

Alternative Dispute Resolution (ADR)

DECISION
2013-02-22

TICKET NUMBER
647

APPLICANT

Viacom International Inc.
1515 Broadway, New York
NY 10036
USA

OPPONENT

Kristoffer Ö

MATTER

Alternative Dispute Resolution regarding the domain name <**viacom.se**>.

DECISION

The domain name <viacom.se> is transferred to the Applicant Viacom International Inc.

Background

The domain name <viacom.se> was registered by the Opponent on December 6, 2011.

The application for the ADR proceeding was submitted on December 20, 2012 and the Applicant requested that the dispute should be decided by a sole Adjudicator.

The Adjudicator notes that section 26 of the Rules for Procedure for Alternative Dispute Resolution, allows for an application to be filed in Swedish and English. The decision will therefore be worded in English, the language of the Application.

The opponent has answered within the given time frame.

On January 22, 2013 the files were handed over to the Adjudicator.

CLAIMS

The Applicant has requested that the domain name <viacom.se> be transferred to the Applicant.

The Opponent rejects the claims of the Applicant.

FACTS OF THE CASE / PARTIES CONTENTIONS

Applicant

The Applicant, Viacom International Inc. is a well-known global entertainment company, with a wide range of digital media, television and motion pictures. The Applicant owns prominent brands such as inter alia MTV, Nickelodeon and Comedy Central.

The Applicant has used the trademark VIACOM since 1970 in the US and at least since 1971 in Europe. The Applicant holds four trademark registrations with validity in Sweden. Three of which are national Swedish trademarks, with the first one registered in 1972, reg. no. 0138972, reg. no. 0325741 and reg. no. 0261005. The Applicant is also the holder of the Community Trademark no. 000190199.

The domain name <viacom.se> is identical to the Applicant's trademark, causing confusion for consumers regarding the source of the website, and their affiliation to the same.

The Opponent has not been given a license to use the trademark, nor is he commonly known by the domain name. The domain name is connected to a website where, under the heading

Related searches, different links are found. Among these links are *Nickelodeon* and *Disney*. Nickelodeon is one of the most prominent brands of the Applicant and Disney is one of its biggest competitors. When clicking on one of the links, the visitor is shown more options containing references to the Applicant and its trademarks, or to competitors and their trademarks.

Since it must be assumed that the Opponent is profiting from the ads on the website, the Opponent's use of the domain name must be seen as illegitimate and non-fair, with the intent of commercial gain by misleading internet users when searching for the Applicants trademark and website.

The trademark VIACOM was very well known at the time of the Opponents registration of the domain name, therefore he must have been aware of the trademark. Furthermore a search on the internet or the Swedish PTO would have made the Applicant's rights very clear to the Opponent.

The fact that the website connected to the domain name contains links to Nickelodeon and other brands connected to the Applicant makes it evident that the Opponent was, or at least now is aware of the Applicants business and trademark. According to ADR proceedings no. 355 "jemogfix" and no. 374 "molway", links such as the above mentioned are strong indications of bad faith in the domain name holder, and lack of a legitimate interest.

Moreover, when contacted, the Opponent offered to sell the domain name in question to the Applicant for SEK 20 000, and continued with the above mentioned use even after the explanation of how the described use infringes the rights of the Applicant.

It is not only damaging to the Applicant and its business not to be able to register the domain name <viacom.se>, but also the use of the domain name in the described manner is damaging, with inter alia links to one of its biggest competitors. Furthermore there is an obvious risk that the visitors, including business partners and customers, that are looking for the Applicants trademark and website will be misled to believe that the Opponents website is sponsored by or in any way connected to the Applicant.

Opponent

The Opponent is a Swedish national starting a new business, and was before being contacted by the Applicant on October 31, 2012, unaware of the trademark and business of the Applicant. The Applicant has fully complied with the rules set forth by .SE when registering the domain name, and according to the Swedish PTO a registration of a domain name only constitutes infringement when used to mislead consumers by selling similar goods and services.

The trademark VIACOM is made up of two words, where “COM” is short for communication and “VIA” means by or through. The meaning of the trademark is thus “by [means of] communication”.

The Opponent’s first-hand choice was to register <com.se> or <communication.se>, but the first was blocked, and the second was unavailable. That is why the prefix “via” was used together with “com”.

The terms “via” and “com” render large amounts of hits when searched on the search engine Google, this indicates that the words lack originality. There are also a vast number of businesses that are made up of the word “via” and another word, for example *ViaTravel*. The same goes for company names that include the word “com” for example, *ComHem*. This too is an indication of the lack of distinctiveness for the combination of the words “via” and “com”, and that VIACOM is not protected for all classes of products and services or territories. The two Swedish companies “Viacom Försäljning” and “Viacommunication Media Group AB” are also indications that the Applicant cannot legitimately claim exclusivity to the domain name.

Even though the Applicant shows that they have valid trademark protection in Sweden for VIACOM, the protection is limited to the registered classes. According to Swedish trademark laws, the scope of protection of a trademark is limited to stopping identical or similar trademarks used for identical or similar goods and services. The Applicant is the owner of numerous famous trademarks, but has no Swedish affiliates nor any Swedish presence, except through its subsidiary brands, inter alia MTV, Nickelodeon and Comedy Central. Thus it cannot be taken for granted that the Swedish public is aware of the trademark VIACOM, when there are no direct outlets for, marketing or exposure of any kind of the trademark.

The Opponent was interested in starting up a company within the field of e-trading in 2011, but due to hard competition on the market, he decided to do business as a web shop selling mobile telephone accessories. Due to the named competition on the market, it becomes increasingly important to find a good domain name on which one can build a brand and a web site. It is also natural that the registration of a domain name precedes the registration of a company, and the building of a stock. The domain name was registered on December 6, 2011, with the intent to start the business in the summer of 2012.

The Opponent chose to put ads on the web page while waiting to get the business started. The ads are based on templates with the key words for mobile telephones, and therefore no similarities or risk for confusion between the content of the web site and the Applicant can be found.

Although the start of the business has been delayed, the Opponent intends to use the domain name and the web site as intended in the near future.

The Opponent was not aware of the Applicants trademark or its business prior being contacted by a representative of the company. He isn't affiliated with any competitors to the Applicant. The Opponent has explained the reasons to why he chose the domain name to the Applicant upon contact. The Opponent has not attempted to sell the domain name to the Applicant or any third party.

The links and the ads on the web page should not be considered use in bad faith, since they are automatically generated by Goggle ads. The ads are to be generated by the key words "mobile telephone" and related phrases. The ads are supplied by a third party, and the Opponent has no cooperation with or influence on the supplier. The technology behind these ads use the cookies on the visitor's computer to dynamically create ads suited for each visitor. The reason to why the Applicant sees ads for Nickelodeon and Disney, is because it has in the past searched these words, and visited web pages with connection to these trademarks. A "clean" web browser would only generate ads connected to the key words stated above.

The domain name was registered with the intent to use in the field of mobile telephone accessories, and that is the Opponents intention still. The domain name has never, and will never be used in a manner which infringes the rights of the Applicant. A normally informed and reasonably attentive internet user will not think that the web site under the domain name is in any way connected to the Applicant.

Findings of the Adjudicator

A domain name may, in accordance with .SE's Terms and Conditions of Registration paragraph 7.2, in connection to an ADR proceeding be cancelled or transferred to the Applicant requesting such a proceeding if

- a) the disputed domain name is identical or confusingly similar to a trademark, trade name or similar name right, to which the Applicant have rights, and these rights are in legal force in Sweden, *and*
- b) the domain name holder has no rights or legitimate interest in the domain name, *and*
- c) the disputed domain name has been registered or used in bad faith.

Identical or confusingly similar

The Applicant is the holder of registered trademarks VIACOM in Sweden. The disputed domain name is identical to the registered rights of the Applicant.

Registered or used in bad faith

It is obvious that the Opponent has a high level of knowledge in relation to the Internet, through his argumentation in this matter regarding ad words and the technology behind. The Opponent also states that he was planning to launch an e-business, but decided to start a business through a web page instead. The Opponent emphasises – when starting a new

business - the importance of finding a good, functional domain name before registering the company itself. The Adjudicator finds it unlikely that the Opponent was not aware of the Applicant's existence and potential previous rights when choosing the disputed domain name. Even if the fame of the Applicant and its trademark VIACOM has not been established by the Applicant in this matter, a quick search on the Internet (for the word *viacom*) would have alerted the Opponent of previous rights related to the Applicant. Such search is something an Internet skilled person do when he is about to launch a new business. This is a strong indication of the Opponent being in bad faith when registering the disputed domain name.

Further still, it is clear that the registration prevents the Applicant from exercising its rights to register its trademark as a domain, which is disruptive to the Applicants business.

However, under all circumstances, even if the Internet search history of a visitor of a web page might influence what advertisements and links that will be displayed to the visitor, it is the holder of the web page (the Opponent) that has the ultimate responsibility for the content of the page. The domain name has been pointed to a commercial web page, generating commercial gain to the Opponent every time visitors click on the links that can be found. A number of these links are under the names of affiliates to the Applicant or competitors to the same. This conduct is misleading to consumers and detrimental to the business of the Applicant and must be deemed use in bad faith.

Rights or legitimate interest

The Opponent is using the domain name in bad faith. Such use will not normally create a right or legitimate interest in the domain name. Nothing has been revealed in the matter that would change these findings. Thus, the Opponent lacks a right or legitimate interest to the domain name in dispute.

The Adjudicator concludes that it has been shown that the Opponent has used the domain name <viacom.se> in bad faith and has no legitimate right to the domain name

On behalf of .SE,

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Peter Hedberg