 (the “Transmittal Letter”) forwarded a copy of the Complaint to the Registrant at the email address for the Registrant as set out in the WHOIS database to serve as notice of the Complaint to the Registrant in accordance

with Paragraphs 2.1 and 4.3 of the Rules. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Paragraph 4.4 of the Rules to be June 10, 2022. The Transmittal Letter advised the Registrant that in accordance with the provisions of Paragraph 5 of the Rules, a response (the “Response”) to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or June 30, 2022.

The Registrant failed to file the Response by June 30, 2022, and the undersigned by letter from CIIDRC dated July 11, 2022 were selected as the Three Member Panel (the “Panel”) to determine this matter. The undersigned have confirmed to CIIDRC that they can act impartially and independently as the Panel in this matter.

The undersigned determine that they have been properly appointed and constituted as the Panel to determine the Complaint in accordance with the Rules.

2. FACTS ALLEGED BY THE PARTIES

2.1 The Complainant

The facts in the Complaint might be summarized as follows:

1. The Complainant is a company registered in Guernsey, United Kingdom and owns the trademark JACKPOT CITY (the “Trademark”) which was registered in the Canadian Intellectual Property Office on June 28, 2002 following its use in Canada since at least as early as July 1998. The registration of the Trademark covers entertainment services, namely, casino-style gaming services rendered on-line.
2. The Complainant licenses the Trademark to Baytree Limited (“Baytree”), a gaming operator. Baytree is licensed by the Kahnawake Gaming Commission to enable Baytree to offer entertainment services (the “Services”) with a focus on online gaming to persons located in Canada.
3. The Services are offered through a website accessed through <jackpotcitycasino.com> (the “Baytree Website”) and include what are called “casino style games”, a term used in the online gaming industry to refer to the types of games an individual would encounter in a “bricks and mortar” casino, such as slot machines, blackjack, craps, roulette, and electronic facsimiles of games of chance. The slot machine games involve user interactive software running on the Baytree Website to operate the slot machine games. Other games running on the Baytree Website, such as poker or blackjack, permit the user to interact with other users through a live video stream.
4. Pursuant to the terms of the license with Baytree (the “Baytree License”), the Complainant has control over the quality of the Services performed by Baytree in Canada, including the ability for Baytree to display the Trademark on the Baytree Website.
5. The Trademark has been depicted on the Baytree Website for at least the last 10 years and, as of May 2020, the Baytree Website had over 1,600,000 registered users. For the years from July 2017 to May 2020, the Baytree Website received over 9 million visits from individuals whose IP address indicated that they were located in Canada and Baytree generated over \$342,000,000 in revenue by way of the delivery of the Services through the Baytree Website.
6. The Complainant also owns the domain name <jackpotcity.net> which resolves to a website (the “Complainant’s Website”) which also offers the Services and has been extensively advertised in Canada in such venues as the television broadcasts of basketball and hockey games.

7. In 2012, the Complainant spent USD\$34.7 million on advertisements on television, radio, and other traditional offline media in Canada, all of which featured the Trademark. This expenditure amounted to USD\$14.7 million for the first six months of 2022.
8. The Registrant registered the Domain Name on April 8, 2014.
9. The Domain Name resolves to a website (the “Registrant’s Website”) which provides information and services which compete with the Services, thereby misleading users seeking to access either the Baytree Website or the Complainant’s Website.
10. An example of the Registrant exploiting the use of the Trademark on the Registrant’s Website occurs when on the Registrant’s Website a user clicks a link entitled “visit website” and the user is redirected to a website with the domain name <bingo-country.ca>, which website provides information and services which compete with the Services.

2.2 The Registrant

The Registrant has not filed the Response.

3. CONTENTIONS OF THE PARTIES

3.1 The Complainant

The Complainant submits that the purpose for registering the Domain Name was to attract parties attempting to access the Baytree Website and the Complainant’s Website by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Registrant’s Website resulting in a scenario where the Registrant holds itself out as having the right to utilize the Trademark with no authority to do so.

3.2 The Registrant

As noted above, the Response has not been filed.

3.3 The Remedy Sought

The Complainant seeks an order from the Panel in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules that the Domain Name be transferred to the Complainant.

4. DISCUSSION AND FINDINGS

4.1 Canadian Presence Requirements

Paragraph 1.4 of the Policy requires that in order to initiate the Complaint, the Complainant, at the time of the initiation of the Complaint, must satisfy the Canadian Presence Requirements for Registrants v 1.3 (“Canadian Presence Requirements”) unless the Complaint relates to a trademark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of that trademark.

Paragraph 2 of the Canadian Presence Requirements lists the individuals and entities who meet these requirements. The Complainant as a company registered in Guernsey, UK, does not qualify under this list.

However, paragraph 2(q) of the Canadian Presence Requirements provides:

Trade-mark registered in Canada. A Person which does not meet any of the foregoing conditions, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark;

The Panel finds that the Complainant is the owner of the Trademark and that the Domain Name includes “the exact word component” of the Trademark, namely the words “JACK POT CITY”.

Therefore, the Panel finds that the Complainant has satisfied the provisions of paragraph 1.4 of the Policy.

4.2 The Policy

The purpose of the Policy, as stated in Paragraph 1.1 of the Policy, is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. The Trademark qualifies as a “Mark” as defined in Paragraph 3.2 of the Policy,
2. the Complainant had “Rights” in the Trademark prior to the date of registration of the Domain Name and continues to have “Rights” in the Trademark,
3. the Domain Name is “Confusingly Similar” to the Trademark as the concept of “Confusingly Similar” is defined in Paragraph 3.3 of the Policy,
4. The Registrant does not have a “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in Paragraph 3.4 of the Policy, and
5. the Registrant has registered the Domain Name in “bad faith” in accordance with the definition of “bad faith” contained in Paragraph 3.5 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated, and the Complaint fails.

4.3 That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

Mark

In the matter at hand, the relevant portions of Paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (a) trademark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of

distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

The evidence before the Panel is that the Trademark was registered in the Canadian Intellectual Property Office on June 28, 2002 well prior to the registration of the Domain Name by the Registrant on April 8, 2014 and that through the operation of the Baytree License, the Trademark continues to be used in Canada.

The Panel finds that the Complainant has established that the Trademark qualifies as a “Mark” for the purposes of Paragraph 3.2(a) of the Policy.

Rights

Paragraph 3.1 of the Policy requires that the Complainant has “Rights” in the Trademark. Unfortunately, the term “Rights” is not defined in the Policy.

However, given the evidence before the Panel of the Complainant’s ownership of the Trademark and the licensing of the same through the Baytree License, the Panel finds that the Complainant has “Rights” in the Trademark for the purpose of Paragraph 3.1 of the Policy. Also, given that the Registrant has not submitted the Response, Paragraph 5.8 of the Rules states that in this case, the Panel will decide the proceeding on the basis of the Complaint.

Confusingly Similar

The Policy in Paragraph 3.3 provides that the Domain Name will be found to be “Confusingly Similar” to the Trademark only if the Domain Name so nearly resembles the Trademark in appearance, sound or the ideas suggested by the Trademark as likely to be mistaken for the Trademark.

As Paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “jackpotcitygaming” is the portion of the Domain Name relevant for consideration.

The Domain Name consists of the words “jackpot city” together with the generic term “gaming”. To satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that the addition of the word “gaming” to the Mark in the Domain Name is not sufficient to distinguish the Domain Name from the Mark so that the Domain Name can not be said to so nearly resemble the Mark in appearance, sound or the ideas suggested by the Mark as likely to be mistaken for the Mark.

The test to be applied when considering confusing similarity is one of first impression and imperfect recollection. Will a person as a matter of first impression, knowing only the complainant’s corresponding trademark, and having imperfect recollection of this trademark, likely mistake the disputed domain name for the complainant’s trademark based upon the appearance, sound or the idea suggested by the trademark?

In the matter at hand, the Panel finds that the evidence before the Panel clearly demonstrates that the Mark is sufficiently known in Canada. The Panel is, therefore, satisfied that the Complainant has met the confusingly similar requirement of Paragraph 3.3 despite the mere addition of the descriptive word “gaming” to the Mark.

In fact, the Panel finds that the addition of the word “gaming” in the Domain Name increases the likelihood that a person would associate the Domain Name with the Mark given that casino gaming services are a major component of the Services offered in association with the Mark.

The Panel finds that the Complainant has met the onus placed upon it by Paragraph 3.3 of the Policy and has demonstrated that the Domain Name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

4.4 That the Registrant has No Legitimate Interest in the Domain Name

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in Paragraph 3.4 of the Policy. Again, the Panel notes that since the Response has not been filed, this issue will be decided based on the Complaint per Paragraph 5.8 of the Rules

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
- b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of:
 - (i) the character or quality of the wares, services or business;
 - (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or
 - (iii) the place of origin of the wares, services or business;
- c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- f) the domain name was the geographical name of the location of the Registrant’s non-commercial activity or place of business.

In Paragraph 3.4(d) “use” by the Registrant includes, but is not limited to, use to identify a website.

It is to be noted that with respect to the matter at hand, in Paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrant acts “in good faith”. There is no evidence before the Panel that the Registrant used the Domain Name or the Registrant’s Website in good faith. Rather, there is a strong suggestion in the evidence before the Panel that the Registrant uses the Domain Name to trade upon the goodwill of the Complainant without a license to do so in order to encourage internet users seeking to access the Services to, by mistake, access the Registrant’s Website.

Therefore, the provisions of these paragraphs do not apply.

The Registrant's name is not included in the Domain Name, nor is there evidence before the Panel that the Registrant had any relationship with the Complainant and the Trademark to suggest that the Domain Name was a geographical reference to the location of the Registrant's non-commercial activity or place of business. Therefore, the provisions of Paragraph 3.4(e) and Paragraph 3.4(f) do not apply.

The Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

4.5 That the Registrant has Registered the Domain Name in Bad Faith

Under Paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the four general intentions set out in Paragraph 3.5.

Of these intentions, the form of intention contained in Paragraph 3.5(d) is the one most applicable to the matter at hand.

Paragraph 3.5(d) provides as follows:

- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

Based upon the evidence before the Panel with respect to both the Registrant's lack of submitting the Response and to the actual use of the Registrant's Website to which the Domain Name resolves, the Panel finds that the Complainant has satisfied the provisions of Paragraph 3.5 (d) of the Policy by establishing that that the Registrant has intentionally attempted to attract for commercial gain traffic to the Registrant's Website to which the Domain Name resolves by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement of such website.

5 DECISION and ORDER

5.1 Decision

As was above set out, Paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainant has the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Name.

The Panel finds that the Complainant has satisfied this onus with respect to all three of these items by demonstrating that the Trademark qualifies as a Mark in accordance with Paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to the Trademark; and that the Registrant has registered the Domain Name in bad faith in accordance with the provisions of Paragraph 3.5 of the Policy.

The Panel also finds that the Complainant has shown some evidence that the Registrant does not have a legitimate interest in the Domain Name in accordance with the provisions of Paragraph 3.4 of the Policy.

The Panel therefore finds that the Complainant has satisfied the onus placed upon it by Paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

5.2 Order

The Complainant in the Complaint seeks an order in accordance with the Policy and the Rules directing that the registration of the Domain Name be transferred from the Registrant to the Complainant.

Section 2 of the Canadian Presence Requirements lists the types of individuals and entities who are permitted to apply for the registration of and to hold and maintain the registration of a .ca domain name. As referenced above, the Complainant is the owner of the Trademark and the Domain Name includes “the exact word component” of the Trademark, namely the words “JACK POT CITY”.

Therefore, the Panel finds that the Complainant has satisfied the provisions section 2 of the Canadian Presence Requirements.

For the above reasons, in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules, the Panel orders that the domain name <jackpotcitygaming.ca> be transferred to the Complainant.

Made as of July 22, 2022.

SIGNATURE OF PANEL

“R. John Rogers”

R. John Rogers, Chair

“Claude Freeman”

Claude Freeman, LL.M., C. Med., C. Arb., Panel Member

“Richard C. Levin”

Richard Levin, Panel Member

