

## **DISPUTE RESOLUTION SERVICE**

**D00022218**

### **Decision of Independent Expert**

**VIVENDI**

and

**NVA Online Advertising B.V.**

#### **1. The Parties:**

Complainant: VIVENDI  
42, Avenue de Friedland  
Paris  
75008  
France

Respondent: NVA Online Advertising B.V.  
Opper 14  
Uden  
Noord-brabant  
5406CA  
Netherlands

#### **2. The Domain Name(s):**

vivendi.uk (“the Domain Name”)

#### **3. Procedural History:**

The Complaint was submitted to Nominet on 10 January 2020 and was validated and notified to the Respondent by Nominet on 14 January 2020. The Respondent was informed in the notification that it had 15 working days, that is until 4 February 2020, to file a response to the Complaint.

On 16 January 2020, the Respondent filed a Response. On 21 January 2020 the Complainant filed a Reply to the Response. The case proceeded to the mediation stage on 23 January 2020. On 30 January 2020, Nominet notified the Parties that mediation had been unsuccessful and, pursuant to paragraph 10.5 of Nominet’s Dispute Resolution Service Policy Version 4 (“the Policy”), invited the Complainant to pay the fee for referral of the matter for an expert decision. On 31 January 2020, the Complainant paid the fee for an expert decision. On 5 February 2020, Andrew D S Lothian, the undersigned (“the Expert”), confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 10 February 2020.

#### **4. Factual Background**

The Complainant is a French multinational mass media conglomerate headquartered in Paris with operations in music, television, film, video games, telecommunications, tickets and video hosting. It has over 44,000 employees based in 78 countries and its worldwide revenue for the year 2018 amounted to EUR 13,932,000,000. The Complainant has its origins in the 19<sup>th</sup> century and has been known as “Vivendi” since 1998. Its principal domain name <vivendi.com> was registered on 12 November 1997.

The Complainant is the owner of a portfolio of registered trade marks consisting of or containing the mark VIVENDI including, for example, international registered trade mark no. 687855 in respect of the word mark VIVENDI registered on 23 February 1998 in use classes 09, 35, 36, 37, 38, 39, 40, 41, and 42, designated in respect of 52 countries or territories.

The Domain Name was registered on 27 December 2019. The Respondent appears to be a company with an address in the Netherlands. It has provided no information regarding its operations or the nature of its business. According to a screenshot of a website at the domain name <dan.com> taken by the Complainant and time-stamped 9 January 2020, the Domain Name was offered for sale by the Respondent. According to a screenshot supplied by the Respondent listing online communications dating between 7 and 8 January 2020, representatives of the Complainant and the Respondent attempted to reach agreement as to the terms of purchase of the Domain Name. The exchange of communications demonstrates that the Complainant’s representative was clear as to its affiliation to the Complainant. It also shows that the Parties were unable to agree a price for the Domain Name, as the communications conclude with the Respondent’s representative stating “no problem, we cannot sell this premium for [the Complainant’s proposed figure]. Thank you”.

#### **5. Parties’ Contentions**

##### **Complainant**

The Complainant submits that it has rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The Complainant notes that its registered trade mark VIVENDI is identical to the Domain Name, subject to the addition of the country code top level domain “.uk” which it says is to be disregarded in the comparison exercise. The Complainant asserts that said trade mark is very well-known worldwide, noting its presence in 78 countries, and referencing a domain

name dispute case in connection with a different dispute resolution policy in which the deciding panel stated that the Complainant's VIVENDI mark was "highly distinctive and well-established". The Complainant submits that the Respondent has no rights of its own in the Domain Name, nor any affiliation to the Complainant.

The Complainant states that the name "Vivendi" is based on the Latin phrase "modus vivendi" and that, on its own, "vivendi" has no meaning other than its affiliation with the Complainant. The Complainant points out that a past case under the Policy has indicated that where a domain name is identical to a trade mark without any adornment, barring exceptional circumstances, this will almost inevitably lead to confusion. The Complainant contends that it is reasonable to infer that the Respondent registered the Domain Name with full knowledge of the Complainant's marks.

The Complainant notes that the Domain Name has been offered for sale in the sum of €3,999 and submits that the offer of sale to the Complainant of the Domain Name for a profit takes unfair advantage of and is unfairly detrimental to the Complainant's Rights. The Complainant asserts that Abusive Registration is also demonstrated by the fact that the only use which the Respondent could make of the Domain Name would be likely to give rise to at least initial interest confusion in that the Respondent would unfairly attract visitors to its website who would not otherwise have accessed it, and the content of such website would be outside the control of the Complainant.

### **Respondent**

The Respondent requests that the Complaint be denied.

The Respondent states that it has not seen evidence of Abusive Registration and asserts that it is not infringing the Complainant's trade mark. The Respondent notes that .uk domain names are issued on a first-come-first-served basis and submits that its registration of the Domain Name is legitimate.

The Respondent asserts that "vivendi" translates as "of living" and is used as a term by many people, adding that its use is not intended to cause confusion with the Complainant or its website.

The Respondent indicates that it sees no reason to give up its registration of the Domain Name as it is not an Abusive Registration, noting that the Complainant made a bid for the Domain Name on the platform where the Respondent has offered it for sale. The Respondent states that it has rejected this bid because it cannot take such a small offer seriously. The Respondent notes that it has proposed a higher price but that the Complainant then filed the present dispute, which it says came as a surprise to the Respondent.

### **Complainant's Reply to Response**

The Complainant accepts that domain names are issued on a first-come-first-served basis, adding that this is subject to a proviso that they do not infringe a registered trade mark. The Complainant provides the URL of the Respondent's website and states that the Respondent is an IT consultant, adding that, as such, it could not ignore the likelihood of confusion with the Complainant's VIVENDI mark. The Complainant asserts that VIVENDI derives from the Latin word [*sic*] "modus vivendi" meaning "lifestyle" and references an online entry

regarding such phrase from the “Wikipedia” website. The Complainant reasserts its original contention that the word “vivendi” alone has no meaning in Latin or English.

The Complainant reiterates its position that the Respondent registered the Domain Name with knowledge of the Complainant’s brand and says that this was done only for the purposes of selling it to the Complainant or a competitor and that the Respondent had no good faith interest in using the Domain Name. The Complainant notes the terms of the Parties’ discussions as to the price of the Domain Name and concludes that the Respondent took advantage of the notoriety of the Complainant’s mark when registering the Domain Name solely for the purpose of selling it.

## **6. Discussions and Findings**

### **General**

In terms of paragraph 2.2 of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraphs 2.1.1 and 2.1.2 of the Policy, namely that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### **Complainants’ Rights**

Paragraph 1 of the Policy provides that Rights means “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called ‘common law rights’.

In the present case, the Complainant relies upon its registered trade mark for the word mark VIVENDI. The Expert finds that the Complainant has Rights in said mark. Comparing the second level of the Domain Name with the Complainant’s VIVENDI mark, the Expert notes that the Domain Name is alphanumerically identical. The first (.uk) level of the Domain Name is typically disregarded in the comparison exercise as being required for technical reasons only.

The Expert therefore finds that the Complainant has proved on the balance of probabilities that it has Rights in the mark VIVENDI and that such mark is identical to the Domain Name.

### **Abusive Registration**

Paragraph 1 of the Policy defines “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 the Complainant's Rights; or*

*ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

This general definition is supplemented by paragraph 5.1 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 8.1 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The thrust of the Complainant's submissions on Abusive Registration is directed principally to paragraph 5.1.1.1 (registration of Domain Name primarily for the purposes of sale to the Complainant or a competitor) and paragraph 5.1.2 (Respondent threatening to use Domain Name in a manner likely to cause confusion) of the Policy. However, the Complainant's case can be directed equally well to paragraph 5.1.6 of the Policy (Domain Name is exact match for mark in which Complainant has Rights, said mark has a reputation and Respondent has no reasonable justification for having registered Domain Name).

The Expert is satisfied from the evidence supplied by the Complainant that the Complainant's VIVENDI mark does have a reputation and indeed is well-known. The question therefore is whether the Respondent has any reasonable justification for having registered an exact match for such mark within the Domain Name. It is clear that the Respondent registered the Domain Name in order to offer it for sale for valuable consideration in excess of out-of-pocket costs. As paragraph 8.4 of the Policy notes, trading in domain names for profit is of itself a lawful activity, although each case must be reviewed on its merits.

The Respondent claims a reasonable justification in registering and offering the Domain Name for sale because it is "used as a term by many people" and was not intended to target the Complainant's Rights in its VIVENDI mark. In so saying, the Respondent is effectively relying upon paragraph 8.1.2 of the Policy which indicates that if the Domain Name is generic or descriptive and the Respondent is making fair use of it, this may be evidence that it is not an Abusive Registration. In support of this claim, the Respondent provides a single screenshot showing a link to a "Wikipedia.org" webpage about the well-known Latin phrase "modus vivendi". The Complainant provides the same link in its Reply and adds that its trade mark was originally derived from that phrase. The "Wikipedia" entry explains that "modus vivendi" is a phrase in widespread use, notably in science and diplomacy, and can be translated variously as "mode of living" or "way of life".

The Parties are therefore agreed that the word "vivendi" comes from the Latin language, translates into English as "of living", and can be found in the phrase "modus vivendi". Neither of the Parties suggests that "vivendi" may mean anything in any other language, such as for example the various modern languages derived from Latin. The Expert's limited classical education likewise supports what the Parties say about the origins of the word, it being the genitive form of the gerund, from vivere, "to live". In Latin, it could appear in any sentence where the partial phrase "of living" is needed. "Modus vivendi" is but one example, and both Parties agree that this phrase has attained a special meaning in certain fields, however there are countless possible permutations, such as for example "ars vivendi", meaning "the art of living". However, as far as the Panel is aware, and in the absence of any other evidence, for "vivendi" to make sense as a generic or descriptive term, it needs to be placed with least one other word, making it part of a phrase. In linguistic terms, as opposed to trade mark terms, the word "vivendi" meaning "of living" cannot sensibly or meaningfully exist on its own.

This is the nub of the Complainant's case. Its central assertion is that "vivendi", when presented on its own as it is in the Domain Name, can only denote the Complainant's well-known trade mark and that any premium sought by the Respondent must necessarily derive from and take unfair advantage of the value of such mark. The Complainant provides reasonable and unchallenged supportive evidence as to the extent and reach of such mark, which is significant. Although the Respondent's case is to some extent imperfectly expressed, its only counter seems to be that the word "vivendi" in the Domain Name can call to mind the phrase "modus vivendi" and thus has independent value to third parties which it is entitled to realise.

The problem for the Respondent, however, is that it has put forward nothing of any substance to challenge the Complainant's central assertion. The Respondent says that the word "vivendi" is "used as a term by many people" but provides no evidence, other than the entry for "modus vivendi," to support this sweeping statement. Notably, it does not assert or provide any evidence that the word is in use on its own as a generic or descriptive term anywhere in any context, which might have suggested that paragraph 8.1.2 of the Policy could be applicable.

In order for the Respondent to have made out a successful case of fair use of the word "vivendi" in terms of paragraph 8.1.2 of the Policy, the Expert considers that it would typically have to be deployed in combination with one or more other relevant words, such as in the example phrases previously described. A word on its own translating as "of living" is meaningless and could not be asserted credibly to have much, if any, generic or descriptive value. On the other hand, that term undeniably has considerable value and notoriety, when used alone, as the Complainant's trade mark VIVENDI. On the balance of probabilities, the Expert considers that this is the more likely reason for the Respondent's registration of the Domain Name and for the "premium" nature or value which it has ascribed to it. Accordingly, even if the word "vivendi" could be said to have any real generic or descriptive value, which the Expert doubts given the above analysis, it could not be argued that the Respondent is making fair use of it in the face of the strength of the Complainant's Rights.

In conclusion, absent any supportive evidence, the Respondent's mere assertion of widespread third party use in this case neither brings it within the safe harbour of paragraph 8.1.2 of the Policy, nor provides it with any reasonable justification for having registered an exact match of the Complainant's trade mark in the Domain Name along the lines anticipated by paragraph 5.1.6 of the Policy, particularly when the notoriety of such mark is factored into the equation. Indeed, the Respondent makes no serious attempt to rebut the Complainant's case as to the well-known nature of its VIVENDI mark and notably does not deny prior knowledge of such mark, however credible or otherwise a denial might have been on the facts of this case.

In these circumstances, the Panel finds that the Domain Name in the hands of the Respondent takes unfair advantage of the Complainant's Rights and constitutes an Abusive Registration within the terms of the general definition provided in the Policy and specifically in terms of paragraph 5.1.6.

## **7. Decision**

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain

Name be transferred to the Complainant.

**Signed** .....

Andrew D S Lothian

**Dated** ..... 21 February, 2020