

DISPUTE RESOLUTION SERVICE

D00009819

Decision of Independent Expert

Viking Office Products, Inc

and

Multisys Computers Limited

1. The Parties:

Complainant: Viking Office Products, Inc
c/o Greenberg Traurig, LLP,
77 West Wacker Drive,
Suite 2500
Chicago
Illinois
60601
United States

Respondent: Multisys Computers Limited
5 Silverlands
Buxton
Derbyshire
SK17 6QF
United Kingdom

2. The Domain Name(s):

vikingdepot.co.uk
vikingoffice.co.uk

vikingofficesupplies.co.uk
vikingstationery.co.uk
vikingsupplies.co.uk

3. Procedural History:

18 April 2011 19:45 Dispute received
19 April 2011 09:30 Complaint validated
19 April 2011 09:37 Notification of complaint sent to parties
12 May 2011 02:30 Response reminder sent
16 May 2011 12:19 Response received
16 May 2011 12:19 Notification of response sent to parties
19 May 2011 02:30 Reply reminder sent
23 May 2011 13:32 Reply received
23 May 2011 13:33 Notification of reply sent to parties
23 May 2011 13:34 Mediator appointed
26 May 2011 14:15 Mediation started
15 June 2011 13:57 Mediation failed
15 June 2011 13:58 Close of mediation documents sent
17 June 2011 12:13 Expert decision payment received
23 June 2011 Conflict Check
23 June 2011 Notification appointment of Expert
23 June 2011 13(b) DRS Policy explanatory paragraph filed on behalf of the Claimant
30 June 2011 13 (a) DRS Policy Expert Request for Registrant

4. Factual Background

4.1 The domain names in question are collectively referred to in the Decision as the "Domain Names".

4.2 The Complainant is Viking Office Products, Inc. which was established in 1960 ("the Complainant"). The Complainant uses the trading name Viking and is a global concern currently with a presence in over 16 countries worldwide. It employs over 1,300 people in the United Kingdom alone.

4.3 The Domain Names were registered on the 13 September 2002.

4.4 Results of a search on the online internet archive web.archive.org submitted by the Complainant indicate that between 18 November 2002 and 9 May 2008 the website link to the Domain Names appears to have been live and offering "retail of office and furniture items".

4.5 The Complainant first became aware of the Domain Names in late 2010.

4.6 The website at the Domain Names is currently dormant.

5. Parties' Contentions

The Complainant's Submission

5.1 The Complainant sets out its trading history as follows:

5.1.1 The Complainant company is a subsidiary of Office Depot, Inc., one of the largest suppliers of office stationery in the world. The Complainant's parent company provides office stationery products and services to its customers through 1,600 worldwide retail stores and has a thriving US\$ 4.1 billion e-commerce business, which equates to approximately one third of its total business revenue.

5.1.2 The Complainant's parent company has annual global sales of approximately US\$ 12.1 billion and employs 41,000 people around the world. It provides more office stationery products and services to more customers in more countries than any other company and currently sells to customers directly or through affiliates in 53 countries.

5.1.3 The Complainant has a significant national and global reputation and its trading name, Viking, is a recognisable national and global brand.

Complainant's Submission regarding Rights in the Viking Mark

5.2 The Complainant alleges use of the mark 'VIKING' as the identifying part of its company name for 50 years. Through this extensive and lengthy use, the 'VIKING' trade mark has become famous in the UK and throughout the world and is associated as being the brand of one of the largest suppliers of office stationery in the world.

5.3 The Complainant is the proprietor of a significant number of UK trade mark registrations which incorporate the mark VIKING, including in particular the following which predate the creation of the Domain Names:

TM Number	Mark Text	Type	Date	Status	Classes
693872	VIKING	WO	15.11.1950	Registered	16 17
1426448	VIKING	WO	01.05.1990	Registered	17
2025546	VIKING	WO	30.06.1995	Registered	09 16 17 20 21 35 42
2251342	VIKING	WO	03.11.2000	Registered	35
1497442	VIKING DIRECT	WO	09.04.1992	Registered	09
1497444	VIKING DIRECT	WO	09.04.1992	Registered	16

1497445 VIKING DIRECT WO 09.04.1992 Registered 20
2025747 VIKING DIRECT WO 30.06.1995 Registered 09 16 17 20 21 35 42
2146932 VIKING DIRECT SW 03.10.1997 Registered 39

In particular UK trade mark number 2025546 for the mark VIKING covers the following goods and services:

Class 09:

Magnetic data carriers, diskettes, notice and information boards, cash registers, calculating machines, fire extinguishing apparatus, mouse pads, protective dust covers for computer printers and terminals, laminating machines, computer cleaning products, safety signs.

Class 16:

Repositionable notes, writing instruments, hole punches, perforators, stapling machines, staples, paper clips, fold back clips, market pins, rubber bands, paper rolls, hardback manuscript books, analysis books, analysis pads, message books, duplicate/triplicate books, office pads, legal pads, memo pads, steno books, shorthand notebooks, ring binders, letterhead quality paper, correction fluid, correction rollers, packaging tape, masking tape, polypropylene clear adhesive tape, heavy duty paper tape, copier labels, address labels, laser printer labels, inkjet printer labels, continuous computer labels, diskette storage boxes, computer printout/listing paper, computer printout/data binders, overhead projection inkjet film, laser film, computer printer ribbons, typewriter ribbons, remanufactured inkjet cartridges, remanufactured laser toner cartridges, envelopes, postal tubes, display books, albums, binders, plastic files, badges, clipboards, manilla files and folders, suspension/hanging files, box files, lever arch files, presentation binders, plastic zip up wallets, dividers and indexes, magazine files, letter trays, desk top sorters, literature organisers, card planning systems, year planners, diaries, personal organisers, rubber stamps, chair mats, fax paper, laminating machines, laminating pouches, report covers, plastic binding combs, copier paper, inkjet paper, laser paper, bond paper, bank paper, copier card, laser business card blanks, certificate paper, flipchart pads, flipchart easels, whiteboards, notice and information boards, cork boards, corrugated shipping cartons, tote boxes, refuse sacks and bags, filing cabinets.

Class 17:

Packaging materials, packaging tape, insulating tape, masking tape, PVC electrical tape, heavy duty paper tape, carton strapping systems, seals, strapping, tools, filing cabinets.

Class 20:

Office furniture, diskette storage boxes, filing cabinets, cable ties, archival storage boxes, office chairs, plastic tote boxes, waste paper bins.

Class 21:

Computer cleaning products, wipes, pads, sprays, waste paper bins, sponges, brushes.

Class 35:

Business management, business administration, direct mail advertising, demonstration

of goods, rental of office machines and equipment, transcription services, typing services, word processing services.

Class 42:

Computer programming services, leasing access time to a computer data base, computer rental, up-dating of computer software, computer software, computer software design, photographic printing, offset printing, translation services, rental of vending machines, destruction of waste and trash.

5.4 In addition to the marks set out at 5.3 above the VIKING mark is registered in various countries around the world, the Complainant is the owner of U.S Reg. No. 1775567 for the mark VIKING (stylized) covering “retail catalog services and distributorship services both in the fields of office supplies and office products; namely, paper goods, stationery, printed matter, writing instruments, office equipment, office furniture, chairs, adding machines, electronic calculators, telephones, electrical equipment, measuring appliances, magnetic diskettes and other magnetic media, computer products; retail catalog services and distributorship services of cardboard and cardboard articles; namely, storage boxes, corrugated record storage boxes, card files and file trays” having a registration date of June 8 1993 and a date of first use of March 15 1960.

5.5 In addition to the trade marks, the Complainant and the Complainant’s group of companies, in particular the Complainant’s parent company Office Depot Inc, own a significant number of domain names incorporating the mark VIKING including in particular viking-direct.co.uk which was created on 4 April 1997 and viking.com which was created on 24 March 1994.

Complainant’s submission regarding Abusive Registration

5.6 The Complainant makes numerous submissions as to why the Respondent’s registration and use of the Domain Names is Abusive under the terms of the Policy including the following:

5.6.1 That the Respondent is not affiliated or related to the Complainant in any way, nor is the Respondent licensed by the Complainant or otherwise authorised to use the VIKING brand.

5.6.2 That the Domain Names were registered on 13 September 2002 long after the VIKING brand became famous. In addition, the recorded details for the Domain Names were last updated on 6 October 2010 long after the VIKING brand became famous, long after the Viking-direct.co.uk and Viking.com domain names were registered by the Complainant’s parent company and long after the VIKING trade marks were registered.

5.6.3 That the website at the Domain Names is currently dormant and results of a

search on the online internet archive web.archive.org indicate that there was no use of the Domain Names at all until 18 November 2002 long after the VIKING brand became famous, long after the Viking-direct.co.uk and Viking.com domain names were registered by the Complainant's parent company and long after the VIKING trade marks were registered.

5.6.4 That there has not been any actual or contemplated good faith use by the Respondent or any previous registrant of the Domain Names. The Respondent has never operated any bona fide or legitimate business under the Domain Names, and is not making a protected commercial or fair use of the Domain Names.

5.6.5 That the Company Viking Office Supplies Limited who the Respondent claims to have been acting for at the time of registration is now dissolved. In any event, Viking Office Supplies Limited is not affiliated or related to the Complainant in any way, nor is the Respondent licensed by the Complainant or otherwise authorised to use the VIKING brand. Use by Viking Office Supplies Limited of the Domain Name in relation to the retail of office and furniture items would have been an infringement of the Complainant's rights.

5.6.6 That the Respondent has failed to comply with the Complainant's transfer demand.

5.6.7 That the Domain Names are having an adverse impact and will continue to have an adverse impact on the Complainant's business. The reason stated by the Complainant is that Internet users who type the Domain Names into their browser by mistake, instead of inserting the address for the Complainant's parent company website, will be taken to the incorrect and currently dormant website. The Complainant claims that Internet users making this simple error are likely to assume that the website accessed, if reactivated, via the Domain Names are registered to, operated by or authorised by the Complainant, when that is not the case.

5.6.8 That the Respondent is not known by the Domain Names and does not offer any goods or services of its own under that mark. The Respondent does not offer any genuine, authorised or legitimate goods or services which relate to the trade mark. Accordingly, the Respondent has not acquired any trade mark rights in the Domain Names. The Respondent is not making any fair use of the Domain Names.

5.6.9 That the Complainant has not licensed or otherwise permitted the Respondent to use the Domain Names or to apply for or use any domain name incorporating the VIKING brand.

5.6.10 That the Domain Names intentionally trade off the Complainant's fame and

reputation.

5.6.11 That to the extent that the Respondent may obtain any revenue via a referral, pay-per-click or advertising model through its use of the Complainant's marks in the Domain Names and through internet search results, this takes unfair advantage and is unfairly detrimental to the Complainant's rights.

5.6.12 That the Domain Names are an 'Abusive Registration', as the circumstances indicate that the Respondent has registered or otherwise acquired the Domain Names primarily for the purposes of selling, renting or otherwise transferring the Domain Names to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Names

5.6.13 That the Domain Names are an 'Abusive Registration', as the circumstances indicate that the Respondent has registered the Domain Names primarily as a blocking registration against a name and mark in which the Complainant has registered and unregistered rights.

5.6.14 That the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the registration of the Domain Names is part of that pattern.

5.6.15 That the number of Domain Names, which are the subject of this complaint, is evidence itself that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to trade marks in which the Respondent has no rights. In addition the Respondent has registered Viking-office.com which is the subject of another complaint in respect of which a decision has issued since the Complaint was filed.

5.6.16 That it appears the Respondent obtained and registered the Domain Names in order to run a competing website in direct competition with the Complainant's viking.com and viking-direct.co.uk websites.

5.6.17 That the totality of the circumstances indicate the Respondent knew of the Complainant and its various marks at the time of registration of the Domain Names, since the Domain Names are identical and confusingly similar to the Complainant's VIKING brand, and are or may be being used to solicit business from the Complainant.

5.6.18 That in the circumstances of this Complaint, the passive holding of the Domain Names by the Respondent amounts to the Respondent acting in bad faith.

The Respondent's Submissions

5.7 The Respondent is a software developer and systems support company. In 2002 the Respondent brought and registered a number of domain names subject to this Complaint for an established UK based company Viking Office Supplies Limited which had traded under the mark VIKING since at least 1974.

5.8 The goodwill and assets of Viking Office Supplies Limited have been assigned and transferred a number of times since 2002. The company Viking Office Supplies Limited was incorporated by change of name on 29 October 1987.

5.9 The Respondent effectively held and holds some domain names in trust for Viking Office Supplies Limited its successors and assigns. A further company Viking Office Supplies (UK) Limited was incorporated on 6 October 2006 but is now in administration.

5.10 The company Viking Office Supplies Limited, its successors and assigns, have used the mark VIKING and domain names including VIKING as is acknowledged by the Complainant at clause 11, at least in the period 18 November 2002 and 9 May 2008.

5.11 The Complainant despite knowledge of the company Viking Office Supplies Limited and their use of the mark VIKING made no contact to the knowledge of the Respondent with Viking Office Supplies Limited its successors, assignees or associates. No evidence of such contact has been offered by the Complainant.

5.12 The Complainant alleges prior UK Registered Trade Marks all of which pre-date the acknowledged use of the mark VIKING by Viking Office Supplies Limited. However UK Registered Trade Mark No. 693872 has a very limited specification of goods and far less than necessary to justify the rights alleged under case law or natural justice or Statute. All of the Trade Mark Registrations recite limited ranges of goods and services in a particular market sector namely Stationery.

5.13 The word VIKING has a well-known historical meaning and there are other highly successful businesses using VIKING as part of their brand such as VIKING Press, VIKING Tyres, VIKING Airlines and VIKING Bikes most of which were established long before the Complainant. The Complainant does not have sufficient reputation across all trade sectors to all rights to the mark VIKING with all descriptors such as Supplies, Depot etc. to claim exclusivity. The Complainant is not in the same position as a famous mark such as COCA-COLA or the like.

5.14 The Respondent has conducted a search for registered trade marks and in the UK alone found 221 postings of live rights so the Complainant cannot claim any exclusive right to the mark VIKING registered or otherwise.

5.15 Viking Office Supplies Limited has generated goodwill in the mark VIKING which has transferred to its successors and assigns. The Respondent believes the latest owner of

that goodwill is in administration under UK law. The Respondent is under a duty of care to protect as a service provider the assets including that goodwill and the Domain Names the subject of the Complaint until released by the administrator/receiver under UK law. The Respondent has received no such release.

5.16 The Complainant alleges that a transfer demand was made. However the Respondent has never received any such transfer demand. The Complainant provides no evidence that any contact nor demand was made upon the Respondent. The Respondent claims that no transfer demand has or was made.

5.17 The Complainant alleges there has been no active use of all the Domain Names the subject of the Complaint but then acknowledges use at clause 11 at least. No action was taken by the Complainant until this Complaint despite such use, registration of the domain names since 2002 and supposed traffic diversion.

5.18 The Complainant alleges any use of the mark VIKING in the UK and elsewhere would amount to trade mark infringement. The Complainant acknowledges that the Respondent is not using the mark VIKING but holding the Domain Names on trust for others. The prior use by and goodwill of Viking Office Supplies Limited in the UK and elsewhere before the effective rights of the Complainant would prevent any successful legal action for trade mark infringement even over the relatively narrow range of goods/services for which the Complainant can allege any rights. It is submitted the Complainant is aware of this so did not launch such legal action. To allege legal action for trade mark infringement now would be successful is vexatious. The goodwill and assets of Viking Office Supplies Limited has transferred to its assigns and successors and provides more than adequate grounds for at least co-existence even if required.

5.19 It is acknowledged that the Domain Names include descriptive words but they are for the most part descriptors of the Respondent's client company name Viking Office Supplies Limited and in relation to 'supplies' wholly within that name and not the Complainant, in relation to 'depot' separate to both the Complainant and Viking Office Supplies Limited but general and more associated with hardware goods whilst 'office' and 'stationery' are so universal as to be commonplace. The Complainant according to their own allegations is known as VIKING DIRECT not with any other descriptor.

5.20 Contrary to the allegations of the Complainant it would seem that it is the Complainant who wishes to divert the goodwill of Viking Office Supplies Limited its successors and assigns to the Complainant in an opportunistic and predatory attack through this Complaint at a time when assignment of that goodwill may be being arranged by the receiver/administrator under UK law in control of those rights and assets whilst the company is 'In Administration'. A simple Google search for the word string 'viking office supplies' will show optimisation and linkage to the Complainant's sites and domain names.

5.21 The Respondent understands that as a result of disputes between the successors and assigns of Viking Office Supplies Limited that there may be legal proceedings with regard to assets including goodwill. The Domain Names are part of those assets. The Respondent as custodian of the domain names cannot allow the Domain Names to lapse or be expunged based upon a flawed presentation of the facts particularly as the Respondent may be subject to legal action for such loss.

5.22 The Domain Names were filed in good faith on behalf of a company with a legitimate right to register the Domain Names and the Complainant has provided no substantive evidence to deny that Viking Office Supplies Limited did not have rights to have the Domain Names at the date of registration. The Complainant alleges bad faith now but provides no rationale why such good faith may now be bad faith nine years after registration of the Domain Names. The Complainant alleges in effect trafficking in the Domain Names and that the Complainant is being held to ransom but provides no evidence as to how such trafficking or ransom is to have effect when there has been no contact between the Complainant and the Respondent.

5.23 The Complainant has acquiesced with regard to the Domain Names since first registered in 2002. In some jurisdictions there may be statutory bars with regard to any rights and the motives of the Complainant seem to be questionable in view of the acknowledged rights of Viking Office Supplies Limited, both by statement and action, along with the Domain Names in question expiring in 2012 and no approach to the Respondent till the date of this Complaint. It would seem the objective is to frustrate the normal legitimate business of goodwill transfer from the successors and assigns of Viking Office Supplies Limited to others and threaten such transfer without due cause. The behaviour of the Complainant in terms of lack of contact prior to the Complaint would suggest they believe expeditious vexatious behaviour now, as compared to lack of action previously due to no basis, will result in removal of a business rival as a successor/assign of Viking Office Supplies Limited rather than a real threat to the on-going business of the Complainant.

5.24 There are a number of companies which trade under the brand VIKING and there are not surprisingly also a large number of domain names including VIKING with examples listed below. It is not clear why the Complainant believed the Domain Names the subject of the Complaint should have these domain names transferred to them rather than the successors/assigns of Viking Offices Supplies or others.

www.viking.co.uk –Viking Tyres

www.viking-press.com – Viking Press

www.vikingairlines.net – Viking Airlines

www.vikingfm.co.uk – Viking FM Radio

www.vikingpetfood.com – Viking Pet Food Limited

www.vikingoptical.co.uk – Viking Optical Limited

www.vikingmovers.co.uk – Viking Movers Limited

www.vikingenergy.co.uk – Viking Energy Limited

Complainant's Reply to Response filed by the Respondent

The Complainant made the following Reply to the matters set out in the Response

5.25 The Domain Names have at all material times been registered in the name of the Respondent. For the reasons set out in the Complaint as filed ('the Original Complaint') therefore the Domain Names in the hands of the Respondent constitute Abusive Registrations.

5.26. While the Respondent alleges the Domain Names were registered for a company Viking Office Supplies Limited (which is no longer in existence) and are held on trust they were registered for a company known as Viking Office Supplies Limited which no longer exists the Domains are nonetheless Abusive Registrations for the reason set out in the Original Complaint.

5.27 In the event that Viking Office Supplies Limited were in fact the actual registrant, the contract with Nominet would have expired in accordance with clause 19 of the Nominet Terms and Conditions on dissolution of the company. Further, if the Domain Names should have been registered in the name of a third party the contract with Nominet should be cancelled as it is based on significantly inaccurate, not correct, unreliable and/or false contact details under clause 16.1 of the Nominet Terms and Conditions.

5.28 No evidence has been filed by the Respondent in respect of the claim that it "effectively held and holds some domain names in trust for Viking Office Supplies Limited its successors and assigns". The Respondent makes a reference to a further company, Viking Office Supplies (UK) Limited, but no submissions or evidence are given in relation to this company other than the fact that it is also in administration. The Respondent alleges that there is a "dispute between successors and assigns of Viking Office Supplies Limited" and that there "may be legal proceedings" in relation to Domain Names but gives no further information and further in the submission states that it is not aware of any legal proceedings in connection with the Domain Names.

5.29 The Respondent does not appear to know and has not stated for whom it claims to hold the Domain Names. The Nominet terms and conditions make it clear at section 10 that a domain name is not an item of property and has no "owner". By registering the Domain Names in its own name the registrant is the relevant and appropriate Respondent. Further it is irrelevant if the Respondent may be "subject to legal action" if the Domain Names are transferred or cancelled.

5.30 For the avoidance of doubt, it is denied that Viking Office Supplies Limited traded under the mark VIKING since at least 1974. It is also denied that Viking Office Supplies Limited owned any goodwill in the name VIKING. The Respondent has submitted no

evidence to this effect. It is also denied that goodwill (if any) and assets (if any) of Viking Office Supplies Limited has been assigned or transferred since 2002. The Respondent has submitted no evidence to this effect.

5.31 The Respondent has provided no evidence relating to any valid use of the mark VIKING by the Respondent or any other company it refers to. Any such use of the mark VIKING is denied. The Complainant was not aware of the existence of the Domain Names until late 2010 or early 2011. The Complainant has not acquiesced to use of the Domain Names by any third party including Viking Office Supplies Limited. It is also rejected that the issuing of the Complaint demonstrates any motive of the Complainant, other than to legitimately defend and enforce its legitimate rights.

5.32 It is possible for a company incorporated in 1960 to own a mark registered in 1950. All rights in UK Registered Trade Mark no. 693872 were assigned to the Complainant.

5.33 The Complainant accepts that no demand to transfer the Domain Names was made by the Complainant, merely an attempt - as noted in the Complaint to open a dialogue with the Respondent in an attempt to avoid these proceedings.

5.34 The Respondent refers to “a well known historical meaning” and other business in relation to tyres, airlines and bikes. This is irrelevant for the purposes of the present complaint. The Complainant has set out its rights in the Original Complaint. The Complainant’s rights in the VIKING mark and the relevance of the descriptors are set out in the Original Complaint. Further the Complainant’s reputation and mark has a significant reputation and is very well known across the world. The Respondent has not provided any evidence of other UK registered trade marks using the term VIKING in relation to relevant goods and services and therefore the Respondent’s assertions are irrelevant and rejected.

5.35 The Respondent’s arguments as to legitimate use made of the Domain Names on unsubstantiated and irrelevant claims to regarding Viking Office Supplies Limited, which are denied. There has been no use of the mark VIKING by the Respondent or Viking Office Supplies Limited which pre-date the Complainant’s rights. As set out in the Original Complaint, the Domain Names were all registered long after the Complainant’s rights were established. It is not accepted by the Complainant that the Respondent or Viking Office Supplies Limited at any time had legitimate interests or goodwill in the term VIKING and use of this mark by the company is not acknowledged by the Complainant. Incorporation of a company comprising the term VIKING does not give rise to any registered or unregistered trade mark rights or goodwill in the mark VIKING. The Respondent has not submitted any evidence in support of its contention that Viking Office Supplies Limited has any goodwill in the name VIKING. In any event, the Complainant’s rights pre-date the incorporation of Viking Office Supplies Limited.

5.36 As the registrant of the Domain Names, it is for the Respondent to demonstrate its legitimate interests in the same. The Complainant is entitled to bring such a complaint against any proprietor of a domain name which infringes its rights. In any event, the Respondent has not submitted any evidence of the current status whoever it considers it holds the Domain Names “on trust” for, nor its relationship to any such entity.

5.37 The Complainant only admits that, of the Domain Names, only the vikingoffice.co.uk domain name has been used (as set out in the Original Complaint), with all such use post dating and infringing the Complainant’s rights. The vikingoffice.co.uk does not appear to have been used at all since 9th May 2008. The Respondent has submitted no evidence of active use of the Domain Names. At no time has the Complainant permitted the use of the vikingoffice.co.uk domain name, or any of the other Domain Names. The use of the Domain Names by Viking Office Supplies Limited would have been an infringement of the Complainant’s rights.

5.38 The Respondent’s assertion that any action for trade mark infringement by the Complainant against the Respondent would be unsuccessful is rejected. To the contrary, the Complainant is confident that any such action would succeed and it reserves its rights in this respect. To suggest that the Complainant filed the complaint because it would not succeed in an action for trade mark infringement is entirely incorrect. Since the Complainant wishes to enforce its rights in respect of the Domain Names, the Nominet DRS complaint procedure is the most suitable primary method of determination and resolution.

6. Discussions and Findings

6.1 Paragraph 1 of the Policy defines Rights as rights as enforceable by a complainant, whether under English law or otherwise.

6.2 Complainant has rights in respect of the VIKING trade mark under Paragraph 2(a) of the Policy. Furthermore, the Domain Names are identical or similar to Complainant’s Viking Mark.

6.3 As stated above, rights are defined as rights enforceable by a complainant whether under English law or otherwise.

6.4 In this case, Complainant owns a valid and existing registration for the VIKING mark in the United Kingdom. In fact, Complainant’s earliest UK trade mark registration dates back to 1950. Complainant also owns valid and existing registrations for the VIKING Mark in the European Union. These registrations predate the Domain Names. Moreover, Complainant has used the VIKING mark extensively all over the world, including in the United Kingdom for numerous years prior to 2002.

6.5 Accordingly, Complainant has enforceable rights in the VIKING mark under the Policy.

6.6 In addition, the Domain Names are similar to Complainant's VIKING mark under Paragraph 2(a) (i) of the Policy.

6.7 The Domain Names feature Complainant's Viking mark along with words such as "Office", "Stationery", and "Supplies." These additional words along with other differences, namely deletion of the apostrophe and addition of the suffix .CO.UK, are minor and unimportant.

6.8 The dominant element of each of the Domain Names registered by Respondent is "Viking" Moreover, terms such as "Office" "Stationery" and "Supplies" are insignificant especially because these terms have a generic connotation in connection with Complainant and its businesses, namely, that the businesses supply office equipment and stationery.

6.10 Accordingly, there is no question that the Domain Names are similar or identical to Complainant's Viking Mark. The Complainant meets the requirements of paragraph 2(a)(i) of the Policy.

6.12 Turning to the question of Abuse, Paragraph 1 of the Policy defines an Abusive Registration as a domain name which either

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to a complainant's rights; or

(ii) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to a complainant's rights.

6.13 Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence that a disputed domain name is an Abusive Registration.

6.14 In this case the Respondent makes a number of claims which if supported by evidence would suggest that the Domain Names in its hands are not Abusive Registrations and are held legitimately by the Respondent on behalf of a Client with right in the name.

6.15 These include the following claims:

6.15.1 That the Respondent has a Client called Viking Office Supplies Limited

6.15.2 Viking Office Supplies Limited is dissolved but has a successor in title who is entitled the goodwill of Viking Office Supplies Limited

6.15.3 Viking Office Supplies Limited had trade mark rights in the word 'Viking' held concurrently with the trade mark rights of the Complainant and was known by the Domain Names

6.15.4 Use that has been made of the Domain Names is legitimate use.

6.15.5 Viking Office Supplies Limited has generated goodwill in the VIKING mark from its use since 1974 or at least from the date of incorporation of the company. The goodwill has been transferred to the VIKING marks successors and assigns, with Respondent believing the latest owner to be Viking office Supplies (UK) Limited a company in administration under UK law

6.15.6 The Respondent claims to be under a duty of care to protect, as a service provider, the assets of its client company, including the goodwill and disputed domain names until released by the administrator or receiver under UK law.

6.16 Statements of fact are capable of demonstration by evidence. A request was made by the expert that the Respondent produce documentary evidence of its client relationship with Viking Office Supplies Limited. This did not lead to the production of any documents. While it is possible that the Respondent once had a client Viking Office Supplies Limited whose assets and goodwill survived its demise, such assets now being held on trust for the successors in title to such company the Respondent's claims are mere assertions and accordingly can only be given weight and considerations as mere assertions.

6.17 A supplier to a "client company" is not without proof of the relationship and trust entitled to possession of a domain name offering competing goods to the Complainant. The Domain Names are not according to the terms and conditions set out by Nominet items of property. Accordingly a registrant has to prove a legitimate interest in the Domain Name. None of the facts stated by the Respondent are supported by any evidence submitted with the Response or produced following a request under 13(a) of the DRS Policy.

6.18 On balance even though the Domain Names are not currently in use taking into account the materials submitted by the respective parties it is more probable than not that the Domain Names were registered to take advantage of the trade mark rights of the Complainant.

6.19 There is evidence that the Domain Names are Abusive Registrations in the hands of the Respondent

7. Action

The Domain Names should be transferred to the Complainant.

Signed MARGARET BRIFFA

Dated 22 July 2011