

DISPUTE RESOLUTION SERVICE

D00009674

Decision of Independent Expert

Furniture Village Limited

and

Furnitureland.co.uk Ltd

1. The Parties:

Complainant: Furniture Village Limited
258 Bath Road
Slough
Berkshire
SL1 4DX
United Kingdom

Respondent: Furnitureland.co.uk Ltd
Chancery Pavilion
Boycott Avenue
Milton Keynes
Buckinghamshire
MK6 2TA
United Kingdom

2. The Domain Name:

furnitureland.co.uk

3. Procedural History:

09 March 2011 19:30 Dispute received
10 March 2011 12:18 Complaint validated
10 March 2011 12:28 Notification of complaint sent to parties
01 April 2011 08:53 Response received
01 April 2011 08:53 Notification of response sent to parties
06 April 2011 02:30 Reply reminder sent
07 April 2011 16:00 Reply received
07 April 2011 16:00 Notification of reply sent to parties
07 April 2011 16:01 Mediator appointed
12 April 2011 11:01 Mediation started
12 August 2011 12:22 Mediation failed

12 August 2011 12:23 Close of mediation documents sent
22 August 2011 11:35 Expert decision payment received

4. Factual Background

The Complainant, Furniture Village Limited, is a limited company that sells furniture. Furnitureland Limited was a separate business that was incorporated in 1973. It became a substantial business with 21 retail stores and a turnover of close to £65 million in the financial year 2003/04. On 19 September 2005 Furnitureland Limited applied to register two trade marks that incorporated the mark FURNITURELAND. Those applications matured into registrations on 10 March 2006. In the interim, Furnitureland Limited entered Administration on 22 September 2005. On 3 March 2006 the Administrators of Furnitureland Limited assigned the two then pending applications to the Complainant.

The Domain Name was registered on 12 April 2009 by Global Publications Limited, a limited company that is owned and controlled by Barry Garner. The Respondent, Furnitureland.co.uk Limited, is a limited company that is also owned and controlled by Barry Garner. It was incorporated at Companies House ten days after the Domain Name was registered. At some point following receipt of a cease and desist letter from the Complainant dated 27 July 2010 the Domain Name was transferred by Global Publications Limited to Furnitureland.co.uk Limited.

The Domain Name is directed to a web site that offers furniture for sale.

Preliminary issue

On 8 September 2011 the Respondent's representative sent an e-mail to Nominet stating that the Respondent had applied for revocation of the two registered trade marks that are relied upon by the Complainant. The Respondent submitted that the revocation proceedings fell within the scope of paragraph 20 of the Procedure which reads as follows:-

a. If legal proceedings relating to a Domain Name are issued in a court of competent jurisdiction before or during the course of proceedings under the DRS and are brought to our attention, we will suspend the proceedings, pending the outcome of the legal proceedings.

b. A Party must promptly notify us if it initiates legal proceedings in a court of competent jurisdiction in relating to a Domain Name during the course of proceedings under the DRS.

It is clear from material provided to the Expert that the revocation proceedings were commenced on 10 June 2011. There was no explanation from the Respondent as to why Nominet had not been notified of the applications for revocation earlier in the DRS process.

The Respondent argues that since the claim to rights in the Domain Name relies on the registered trade mark rights the revocation proceedings go to the heart of the dispute between the parties in the DRS. The Respondent asked Nominet to suspend the DRS proceedings under paragraph 20 of the Procedure.

Nominet responded on 12 September 2011 (copying in the Complainant) pointing out that an application for revocation of a trade mark was not, on the face of it, a legal

action over the status of the Domain Name. Nominet took the position that, in the absence of consent from the Complainant (which was not forthcoming), the DRS proceedings should run their course.

There was a further exchange of e-mails between the Respondent's representative and Nominet on the subject (which was copied to the Complainant) but Nominet maintained that a trade mark revocation application relates to a trade mark registration and not to a domain name registration.

The Expert has considered this point as a preliminary issue and makes a finding that the applications for revocation of the two registered trade marks do not fall within paragraph 20 of the Procedure as they are not legal proceedings relating to the Domain Name.

5. Parties' Contentions

5.1 Complainant

The Complaint, so far as material, is summarised below.

5.1.1 Rights

The Complainant is the registered proprietor of the following UK trade marks:-

Number	Mark	Date filed	Date registered	Classes
2401897	FURNITURELAND	19/09/05	10/03/06	20, 27 and 35
2401896	furniture inspired interiors	19/09/05	10/03/06	20, 27 and 35

The trade mark registrations were assigned by Furnitureland Limited to the Complainant pursuant to a Deed of Assignment dated 3 March 2006, together with the goodwill of the business associated with the trade marks.

Furnitureland Limited was incorporated in 1973 and in the years prior to the assignment operated 21 retail outlets throughout England and Wales, mostly on prime out-of-town retail or destination parks, selling a wide range of quality furniture, upholstery, beds and carpets.

Furnitureland Limited owned the Domain Name prior to the Respondent and promoted its business through a website at that address. Furnitureland Limited operated a furniture retail website at the Domain Name and operated stores in Bolton, Bristol, Cardiff, Chester, Croydon, Enfield, Finchley, Wednesbury, Leicester, Manchester, Nottingham, Peterborough, Plymouth, Poole, Reading, Slough, Southampton, Stevenage, Thurrock, Watford and Wembley.

The turnover in the business of the goods and services provided under the FURNITURELAND trade marks in the years immediately prior to the assignment to the Complainant was:

- 53 weeks ended 2 October 1999: £54,471,000
- 52 weeks ended 30 September 2000: £66,826,000
- 18 months ended 18 March 2002: £102,558,000
- 52 weeks ended 29 March 2003: £70,950,000
- 52 weeks ended 27 March 2004: £64,741,000

The presence of 21 retail stores throughout England and Wales and such significant levels of turnover demonstrate that an enforceable goodwill in the business of the goods and services provided under the FURNITURELAND trade mark was assigned to the Complainant. The Complainant took an assignment of an enforceable common law, passing off right.

The trade mark FURNITURELAND is inherently distinctive as evidenced by the registration of the trade mark by the UK Intellectual Property Office. The trade mark enjoys enhanced distinctiveness by virtue of significant use. At the date of registration of the Domain Name, the trade mark enjoyed a reputation in the United Kingdom.

5.1.2 Abusive Registration

The supply of furniture retail services under the Domain Name by the Respondent constitutes a misrepresentation to the public that the Respondent's business is that of the Complainant, or is in some way associated with the Complainant's business. Such a misrepresentation is damaging to the Complainant's business as it impairs its ability to offer such retail services exclusively by reference to the trade mark FURNITURELAND and there is the risk that the supply of services or products of an sub-standard quality will tarnish the reputation of the Complainant.

As proprietor of goodwill (by assignment) in the business conducted under the FURNITURELAND trade mark, the Complainant was entitled at the date of registration of the Domain Name, and remains entitled, to prevent the Respondent's supply of furniture retail services under the Domain Name and trade mark FURNITURELAND.co.uk, under proceedings for passing off.

It is highly unlikely, almost inconceivable, that the Respondent, a company operating in the business of furniture sales, would not have heard of Furnitureland Limited and the Complainant's trade mark FURNITURELAND at the time of registration of the Domain Name on 12 April 2009. A simple search of the UK Register of Trade Marks would also have confirmed the Complainant's title to the FURNITURELAND trade mark.

Under Section 10(1) of the UK Trade Marks Act 1994, the supply of furniture retail services by the Respondent under the Domain Name and trade mark FURNITURELAND.co.uk constitutes an infringement of the Complainant's FURNITURELAND registrations. The respective marks are identical and the services of the Respondent identical to the Class 35 services of the FURNITURELAND registrations.

The Respondent's supply of retail services under the Domain Name constitutes an infringement of the Complainant's FURNITURELAND registrations under Section 10(2)(b) of the Trade Marks Act 1994 as there exists a likelihood of confusion on the part of the public, including a likelihood of association.

The supply of furniture retail services under the Domain Name constitutes infringement of the FURNITURELAND registrations under Section 10(3) of the Trade Marks Act 1994 in that the FURNITURELAND trade mark has a reputation in the United Kingdom and the supply of furniture retail services under the Domain Name being without due cause, takes unfair advantage of, and is detrimental to, the distinctive character or the repute of the trade mark.

The Domain Name constitutes an Abusive Registration because the identity/similarity between the Complainant's FURNITURELAND trade mark and the Domain Name is such that the relevant public will believe that they are used by the same undertaking, or that there is an economic connection between the users of the marks. The supply of furniture retail services under the Domain Name constitutes passing off and infringement of the FURNITURELAND registrations.

The Respondent, if not aware of the Complainant's title to the FURNITURELAND trade mark at the date of registration of the Domain Name, could easily have identified the Complainant's rights through a simple trade mark search. The Domain Name was registered to free-ride on the Complainant's goodwill and reputation associated with the FURNITURELAND trade mark. By misappropriating the advertising value of the Complainant's FURNITURELAND trade mark, the interest in the Respondent's services is likely to be stimulated to a disproportionately high extent in comparison to the size of its own investment.

The provision of sub-standard services could tarnish the Complainant's reputation in its FURNITURELAND trade mark, thereby causing damage to its business.

The use and registration of the Domain Name could lead to dilution of the ability of the Complainant's trade mark to distinguish its services: the capacity to stimulate the desire of the public to buy the goods/services for which the mark is registered would be diminished, causing further damage to the Complainant's business.

The acquisition by the Respondent of the Domain Name is for the purpose of blocking the Complainant's rightful registration of the Domain Name and disrupting the business of the Complainant.

The Domain Name was originally registered in the name of Global Publications Limited. Shortly after receipt of a letter from the Complainant dated 27 July 2010 setting out its claim to the Domain Name the Domain Name was transferred to the Respondent. The Respondent and Global Publications Limited are both controlled by Mr Barry Garner. The transfer took place in order to thwart the Complainant's claim against Global Publications and, as such, is a further indication that the Domain Name was obtained and trafficked as an Abusive Registration.

The Complainant seeks a transfer of the Domain Name.

5.2 Respondent

The Response was submitted by Barry Garner who accepts that he owns and controls both Global Publications Limited and Furnitureland.co.uk Limited. For the purposes of these proceedings the Expert intends to treat Mr Garner and his two companies as one.

The Response, so far as is material, is summarised below.

5.2.1 Rights

The two registered trademarks relied upon by the Complainant were applied for by Furnitureland Limited (Furnitureland) which had traded using the FURNITURELAND mark for many years. However, Furnitureland went into administration in 2005, then into liquidation and was finally dissolved in 2010.

The Complaint contains no allegation of use of the registered trade marks by the Complainant and the Respondent is not aware of any use by the Complainant of the FURNITURELAND mark, nor of the figurative mark "furnitureland inspired interiors".

As a consequence of the absence of use for over 5 years since the assignment of the trade marks, neither the Respondent, nor any part of the public, associate the mark FURNITURELAND with the Complainant. The Respondent did not know the Complainant had any such alleged rights until receipt of the letter of complaint in 2010.

The Complainant does not have any common law rights that are similar to the Domain Name since it has never used a similar mark.

The Complainant used the website at the Domain Name to advertise its goods without objection from around April 2009 until Feb/March 2011. The Complainant cancelled the advertising link almost immediately before filing the Complaint.

The figurative mark "furnitureland inspired interiors" is not similar to the Domain Name.

The registration of a trade mark does not necessarily mean that the mark is inherently distinctive, as it may have acquired distinctiveness through use. There was a period of over 20 years between the time that Furnitureland commenced trading and the application for the registration of the first trade mark.

Any acquired distinctiveness that enabled the trade marks to be registered belonged to Furnitureland, being the Complainant's predecessor. The Complainant has advanced no evidence that they have used either of the registered trade marks on which its claim relies. Any acquired distinctiveness would not remain more than 5 years since the last use of the mark, especially when that use was by a third party and not use by the Complainant. There no longer remains any goodwill attached to the FURNITURELAND mark.

The Respondent registered the Domain Name because he thought it was an attractive, generic and descriptive domain name and that he would be able to build a website on it that would enable him to advertise furniture products that third parties could supply and he would receive payment of commission in return. This is a legitimate use of a generic and descriptive domain name.

The Domain Name was caught by a commercial drop catcher in 2009 for a figure claimed by the Respondent to be well in excess of the basic domain name registration fee. The Domain Name is an attractive two word domain that lends itself to descriptive use for the resale of furniture products. It is common place that shops use Land and similar additional words along with the generic term of the goods for sale.

In the absence of any use by the Complainant of the mark any alleged goodwill that may have been assigned in 2006 (which is not admitted) would have long since dissipated and ceased to exist.

The alleged transfer of intellectual property rights from Furnitureland to the Complainant in 2006 did not include a transfer of the Domain Name. It was highly disingenuous of the Complainant not to mention that fact.

The Complaint does reference historic use of the Domain Name by Furnitureland, but that use pre-dates the company going into administration and is not an accurate reflection of the use made of the Domain Name for a number of years prior to it lapsing and being caught and then bought in good faith by the Respondent. The Administrators/Liquidators of Furnitureland did not consider the Furnitureland business to be one that could carry on as a going concern.

The Complainant's lack of transparency points to attempted Reverse Domain Name Hijacking.

5.2.2 Abusive Registration

Use of the Domain Name for the online sale of furniture is bona fide use of the Domain Name, utilising its descriptive nature and amounts to a genuine offering of goods and services under paragraph 4(a)(i)A of the Policy.

It also shows that the Respondent is making fair use of a generic and descriptive Domain Name under paragraph 4(a)(ii) of the Policy.

The allegation that the provision for sale of furniture under the Domain Name amounts to a misrepresentation to the public that the Respondent's business is associated with the Complainant's business is totally misconceived. The Complainant has never traded under the name FURNITURELAND and so the public will have no association between the Complainant and the Domain Name.

The allegations of passing off and trade mark infringement are misplaced and misconceived and should not form part of a DRS Complaint. In so far as the allegations need to be addressed, it is denied that the Complainant enjoys any goodwill in the name FURNITURELAND. It has never traded under the name and any goodwill that it purportedly acquired attached to Furnitureland and, in the absence of any continuation of trade, has now long since dissipated.

There was no goodwill at the time of the assignment given that Furnitureland had failed and gone into liquidation, leaving a large number of unsatisfied creditors and customers.

The Respondent's line of business is acquiring good generic and descriptive domain names and developing them. The Respondent is not from a furniture business background, he saw the Domain Name and felt that it would be a successful name for providing links to online and offline furniture suppliers.

The Respondent knew of Furnitureland before it went into liquidation. He was aware that it had gone bust and believed that it no longer existed and there was no likelihood that it would ever trade again. The Administrators/Liquidators conceded that the serious efforts to avoid liquidation (including a cash injection of £4 million) had failed and they consequently dismissed the idea of continuing to trade as Furnitureland.

The Respondent carried out a Google search to see if anyone was trading using the name Furnitureland. The only third party revealed by that search that might have been relevant was Oak Furniture Land, but their brand was sufficiently different that there should not have been any confusion. Oak Furniture Land have advertised on the Domain Name since its first use without complaint and continue to be a major advertiser on the website.

The Respondent registered the Domain Name in good faith, on the basis that the Domain Name was a good descriptive and generic domain name that could be used to establish a website that could be used to utilise the descriptive quality of the Domain Name to provide a bona fide offering of goods and services.

There is no possibility of confusion in the minds of the public in respect of the Complainant's goods and services using the FURNITURE VILLAGE mark and the Domain Name. There is no public association of the Complainant with either of the unused registered marks that it seeks to rely on.

There has been no actual confusion and the Complainant was happy to use the Respondent's services to advertise its goods (using the FURNITURE VILLAGE mark) from around April 2009 until February/March 2011. It would not have done this if it felt that the registration and use of the Domain Name was abusive, much less that the Respondent registered it with fraudulent intent.

The Complainant has undergone a recent change in marketing strategy and has decided to revive the FURNITURELAND brand. They applied on 25 February 2011 for a new trade mark for FURNITURELAND.

The Respondent accuses the Complainant of a lack of transparency in that it failed to mention in the Complaint that (i) it had applied for a new trade mark for FURNITURELAND (using the same trade mark attorneys that submitted the Complaint) and (ii) the assignment in 2006 did not include a transfer of the Domain Name. The Respondent seeks a declaration of Reverse Domain Name Hijacking.

The Respondent did not undertake a trade mark search. He says that if he had done so, he would have assumed (in the absence of any use being made of the trade marks) that they had effectively been abandoned. The Respondent says that it is unreasonable to impose a duty to consider information that he did not have at the relevant time. The DRS does not impose a duty of perfect due diligence on a domain name registrant – rather it requires that he does not deliberately engage in an abusive domain name registration – either at the time of registration or at the time any use of the domain name commences. The Respondent denies that he could have set out to take advantage of the Complainant's alleged rights when he did not know they existed.

The Respondent accepts that both Global Publications Limited and Furnitureland.co.uk Ltd are owned and controlled by Barry Garner. He denies there is anything sinister about this, and points out that the transfer by Global Publications Limited would not have been a particularly useful device since it was quite transparent. The Respondent says that he undertook the transfer for internal organisational reasons, as he has done for other domain names that are active trading entities.

Furnitureland.co.uk Limited was incorporated on 22 April 2009 which was more than a year before the Respondent first had notice of the Complainant's cause for complaint set out in the letter dated 27 July 2010. This shows there was nothing sinister in the appearance of Furnitureland.co.uk Ltd as the registrant of the Domain Name and that it had been planned long before the Complainant's letter was sent.

The Respondent is happy to accept the Complainant's contention that there was no effective transfer of ownership when the Domain Name was moved to Furnitureland.co.uk Ltd. All questions of registration and use should be viewed as

commencing with the registration in 2009 and the subsequent development of the website on the Domain Name.

5.3 Reply

The Reply, so far as is material, is summarised below.

Nothing turns on the fact that Furnitureland Limited entered into administration after the assignment of Furnitureland Limited's intellectual property rights in the FURNITURELAND name to the Complainant.

The Complainant is using the FURNITURELAND trade mark in connection with furniture and the sale of furniture. Even if there had been no use of the trade mark this would not be fatal to the Complaint.

The FURNITURELAND name is distinctive when used in connection with furniture products and the sale of such products. The Respondent has not provided any indication of what it means when it says the name is 'generic' and has not provided any evidence that the name is 'generic'.

The Intellectual Property Office has found that the FURNITURELAND name is not devoid of any distinctive character and does not consist entirely of a sign or indication which may serve to designate any characteristic of furniture or retail services relating to furniture. The Complainant's recent UK Trade Mark Application No. 2573522 for FURNITURELAND has been accepted prima facie by the Intellectual Property Office as a distinctive name and, thus, one which was not descriptive or 'generic'.

The Respondent is mistaken in its assertion that the FURNITURELAND name is an 'attractive generic and descriptive' name and, as such, it was free to register and use the name as a Domain Name. The Domain Name consists of the inherently distinctive word FURNITURELAND, the rights to which reside with the Complainant.

The Respondent admits that it was aware of the FURNITURELAND name being used and owned by the Complainant's predecessors in title. The fact that the Respondent mistakenly made an assumption that the rights in the name were somehow 'abandoned' provides no defence. Indeed, bearing in mind the Respondent was aware of the longstanding use of the FURNITURELAND name, it would have been entirely reasonable for it to have conducted some straightforward checks to ascertain whether there were any enduring rights, in particular whether there were any registered trade mark rights with effect in the United Kingdom.

It is accepted that the Complainant placed advertising for another of its brands (Furniture Village) on the Domain Name but the Complainant was unaware of the placement of the advertising. The Complainant hired a media consultant to place online advertising for its Furniture Village trade mark. The advertising was placed with many affiliates which were approved automatically by the media consultant. The Complainant withdrew that advertising when it became aware of the Domain Name.

The Complainant has clear rights in the FURNITURELAND name and has a strong case that the Domain Name is an Abusive Registration. The allegations that there is a lack of good faith in the Complaint and that the Complaint is an attempted Reverse Domain Name Hijacking are fanciful and strenuously denied.

The omission of any reference to the Complainant's recent UK trade mark application for FURNITURELAND (No. 2573522) is for no other reason than it post-dates the relevant period for the current proceedings.

The Respondent states that 'The DRS does not impose a duty of perfect due diligence on a domain name registrant – rather it requires that he does not deliberately engage in an abusive domain name registration...'. In response to this point, the Complainant has reviewed the co.uk and .org.uk domain names owned by Global Publications Limited (the erstwhile proprietor of the Domain Name and a company which the Respondent admits is owned and controlled by the same hand – Barry Garner – as itself), and it is clear that they are engaged in registering domain names which they know to be 'abusive'.

For example, the Global Publications Limited owns domains consisting of, or containing, third party brands, or obvious misspellings of those brands, such as:

aeg.org.uk
360xboxes.co.uk
barclaycapital.co.uk
barclaysloan.co.uk
barcleysbank.co.uk
barcleysinsurance.co.uk
barcleysbank.co.uk
barklaybank.co.uk
bootsalliance.co.uk
creditswiss.co.uk
deutschbank.co.uk
halifaxpropertysales.co.uk
natwests.co.uk
sainsberry.co.uk
sainsberrys.co.uk
sainsburysupermarket.co.uk
tescointernetphones.co.uk
tescosjobs.co.uk
tescostelecom.co.uk
tsbbanking.co.uk
wii.org.uk
xboxes.co.uk
yorkweights.co.uk

It also owns domains consisting of the names of famous individuals, groups or obvious misspellings of the same, such as:

adrianmutu.co.uk
alanturing.co.uk
benaffleck.co.uk
boyszone.co.uk
elizabethhurley.co.uk and lizhurley.co.uk
emileheskey.co.uk
fatmanscoop.co.uk
gerryadams.co.uk
howardstern.co.uk
jamesmcavoy.co.uk
janetstreetporter.co.uk
keanureeves.co.uk
melgibson.co.uk
puffdaddy.co.uk
silvioberlusconi.co.uk

susanboyles.co.uk
tyrabanks.co.uk

In addition, it owns domains consisting of well known television programmes, such as:

bigbrothersbigmouth.co.uk
coleensrealwomen.co.uk
datemydaughter.co.uk
mtvswitch.co.uk
soyouthinkyoucandance.co.uk
thejuniorapprentice.co.uk
theonlywayisessex.co.uk
theressomethingaboutmiriam.co.uk

It also owns the domain of a local government agency - northlanarkshirecouncil.co.uk – and, further, domains relating to educational establishments, such as:

bristoluniversity.co.uk
burtoncollege.co.uk
universityofbirmingham.co.uk
universityofbristol.co.uk
universityofleicester.co.uk

Furthermore, as a result of DRS Decision Nos. D00007578, D0003840, D00006550 and D00005815, Global Publications Limited has been ordered to transfer the following domains:

fsecure.co.uk
wagamammas.co.uk
lloydsbanking.co.uk
lloydstsbfactoring.co.uk
lyodsbank.co.uk
loydstsbbank.co.uk
bertelsmann.co.uk

There is a clear history of the Respondent, or its directly-related companies, registering or otherwise securing ownership of domains which it knows are abusive. As such, the Respondent's assertion that it was acting in good faith when securing ownership of the Domain Name does not stand up to scrutiny. There is a clear pattern of the registration of domain names which take unfair advantage of third party intellectual property rights.

Bearing in mind the above, it is clear that the real purpose of the transfer from Global Publications Limited to Furnitureland.co.uk Limited was to hide Global Publications Limited's history of engaging in the mass registration of abusive domains. The transfer of the Domain Name from one company to another, where both are directed by the same hand, does not negate the abusive nature of the registration.

The Complainant owns the rights to the FURNITURELAND name in connection with, amongst other things, furniture and the retail of furniture. The registration of the Domain Name is a blocking registration which is designed to prevent the Complainant from securing ownership of the Domain Name in circumstances where the Respondent is unable to demonstrate a prima facie right in the Domain Name or any valid reason to make the registration.

The website at the Domain Name offers a series of advertising links through to third party furniture retailers, in addition to providing a platform for the sale of third party furniture products. As such, the Domain Name was registered and is being used for the purpose of unfairly disrupting the business of the Complainant by misleading consumers into believing that the furniture goods and services found on the website are provided by the Complainant or are otherwise connected to the Complainant.

Further, by using the website to secure income from advertising third party furniture products, the Respondent is taking unfair advantage of the Complainant's FURNITURELAND trade mark and the associated goodwill.

The suggestion by the Respondent that its use of the Domain Name serves only to provide a genuine offering of goods or services and, as such, that the Domain Name is not an Abusive Registration is a fallacy. The Respondent uses the Complainant's FURNITURELAND trade mark as a Domain Name in order to bait Internet users to its website and then switch them to third party websites, whilst receiving advertising revenue in the process. This does not constitute bona fide use of the Domain Name.

5.4 Notice under paragraph 16 of the Procedure and invitation for submissions

On 16 September 2011 the Expert issued a notice under paragraph 16 of the Procedure that he intended to refer to a document in the Decision that was not supplied with the case papers. The notice is reproduced below and the Expert invited submissions from the parties.

One of the issues in this dispute is the extent to which the Complainant has used the registered trade mark FURNITURELAND. The Complainant addresses this issue in paragraph 3 of its Reply in the following terms:-

The Respondent states that the complaint contains no allegations of use of the registered trade marks by the Complainant. In response, we advise that the Complainant is using the FURNITURELAND trade mark in connection with furniture and the sale of furniture. In this regard, we attach printouts from the Complainant's website demonstrating such use. In any case, were there to be no use of the trade mark, this would not be fatal to the complaint.

There were four screenshots attached to Reply from a website at www.furnitureland.uk.com. There is no date on those screenshots. The Expert carried out a whois search at www.whois-search.com, a copy of which is attached. This shows that the domain name furnitureland.uk.com was created on 15 February 2011.

The notice to the parties stated that the Expert intended to refer to the whois search in the Decision as evidence that the domain name furnitureland.uk.com was created on 15 February 2011.

5.4.1 Complainant's submission

The Complainant responded to the notice by e-mail to Nominet dated 26 September 2011 confirming, for the sake of clarification, that it was agreeable to the Expert referring to the whois search for furnitureland.uk.com.

5.4.2 Respondent's submission

On 26 September 2011 the Respondent lodged a submission in response to the notice. The submission went beyond making submissions on the narrow point raised in the notice from the Expert about the whois search for furnitureland.uk.com. It went into detail about the challenge to the validity of the Complainant's trade marks, the communications with Nominet in support of the (unsuccessful) request for a suspension of the DRS process under paragraph 20 of the Policy, the effect of subsequent trade mark registrations, the issue of reverse domain name hijacking and it made a number of submissions on points raised in the Reply. The notice from the Expert was directed at a discrete point and (save for reference to one statement made by the Respondent referred to in the analysis under paragraph 3(a)(iii) below) the Expert intends to disregard submissions that are not concerned with the registration of the domain name furnitureland.uk.com.

The submissions from the Respondent (limited to the issue identified in the notice) are summarised below.

The Registrant notes that the purported use of the domain name on which the Complainant seeks to rely is highly questionable. The domain name was only registered on 15 February 2011, a mere three weeks before the DRS Complaint was filed on 9 March 2011.

The Respondent wishes to question the bona fides of the purported website. The Respondent also notes that no reference was made in the Complaint to the furnitureland.uk.com domain and the purportedly active website on which the Complainant now seeks to rely. Any such rights should have been set out in the Complaint, as required under DRS Procedure 3(c)(v), which states that the Complaint "*shall...describe... what Rights the Complainant asserts in the name or mark...*".

Even if the Complainant submits that the furnitureland.uk.com domain name was used prior to the Complaint being filed (which is denied); and even if the Expert determines that this is sufficient to provide the Complainant with "rights" under the Policy (which is also denied) – then even that would not suffice to show that this was an Abusive Registration. DRS appeal cases establish that the registrant must know of the Complainant's rights prior to either the registration of the Domain Name or the use of the Domain Name that is complained about. In this case, any use that it is alleged may have followed the registration of the domain name furnitureland.uk.com on 15 February 2011 must, by definition, post date the relevant dates for the Respondent's knowledge in this case. The Complainant's submission that a lack of knowledge of the Complainant's alleged rights is not relevant, is wrong. For a registration to be abusive under the Policy, some *mala fides* at the relevant date must be shown.

6. Discussions and Findings

6.1 General

In order for the Complainant to succeed it must (pursuant to Paragraph 2 of the Policy) prove to the Expert, on the balance of probabilities, both that:

it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

The meaning of 'Rights' is defined in the Policy in the following terms:

Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

An Abusive Registration is defined in the Policy as follows:

Abusive Registration means a Domain Name which either:

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; or

has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors which may be evidence of an Abusive Registration is set out in paragraph 3 of the Policy. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is set out at paragraph 4 of the Policy.

6.2 Rights

Rights are defined in the Policy as meaning rights enforceable by the Complainant, whether under English law or otherwise.

Registered rights

The Complainant has produced evidence which demonstrates that it is the registered proprietor of two trade marks consisting of, or incorporating, the mark FURNITURELAND. The evidence consists of printouts from the Intellectual Property Office (IPO) for registered trade marks numbered 2401897 and 2401896. In both cases, the case details recorded by the IPO refer to an effective assignment date to the Complainant of 3 March 2006. The Complainant has also produced a redacted copy of a Deed of Assignment dated 3 March 2006 between Furnitureland Limited (In Administration) and the Complainant. It is clear on the face of this document that the trade marks referred to above were assigned to the Complainant.

The Respondent points out that the Complaint contains no evidence of use of the registered trade marks by the Complainant. The issue of the use (or lack of it) by the Complainant of the mark FURNITURELAND goes to the heart of the issue of Abusive Registration and is addressed in the relevant section below.

It is well established that the requirement to demonstrate 'rights' is not a particularly high threshold test and it is designed to make sure that the person who complains is someone with a proper interest in the Complaint. A registered trade mark can be enforced by statute, through an action for trade mark infringement and, as such, it is clearly a right that is enforceable by the Complainant as defined in the Policy. It is not appropriate for the Expert to embark on the exercise of trying to establish whether the registered trade marks are vulnerable on the applications for revocation. This is outside the scope of the DRS. On the basis of the registered trade marks the Expert is satisfied that the Complainant has enforceable rights in the mark FURNITURELAND which, for these purposes, is identical to the Domain Name.

Unregistered rights

The Deed of Assignment dated 3 March 2006 assigned all common law rights connected with the trade marks together with such goodwill associated with the trade marks as Furnitureland Limited (In Administration) may have had. The Complainant has adduced evidence to show that Furnitureland Limited used the mark FURNITURELAND for a not insignificant period and to a not insignificant degree. The Complainant has produced financial statements which show that, prior to its demise, Furnitureland Limited was a multi-million pound business with a retail presence consisting of 21 outlets. However, the evidence produced with the Complaint related solely to the period prior to the Complainant's acquisition of the registered trade marks in March 2006. What was totally lacking from the Complaint was any evidence of use of the mark by the Complainant itself. Not surprisingly, the Respondent was quick to seize upon this point.

The Complainant did produce some evidence with the Reply of its own use of the mark FURNITURELAND but that evidence was limited to the period from 15 February 2011, which was just 3 weeks before the Complaint was lodged. There is no evidence of use of the mark by the Complainant in the period of nearly 5 years between the assignment in March 2006 and the registration by the Complainant of the domain name furnitureland.uk.com in February 2011.

In light of the fact that the Complainant has succeeded on 'rights' on the basis of its registered rights, it is not necessary to make a finding on the issue of unregistered rights but the issue of the Complainant's use of the mark is highly relevant when one comes to consider Abusive Registration, which is addressed in section 6.3 below.

On the basis of the registered trade marks the Complainant has succeeded in proving the first element required under paragraph 2(a)(i) of the Policy.

6.3 Abusive Registration

The Complaint includes a submission that the actions of the Respondent amount to trade mark infringement. The Complainant sets out a detailed, but largely irrelevant, analysis of the position under sub-sections 10(1), 10(2) and 10(3) of the Trade Marks Act 1994 ('the Act'). The Respondent points out allegations of trade mark infringement have no place in the DRS but he did seek to persuade Nominet to suspend the DRS on the basis of the applications for revocation made under the Act.

Paragraph 16 of the Procedure states:

The Expert will decide a complaint on the basis of the Parties' submissions, the Policy and this Procedure.'

It would be far better for parties to a DRS complaint to concentrate their energies on making submissions based on the definitions and guidance set out in the Policy. The definition of what constitutes an Abusive Registration is found in paragraph 1 of the Policy and not in the Act. The best guide as to what constitutes an Abusive Registration is to be found in paragraph 3 of the Policy and the best guide as to what does not constitute an Abusive Registration is to be found in paragraph 4 of the Policy.

The Respondent has put forward an explanation for the registration of the word FURNITURELAND as a domain name. He says that he was aware of the

Furnitureland business but knew it had 'gone bust' and believed that it no longer existed and there was no likelihood that it would trade again. He thought FURNITURELAND was a good, generic and descriptive domain name that would be successful for providing links to online and offline furniture suppliers. He says that he carried out a Google search and, on the basis of that search, there was no reason to believe that anyone had rights in the mark FURNITURELAND.

The Respondent's explanation is plausible. He has not denied all knowledge of the mark FURNITURELAND which would have been difficult given the scale of the business prior to its insolvency. The Respondent has however denied knowledge of any connection between the Complainant and the mark. This puts the issue of the Complainant's use of the mark prior to registration of the Domain Name firmly in issue. The Complainant's case on this point is weak and this aspect of its case troubles the Expert. The Complainant was silent on the point in the Complaint and, when challenged by the Respondent, merely stated in the Reply:-

'we advise that the Complainant is using the FURNITURELAND trade mark in connection with the sale of furniture.'

The evidence of use provided by the Complainant consisted of four screenshots attached to the Reply from a website at www.furnitureland.uk.com. There was no date on those screenshots. The Expert noted that the Complainant had used the present tense in describing its use of the mark. The Expert carried out a whois search at www.whois-search.com, which revealed that the domain name furnitureland.uk.com was registered on 15 February 2011, a mere 21 days before the Complaint was lodged with Nominet. This does rather lend support to the suggestion, advanced by the Respondent, that the Complainant recently underwent a change of marketing strategy and decided to revive the FURNITURELAND brand.

There are also aspects of the Respondent's case that trouble the Expert, in particular the large number of domain names which consist of well known brands registered by Global Publications Limited. The Respondent confirmed that he was happy for the Expert to proceed on the basis that there had been no effective transfer of the ownership when the Domain Name was transferred from Global Publications Limited to Furnitureland.co.uk Limited. The nature of some of the domain names in the portfolio might lead someone of a cynical nature to form the view that the Respondent's explanation as to his motivation for registering a particular domain name needs to be treated with considerable caution.

The Expert needs to determine the admissibility, relevance, materiality and weight of the evidence in order to reach a finding as to whether the Complainant has proved, to the required standard, that the Domain Name is an Abusive Registration. The burden of proof is on the Complainant. Whilst the DRS is an ideal process for determining clear cut cases, it has its limitations when it comes to cases that are not clear-cut, particularly where the testimony of the parties is at issue.

This is not a clear cut case and there is some animosity between the parties which has led them to question the veracity of some of the statements that have been made by the other party. The Complainant rejects the Respondent's statement that he was acting in good faith in registering the Domain Name. The Respondent accuses the Complainant of bad faith in support of the allegation of reverse domain name hijacking. The DRS does not allow the evidence of the parties to be tested as it would be if the dispute was proceeding in the Courts. There is of course a material source of error when it comes to the testimony of a witness and that is the fallibility of assertion. It is entirely possible that someone's recollection of events may not be

accurate for many reasons, which range from an innocent failure to recall the precise details to rather more sinister motivations. The Court process enables an opponent to test the direct evidence of a witness who claims to have perceived something through cross-examination of that witness on oath. Clearly, that is not applicable (nor is it desirable) under the DRS given that it is designed to be a quicker and cheaper alternative to litigation.

The Expert's view is that this is not a case that is well suited for disposal under the DRS. The Respondent's explanation for registering the Domain Name has a degree of plausibility but that explanation cannot be tested. There is an application proceeding for revocation of the registered trade marks which may have some bearing, in due course, on the issue of rights to the mark that is in dispute. In addition, the Complainant has failed to engage meaningfully on the issue of its use of the mark in the relevant period. The Expert has to do his best based on the evidence before him. The Complainant has raised a number of arguments that fit under several of the factors listed in paragraph 3 of the Policy. The Respondent has raised a number of arguments that fit under several of the factors listed in paragraph 4 of the Policy. The Expert addresses those points in turn below.

Paragraph 3(a)(i)B

This paragraph reads as follows:-

Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has rights.

The Respondent says that his line of business is acquiring good generic and descriptive domain names and developing them. He says that the Domain Name was caught by a commercial drop catcher in 2009. He readily concedes that he knew of Furnitureland before it went into liquidation but he believed that it no longer existed and there was no likelihood it would trade again. The Respondent says that he was not aware of the Complainant's rights in the mark until he received a letter in July 2010.

The Respondent says he carried out a Google search that did not reveal the Complainant's interest in the mark but he did not carry out a search of registered trade marks. He says that if he had been aware of the Complainant's registered rights in the mark he would have assumed that they had effectively been abandoned.

Paragraph 3(a)(i)B is concerned with the Respondent's motivation at the date of registration of the Domain Name. The Expert considers the issue of use of the mark in detail below. It is sufficient for the purposes of the analysis under this paragraph to note that there is no evidence before the Expert at all to show that the Complainant used the trade mark in the period between the assignment of the trade marks on 3 March 2006 and the registration by the Respondent of the Domain Name on 12 April 2009. Nor is there any evidence before the Expert to show that the Respondent ought to have been aware that the Complainant had plans to make use of the trade marks in the future. The failure of the Respondent to conduct a trade mark search was imprudent, but not sufficient for the Expert to infer abusive intent.

On this basis the Expert is not satisfied that the Respondent registered the Domain Name primarily as a blocking registration.

Paragraph 3(a)(i)C

This paragraph reads as follows:-

Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant..

The Complainant says that the Respondent registered the Domain Name to free-ride on the Complainant's goodwill and reputation associated with the FURNITURELAND trade mark. The Complainant says that by misappropriating the advertising value of the trade mark interest in the Respondent's services is likely to be stimulated to a disproportionately high extent in comparison to the size of its own investment. The Complainant also argues that the provision of sub-standard services could tarnish the Complainant's reputation in its FURNITURELAND trade mark, thereby causing damage to its business.

The Expert is not satisfied that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant given that, on the evidence, there had been no business trading under the mark FURNITURELAND for 3 years prior to the registration of the Domain Name.

Paragraph 3(a)(ii)

This paragraph reads as follows:-

Circumstances indicating that the Respondent is using the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Complainant puts its case on confusion in the following terms:-

The disputed domain name constitutes an Abusive Registration because the identity/similarity between the Complainant's FURNITURELAND trade mark and the disputed domain name is such that the relevant public will believe that they are used by the same undertaking, or that there is an economic connection between the users of the marks.

It is clear from the Experts' Overview ('the Overview') that the 'confusion' referred to in paragraph 3(a)(ii) of the Policy is confusion as to the identity of the person/entity behind the Domain Name. The Overview frames the issue by asking the following question:-

'Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant?'

If the answer to that question is yes then the Internet user will have been drawn to the web site by use of the mark of the Complainant and that is not a 'legitimate' use of the mark. It follows that if there is no likelihood of confusion as to the identity of the person behind the Domain Name then a complaint under paragraph 3(a)(ii) will not be made out.

The Complainant has presented no evidence of actual confusion and its case is built on the fact that the Domain Name and the registered trade mark are identical. In most cases where the domain name is identical, i.e. without any adornment (other than the generic domain suffix), the issue will be clear cut and there will be a finding of Abusive Registration. This is usually because the mark in question cannot sensibly refer to anyone other than the Complainant. That might be the case because the trade mark in issue is particularly well known or highly distinctive. The mark in issue in this case is not highly distinctive – it is the combination of two ordinary English words.

The Respondent argues that the mark did refer to someone other than the Complainant: it referred to the business of Furnitureland Limited which went into Administration in 2005. The Respondent says that, whilst he was aware of the Furnitureland business, he was not aware that the Complainant had any rights in that mark at the date of registration. The Respondent suggests that the purchasing public could not have been confused as the Complainant had not used the mark.

In order to determine this point it is necessary to consider the available evidence that goes to the following two questions:-

- (i) Has the Complainant used the mark and, if so, over what period and to what extent?
- (ii) Is the mark recognised by the purchasing trade/public as indicating the goods or services of the Complainant?

As noted above, the Complainant made no mention in the Complaint of its use of the mark following the assignment of the trade marks in March 2006. The Respondent advanced a case that the Complainant had not traded under the name FURNITURELAND. The Respondent suggested that the Complainant may have undergone a recent change in its marketing strategy and decided to revive the FURNITURELAND brand. In support of that suggestion the Respondent produced evidence to show that the Complainant had applied for a new trade mark for FURNITURELAND on 25 February 2011.

The Complainant says there is no merit in the Respondent's point that the application for a new trade mark was not referred to in the Complaint. It is said, by way of explanation, that the application post-dated the relevant period for these proceedings. The Complainant did not respond to the contention that it had recently undergone a change of marketing strategy and decided to revive the brand FURNITURELAND.

The Complainant responded to the challenge made by the Respondent about its lack of use of the mark in the Reply in the following terms:-

The Respondent states that the complaint contains no allegations of use of the registered trade marks by the Complainant. In response, we advise that the Complainant is using the FURNITURELAND trade mark in connection with furniture and the sale of furniture. In this regard, we attach printouts from the Complainant's website demonstrating such use. In any case, were there to be no use of the trade mark, this would not be fatal to the complaint.

The evidence of use produced by the Complainant is thin putting it at its best. It consists of four screen prints from a web site at www.furnitureland.uk.com, which is said to be the Complainant's web site. The business that is displayed on that web

site is clearly branded as 'Furnitureland'. The Complainant has provided no information about the period of use of the mark and the screen prints are not dated. The Expert carried out a whois search for the domain name furniturelanduk.com which shows that it was only registered on 15 February 2011.

The Complainant has produced no evidence to show that there is a residual goodwill residing in the hands of the Complainant surviving from its predecessor in title's use of the trade marks. Nor has the Complainant produced sufficient evidence to show that it has used the mark for a significant period and to a significant extent. The Complainant says that, even if there were no use of the trade mark, this would not be fatal to the Complaint. It may not be fatal but it is certainly a factor to be considered when deciding whether '*an Internet user seeing the domain name or the site to which it is connected [will] believe or be likely to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant?*'

The Complainant has not produced sufficient evidence to satisfy the Expert that the Domain Name has been used in a way that is likely to confuse people as to the identity of the entity behind the Domain Name.

Paragraph 3(a)(iii)

This reads as follows:-

The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

The Overview provides some useful guidance on this paragraph as follows:-

The purpose behind this paragraph is to simplify matters for a Complainant, where the only available evidence against the registrant is that he is a habitual registrant of domain names featuring the names or marks of others. However, there is a divergence of view among Experts as to what constitutes a pattern for this purpose.

One view, as expressed by the Appeal Panel in DRS 04884 (maestro.co.uk), is that the mere fact that a registrant has some objectionable domain names in his portfolio cannot of itself be enough to render the domain name in issue an Abusive Registration. To get the benefit of this provision, the Complainant must show that the domain name in issue is part of a conscious policy on the part of the registrant. There must be evidence to justify the linking of the domain name in issue to the other objectionable domain names. The link may be found in the names themselves and/or in the dates of registration, for example.

The contrary view is that the pattern does not need to result from any conscious policy on the part of the Respondent. If the domain name in issue is a well-known name or mark of the Complainant and the Respondent is the proprietor of other domain names featuring the well-known names or marks of others, the pattern is likely to be established, even if there is no obvious link between the names or the manner or their dates of registration.

In practice this difference of view is unlikely to have much of an impact. If the domain name in issue is a well-known trade mark of the Complainant and there

is no obvious justification for the Respondent being in possession of the domain name, it is probable that the Complaint will succeed on other grounds.

The Complainant points out that the Domain Name was originally registered in the name of Global Publications Limited. It is said that shortly after receipt of the Complainant's letter dated 10 July 2010 the Domain Name was transferred to the Respondent. The Respondent (in the person of Mr Garner) points out that he incorporated Furnitureland.co.uk Limited on 22 April 2009 and he has produced supporting evidence in the form of a printout from Companies House. He says he planned a transfer of the Domain Name before he received the letter of complaint from the Complainant. The Respondent said in the Response that he was happy for the Expert to accept the Complainant's contention that there was no effective transfer of ownership when the Domain Name was moved from Global Publications Limited to Furnitureland.co.uk Limited.

The Complainant set out in the Reply a long list of domain names registered by Global Publications Limited and pointed out that many consist of third party brands or obvious misspellings thereof. It is clear from the evidence produced by the Complainant that Global Publications Limited has engaged in a pattern of registrations where it is the registrant of domain names which correspond to well known names or trade marks in which it has no apparent rights. This evidence was only introduced with the Reply which, under paragraph 6 of the Procedure, must be restricted solely to matters which are newly raised in the Response and were not raised in the Complaint.

The Respondent's concession that the Expert could proceed on the basis that there was no effective transfer of ownership of the Domain Name was made before the Reply was served. In response to the notice served by the Expert under paragraph 16 of the Procedure (referred to in paragraph 5.4 above) the Respondent included the following statement:-

The Registrant denies that it has engaged in a pattern of abusive registrations. It also denies that it is subject to DRS Policy Paragraph 3(a)(iii).

The Respondent appears to be making the point that Furnitureland.co.uk Limited (as the current registrant and Respondent to the DRS Complaint) has not engaged in a pattern of registrations.

It is to be noted that the Complainant has produced no evidence of any kind (beyond the list itself) to show why the Domain Name forms part of the pattern. The Expert is not prepared to make a finding under paragraph 3(a)(iii) when the evidence was produced with the Reply and the Complainant has failed to address whether the registration of the Domain Name is part of a pattern on the part of the Respondent.

Paragraph 3(c)

This reads as follows:-

There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the Complaint was filed. This presumption can be rebutted (see paragraphs 4(a)(iv) and 4 (c)).

The Complainant has referred to four previous DRS decisions in which Global Publications Limited was ordered to transfer the domain names in dispute. The details are as follows:-

No	Domain name	Date	Type of decision	Outcome
3840	wagamammas.co.uk	08/09/06	Full – no response	Transfer
5815	bertelsmann.co.uk	24/07/08	Full – no response	Transfer
6550	loydstsbbank.co.uk, lyodsbank.co.uk, lloydsbanking.co.uk & lloydstbfactoring.co.uk	23/12/08	Summary	Transfer
7578	fsecure.co.uk	20/10/09	Full – response	Transfer

The Complaint was filed on 9 March 2011 and accordingly the only DRS case that falls within the two year time limit is the final one listed above. Accordingly, the presumption of Abusive Registration does not apply.

Paragraph 4(a)

This reads as follows:-

Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;*
- B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;*
- C. made legitimate non-commercial or fair use of the Domain Name; or*
- ii. The Domain Name is generic or descriptive and the Respondent is making fair use of it;*
- iii. In relation to paragraph 3(a)(v); that the Respondent's holding of the Domain Name is consistent with an express term of a written agreement entered into by the Parties; or*
- iv. In relation to paragraphs 3(a)(iii) and/or 3(c); that the Domain Name is not part of a wider pattern or series of registrations because the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent.*

The Respondent says that the first time he (Mr Garner) became aware of the Complainant's cause for complaint was on receipt of the cease and desist letter dated 27 July 2010, which was over a year after the registration of the Domain Name. The Complainant has not produced any evidence to show that the Respondent was aware of its cause for complaint any earlier.

The Respondent's case is that he registered a combination of two descriptive words that had not been used for some years and that he had been using the Domain Name in ignorance of the Complainant's rights. He also points out that for a period of nearly two years the Complainant itself advertised its own goods on the Respondent's web site. The Complainant says that it did so unknowingly through the actions of an agent so the Expert does not place any reliance on this point. The

Expert has set out above his view which is that the Respondent's explanation is plausible and the Complainant has failed to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

The Overview makes it clear that paragraphs 3 and 4 of the Policy are non-exhaustive lists and the Expert has a broad discretion when it comes to determining abusiveness which involves a multi-factorial assessment. The Expert is not satisfied, on the balance of probabilities, that the Domain Name was registered, or has been used, in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Reverse Domain Name Hijacking

'Reverse Domain Name Hijacking' means using the Policy in bad faith in an attempt to deprive a registered domain name holder of a domain name. The Expert has expressed some cause for concern about the Complainant's case on use of the mark but the fact is that it did take an assignment of the registered trade marks. The Expert's view is that whilst the way in which the Complainant put its case may have been designed to imply that its use of the mark was more substantial than the evidence suggests it actually was, it did not make any statements that have been shown to be untrue. The Complainant has established that it has Rights in a name that is identical to the Domain Name and, although the Expert has found against it, the case on Abusive Registration was arguable. The Respondent argued that the Complainant's failure to refer in the Complaint to the application for a new trade mark and the fact that the Deed of Assignment did not include the Domain Name showed a lack of transparency but they do not justify a finding of bad faith. As noted above, this is not a clear cut case and the Expert is not prepared to conclude that the Complainant has used the Policy in bad faith. The Expert therefore refuses to make a finding of Reverse Domain Name Hijacking against the Complainant.

7. Decision

The Expert finds, on the balance of probabilities, that the Complainant has rights in a mark which is identical to the Domain Name but is not satisfied that the Domain Name is, in the hands of the Respondent, an Abusive Registration. The Expert directs that no action be taken.

Signed Andrew Clinton

Dated 06 October 2011