Decision for dispute CAC-UDRP-103286

Case number	**CAC-UDRP-103286**
Time of filing	**2020-09-16 08:58:19**
Domain names	**vivendiusa.com**

Case administrator

Organization	**Iveta Špiclová (Czech Arbitration Court) (Case admin)**

Complainant

Organization	**VIVENDI**

Complainant representative

Organization	**Nameshield (Enora Millocheau)**

Respondent

Organization	**Stott.Inc**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on the following trademarks:

- the international trademark VIVENDI (word) No. 687855, registered on February 23, 1998 and renewed;

- the international trademark VIVENDI (word and device) No. 930935 registered on September 22, 2006 and renewed.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is a French multinational mass media conglomerate headquartered in Paris. It is active in music, television, film, video games, telecommunications, tickets and video hosting services.

With 44,641 employees in 81 countries, the Complainant's total revenues amounted to €15,898 million worldwide in 2019.

The Complainant is the owner of the international trademarks referred to above and also owns and communicates on the Internet through various domain names, such as <vivendi.com> registered on November 12, 1997.

The disputed domain name was registered on September 9, 2020.

The Complainant states that the disputed domain name is confusingly similar to its trademark "VIVENDI" as it incorporates the trademark in its entirety.

The addition of the term "USA" to the trademark VIVENDI is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and branded goods "VIVENDI".

The Complainant contends that the addition of the generic Top- Level Domain suffix ".COM" does not change the overall impression of the designation as being connected to the trademark of the Complainant. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Therefore, the disputed domain name is confusingly similar with the trademark of the Complainant.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not identified in the Whois by the disputed domain name and therefore is not commonly known by a disputed domain name.

The Complainant contends that the Respondent is not related in any way to the Complainant's business.

The Complainant adds that the Respondent is not affiliated with nor authorized by the Complainant in any way to use the "VIVENDI" trademark. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The website related to the disputed domain name is not used. The Complainant contends that the Respondent did not make any use of the disputed domain name since its registration, and it confirms that the Respondent has no demonstrable plan to use the disputed domain name.

It demonstrates a lack of legitimate interests in respect of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

The Complainant highlights distinctive character of the Complainant's trademarks and their reputation and believes it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

Furthermore, the website related to the disputed domain name is not used.

The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

The Complainant refers to previous UDRP panels that held that the incorporation of a famous mark into a domain name,

coupled with an inactive website, may be evidence of bad faith registration and use.

Thus, the Complainant asserts that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar with Complainant's trademark

The Complainant is the owner of "VIVENDI" trademark registrations.

As confirmed by WIPO Overview 3.0, paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name fully incorporates the "VIVENDI" mark of the Complainant with the addition of the word "USA".

It is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of geographical terms would not prevent a finding of confusing similarity under the first element (see par. 1.8 of WIPO Overview 3.0).

The Panel notes that the addition of the "USA" element does not change overall impression and does not eliminate the confusing similarity between the disputed domain name and the Complainant's "VIVENDI" trademarks.

The trademark is clearly recognizable in the disputed domain name.

The gTLD suffix ".com" is to be disregarded under the confusing similarity test.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110 and CAC Case No. 101284.

The disputed domain name was registered on September 9, 2020 and is inactive.

The Complainant states that the Respondent is not commonly known by the disputed domain name and is not related in any way to the Complainant's business.

The Complainant further asserts that the Respondent is not affiliated with the Complainant nor authorized by the Complainant in any way to use the trademark.

The Complainant contends that the Respondent did not make any use of the disputed domain name since its registration.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095, National Arbitration Forum).

The Complainant has made out a prima facie case and there is no evidence that would demonstrate any possible rights or legitimate interests of the Respondent.

The Panel, therefore, finds that the Complainant satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

The website by the disputed domain name is inactive.

There is a general agreement that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see par. 3.3 of WIPO Overview 3.0 and Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

One has to look at the circumstances of a case taking into account, in particular, the nature of the domain name (e.g., a domain name incorporating the complainant's mark plus an additional term such as a geographic term), the degree of distinctiveness or reputation of the Complainant's mark, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use and the implausibility of any good faith use to which the domain name may be put (see e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246; CAC Case No. 101435, CAC Case No. 101691, CAC Case No. 101640 and par. 3.2.1 of WIPO Overview 3.0).

The Complainant's "VIVENDI" trademark is widely-known and distinctive and had been registered long before registration of the disputed domain name.

Previous UDRP panels found Complainant's "VIVENDI" trademark "highly distinctive and well-established" and having "a considerable reputation" (see CAC Case No. 101875 and Vivendi v. (Wuchaowen), WIPO Case No. D2019-2792).

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see par. 3.1.4 of WIPO Overview 3.0).

The disputed domain name fully incorporates the Complainant's highly distinctive trademark with the addition of a geographic term.

The Respondent failed to respond and provide any explanations and one can hardly envisage any conceivable good faith use of the disputed domain name by the Respondent in these circumstances.

Taking into account all of the above, the Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **VIVENDIUSA.COM**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2020-10-17

Publish the Decision