

**DISPUTE RESOLUTION SERVICE**

**D00009674**

**Decision of Appeal Panel**

**Furniture Village Limited**

**and**

**Furnitureland.co.uk Ltd**

**1 The Parties:**

Lead 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

- 1.1 In this decision, since the Complaint failed at first instance and the original Complainant has appealed, the parties are referred to with no risk of confusion by reference to their nomenclature at first instance. In other words the Complainant remains “the Complainant” and the Respondent remains “the Respondent”.

## **2 The Domain Name(s):**

furnitureland.co.uk

This domain name is referred to below as “the Domain Name”

## **3 Procedural History**

3.1 On 6 October 2011 Mr Andrew Clinton (the “Expert”), who had been appointed as an expert to determine the Complaint gave his decision, a copy of which is available on the Nominet website (<http://www.nominet.org.uk/disputes/drs>). The procedural history of this case prior to then is set out in the Expert’s decision.

3.2 On 10 November 2011 the Complainant filed an appeal notice seeking to appeal the decision of the Expert.

3.3 On 2 December 2011, Nick Gardner, Claire Milne and David King (the undersigned, “the Panel”) were appointed to determine this Appeal and have each confirmed to the Nominet Dispute Resolution Service that:

*“I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.”*

3.4 Accordingly this is an Appeal against the decision of the Expert at first instance. The Panel was appointed to provide a decision on or before 18 January 2012. This process is governed by the Procedure for the conduct of proceedings under the Dispute Resolution Service version 3 (“the Procedure”) and the Decision is made in accordance with the Policy. Both of these documents are available for inspection on the Nominet website.

## **4 The Nature of This Appeal**

4.1 The Panel has considered the nature of this appeal process and the manner in which it should be conducted. The Policy paragraph 10a provides that: “the appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters”.

4.2 The Panel concludes that in so far as an appeal involves matters other than purely procedural complaints the appeal should proceed as a re-determination on the merits.

4.3 Accordingly, the Panel does not propose to undertake a detailed analysis of the Expert’s decision.

## **5 Formal and Procedural Issues**

5.1 The first procedural issue that arises is that the Respondent says that the DRS proceedings should be stayed because of its pending oppositions in the

Intellectual Property Office (the "IPO") to the registered trademarks upon which the Complainant relies (see below for further details of these proceedings). It says these are "legal proceedings relating to a Domain Name" within the meaning of paragraph 20 of the Policy and hence the DRS proceedings have to be stayed. That contention was rejected by the Expert but the Respondent maintains it in this Appeal.

- 5.2 The merits of this issue and the Panel's decision on it are dealt with in paragraphs 8.2 to 8.7 of the decision below.
- 5.3 The second procedural issue is that the Panel notes that the manner in which each party's case and the supporting evidence has emerged has been somewhat unsatisfactory. In particular many substantive issues the Complainant wished to rely upon were raised for the first time in reply, and with further substantive issues being raised by the Respondent in response to the notice issued by the Expert under paragraph 16 of the Procedure. Yet further material has been adduced in the parties' submissions in relation to this Appeal, contrary to paragraph 18(c) and 18(f) of the DRS Procedure.
- 5.4 In the particular circumstances of this case the Panel takes the view, in the light of the decision it has come to, that it is appropriate to have regard to the totality of the material before it, irrespective of how and when it was filed. This should not be taken to be an indication that this will necessarily be the case in other decisions or appeals. It is incumbent upon a party and/or its advisers to file material it wishes to rely upon at the appropriate time in accordance with the Procedure if it wishes to be sure that material will be considered.

## **6 The Facts**

- 6.1 It is convenient to summarise the relevant facts as they have emerged during both the determination of the original Complaint and during this Appeal. They are as follows.
- 6.2 The Complainant was, at the time the Complaint was filed, the registered proprietor of the following United Kingdom Trade Mark Registrations (the "Furnitureland Registered Marks"):

No. 2401897 FURNITURELAND, filed on 19 September 2005 and registered on 10 March 2006 for "furniture, mirrors, picture frames; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; beds, sofa beds; mattresses; bed heads; bed bases; bed frames; bedsteads; bedding; divan sets; pillows; ornaments; cushions; fittings for curtains; parts and fittings for all the aforesaid goods" in Class 20, "carpets, underlays and floor coverings" in Class 27 and "the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail furniture store or by means of telecommunications" in Class 35; and

No. 2401896 furnitureland inspired interiors logo, filed on 19 September 2005 and registered on 10 March 2006, for the same goods and services as registration No. 2401897 above.

- 6.3 The Complainant obtained the Furnitureland Registered Marks by assignment. They were assigned to the Complainant on 3 March 2006. The assignment in question was made by the administrators of a company called Furnitureland Limited which the assignment recorded as being in administration, and was of such interest as those administrators had in the Furnitureland Registered Marks and such goodwill as was associated with those trademarks.
- 6.4 Furnitureland Limited had been incorporated in 1973 and had traded on a very significant scale through numerous outlets nationally. Its turnover in the 52 weeks ended 27 March 2004 for example was £64,741,000. It had also owned the Domain Name and traded via a web site at that address.
- 6.5 As is apparent from the fact that the Complainant derived its title to the Furnitureland Registered Marks from administrators, the Furnitureland Limited business ran into financial difficulties and entered administration at some stage in 2005. It subsequently went into liquidation and in due course was dissolved. The Complainant has no connection to the business of Furnitureland Limited other than having taken the assignment referred to above of the Furnitureland Registered Marks and such other rights as may have transferred by that assignment.
- 6.6 The evidence as to how the Complainant has used the term "furnitureland" since it acquired the Furnitureland Registered Marks is limited (see further below).
- 6.7 Revocation proceedings were filed by the Respondent in relation to both the Furnitureland Trademarks on 10 June 2011. These allege that the trademarks should be revoked as not having been used for five years.
- 6.8 Subsequent to the decision of the Expert, registered trademark 2401896 was surrendered by the Complainant on or about the 19 October 2011.
- 6.9 The application to revoke registered trademark 2401897 is pending. As yet no evidence has been filed by the Complainant in relation to this application
- 6.10 A company called Global Publications Limited purchased the Domain Name in 2009. It subsequently transferred the Domain Name to the Respondent. The Respondent was incorporated on 22 April 2009. It is owned and controlled by a Mr Barry Garner as is Global Publications Limited
- 6.11 The Respondent has disclosed the figure that was originally paid by Global Publications Limited for the Domain Name but asked that it be kept confidential – as nothing turns on the precise amount the Panel will do so. The Respondent says the name was acquired by Global Publications Limited after it had been "caught by a commercial drop catcher", which the Panel takes to be a reference to an automated procedure which will seek to acquire domain names that have been allowed to lapse.

6.12 Global Publications Limited owns a portfolio of other domain names. Mr Garner operates via this latter company as a trader in domain names and seeks to exploit at least some of the names in question commercially. The names owned by this company include, by way of example of names the Complainant refers to in its submissions, the following:

aeg.org.uk  
360xboxes.co.uk  
barclaycapital.co.uk  
barclaysloan.co.uk  
barclaybank.co.uk  
barclayinsurance.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

6.13 The Domain Name has been used by the Respondent as the address for a web site which carries furniture related advertising and links. The Complainant has from time to time placed at least some advertising on this site.

## **7 The Parties' Contentions**

7.1 The Parties' respective contentions are in large measure set out in the Expert's decision and to that extent do not need to be repeated here. They have been supplemented by the following further points made in the context of this appeal.

### **Complainant**

7.2 The Complainant repeats its reliance on the Furnitureland Registered Marks. Curiously it made no reference to the fact that one of the marks had, by the time the appeal was filed, been surrendered. It denied that it had not used the marks but said that in any case it did not matter. It also denied that the marks were generic. It also said it had common law rights.

- 7.3 It also alleged the Expert had given insufficient weight to what it described as "the primary purpose" of the Respondent's business as being "to obtain deceptive domain names, including well known marks, or misspellings thereof".

## **Respondent**

- 7.4 The Respondent says the Complainant's failure to mention that one of the two Furnitureland Registered Marks has been surrendered is extraordinary and further evidence of the Complainant's behaviour amounting to "reverse domain name hijacking".

## **8 Discussion and Findings**

- 8.1 The Respondent has confirmed that it is owned and controlled by Mr Barry Garner, as is Global Publications Limited and that in practical terms all of them could be treated as the same person. It confirmed it was content for the Expert to proceed on this basis and the Panel will do so as well.
- 8.2 It is convenient to first deal with the Respondent's submission that the revocation proceedings in the IPO relating to the Furnitureland Registered Marks are "legal proceedings relating to a Domain Name" within the meaning of paragraph 20 of the Policy and hence the DRS proceedings have to be stayed.
- 8.3 The Panel disagrees. The Panel accepts that although technically these are opposition or revocation proceedings within the IPO rather than court proceedings, they may be "legal proceedings". They do not however "relate to the Domain Name". The Panel accepts they are clearly of at least potential relevance to this case but the Domain Name is not the subject matter of the proceedings. It seems to the Panel that paragraph 20 is directed at circumstances where there are existing proceedings which have directly within their ambit the Domain Name. These could for example be proceedings as to who was the rightful owner of the Domain Name, or proceedings alleging that the use of the Domain Name amounts to trade mark infringement. An action concerning trademarks which are said to be part of the Rights supporting the Complaint, but where the Domain Name itself is not the subject of the proceedings, does not in the Panel's view fall within this wording.
- 8.4 The Panel recognises however the force of the submission made by the Respondent that if it was to succeed in the trade mark opposition proceedings, the Expert, or this Panel, could reach a decision in favour of the Complainant based upon Rights which would ultimately be found to be invalid.
- 8.5 The Panel takes the view that whilst the automatic right to a stay under paragraph 20 does not apply, circumstances such as these could give rise to a discretion to stay the proceedings under paragraph 12 of the Policy – "We, or the Expert if appointed, may in exceptional cases extend any period of time in proceedings under the DRS". The Panel concludes that it has similar powers to those given to the Expert under this provision.

- 8.6 Individual cases will turn on their facts but there may be cases where it would be undesirable for the Expert or a Panel to proceed to a decision which was in favour of the Complainant if it subsequently transpired as a result of proceedings elsewhere that the Rights the Complainant relied upon were found to be invalid or liable to revocation.
- 8.7 In the present case in view of the Panel's decision on the merits (see below) it is not necessary to decide whether this is such a case and accordingly the Panel declines to stay these proceedings.
- 8.8 The Panel then turns to the question of Rights. In order for the Complainant to succeed it must (Policy paragraph 2) prove to the Panel, on the balance of probabilities, both:
- 8.8.1 that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - 8.8.2 that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.
  - 8.8.3 Rights are defined in Paragraph 1 of Version 3 of the Policy as follows:

“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.”
- 8.9 In relation to this issue both Parties have made extensive submissions as to matters of trade mark law, which the Panel concludes are of limited relevance here. In essence the Panel concludes that the combination of the descriptive word "furniture" with a generic term "land" produces what is at best a not particularly unusual or distinctive term, but one which is at least capable of enjoying protection as a registered trademark. Common law rights may arise in the same term through virtue of its use and its recognition as a trading name or style by at least a part of the relevant public.
- 8.10 If this matter had simply proceeded on the basis of the facts as in 2004 or 2005 and the Complainant was Furnitureland Limited it would be entirely straightforward to conclude that company had Rights. As indicated above it operated nationally on a very substantial scale and had the Furnitureland Registered Marks.
- 8.11 That is not however the position. That business failed and the company no longer exists. The Complainant is the successor in title to the Furnitureland Registered Marks. The Complainant also claims to be the successor in title to the goodwill in the name Furnitureland and to the common law rights which Furnitureland Limited enjoyed. It is not clear to the Panel that is correct. The relevant assignment simply assigns to the Complainant whatever rights in the goodwill associated with the trademarks, if any, the administrators at that time had. What that may have comprised is unclear and may well depend upon what other transactions the administrators had effected. It is not claimed by the Complainant that it took over the business of

Furnitureland Limited as a going concern; nor has it provided any evidence as to the existence or extent of any goodwill that may have been assigned to it. The question of whether under English law actionable rights in respect of goodwill can be assigned without a transfer of the business as a going concern is not a matter for the Panel, but would involve legal considerations outside the scope of the DRS.

8.12 Accordingly the Panel concludes that the starting point in assessing whether the Complainant has Rights is its assignment of the Furnitureland Registered Marks. The figurative mark has now been surrendered and there is a pending action before the IPO seeking to revoke the other mark on the basis of five years non-use. This is not a matter for the Panel to determine but presumably the Complainant's defence to that action will be based upon use of the term "furnitureland" by the Complainant in the last five years. Such use will also be directly relevant to whether the Complainant has Rights under the DRS in addition to whatever Rights derived from its acquisition of the Furnitureland Registered Trademarks.

8.13 The Complainant's evidence as to its own use of the term "furnitureland" is sketchy in the extreme. The original Complaint contained no details at all of any use subsequent to the assignment. This point was taken by the Respondent in its Response and in Reply the Complainant said:

*"The Respondent states that the complaint contains no allegations of use of the registered trademarks 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."*

8.14 This is hardly a detailed response to a point that had been squarely raised and which was clearly highly relevant. The Complainant had ample opportunity to provide a "chapter and verse" response describing its use of the term "furnitureland". It did not do so but instead provided this rather perfunctory statement. This matter became the subject of a request by the Expert and, as detailed in his decision, it appears that the Complainant accepts that the website in question was located at the domain name furnitureland.uk.com and this domain had only been registered three weeks before the Complaint had been filed. The Panel does not believe this limited evidence, taken on its own, establishes that the Complainant has Rights (other than those deriving from the Furnitureland Registered Marks) in a term such as "furnitureland" which is simply a combination of two individually non distinctive terms.

8.15 It follows that the Complainant's Rights so far as this Appeal is concerned stand or fall with the registered trade mark for Furnitureland - which is the subject of pending revocation proceedings. The Panel accepts that while that trademark is in force the Complainant has Rights. If however this issue was determinative of the Panel's decision there would be an obvious risk of injustice to proceed to a decision in the Complainant's favour, if it



subsequently transpires the Rights in question are revoked. That could give rise to it being desirable for the Panel to exercise its discretion to stay the proceedings – see above.

8.16 In the present case the Panel however concludes that even if the Complainant has Rights that is not determinative of the matter. Accordingly the Panel will proceed with its decision based on the fact that as at the present date the Complainant has Rights but even if those Rights are liable in due course to revocation this matter can be decided now without risk of injustice, having regard to the facts of this case.

8.17 The question then arises as to whether the Respondent's registration was an Abusive registration. 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".

8.18 The Respondent's Response to the Complaint was in the form of a statement from Mr Garner. It is helpful to set out verbatim some extracts from this statement, as follows:

*"I knew of the FurnitureLand before it went into liquidation. I was aware that it had gone bust and believed (and was entitled to believe) that it no longer existed and there was no likelihood that it would ever trade again. That belief was accurate, as established by the statement of the administrators/liquidators, who conceded that there had been serious efforts to avoid liquidation that had failed (including a cash injection of 4 million pounds) and they consequently dismissed the idea of continuing to trade as FurnitureLand.*

*In so far as I thought about the previous existence of Furniture Land at all when I registered the domain name, I believed that the company had long since gone bust and was no longer trading. The statements of the administrators (later liquidators) from the time, which I have only recently been shown, by my legal representatives, show that my perception in fact reflects the approach taken by them at the time.*

*I did do a Google search to see if anyone was trading using the name Furniture Land. The only party I found that I thought might be relevant was Oak Furniture Land, but I believe that their brand and mine are sufficiently different that there should not be any confusion. Like the Complainant, Oak FurnitureLand have advertised with me from the beginning of my use of the domain name, so it would seem that they take a similar view to mine. They have certainly never complained and continue to be a major advertiser on my site.*

*The truth is that I registered the domain 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 I could use to utilise the descriptive quality of the domain name to provide a bona fide offering of goods and services."*

- 8.19 This appears to be the Panel to be an entirely credible statement and one that accurately reflects the facts as before this Panel. In particular there is no evidence to suggest that any searching by Mr Garner would have revealed trading activity by the Complainant under or by reference to the name "furnitureland", or indeed any association between the Complainant and this name, unless the Register of Trade Marks itself had been consulted, which Mr Garner did not do. The Panel does not consider he was under any obligation so to do, nor that his failure in this respect in some way makes him culpable.
- 8.20 In order to overcome this position the Complainant in its Appeal Notice has raised a number of points. It is convenient to deal with each in turn.
- 8.21 The Complainant argues that the original Expert gave insufficient weight to its Rights in the name, and to the fact that the Respondent's activities amounted to trade mark infringement. Like the original Expert, this Panel finds that the Complainant does have Rights sufficient to bring this Complaint; the question of whether the Respondent's activities amount to trade mark infringement is a matter to be determined elsewhere, but for the reasons identified above the panel does not consider the Respondent's registration to be Abusive.
- 8.22 The Complainant also argues that the Expert gave insufficient weight to the Respondent's record of registering domain names corresponding to well-known names in which he has no apparent rights. This argument, even assuming it were correct, does not assist the Complainant in relation to the Domain Name as the Panel does not regard the Domain Name as being part of the same pattern, as would be required if paragraph 3(a)(iii) of the Policy were to apply. Furthermore, as the Expert has shown and the Complainant accepts, the DRS cases in which the Respondent has been unsuccessful are long enough ago that there is no presumption of abusive registration in accordance with paragraph 3(c).
- 8.23 The Complainant claims that the Respondent's record of dealing in Domain Names points to the likelihood that the Respondent's primary motive for acquiring the Domain Name was to sell it to the Complainant or to a competitor of the Complainant for a sum in excess of costs. While the Panel accepts that the Respondent deals in Domain Names, the evidence points to the Respondent having been unaware of the Complainant until recently, which means that activity directed at the Complainant cannot have been primary motive for the acquisition. By the same token, this cannot have been a blocking registration, as the Complainant claims. The Respondent was indeed aware of the original Furnitureland before it went out of business, but this is entirely different from being aware of the Complainant or that it had acquired the Furnitureland Registered Marks.

- 8.24 Finally, the Complainant denies that the use that the Respondent has made of the name constitutes "a genuine offering of goods or services", in that the Respondent's use has been, the Complainant says, just a "click-through" website. The Panel tends to agree with the view that many "click-through" websites (including possibly this one) do not of themselves amount to genuine offerings of goods or services. However, neither does setting up a "click-through" website of itself constitute abusive behaviour, and in this case the Panel does not find that the use in question is abusive.
- 8.25 The Panel has considered the Respondent's submission that a finding of "reverse domain name hijacking" should be made against the Complainant. To make such a finding the Panel would need to be satisfied that the Complainant had brought the complaint in bad faith in order to deprive the Respondent of the Domain Name in circumstances where the Complainant knew that the complaint had no merit within the terms of the Policy. The Panel has established that the Complainant had Rights when the Complaint was submitted by virtue of the registered trademarks. Although the Panel has concerns that the Complainant did not refer to the surrender of one of its trademarks in its appeal notice, the Panel accepts that the Complainant has Rights while the other trademark registration is in force. The Panel considers that the Complainant had an arguable case even if it was not particularly well-presented as originally filed, nor was it on analysis supported by the evidence submitted. These factors however are not in the Panel's opinion clearly indicative of bad faith and in all the circumstances the Panel does not find that the Complainant has used the Policy in bad faith. The Panel, therefore, declines to make a finding of reverse domain name hijacking against the Complainant.

## **9 Decision**

- 9.1 The Panel 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. If it ultimately transpires that the Complainant's Rights are revoked by the IPO the Panel's decision would be the same. The Panel directs that no action be taken.

Signed: Nick Gardner, Claire Milne, David King

Dated: 03 January 2012