

DISPUTE RESOLUTION SERVICE

D00017566

Decision of Independent Expert

Vice UK

and

AWB i Stockholm AB

1. The Parties

Complainant: Vice UK
New North Place
London
EC2A 4JA
United Kingdom

Respondent: AWB i Stockholm AB
St Eriksgatan 46c
Stockholm
10028
Sweden

2. The Domain Name

viceland.co.uk

(‘the Domain Name’)

3. Procedural History

Nominet checked that the complaint received on 6 June 2016 complied with its UK Dispute Resolution Service ('DRS') Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). A letter sent by the Chair of Nominet's panel of experts, routinely issued when complaints are short or unsupported, was viewed on 7 June 2016. But the Complainant did not take the opportunity to revisit its case.

Nominet notified the Respondent of the complaint and invited it to file a response. No response was received so mediation was not possible and, on 29 June, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 14 July.

On 21 July I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I subsequently confirmed that I am independent of each of the parties and that, to the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

4. Factual Background

I have typed the Domain Name into a browser and visited the website at <vice.com> to which the complaint refers. I also asked Nominet whether it is possible to infer, from the 'Whois' report showing a registrant and a 'registered on' date, that the registration at the 'registered on' date was by the registrant. Their response confirms that this is not a reliable inference generally – the 'Whois' report shows the original registration date and the current registrant (who may or may not be the original registrant) – but also that, in this case, the Respondent was the registrant at the date of registration and has held the Domain Name since. From that limited research, the complaint and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant, Vice UK, appears to be related to Vice Media Canada Inc – because the trade mark papers appended to the complaint refer only to the Canadian company. But the nature of that relationship is not set out. The Complainant, or Vice Media Canada Inc, has registered the domain name <vice.com> and uses it for a website containing news and features. On 25 April 2016, the Canadian company applied to register 'VICELAND' as a European Union trade mark.

The Domain Name was registered by the Respondent on 10 June 2004. At the time of the complaint and of writing it did not resolve to a web page.

5. Parties' Contentions

Complaint

The complaint is extremely short and I therefore reproduce it below in full.

What rights are you asserting?

Viceland is a globally recognised brand owned in multiple international countries by Vice, we have pending trademarks as viewable here: <https://www.ipo.gov.uk/tmcase/Results/4/EU015371206>

We are shortly to be launch a TV channel in the UK named VICELAND - this will be going live in September this year. It was previously our original website when the company was founded, we have since moved to Vice.com but we are reusing this trademark four our new channel. We have in the past attempted to contact the owner but have had no communication with them.

Why is the domain name an Abusive Registration?

The domain is currently displaying no content what so ever, and is owned by an aggregator in Sweden. We have had no useful communications with the current owner and have been unable to contact who assert is that actual owner.

How would you like this complaint to be resolved?

Transfer

Additional Complainants:

[no additional complainants]

As far as you are aware have any legal proceedings been issued or terminated in connection with the domain name?

[answered no]

Are there any web pages that support this dispute?

- <https://www.ipo.gov.uk/tmcase/Results/4/EU015371206>

Response

There has been no response.

6. Discussion and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it 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.

Rights

A trade mark for 'VICELAND' is described as 'pending' in the complaint. The UK's Intellectual Property Office page to which the complaint provides a link shows that the application is still at the 'Examination' stage, which means that it has not yet been accepted for publication and is still some way off being registered.

The DRS *Experts' Overview* anticipates a question about whether the mere existence of a trade mark application can give rise to a right within the Policy's definition of 'rights'. The answer given (section 1.9) is:

No. The validity of a trade mark application has not yet been determined and ordinarily it affords the proprietor no legal right to prevent others from using the mark. In and of itself an application will not constitute 'Rights' under the Policy. Of course in some cases an applicant for a trade mark will also have separate parallel unregistered rights in the mark in question and may be able to show Rights in this way.

It seems clear to me that, in the context of the Policy, this pending application does not of itself give rise to or reflect registered rights.

Does the Complainant have any unregistered rights in 'Viceland' - which, ignoring the .co.uk suffix as merely a generic feature of the domain name register, is identical to the Domain Name? Or does it have any such rights in 'Vice' - which is arguably similar to the Domain Name (at least for the purpose of the low threshold 'rights' test used to establish whether a complainant has the standing to make a valid complaint)? There is no evidence of any such unregistered rights. All I have before me is the bare assertion that

Viceland is a globally recognised brand owned in multiple international countries by Vice, we have pending trademarks

plus the prospect of a future TV channel launch and the unsupported and imprecise claim that '[Viceland] was previously [the name of] our original website' that 'we are reusing'.

It is also clear from the pending trade mark documentation supplied that 'we' refers not to the Complainant but to Vice Media Canada Inc. There is no

attempt in the complaint to explain how the Complainant may be related to the trade mark applicant. So, even if there were rights, based on the complaint itself it would not be legitimate to conclude that they belonged to the Complainant.

I do not think, therefore, that the Complainant has even made out rights for the purpose of establishing standing. If no relevant rights are established, the question of abusive registration does not fall to be considered. There can be no unfair advantage taken of the Complainant's rights because it has not established that it has any relevant rights.

I note that a 'Chairman's letter', triggered routinely when complaints are short or unsupported, was viewed on 7 June 2016 but that the Complainant did not take the opportunity to review and strengthen its case.

It is possible to envisage an alternative case in which evidence is introduced to show that

- Vice Canada has rights in the name 'Viceland' or 'Vice'
- It has given the benefit of those rights to (or has in some other way conferred the benefit of those rights on) the Complainant here, Vice UK
- Vice UK can use those rights to make a complaint under the Policy, forcing the Respondent to submit to proceedings under the DRS.

But no such chain of reasoning in relation to rights has been attempted, let alone established.

Registration

As defined by the Policy, an abusive registration is a domain name which:

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

But as the Complainant here has not established any relevant rights, it cannot successfully argue that the registration or use of the Domain Name here has taken unfair advantage of them.

Supposing, counterfactually, that the Complainant here had demonstrated rights in the name 'Viceland', it would be necessary to look at the registration and use of the Domain Name.

The Domain Name was registered by the Respondent in 2004. There is no evidence about when the Complainant had established rights in 'Viceland', so

the case has not been made out that registration took unfair advantage of the Complainant's supposed rights. Even if, contrary to the view expressed in the *Overview*, the trade mark application in April 2016 had been sufficient to give rise to rights, it would be of no help to the Complainant since that date falls after the Respondent's registration of the Domain Name.

The Domain Name is not being used, so 'use' cannot be taking unfair advantage of the Complainant's supposed rights either. Of course there are circumstances in which non-use is effectively regarded as 'use' for the purposes of the Policy - for example when a domain name is held simply as a 'blocking' registration. But the complaint says: 'It was previously our original website when the company was founded, we have since moved to Vice.com but we are reusing this trademark.' So the non-use of the Domain Name here appears to have been during a period when the Complainant was itself not making or seeking to make use of the name 'Viceland'. That does not appear to me to be the kind of non-use that takes unfair advantage of a complainant's rights.

All of this is counter-factual, but it is interesting to note that, even if the Complainant had got over the 'rights' threshold, in my judgement it would not have shown, on the balance of probabilities, that the Domain Name is an abusive registration.

7. Decision

I find that the Complainant does not have rights in respect of a name which is identical or similar to the Domain Name and that the Domain Name cannot therefore be an abusive registration.

In the light of that, I direct that the Domain Name be left undisturbed.

Mark de Brunner

5 August 2016