

## **ADMINISTRATIVE PANEL DECISION**

### **Take-Two Interactive Software, Inc. v. Domain Administrator Case No. DTV2013-0006**

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

The Complainant is Take-Two Interactive Software, Inc. of New York, New York, United States of America represented by Mitchell, Silberberg & Knupp, LLP, United States of America.

The Respondent is Domain Administrator of Snohomish, Washington, United States of America.

#### **2. The Domain Name and Registrar**

The disputed domain name <valiant-ent.tv> is registered with Name.com LLC (the "Registrar").

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 19, 2013. On September 20, 2013, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed domain name. On September 23, 2013, the Registrar transmitted by email, to the Center, its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and its contact information as both set forth in the Complaint.

The Center sent an email communication to the Complainant on September 26, 2013 providing the registrant and contact information disclosed by the Registrar and invited the Complainant to submit an amended Complaint. The Complainant filed an amended Complaint on October 1, 2013.

The Center verified that the Complaint together with the amended Complaint (hereinafter collectively the "Complaint") satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint and that the proceedings commenced on October 3, 2013. In accordance with paragraph 5(a) of the Rules, the due date for Response was October 23, 2013. On September 21, 2013, the Response was filed using the Center's Online Response Filing Form, prior to the Center's formal notification of the

Complaint. Upon the Center's formal notification of the Complaint, the Respondent confirmed to the Center that its Response filed on September 21, 2013 is the final Response.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on October 16, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with paragraph 7 of the Rules.

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

##### **A. Disputed Domain Name Registration**

As reflected in the registration record for the disputed domain name in the Registrar's WhoIs database (a copy of that record appears in Exhibit C to the Complaint), the disputed domain name was registered on August 18, 2013 and is set to expire on August 18, 2014.

##### **B. The Complainant**

The Complainant develops, markets and publishes interactive entertainment content for consumers, specifically, video games designed for multiple platforms including personal computers, mobile phones, iOS devices, handheld gaming units and gaming console systems. This content is delivered to its users through physical retail, digital download, online platforms and cloud streaming services.

The Complainant, through a wholly-owned subsidiary Rockstar Games Inc., produces a number of apparently well-known video game series, including the MANHUNT series. The games in these series are distinguished by complex narratives that unfold in large virtual worlds depicting complex environments, politics, entertainment, race relations and other subjects. The games are essentially interactive movies in which the player is in the role of the main character and can influence the outcome of each game. Each game has its own unique storyline with original characters. The MANHUNT series consists of the MANHUNT and MANHUNT2 games released in 2003 and 2007, respectively.

In 2004, the MANHUNT game was nominated at the 7th Annual Interactive Achievement Awards for "Console Action Adventure Game of the Year", is included in the video game reference book *1001 Video Games You Must Play Before You Die* and was listed at number 85 on IGN Entertainment's list of "Top 100 PlayStation 2 Games." The MANHUNT series of games has sold over two million copies.

The plot of MANHUNT games focuses on a death row inmate, James Earl Cash ("Cash"), who is abducted from prison by a company called Valiant Video Enterprises ("Valiant Video"). Valiant Video will film Cash as he fights his way past various assailants Valiant Video has put in his path. If Cash survives, he will earn his freedom. If he fails – or refuses to fight – Valiant Video will kill his family. Cash acts throughout the games at Valiant Video's direction, though constantly trying to find a method of escape that will not harm his family. Valiant Video itself is the omnipresent villain of the MANHUNT games.

Prior to release of the MANHUNT game, the Complainant created a website for Valiant Video to promote that game. The domain name used for this site was <valiant-ent.tv> (the disputed domain name), and the Complainant maintained and used the disputed domain name during 2003-2011. In or about March 2011, the Complainant unintentionally allowed the registration for the disputed domain name to expire.

Visitors to the Complainant's presumably main website encountered popup advertisements (print-outs of which appears in Exhibit A to the Complaint) for the <valiant-ent.tv> website, and, upon clicking on any of those pop-ups, those visitors were directed to the website at <valiant-ent.tv>.

The Complainant has provided, in Exhibit B to the Complaint, printouts from video game message boards where users discuss the Complainant's Valiant Video website, its connection to the MANHUNT series and

also the Complainant.

### **C. The Respondent**

The Respondent registered the disputed domain name two years after the Complainant's registration for that domain name expired. In doing so, the Respondent registered the name through a privacy service provided by the Registrar in order, as noted in its Response, to "avoid spam, and more importantly to keep my private and business life separate".

The disputed domain name resolves to the Respondent's website (screen shots of which are provided in Exhibits D and E to the Complaint), which Respondent states is a "fan site" for the MANHUNT series of games. The website prominently depicts the disputed domain name near the top of its home page followed by an electronic bulletin board formed of series of what appear to be blog entries, primarily textual in nature, submitted by various corresponding individuals. Through these entries, these individuals seem to discuss aspects of the MANHUNT games.

To the extent of the information provided in Exhibits D and E, the Panel did not discern that the Respondent was conducting any commercial activity through this site. Rather, the site was simply hosting user commentary.

Upon receiving a cease and desist email message from the Complainant dated August 29, 2013, the Respondent altered its website to include a disclaimer near the bottom of the home page (as shown in Exhibit E) which stated, "NOT Affiliated with Rockstar Games. Sorry, we make videos, not video games".

The Respondent states that the only reaction it received from its fan site was from a small group of cult fans of MANHUNT games who "mostly understood it was just for fun and appreciated that someone revived the site".

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's common law marks VALIANT VIDEO and VALIANT VIDEO ENTERPRISES. In that regard, the Complainant asserts that the name includes the term VALIANT with the suffix "ent". The latter is simply a well-known abbreviation for "enterprises," which, when added to the term VALIANT, is insufficient to ameliorate any confusion that occurs to Internet users between either of the marks and the name.

Specifically, the Complainant asserts that through its efforts and the attendant publicity which it has received and continues to receive, the VALIANT VIDEO and VALIANT VIDEO ENTERPRISES marks have acquired secondary meaning and thus constitute common law marks.

As evidence of this, the Complainant points to the Respondent's own conduct in registering the disputed domain name (after it expired), and then (a) creating a website, to which that name resolves, for Valiant Video Enterprises and specifically using in its site certain MANHUNT graphics previously created by the Complainant, and (b) shortly thereafter sending email to fan sites dedicated to the Complainant's MANHUNT games with teasers designed to appear as if the Complainant had reinvigorated its prior website at <valiant-ent.tv>.

The Complainant points to the Respondent's plagiarism in copying graphics of the Complainant's prior website as reflecting the Respondent's recognition of the public reputation of those marks as being associated with the Complainant's MANHUNT games. Further, if that reputation did not exist, then it would

be quite doubtful that the Respondent would have had any reason to have copied the Complainant's content into its own website. Thus, the Complainant concludes that "it is impossible for the Respondent to argue with any honesty that the 'Valiant Video' and 'Valiant Video Enterprises' marks do not have trademark meaning strongly associated with the Complainant".

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

**(ii) Rights or Legitimate Interests**

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Respondent is not and has never been authorized by the Complainant to register and use the VALIANT VIDEO or VALIANT VIDEO ENTERPRISES marks or the disputed domain name. Moreover, there is no affiliation between the Complainant and the Respondent.

The Complainant asserts that the Respondent cannot prove that it satisfies any of the provisions ((i)-(iii)) of paragraph 4(c), through which it can show it has acquired rights or legitimate interests in the name. In that regard, the Respondent is not using the name in conjunction with a *bona fide* offering of goods or service under paragraph 4(c)(i). The Respondent is not known by the name and lacks any association with the Complainant, thus unable to qualify under paragraph 4(c)(ii). Lastly, the Respondent cannot establish, under paragraph 4(c)(iii), that it is making legitimate noncommercial or fair use of the domain names without intent for commercial gain to misleadingly divert customers. Consequently, the Complainant concludes that the Respondent is simply "siphoning off of Complainant's fame in order to attract and divert users of the Internet to Respondent's own website in order to profit commercially".

**(iii) Registered and Used in Bad Faith**

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, as the Respondent's website mimics the Complainant's site, which it previously maintained at the same domain name, the only conceivable intent of the Respondent in doing so must have been to imply to users of the MANHUNT games that content and information related to those games can still be found at the site and that the site is still owned, sponsored by or associated with the Complainant.

Furthermore, the Respondent, by registering the name through a privacy service to conceal its true identity and address, also committed bad faith registration and use.

**B. Respondent**

**(i) Identical or Confusingly Similar**

The Respondent does not appear to dispute the Complainant's contention that it has common law trademark rights in its VALIANT VIDEO and VALIANT VIDEO ENTERPRISES marks.

**(ii) Rights or Legitimate Interests**

However, the Respondent implicitly contends that it has rights and legitimate interests to the disputed domain name under paragraph 4(c)(iii) of the Policy. Specifically, the Respondent states that its website is simply a fan site for the MANHUNT series of games and thus its use of the name in connection with that site is a fair use.

### **(iii) Registered and Used in Bad Faith**

Lastly, the Respondent contends that, for any of several reasons, its registration and use of the disputed domain name does not reflect bad faith.

First, the Respondent states that VALIANT is a purely fictitious company, portrayed on the MANHUNT games, which was never in commercial operation and hence never offered any real services or products.

Second, as to the specific examples of activities that constitute bad faith under paragraphs 4(b)(i)-(iv) of the Policy, the Respondent contends the following:

(a) with respect to paragraph 4(b)(i), the Respondent has not registered the name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs of registration. In that regard, if the Respondent intended to attempt to sell the name to another, the Respondent would not have used it, as it did, for a fan site. Moreover, the Respondent did not attempt to sell the name to the Complainant.

(b) with respect to paragraph 4(b)(ii), the Respondent did not register the name to prevent the Complainant from reflecting either of its marks in a corresponding domain name, let alone engaged in a pattern of such conduct. In that regard, the Complainant expressly acknowledged that it previously owned the name from 2003-2011 but let its registration expire. Thereafter, the name was effectively released back into the pool of names available for public registration. After a further two year period, the Respondent registered the name in August 2013. As such, it is reasonable to conclude, as most fans of the MANHUNT games did, that not only did the Complainant retire its website to which the name once resolved but also retired the MANHUNT franchise itself, hence providing no new content or games in that series. The Respondent questions why, if the Complainant thought that the name was so important to it, did the Complainant wait two years to retrieve the name.

(c) as to paragraph 4(b)(iii), the Respondent did not register the name primarily for the purpose of disrupting the business of a competitor. In that regard, the Respondent is not and has never been a competitor of the Complainant, as the Respondent does not produce video games. Rather than competing with the Complainant, the Respondent is actually a large fan of the Complainant's MANHUNT games.

(d) as to paragraph 4(b)(iv), the Respondent did not intentionally attempt to attract, for financial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. In that regard, VALIANT VIDEO ENTERPRISES is not a real company or product but rather a fictitious entity within the MANHUNT games, and as such, brand confusion could not occur. That entity is an obscure part of a fictitious world; it is not a product or brand itself which was ever in commercial operation. Further, the Respondent's website is purely a fan site, devoid of any commercial or business aspects.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar, Registered and Used in Bad Faith**

A fundamental issue exists as to whether, under the evidence of record, either or both of the terms VALIANT VIDEO or VALIANT VIDEO ENTERPRISES, as used by the Complainant within its MANHUNT series of video games, have acquired sufficient distinctiveness in the gaming marketplace such that one or both of those terms have acquired legal status as common law trademarks.

Fortunately, based on the finding that the Respondent has rights and legitimate interests in the disputed domain name predicated on its use in conjunction with a valid fan site, the Panel need not and will not opine on either this issue or whether the Respondent's use and registration of the name reflected bad faith — as both issues are now moot.

## B. Rights or Legitimate Interests

Despite the Complainant's assertions to the contrary, the Panel finds that the Respondent has established its rights and legitimate interests in the disputed domain name under paragraph 4(c)(iii) of the Policy.

Paragraph 4(c) of the Policy states:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name ...iii) you are making a legitimate noncommercial or *fair use of the domain name*, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue" [emphasis added].

Contrary to the Complainant's view, the Panel finds no evidence from the pages of the Respondent's website provided by the Complainant, in Exhibits D and E to the Complaint, that the Respondent is undertaking any commercial activity whatsoever through its website. The website appears to be just what the Respondent says it is: a fan site, nothing more. The site provides commentary of users, in the form of a series of primarily textual blog entries regarding the Complainant's MANHUNT games. The Panel does not opine on any specific characteristic of the commentary, as doing so lies outside the Panel's rather narrow purview, but limits its view to the website's general nature, the latter sufficing for the Panel to assess the purpose of the Respondent's website in analyzing the Respondent's use of the disputed domain name under the Policy.

Further, the Panel finds that the Complainant's failure to renew its domain registration and not act promptly in re-registering the name is, realistically, a causative element in the Respondent's own action in establishing its fan site at the disputed domain name. Though the Panel does not question — nor does the Respondent — that the Complainant's failure was inadvertent, nevertheless, it stands to reason that if the Complainant accorded sufficient importance, whether commercial or otherwise, to the disputed domain name, then the Complainant would have taken appropriate and sufficient steps to either prevent its registration to that name from expiring in the first instance back in 2011 or simply re-register the name within the two year period that elapsed between the time the Complainant's registration to the name expired in 2011 and August 18, 2013 when the Respondent registered the name. The Complainant did neither. Having effectively cast the disputed domain name into the public arena where it could be registered by any party, the Complainant cannot now validly complain if two years later the Respondent (or any other third-party) registered the name for a legitimate use, including as here, a fan site for the Complainant's own MANHUNT series of games. The Respondent, by registering the name, did not prevent the Complainant from reflecting either of its marks — to the extent the Complainant has any common law trademark rights in either of the terms VALIANT VIDEO or VALIANT VIDEO ENTERPRISES — in a domain name; the Complainant's inaction over a sufficiently long period of time simply did so itself.

Additionally, there is no evidence of record in the Respondent's website that the Respondent is intentionally misrepresenting itself as being associated with the Complainant, nor has the Complainant provided any other evidence of record supporting such misrepresentation. Nevertheless, in response to a concern harbored by the Complainant and stated to the Respondent that visitors to the Respondent's site might perceive such an association, the Respondent then inserted a disclaimer in its home page disavowing such association.

Under the specific facts of the record here and particularly given the general nature of the commentary provided on the Respondent's website and its absence of any commercialization whatsoever or intentional misrepresentation of the Complainant, the Panel finds that: (a) the Respondent's website is a valid fan site; and (b) the Respondent's use of the disputed domain name (arguably being confusingly similar to the terms VALIANT VIDEO or VALIANT VIDEO ENTERPRISES — again assuming that the Complainant has any common law trademark rights in either of the terms) in conjunction with that site is a fair use.

Further, there is no evidence of record that the Respondent's use of the name in any way tarnishes whatever

trademark rights, if any, the Complainant has in either of those terms.

Consequently, the Respondent's use of the disputed domain name to address a valid fan site falls squarely within the ambit of paragraph 4(c)(iii) of the Policy and thus is legitimate. See WIPO Overview of WIPO Panel Views on Selected UDRPO Questions (WIPO Overview 2.0), paragraph 2.5 and specifically views 1 and 2 as well as cases cited therein.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

**Peter L. Michaelson**

Sole Panelist

Date: October 21, 2013