

Nominet UK Dispute Resolution Service

DRS 9096

DECISION OF THE INDEPENDENT EXPERT

Shabby Chic Brands LLC v Jacqueline Fabian

1. Parties

Complainant's Details

Complainant Type: Business
Complainant: Shabby Chic Brands LLC
Address: 10100 Santa Monica Boulevard #600
90067 Los Angeles

Postcode:
Country: USA

Respondent's Details

Respondent: Jacqueline Fabian
Address: 45 Windsor Street,

Uxbridge,
Middlesex

Postcode: UD8 1AB
Country: GB

2. Disputed Domain Names

Shabby-chic.co.uk ('the Domain Name')

3. Procedural Background

- 3.1 The Complainant lodged the complaint with Nominet on 24th September 2010. Nominet contacted the Respondent and the Claimant's representative on 27th September advising that a complaint had been received and requesting the Respondent to respond.
- 3.2 A response to the complaint from the Respondent was received by Nominet on the 18th of October 2010.

- 3.3 A reply to the response from the Complainant was sent to Nominet on the 25th October 2010.
- 3.4 The Complainant paid the fee for expert determination on 25th November 2010. Following a conflict check Margaret Briffa was appointed from the panel of experts.

4. Outstanding Formal Procedure.

None

5. The Facts

- 5.1. The Complainant is the proprietor of two registered trade marks:

5.1.1. GB Trade Mark No: 1513461 for the word 'Shabby Chic' registered on 24 September 1992 covering furniture, parts and fittings for all aforesaid goods, all included in Class 20; and

5.1.2 Community Trade mark No: 000882035 for the word Shabby Chic registered covering goods in Class, 20, 24, 35 and 42 on 20th July 1998.

The Community Trade mark includes within Class 42 'technical assistance and advising in the establishment of retail stores in the field of furniture and gifts'.

- 5.2. The Complainant claims to have used the trade mark Shabby Chic continuously around the world since 1990. The Complainant also states that the trade mark Shabby Chic is a well known mark enjoying substantial reputation and goodwill. No evidence is submitted to support these facts.
- 5.3. The Complainant registered the domain name shabbychic.com on 9th September 1996.
- 5.4. The Domain was registered by the Respondent on 21st September 2004. The Respondent claims that at the time of business set up there were no registered companies trading under the name of Shabby Chic Interiors. Further the Respondent states that the words and description 'shabby chic' are commonly used in the interior design business to describe a design style and in no way reflects on the business of the Complainant or its trademarks.
- 5.5. On receipt of the letter from the Complainant of the 10th of February 2010 which was attached with the Complaint the Respondent offered to transfer the Domain to the

Complainant as a goodwill gesture and in consideration of the Claimant paying the costs of rebuilding the Respondent's web site. This offer was rejected by the Complainant's on the 10th March 2010.

5.6 Since receiving the letter of complaint from the Complainant dated 10th February 2010 claiming that the Respondent was infringing the Complainant's trade mark rights the Respondent has of its own volition changed its web site significantly. In particular all pictures showing the Respondent's retail premises have been removed and address and location pages have been deleted. The site currently appears to operate for email communication only.

5.7 The Complainant has submitted evidence of the site as it appeared on the date of the Complaint. There is no evidence submitted by the Complainant of the site's appearance prior to or at the time of the Complainant's letter of 10th February 2010 to the Respondent. The Respondent has however included photographs in its Reply of the premises bearing the name 'Shabby Chic Interiors' in a stylised form.

6. Abusive Registration

6.1 The Complainant claims that the Domain Name should be deemed as an abusive registration under the Dispute Resolution Service Policy ("the Policy")

6.2 Under paragraph 3(a)(i)(A) of the Policy, the Complainant must show evidence of circumstances that the Respondent acquired the Domain Name primarily for the purpose of selling, renting or otherwise transferring the Domain Name to the Complainantfor valuable consideration in excess of the Respondent's out of pocket expenses directly associated with acquiring the Domain Name'

6.3 Under paragraph 3(a)(i)(C) of the Policy, the Complainant must show that the Respondent registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant.

6.4 Under paragraph 3(a)(ii) of the Policy, the Complainant must show circumstances that the Respondent is using or threatening to use 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.

6.5 The Respondent claims that at the time it registered the domain it was not aware of any company registered at Companies House using the name Shabby Chic. The Respondent claims to be a bona fide retailer dealing in interiors which fit the description 'Shabby Chic'.

7. Decision and Findings

7.1 According to 2(a) of the Dispute Resolution Services Policy ('the Policy'), in order to succeed in a Complaint, the Complainant has to prove that on the balance of probabilities:

- i. the Complainant has Rights in respect of the name or the mark which is identical or similar to the disputed domain name; and
- ii. the disputed domain name, in the hands of the Respondent is an Abusive Registration.

Does the Claimant have Rights?

7.2 I refer to the facts set out in paragraph 5 above. Under the Policy the test as to whether a Complainant has Rights is a deliberately low hurdle. Rights include but are not limited to, rights enforceable under English Law. Based on all the evidence submitted I have no doubt that the Complainant does have Rights. The inclusion of the hyphen between the words Shabby and Chic in the Domain makes no difference to this finding.

Abusive Registration

7.4 Paragraph 1 of the Policy states that an 'Abusive Registration' means a Domain Name which either:

- i 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

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

- 7.5 The Domain Name was registered on 2004. The Respondent states that at that time there was no company trading with the name Shabby Chic and that the Respondent has indeed carried out a bona fide business from the website. I have seen no evidence to verify the statement made as to the existence of any other company with the name 'Shabby Chic'. The Respondent has however attached photographs of its shop front proving the establishment of a genuine business at the address, which suggest that the position was otherwise than as stated by the Respondent. This evidence indicates that the Domain Name was (at least until the receipt of the Complainant's letter of the 10th February 2010) being used in accordance with paragraph 4(a)(i)(A) of the Policy, in that it is "used.....in connection with a genuine offering of goods and services".
- 7.6 As paragraph 3(a)(i)(B) of the Policy requires that the Complainant shows evidence of circumstances that the Respondent primarily registered the Domain Name as a blocking registration against a name or mark in which the Complainant has Rights, and because of the bona fide business carried out by the Respondent at the Domain Name as referred to in paragraph 7.5 above, I find that the Domain Name does not amount to an abusive registration under section 3(a)(i)(B) of the Policy.
- 7.7 Similarly, because paragraph 3(a)(i)(C) of the Policy requires that the Complainant shows that the Respondent registered or acquired the Domain Name primarily for the purposes of disrupting the Complainant's business, and because of the bona fide business carried out at the Domain Name again referred to in paragraph 7.5 above, I find that the Domain Name does not amount to an abusive registration under section 3(a)(i)(C) of the Policy. There is no evidence that the Respondent has taken unfair advantage of the Complainant's rights.
- 7.8. Paragraph 3(a)(ii) of the Policy refers to circumstances in which the use of a Domain Name has confused people or businesses into believing that the Domain Name is registered to or operated by, or otherwise connected with the Complainant.
- 7.9. The Complainant has adduced no evidence of actual confusion, despite the fact that the Domain Name was registered in September 2004, giving ample opportunity (6 years) for such evidence to be produced. The Complainant's trade mark does not appear to have acquired the secondary meaning indicative of the Complaint and there is no evidence to suggest the words are other than ordinary English words. The claim as to likelihood of confusion also needs to be considered against this background. On balance I do not accept the claim made as to likelihood of confusion.

8. Conclusion

- 8.1 The Domain Name is not an Abusive Registration and should not be transferred to the Complainant.**

Signed: Margaret Briffa

Date: 17 December 2010