

## **DISPUTE RESOLUTION SERVICE**

**D00022217**

### **Decision of Independent Expert**

**VIVENDI**

and

**Mr Brian Hill**

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

Lead Complainant: VIVENDI  
42, Avenue de Friedland  
Paris  
75008  
France

Respondent: Mr Brian Hill  
40 Shutlock Lane  
Birmingham  
West Midlands  
B13 8NZ  
United Kingdom

I refer herein to the Parties as the “Complainant” and the “Respondent” respectively.

#### **2. The Domain Name**

vivendi.co.uk

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

- 3.1. I can confirm that I am independent of each of the parties. 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 to be disclosed because

they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

- 3.2. This dispute is governed by the Nominet Dispute Resolution Service Policy version 4 (the “DRS Policy”). I refer also below to the Dispute Resolution Service – Experts’ Overview, version 3, dated December 2016 (the “DRS Experts’ Overview”). Both the DRS Policy and the DRS Experts’ Overview are available for download from the Nominet website. I adopt definitions from the DRS Policy and the DRS Experts’ Overview in this decision.
- 3.3. The Complaint was filed on 10 January 2020. The Respondent filed a response on 3 February 2020, and the Complainant filed a Reply on 6 February 2020. The Complainant paid the fee for an expert decision on 26 February 2020.

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

- 4.1. The Complaint sets out several facts on which the Complainant relies. None of those facts are obviously incredible, and the Respondent does not challenge any of them in his Response. In those circumstances, I can take the facts in the Complaint as true, and I set out below those which I consider to be relevant.
- 4.2. The Complainant is a French company, founded in the mid-19<sup>th</sup> century under the name ‘Compagnie Générale des Eaux’. It later diversified its business into several areas including communications. In 1990, the Complainant had 1,600 subsidiaries, 173,000 employees, and revenue in excess of 100 billion French Francs. The Complaint does not state the contemporaneous French Franc to Sterling exchange rate, but I recall from my personal knowledge that, around that time, 10 French francs were very roughly equivalent to around 1 GBP. On any view, the Complainant’s revenues were at that time very significant.
- 4.3. In 1998, the Complainant changed its name to ‘Vivendi’.
- 4.4. Since 1998, the Complainant has carried on business as a multinational mass media conglomerate headquartered in Paris, which conducts activities in the music, television, film, video games, telecommunications, tickets and video hosting service industries. By 2018, it had 44,142 employees in 78 countries with total revenue of nearly €14 billion.
- 4.5. The Complainant is the owner of a number of registered trade marks, including the following registered trade marks for the plain text word ‘VIVENDI’ (the “Complainant’s Trade Marks”):
  - i. French trademark no. 1617000, registered on 25 September 1990;
  - ii. French trademark no. 95601123, registered on 7 December 1995;

- iii. French trademark no. 97694077, registered on 8 September 1997;
  - iv. International trademark designating the UK, no. 687855, registered on 23 February 1998; and
  - v. French trademark no. 98726148, registered on 2 April 1998.
- 4.6. The Complainant has also been the registrant of the undisputed domain name <vivendi.com> since November 1997.
- 4.7. The disputed Domain Name <vivendi.co.uk> was registered on 3 February 2002. Excerpts from the Wayback Machine indicate that:
- i. On 23 November 2002 and on 12 February 2003 the Domain Name resolved to pages containing only a counter.
  - ii. On 5 December 2004 it resolved to a page which said *“Welcome to the new website for brianhill.co.uk”*. There is no evidence of any further content on that website.
  - iii. On 2 September 2006 it resolved to a page with a message from ‘moonfruit’ stating *“Sorry, this page cannot be found.”*
  - iv. On 10 August 2008 it resolved to a landing page containing a message from a company called ‘50MEGS’;
  - v. On 10 January 2016 it resolved to a page with a message from ‘servageone’ stating *“website not yet configured”* and *“The website you are trying to access is unknown in the system”*.
- 4.8. Attached to the Complaint is a recent screenshot showing the Domain Name resolves to a page titled ‘My blog’, which page incorporates a picture of two people by the sea and the word ‘welcome’. There is no evidence of any further content on that website.
- 4.9. The Respondent has asserted that no one, including the Complainant, has approached him with a complaint of any kind in the 18 years since he registered the Domain Name. The Complainant does not challenge that assertion, and I accept it.

## **5. Parties’ Contentions**

### **Complaint**

- 5.1. The Complainant says, of the name VIVENDI:
- i. that the trademark VIVENDI is well-known worldwide, including in the United Kingdom;

- ii. that the word 'VIVENDI' on its own has no meaning other than its affiliation with the Complainant.
- 5.2. Of the Domain Name, the Complainant asserts that it is identical to the Complainant's Trade Marks for the word VIVENDI, because the '.co.uk' element can be discounted as it does not change the overall impression of the domain name.
- 5.3. The Complainant makes four principal submissions as to why the Domain Name is an abusive registration.
- i. First, it is reasonable to infer that the Respondent registered the Domain Name with full knowledge of the Complainant's Trade Marks.
  - ii. Second, the Complainant asserts that the Domain Name has never been actively used, and contends that the Respondent has no right nor legitimate interest in the Domain Name.
  - iii. Third, the Domain Name is likely to give rise to 'initial interest confusion' in that Internet users may initially be confused because, on the basis of the Domain Name alone, they will visit [www.vivendi.co.uk](http://www.vivendi.co.uk) believing that they will find the website of the Complainant.
  - iv. Fourth, the Complainant contends that the Respondent has registered the Domain Name in order to prevent the Complainant from "*reflecting the mark in a corresponding domain name.*"
- 5.4. The Complainant requests transfer of the Domain Name.

### **Response**

- 5.5. In Response, the Respondent makes two points.
- i. First, he states: "*I have made legitimate non commercial use of the domain for 18 years.*"
  - ii. Second, he says that the Complainant's long delay in issuing this complaint indicates that the Respondent's ownership of the Domain Name does not present any concerns to the Complainant.

### **Reply**

- 5.6. In Reply, the Complainant repeats its statement that the Domain Name has never been actively used, and avers that "*passive detention is not a legitimate non commercial use for 18 years.*"

## 6. Discussions and Findings

6.1. Under Section 2 of the DRS Policy the Complainant must prove:

- i. that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

6.2. There are thus three elements to be proven: (i) Rights; (ii) identity or similarity; and (iii) Abusive Registration.

### (i) Rights

6.3. Section 1 of the DRS Policy defines Rights as meaning “*rights enforceable by the Complainant, whether under English law or otherwise...*”. The Complainant’s Trade Marks are rights enforceable by the Complainant in the United Kingdom and in France. The Complaint satisfies the first element.

### (ii) Identity or similarity

6.4. Section 2.3 of the DRS Experts’ Guide states “*...a name or mark will ordinarily be regarded as identical to the domain name if, at the third level, and ignoring the presence of hyphens and the absence of spaces and ampersands, they are the same.*”

6.5. The Domain Name is <vivendi.co.uk>. At the third level, that is identical to VIVENDI. I agree with the Complainant that the Domain Name is identical to the name in respect of which the Complainant has Rights. The second element is satisfied.

### (iii) Abusive Registration

6.6. An Abusive Registration is defined in Section 1 of the DRS Policy. It includes 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.

6.7. The question of whether a domain name is an Abusive Registration is a multi-factorial assessment. A non-exhaustive list of factors which may indicate an Abusive Registration is set out in section 5.1 of the DRS Policy. Section 8.1 of the DRS policy sets out, on the other hand, a list of factors which may indicate that a Domain Name is not an Abusive Registration. I will discuss the relevant parts of sections 5.1 and 8.1 in my consideration of the parties’ submissions below.

- 6.8. I should add that, although it is nowhere to be found expressly in the DRS Policy, the overriding view of Nominet Experts is that, because the system of registration of domain names is a 'first come first served system' in which as a general rule any person is entitled to register any available domain name, in order to show that a domain name amounts to an Abusive Registration a complainant generally needs to show on the balance of probabilities that the respondent was aware of the complainant and/or its rights in a name or mark identical or similar to the domain name at the time it was registered (see, for example, EQUEST.co.uk – DRS 20412).
- 6.9. I now turn to the Complainant's four principal submissions.
- 6.10. First, the Complainant says it is reasonable to infer that the Respondent registered the Domain Name with full knowledge of the Complainant's Trade Marks.
- 6.11. The Complainant asserts that the trademark VIVENDI is well-known worldwide, including in the United Kingdom, and that it has no meaning other than its affiliation with the Complainant. Those are reasonable assertions on the evidence before me, they are unchallenged by the Respondent, and I accept them. It is therefore at least probable that the Respondent was aware of the Complainant's VIVENDI business when the Domain Name was registered. Further, the Respondent did not deny in his Response the Complainant's inference that the Domain Name was registered "*with full knowledge*" of the VIVENDI trade marks.
- 6.12. In the circumstances, I accept the Complainant's first submission. The Complainant has shown on the balance of probabilities that the Respondent was aware of the Complainant and/or its rights in VIVENDI at the time the Domain Name was registered.
- 6.13. This on its own does not mean the Domain Name is an Abusive Registration. That requires the Complainant to show that at the time when the registration or acquisition took place, the Domain Name took unfair advantage of or was unfairly detrimental to the Complainant's Rights.
- 6.14. On the one hand, given that VIVENDI was in 2002 well-known as indicating the Complainant, it is easy to see how use by the Respondent of the Domain Name *could have* taken unfair advantage or been detrimental. Certainly, it would seem that any *commercial* use of a website at the Domain Name would more likely than not have done so, for example by causing confusion.
- 6.15. On the other hand, and whilst the question is to be answered as at the time of registration in 2002, there is some force in the Respondent's submission that, in the 18 years that have since passed, the Complainant has not raised any concern with the Respondent. That delay might well indicate that the registration of the Domain Name was neither unfair nor detrimental.

- 6.16. The question really turns on whether the Respondent had any legitimate and/or fair reason for registering the Domain Name.
- 6.17. That takes me to the Complainant's second submission – that the Respondent has never made active use of the Domain Name, and has no right or legitimate interest in it. In circumstances where I have found the Domain Name is identical to the well-known name VIVENDI, that submission engages section 5.1.6 of the DRS Policy:
- 5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.*
- 6.18. The Respondent's position is that he has made legitimate non-commercial use of the Domain Name for 18 years. Section 8.1.1.3 of the DRS Policy provides that a domain name may not be an Abusive Registration if, before being aware of the cause for complaint, the respondent has "*made legitimate non-commercial or fair use of the Domain Name*".
- 6.19. If the Respondent were able to demonstrate that he had, for example, made use of the Domain Name to host a blog, then his submission may have considerable force. However, the Respondent's difficulty is that section 8.1.1.3 requires a respondent to make use of a domain name. Whilst the Respondent says he has done so, he has adduced no evidence of that use. Further, that failure to adduce evidence is in the face of a Complaint which included:
- i. several exhibits from the Wayback Machine suggesting that there has been no active use of the Domain Name since 2002;
  - ii. an exhibit indicating that the Domain Name remains unused; and
  - iii. an allegation that: "*...since its registration, the Complainant asserts that the disputed domain name has not been actively used*".
- 6.20. Had there been any such active use, the Respondent ought easily to have been able to adduce evidence of any such use in response. He neither did so, nor explained why he could not. I find as a consequence that the Respondent has not made any use at all of the Domain Name, such that the Respondent's submission that he has made legitimate non-commercial use of it must fail.
- 6.21. Further, it seems to me that the Respondent's absence of use of the Domain Name provides a likely explanation as to why the Complainant has not raised any concern for the last 18 years. One might ask, rhetorically, without any

use, what would have attracted the Complainant's attention? That is particularly so given the Complainant has its own non-disputed domain name (<vivendi.com>).

- 6.22. In all the circumstances, I accept the Complainant's second submission, and I find on the balance of probabilities that the Domain Name was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights. Accordingly, the Domain Name is an Abusive Registration.
- 6.23. I now turn to the Complainant's third submission – namely that use of the Domain Name is likely to give rise to 'initial interest confusion'. I have found that the Respondent is not using, and has not for 18 years used, the Domain Name. Accordingly, the issue of confusing use does not arise. However, as I have indicated, if the Respondent *were to use* the Domain Name in a commercial context, it is at least on the face of it likely that some degree of confusion would arise. That would justify an explanation from the Respondent as to why such confusion would either not occur, or would not take unfair advantage of or be detrimental to the Complainant's Rights. No such explanation has been provided. Accordingly, I accept the Complainant's third submission, and for this reason too, I find that the Domain Name is an Abusive Registration.
- 6.24. The Complainant's fourth submission is that the Respondent registered the Domain Name in order to prevent the Complainant from "*reflecting the mark in a corresponding domain name.*" That submission, which amounts to a contention that the Respondent has used the Domain Name as a blocking registration, sits uneasily with the fact that, for 18 years, the Complainant has not raised any concern in relation to the registration of the Domain Name. If the Complainant had actually been blocked by the registration of the Domain Name, it could and no doubt would have raised a complaint earlier. In the circumstances, I reject the Complainant's fourth submission.

## **7. Decision**

- 7.1. The Complainant has Rights in the name VIVENDI, which is identical to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration.
- 7.2. The Complainant requests, and I direct, that the Domain Name be transferred to the Complainant.

**CHRISTOPHER HALL**  
**24 March 2020**



