Decision for dispute CAC-UDRP-104240

Case number	**CAC-UDRP-104240**
Time of filing	**2021-12-17 10:03:25**
Domain names	**vivendipm.com**

Case administrator

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

Complainant

Organization	**VIVENDI**

Complainant representative

Organization	**NAMESHIELD S.A.S.**

Respondent

Name	**Maria Diaz**

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

The Complainant is the owner of at least two international trademark registrations for the wording “VIVENDI”:
- International trademark VIVENDI® n° 687855, registered and renewed since February 23, 1998;
- International trademark VIVENDI® n° 930935 registered and renewed since September 22, 2006.

FACTUAL BACKGROUND

The disputed domain name <vivendipm.com> was registered on December 11, 2021 and redirects to a blank page, showing only a tab stating "This site is under development".

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:
COMPLAINANT:
The Complainant is a French multinational mass media conglomerate headquartered in Paris. The company has activities in music, television, film, video games, telecommunications, tickets and video hosting service. With 42,526 employees in 82 countries, the Complainant’s total revenues amounted to € 16,090 million worldwide in 2020.

The Complainant owns and communicates on Internet through various domain names, such as the domain name <vivendi.com> registered on November 12, 1997.
The disputed domain name <vivendipm.com> was registered on December 11, 2021 and redirects to a blank page.

The Complainant states that the disputed domain name <vivendipm.com> is confusingly similar to its trademark VIVENDI®, as it incorporates the trademark in its entirety.
The addition of letters “PM” 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®. It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”. Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

Several UDRP panels confirmed the Complainant’s rights over the term “VIVENDI”, such as:
- WIPO Case No. D2021-0026, Vivendi v. (Gong Xiao Li) <universal-vivendi.com>;
- CAC Case No. 102885, VIVENDI v. Super Privacy Service LTD c/o Dynadot <vivendiwater.com>;
- CAC Case No. 102736, VIVENDI v. VARUNZ.COM <vivendimediaworks.com>.

According the Complainant, the Respondent does not have any rights or legitimate interest in the disputed domain name
According to the WIPO case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd., the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.
The Complainant asserts that the Respondent is not identified in the Whois as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name.
The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name <vivendipm.com> and that he is not related in any way to the Complainant’s business.
The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use the trademark VIVENDI®. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Moreover, the disputed domain name is not used. The Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that 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 has been registered and is being used in bad faith
The Complainant contends that the disputed domain name <vivendipm.com> is confusingly similar to its distinctive and worldwide known trademarks VIVENDI®. See for instance CAC Case No. 101875, VIVENDI v. Phoenix Global Organization Incorporated (“The Panel is convinced that the Trademarks [VIVENDI] are highly distinctive and well-established.”).
Besides, the Complainant is a diversified content, media and communications group present worldwide, with 42,526 employees in 82 countries and 16,090 million euros in revenues. Therefore, given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks. See for instance WIPO Case No. D2004-0673, Ferrari S.p.A v. American Entertainment Group Inc.
Besides, the disputed domain name resolves to an inactive page. 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 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.
As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. See for instance (WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; or WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen).

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT
The Respondent filed an administratively compliant response in which it states:
“We are in the formality of creating an LLC company named Vivendi Property Management, focused on realtor services and property management services in the state of Florida. Therefore the domain name vivendipm, which was available for purchase.”

Legal Grounds
The disputed domain name is neither identical nor confusingly similar to the protected mark for the following reasons :

The selection of the name was based on its relation with the concept of living, that is directly related to our business mission and needs.

The Respondent has rights and/or legitimate interest in the disputed domain name
Categories of issues involved:
- Use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services
- Use or demonstrable preparations to use

The disputed domain name has not been registered and used in bad faith
Categories of issues involved:
- Meaning of registration
- Acquisition

“The domain in question was purchased in good faith, based on our company name Vivendi Property Management. Our company is focused on realtor and property management services and the name was chosen because of its meaning and had no relation to any other company.”

RIGHTS

The Complainant has shown only that it has two International Registrations. Neither of them designates the United States, where Respondent appears to be located. Respondent has not otherwise shown any registered or common law trademark rights in the United States. Respondent has also not purported to show how the acronym "pm" is relevant to its business. Respondent has not proved that it actually engages in "property management" services in the United States, or anywhere; nor how such services are related to its business as a "diversified content, media and communications group.”
Therefore, in this panel’s view, it is questionable whether Complainant has shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has relevant rights (within the meaning of paragraph 4(a)(i) of the Policy) (“(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.”)
In analysing this first element of the Policy, UDRP panels often disregard the geographic and/or substantive scope of the Complainant’s claimed rights, and merely make a visual determination of similarity. Visual comparison of the registered VIVENDI trademark, with the disputed vivendipm.com domain name, indicates some similarity. But they are not identical. Whether they are “confusingly similar” is debatable, given the addition of the ‘pm’ acronym and the scope of Complainant’s proven rights. Given this panel’s view on the other two elements, it need not reach a view whether Complainant has proved this first element.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, 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). Complainant filed the complaint just three days after the domain name was registered. Respondent has not been given time to put the domain name to use, but

states an intent to do so, in good faith. Respondent states an intent to operate a property management business in Florida, which likely would be a legitimate interest in the domain name; at least, insofar as Complainant appears to have no relevant rights to preclude Respondent from such a business name and/or trademark use in the United States. Therefore, Complainant fails to meet its burden of proof as to this second element of the Policy.

BAD FAITH

The Complainant has not, 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). Complainant filed the complaint just three days after the domain name was registered. Respondent has not necessarily had a reasonable amount of time to put the domain name to its intended use. Respondent states an intent to use the domain name in connection with a property management business in Florida, which likely would be a good faith use of the domain name. It is reasonable for Respondent to have an inactive domain name, just three days after registering it. Complainant offers no evidence as to the distinctiveness of the Complainant's trademarks and reputation in the United States, in relation to Respondent's alleged business or otherwise. Complainant offers no other evidence of bad faith, either. Therefore, Respondent fails to meet its burden of proof as to this third element 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

Complainant fails to prove the second and third elements of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **VIVENDIPM.COM**: Remaining with the Respondent

PANELLISTS

Name	**Mike Rodenbaugh**

DATE OF PANEL DECISION 2022-01-19

Publish the Decision