

DISPUTE RESOLUTION SERVICE

D00009967

Decision of Independent Expert

MAISONS DU MONDE SAS

and

Mr M P J Helme

1. The Parties:

Complainant: MAISONS DU MONDE SAS
Le Portereau
VERTOU
44120
France

Respondent: Mr M P J Helme
13 Lewin Road
London
SW16 6JZ
United Kingdom

2. The Domain Name:

maisondumonde.co.uk

3. Procedural History:

08 June 2011 14:55 Dispute received
08 June 2011 16:18 Complaint validated
08 June 2011 16:18 Notification of complaint sent to parties
04 July 2011 02:30 Response reminder sent
07 July 2011 09:27 Response received
07 July 2011 09:28 Notification of response sent to parties
12 July 2011 02:30 Reply reminder sent
14 July 2011 09:40 Reply received
15 July 2011 10:39 Notification of reply sent to parties
15 July 2011 10:40 Mediator appointed

21 July 2011 16:17 Mediation started
26 July 2011 16:37 Mediation failed
26 July 2011 16:38 Close of mediation documents sent
02 August 2011 13:30 Expert decision payment received
06 September 2011 Respondent submitted a non-standard submission
16 September 2011 Complainant submitted a non-standard submission
16 September 2011 at the Expert's request, the Complainant filed translations of various exhibits filed in its Complaint, pursuant to paragraph 13a of the DRS procedure.

Cerryg Jones, the undersigned, ("the Expert") confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual Background

The Complainant, Maisons du Monde SAS, is a French company, which designs, and sells furniture, tableware and home decorative items and accessories. The Complainant is the registered proprietor of various national and CTM marks consisting of the word mark MAISONS DU MONDE, and device marks which incorporate this name.

The Respondent claims also to supply furniture and accessories but the Complainant disputes this. The domain name in issue was registered in July 2000.

This case is the latest in a long running series of conflicts between the parties. The Complainant's applications for two Community trade marks (CTM) for the word mark "Maisons Du Monde" and a device mark incorporating this name were opposed unsuccessfully by the Respondent in a decision published by the Office for Harmonisation in the Internal Market (OHIM) on 28 October 2010.

The Respondent's application to register "Maison Du Monde" before the UK Intellectual Property Office (UK IPO) was unsuccessful, having been deemed withdrawn on 1 November 2010, following the dissolution of Maison Du Monde Limited.

The Complainant's complaint before WIPO in respect of the Respondent's registration of "maisondumonde.com" ("the WIPO Proceedings") was not upheld by the Panel (D2011-0956).

The Respondent's claim in the WIPO Proceedings that the Complainant had sought to reverse hijack the domain name in issue was upheld by the Panel.

5. Parties' Contentions

Complainant's submissions

Rights

The Complainant makes the following submissions in respect of its alleged rights:

- 1 It was established in 1996 in France.
- 2 Its goods are distributed under the trade mark "Maisons du Monde" on-line at the URL www.maisonsdumonde.com, and also through over 180 retail stores in France, Belgium, Luxembourg, Italy and Spain. Sales now extend throughout Europe.

- 3 In 2009, total revenue for its goods exceeded 268 million euros.
- 4 It is the applicant for, or owner of, various trade marks for the name “Maisons du Monde”, including:
 - 4.1 A French national registration under number 99 792285 filed on 10 May 1999 (classes 3, 4, 8, 11, 14, 15, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28) for a device mark incorporating “Maisons du Monde.”
 - 4.2 A French national registration under number 06 3407648 filed on the 2 February 2006 (classes 3, 4, 6, 8, 9, 11, 14, 15, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28, 34, 35) for the word mark “Maisons du Monde”.
 - 4.3 A Community trade mark registered under the number 005120481 on the 19 May 2006 (classes 11, 20, 21, 24, 28) for the word mark “Maisons du Monde”.
 - 4.4 A Community trade mark application filed on the 15 March 2011 (classes 3, 4, 6, 8, 9, 14, 15, 16, 18, 19, 20, 22, 25, 26, 27, 31, 34, 35, 36, 38, 39, 40, 41, 42, 44) for a device mark incorporating “Maisons du Monde”.
- 5 Through extensive use around Europe, the “Maisons du Monde” trade mark has generated substantial goodwill and has become well-known in connection with home decorative goods.
- 6 It has also developed a sizeable presence on the internet and is the owner of several domain names, including:
 - 6.1 maisonsdumonde: with various generic and country code extensions, including .com, .net, .eu, .fr, .co.uk, .es, .lu, .nl, .dk and .pt.
 - 6.2 maisons-du-monde: with extensions .com, .net, .eu, .fr, .co.uk, .es, .lu, .nl, .be, .de, .dk and .pt.
 - 6.3 maiondumonde: with extensions .es, .lu, .nl, .dk, and .pt.
 - 6.4 maison-du-monde: with extensions .fr, .be, .co.uk, .de, .es, .eu, .lu, .nl, .dk, and pt.

Abusive registration

The Complainant alleges the domain name is an Abusive Registration for the following reasons:

- 1 The disputed domain name entirely reproduces the Complainant’s trade mark “Maisons du Monde” and contains no other distinguishing features. The only difference between the trade mark “Maisons du Monde” and the domain name is the letter “s”. The difference is so minute and insignificant that it will go unnoticed by an average consumer. Phonetically, as the letter “s” is not pronounced, the trade mark “Maisons du Monde” and the disputed domain name, are identical.
- 2 The Respondent does not own any brand, trade mark or priority rights in respect of the name “Maisons(s) du Monde.”
- 3 The Complainant has not licensed or otherwise permitted the Respondent to use its trade marks.

- 4 On 9 May 2006, the Complainant filed a Community trade mark application (number 5120481) for the words “Maisons du Monde” and a CTM application (number 5118931) for the words and design “Maisons du Monde” in relation to goods in classes 11, 20, 21, 24 and 28. These applications were published for opposition purposes on 6 November 2006. On 21 January 2007, the Respondent, via the company Maison du Monde Limited, filed notices of opposition. On 27 October 2009, the Office for Harmonisation in the Internal Market (OHIM) rejected both oppositions. The Respondent has not appealed OHIM’s decisions and the applications proceeded to registration.
- 5 On 8 November 2006, the Respondent, via Maison du Monde Limited, filed a UK trade mark application (number 2437865) for “Maison du Monde” in relation to goods in classes 11, 20, 21, 24, 28 and 35. The Complainant opposed the application. The UK opposition proceedings were suspended pending the outcome of the oppositions before OHIM.
- 6 On 31 August 2010, Maison du Monde Limited was dissolved. The Respondent ceased communicating with the Complainant. The Respondent’s trade mark attorneys no longer represent the Respondent in any proceedings. The UK IPO deemed the Respondent’s application withdrawn.
- 7 The Respondent has no right to the name “Maison(s) du Monde” and is not allowed to reproduce the name “Maisons du Monde” and use it as a domain name.
- 8 The Respondent has selected and has used the disputed domain name because it is identical to the Complainant’s trade marks for “Maisons du Monde”, which has the potential to generate a significant amount of Internet traffic by mistake due to user confusion. The Respondent registered the disputed domain name in an attempt to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant’s trade mark. Website traffic is redirected from the website “maisondumonde.co.uk” to the website “maisondumonde.com” belonging to the company Maison du Monde Limited.
- 9 Until the beginning of 2010, Maison du Monde Limited sold via its website “maisondumonde.com” similar furniture to that sold by the Complainant, as well as home decorative items and accessories.
- 10 At the time the Complaint was filed, the webpage connected to the disputed domain name contained the following text:

“Directory Listing Denied. This Virtual Directory does not allow contents to be listed”.
- 11 The Respondent’s website used to display a large banner on its main page promoting “free delivery to France” with prices shown in Euros. There is no legitimate reason why the Respondent, which is based in London, would have included this banner on its website other than to benefit from the Complainant’s reputation in France.
- 12 In 2008, the Complainant discovered that the Respondent’s website had been modified so as to resemble the Complainant’s website. In that regard, the Complainant highlights the fact that the Respondent’s website used the same tabs (“Home”, “Furniture types”, “Styles and countries”, “Materials and colours”, “Different rooms”) as those found on the Complainant’s website.

- 13 The Respondent has infringed the Complainant's copyright by reproducing on the main page of its website one of the Complainant's photographs, which it alleges has been copied from the Complainant's catalogue. This use of its photograph is misleading and confusing for users.
- 14 The Respondent has deliberately used the disputed domain name to take advantage of the Complainant's success, to entice its clients or potential clients and to affect the Complainant's rights.
- 15 The disputed domain name has been registered by the Respondent for the purpose of selling the domain name to the Complainant for an overestimated price. On 21 September 2006, after having discovered the existence of the website "maisondumonde.com", the Complainant contacted the Respondent in order to assert its rights to the trade mark "Maisons du Monde" and to try to negotiate a settlement. The Respondent offered to sell his entire business and domain names including "maisondumonde.co.uk" to the Complainant for £10,000,000, which was unreasonable and excessive. The Complainant asked the Respondent to supply corporate and financial data regarding his business. The Respondent represented that such data was not available and provided the Complainant with estimates.
- 16 The Respondent sought to take advantage of the opportunity of negotiation offered by the Complainant, and to apply pressure on the Complainant, by applying to register in the UK "Maison du Monde" and by filing a notice of opposition to the Complainant's CTM applications. A few months later, the Complainant says it discovered that the Respondent's business was not significant and that the estimations given by him were inflated. Maison du Monde Limited was dissolved immediately following the rejection of its oppositions by OHIM, which demonstrates that the Respondent did not have any genuine trade. The Respondent's proposal was an attempt "to swindle" the Complainant.
- 17 The Respondent owns numerous companies whose names match famous companies, such as Amazon Estates Ltd (similar to Amazon Inc), Transeuropa Estates Ltd (similar to Transeuropa Shipping Lines), Quick Chips (similar to the French/Belgian fast food company Quick).

The Respondent's Response

The Respondent makes the following submissions:

- 1 He accepts that the domain name is similar to "Maisons Du Monde" (albeit that in his submission they are pronounced differently in French and English) but denies that this leads to any confusion. The Complainant's business name focuses on the plural "Maisons", which difference is accentuated by the inclusion of representations of a teepee, an igloo, a house and a grass/mud hut, within the trade mark. There can be no confusion with "maison" when used in connection with the word "home" rather than "houses".
- 2 The Complainant has reproduced the Respondent's domain name.
- 3 There are differences in the goods supplied by each party; when the Complainant commenced trading it traded in decorative goods, primarily gifts and accessories and home ware such as table ware, candles, candlesticks, rugs, incense, jewellery and mugs. The Complainant subsequently broadened its product offering to include a few items of furniture (for example, Indian Sheesham wood, rattan, and teak wood furniture from Indonesia) and traded on-line in larger quantities in 2004, four years after the Respondent's trade in furniture had started on the

internet. The Complainant's trade in furniture items only became significant in 2006. The Complainant continues to trade predominantly in non-furniture products.

- 4 At the time of the Respondent's registration of the disputed domain name in 2000, the Complainant was unknown outside France. The Respondent denies any knowledge of the Complainant at the time of his registration of the disputed domain name. The Complainant was at that time a relatively small company; only recently has the Complainant acquired a reputation which extends to other countries - Belgium, Italy and Spain - where it has opened stores in the last few years. The disputed domain name was not registered in bad faith because he had no knowledge of the Complainant at the time of registration.
- 5 At the date of registration of the disputed domain, the Complainant had no better right than any third party to use the name "maisondumonde.com" or operate under the trade name "maison du monde" in any country other than France.
- 6 The Respondent's trade consists exclusively of high quality furniture sourced from around the world, rather than gifts and accessories. This is similar to his original business. The Complainant has moved into the Respondent's product area by increasing its sales of furniture.
- 7 The Respondent opposed the Complainant's CTM application on the grounds that he had established rights in an unregistered trade mark in the UK under the laws of passing off, and that his business still trades under the "Maison du Monde" brand. The OHIM decision establishes that, before being aware of the Complainant's cause for complaint, the Respondent:
 - 7.1 had used the disputed domain name in connection with a genuine offering of goods four years before the Respondent was aware of the Complainant's existence;
 - 7.2 had been commonly known by a name which is similar to the disputed domain name with six active retail units at various times and locations even if the Respondent has acquired no trade mark rights in the name; and
 - 7.3 had made legitimate fair use of the domain name in issue, without any intention of misleading internet users.
- 8 The Respondent first registered the disputed domain name for Ashburton Corporation Ltd trading as "Maison du Monde" on 13 July 2000. He registered the domain name the subject of the WIPO Proceedings (maisondumonde.com) on 12 July 2000. This occurred ten years before the Complainant acquired any CTM, and four years before the Complainant registered its own domain name in France.
- 9 The Complainant has never traded from a physical address in the UK.
- 10 The Respondent's business started from one store selling hand made high quality furniture. The business expanded over the next five years to a total of six stores in south Eastern England, plus a fully operational e-commerce website selling nationwide and into Europe.
- 11 On 22 September 2005, Maison du Monde Limited and Maison du Monde Camden Limited were incorporated by the Respondent.

- 12 On 13 April 2006, Ashburton Corporation Limited sold its business and goodwill to Maison du Monde Limited and Maison du Monde Camden Limited.
- 13 On 22 September 2006, the Complainant's representatives wrote to the Respondent alleging infringement of its French trade mark. In a letter dated 18 October 2006, its representatives requested the Respondent to outline suitable terms for compensation to transfer the disputed domain name to the Complainant. The Respondent offered to sell his entire business on 8 November 2006 to the Complainant, including the retail shops, for £10 million to test the Complainant's reaction. On legal advice, the Respondent made another offer on 21 January 2007 and reduced the proposed offer to 5m euros. The Complainant thereafter failed to respond meaningfully until March 2007, despite numerous emails and phone calls. The Complainant's allegation that he has attempted to swindle it is without any substance and is designed to discredit the Respondent.
- 14 During the negotiations, the Complainant requested confidential and irrelevant financial information, and filed a CTM application for "Maisons du Monde". The Complainant did not have any intention of ever opening a meaningful dialogue about the possible transfer of the disputed domain name. The Complainant sought to obtain as much information on the Respondent as it could under a pretext, so that they could proceed with its CTM application.
- 15 On 12 May 2009, Spacessence Limited, was incorporated, a company 100% owned by the Respondent. On 10 June 2010 the business and goodwill of Maison du Monde and Maison du Monde Limited was sold to Spacessence Limited.
- 16 On 6 June 2011, the Complainant notified the Respondent of the WIPO Proceedings.
- 17 The Complainant has already received substantial evidence of the Respondent's legitimate trade by means of the OHIM proceedings where in excess of 2000 pages of evidence and submissions were filed in support of the opposition. OHIM has held that:
- "one of the few undisputed points in the proceedings is the fact that the presented evidence is sufficient to prove that the opponent has actually used the name Maison Du Monde in the course of trade".*
- 18 The Complainant is being disingenuous, having forced the Respondent to oppose the CTM application at a huge cost to itself. It is an abuse for the Complainant to be repeating the same claims when OHIM has held that Maison du Monde had properly established its use of the name and traded as such legitimately in the UK since 2000.
- 19 The Complainant is harassing the Respondent and attempting to obtain a competitive advantage by means of the WIPO Proceedings when it knows full well that the Respondent has established its trading history.
- 20 While OHIM found that the Respondent's use of "Maison du Monde" was only of mere local significance (and therefore rejected the opposition), this does not mean that the Respondent has no entitlement to use his non registered trade mark in the UK or that he has no rights in respect of the disputed domain name.
- 21 The Respondent did not pursue his UK trade mark application because of legal advice that it would not be granted after the decision of OHIM.

- 22 The Respondent did not answer the Complainant's letters because he did not receive them.
- 23 The Complainant itself concedes that it was not until 2006, six years after the disputed domain was registered, that it realised that a company in another country was using a similar name to its own. A cursory internet search conducted in the period 2000 - 2006 would have come across legitimate use of the disputed domain name.
- 24 There is nothing extraordinary in calling a retail furniture company "House" or "Home"; it is a natural choice, and there are numerous examples around the world. An analogy can be drawn with the use of "Casa" type names in Spanish or Italian.
- 25 The Respondent has over 20 years experience in the retail furniture business. The Respondent owned a well-known ethnic style worldwide furniture brand called "Global Village" which began in 1990 and was sold in 1995. This business operated 10 stores in the south of England including a concession in Harvey Nichols. The name "Maison du Monde" was chosen by the Respondent as a continuation of the Global Village brand and reflected the nature of the business as "House of the world" furniture, importing household furniture products into the UK from India, Morocco and Indonesia. "House of the world" is not an attractive sounding name in English, but works much better in French.
- 26 The Respondent's retail and internet business was set up from 2000 and is still operating today. The Respondent is trading successfully. The Respondent's website is occasionally shut down for maintenance purposes and may not have been accessible for that reason from time to time.
- 27 The business of Maison du Monde was sold to Spacessence Ltd in June 2010, and the companies of Maison du Monde Ltd and Maison du Monde Camden Ltd were dissolved.
- 28 The disputed domain name was not registered in order to prevent the Complainant from reflecting the mark in a corresponding domain name. He denies that he has engaged in a pattern of such conduct.
- 29 The Complainant was slow to exploit the internet and expand its brand overseas, and only did so four years after the Respondent had started marketing over the web.
- 30 The Complainant did not refer to the date of registration of maisonsdumonde.com and maisonsdumonde.fr (22 July 2004) in the Complaint because this occurred after the Respondent's registration of the disputed domain name. The Respondent claims that it was not until 2006 that the Complainant began registering domain names similar to the Respondent's including maison-du-monde.com , co.uk, .eu, .es .nl, .lu, and so on, and also maisondu monde.es, lu and nl, to name a few. The Respondent says that this constitutes an abuse against his trading name.
- 31 As to the Respondent's incorporation of companies with names which correspond to well know corporations, "Amazon" has a geographical connotation; trans-Europa means "across Europe" and QuickChips was involved in the development of a counter top machine that delivered freshly made French fries. Two of the names were preregistered companies that could be purchased off the shelf in the UK. The Respondent states that this allegation is irrelevant, and is designed to obfuscate

the fact that the Respondent's business under the disputed domain name is legitimate.

- 32 The Complainant is not a competitor, nor is the disputed domain name registered by the Respondent primarily to disrupt the Complainant's business. The Respondent states that it would not make sense to set up a business with six stores to disrupt a business that no one had heard of in the UK.
- 33 As to the Complainant's allegation that the Respondent has modified his website to resemble the Complainant, website companies change their house style, logo and typeface over time. The Respondent has changed and updated his trading style at least four times in 11 years and will continue to do so as it is good commercial practice. Most furniture businesses organise their websites under the terms which the Complainant objects to (Home, Styles, Materials, Room). A survey on the web confirms this for many types of business. This is a common sense layout reflecting the manner in which customers buy furniture. The Complainant has also developed and changed its current website to reflect a completely different set of tabs on its homepage.
- 34 The Respondent has not knowingly displayed any images belonging to any third parties without their permission. The Respondent purchases furniture from China, India and Indonesia including leather chairs, and it is possible that similar suppliers use similar images when promoting their product. The Respondent exercises care to ensure that website images are permitted but where mistakes have been made the Respondent would remove the image and apologise as appropriate.
- 35 The Complainant recently infringed a third party trade mark for Newgate clocks. This illustrates that infringement is an operational problem for most businesses.
- 36 Before any notice of the dispute, the Respondent used the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.
- 37 The Respondent has been commonly known by the domain name, and has acquired unregistered trade mark rights through trading.
- 38 The Respondent is making a legitimate fair use of the domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trademark or service mark at issue.
- 39 The Respondent does not deny the existence of the Complainant's CTM rights in "Maisons du Monde", but they were acquired 10 years after the Respondent registered the disputed domain name.
- 40 The Respondent registered the disputed domain name in connection with his business to support the brand 'Maison du Monde', and has done so successfully for the benefit of his business.
- 41 The Respondent is not a dealer in domain names, never having sold a single domain name.

Reverse Domain Name hijacking

The Respondent makes the following submissions:

- 1 The WIPO rules provide that a Respondent may ask the Panel to make a finding of reverse domain name hijacking. This also should apply to Nominet.
- 2 In 2004 the Complainant only had limited rights to use the name “maisons du monde” in France yet they registered a number of national designations which are identical to the disputed domain name, such as maisondu monde.es, and maison-du-monde.es
- 3 This is a case of reverse hijacking the Respondent’s domain name. The Complainant was fully aware of the Respondent’s prior rights in this domain name; the Complainant is aggressive, litigious and has hijacked these other names.

The Complainant’s Reply

The Complainant makes the following submissions in Reply (omitting those which have already been made in the Complaint):

- 1 The Respondent is malicious and has attempted to discredit the Complainant and to tarnish its image. The Response contains many lies and is misleading.
- 2 According to the Whois of the disputed domain name, the owner of the domain name is the company Ashbourne Burton Lts. However, the Respondent admits that the new and the real owner of the disputed domain name is “Spaceessence Ltd” trading as Martin Helme. According to the terms and conditions of registration, the Respondent should have informed the Registrar of the transfer of the domain name from Ashbourne Burton Ltd to Spaceessence Ltd.
- 3 As to the Respondent’s claim that “Spaceessence Ltd” bought the business and the goodwill of the “Maison du Monde Ltd” on the 10 June 2010, the agreement which evidences this has no legal value because it was made between private parties without being certified by any independent third party. The person who witnessed the agreement lives with the Respondent and is the secretary of Spaceessence. Clause 3 of the agreement states that the purchase price (exclusive of VAT) of the assets is £100,000. This is very substantially below the Respondent’s offer to sell the same business to the Complainant which supports the accusation that the Respondent attempted to swindle the Complainant.
- 4 On 16 June 2011, the Complainant discovered that the Respondent has suddenly reopened its website at the URL “http://maisondu monde.co.uk/.” Prior to that it had been closed for several months. The reopening of this website, immediately after the Complainant filed its complaint before Nominet, proves that the new website is a sham. The Respondent has not provided any proof of sales made via his website.
- 5 As to the Respondent’s claim that his website was temporarily closed for maintenance purposes, this is untrue as the maintenance of a website could not reasonably last one year.
- 6 The Respondent pretends in his response that he has “rights in an unregistered trademark [maison du monde] in the UK under the laws of passing off in the UK”. However, OHIM held that the evidence submitted before it (which is the same as the evidence before the Expert) is not enough to prove that the Respondent’s use of “Maison du Monde” is of more than mere local significance”. OHIM rejected the Respondent’s oppositions, and he has not appealed the decision.

- 7 After OHIM's decision, the Respondent withdraw his application for the trade mark "Maison du Monde" before the UK IPO because he knew that it would be rejected. The Respondent cannot maintain any rights to the name "Maison(s) du Monde."
- 8 The Complainant had rights in respect of "Maisons du Monde" before the Respondent registered the domain name in 2000. The Complainant was created in 1996 under the corporate name "Polymag" but the commercial name was already "Maisons du Monde". The corporate name was changed from "Polymag" to "Maisons du Monde" in 2002. This company merged with the French Group XM in 2003.
- 9 In 1999, the Complainant registered its words and design French trade mark and its first two domain names "maisons-du-monde.com" and "maisons-du-monde.fr". The Complainant's trade marks have generated a real and vast goodwill through its trade. The Complainant also proposes to deliver the products bought via its website in France, Belgium, Germany, Denmark, Spain, Italy, Luxembourg, Nederland, Austria, Portugal, Switzerland and the UK.
- 10 The Complainant has sold furniture since the beginning of its trade. The Complainant's French and Community trade marks are registered under class 20 of the International Classification of Goods and Services under the Nice Agreement which refers to "Furniture."
- 11 The Respondent's allegation that the Complainant has infringed third party trade marks is an attempt to denigrate the Complainant by false accusation.
- 12 The Respondent's evidence that the Complainant's customers have complained about its business is composed of extracts of different pages of the website "www.reviewcentre.com" that the Respondent has selected. The Respondent added the letter "s" to the word "Maison" on the documents filed, and the negative comments concern "Maison du Monde" (the Respondent) and not "Maisons du Monde" (the Complainant). In any case, the website "www.reviewcentre.com" contains few negative comments, and they could not be considered as representative of the global opinion of the Complainant's customers.
- 13 The Respondent has attracted adverse consumer reaction in relation to non-delivery of product and failure to refund.
- 14 The Respondent has provided no proof of any goodwill of his business activity. He alleges that he is commonly known through the name "Maison du Monde" with six active physical retail units. However, in its decision dated 27 October 2009, OHIM considered that the Respondent:
- "could not furnish proof that its shops in and around London reached the threshold of more than mere local significance. As regards the economic dimension of trade, which is another important indicator for the significance of a sign, [the Respondent] has not presented convincing evidence about the impact of its trade name".*
- 15 In order to prove the existence and the extent of his activity, the Respondent has filed with his Response the same vast number of documents that were previously filed during the course of the opposition proceedings before OHIM. OHIM questioned the accuracy and the veracity of those documents. OHIM concluded that

“the evidence submitted in the present case is not enough to prove that the use of the name “MAISON DU MONDE” is of more than mere local significance”.

- 16 The Respondent has concealed the fact that following the OHIM decision, his stores (assuming they existed) were closed as well as the URL'S www.maisondumonde.com and www.maisondumonde.co.uk.
- 17 The Respondent has not provided any evidence supporting his turnover or sales made in his stores or via his website.
- 18 The reproduction of a picture of the Complainant's catalogue was not a coincidence and did not result from a simple mistake. It was part of the attempt to emulate the Complainant's website. The products shown in the catalogue were not sold by the Respondent on its website, as they had been designed by the stylists working for the Complainant. These products had been manufactured exclusively by and for the Complainant. The photograph was undertaken by a French photographer on an exclusive and private basis for the Complainant. In the circumstances, the Respondent cannot pretend that he acquired this picture by mistake from his foreign suppliers. The only way that the Respondent could have obtained this picture was to have copied the photograph directly from the Complainant's catalogue and website.

Respondent's supplemental statement pursuant to 3a of the DRS Procedure.

On 6 September 2011, the Respondent submitted a non-standard submission pursuant to 3a of the DRS procedure in which the following submissions were made:

- 1 He requested that the Expert consider the WIPO Decision, which related to a domain name dispute between the same parties in relation to maisondumonde.com.
- 2 The Complainant was found by the Panel to have attempted to engage in Reverse Domain Name Hijacking.
- 3 The Complainant continues to refuse to communicate with the Respondent or his representative, despite sending more than 12 separate emails.

Complainant's supplemental statement pursuant to 3a of the DRS Procedure.

On 16 September 2011, the Complainant submitted a non-standard submission pursuant to 3a of the DRS procedure in which the following submissions were made:

- 1 In respect of the WIPO Proceedings, the conditions stated in the Nominet DRS Policy are not the same as those defined in the UDRP Policy. In particular, under the UDRP, to establish bad faith a Complainant must prove that the current use is in bad faith, as well as establishing bad faith at the time of registration or acquisition. The Panel did not find bad faith at the time of registration or acquisition.
- 2 Under the Nominet rules, a Complainant can establish an abusive registration through use alone, even if the use was not abusive at the time of registration or acquisition.
- 3 The Expert is not bound by the Panel's decision in the WIPO Proceedings.

4 After the WIPO decision, the Respondent sent a letter to the Complainant dated 12 August 2011, in which he again attempted to sell its fictive business to the Complainant and to pressurise it. This letter constitutes new evidence of the Respondent's bad faith, who is attempting again to swindle the Complainant.

5 Previous submissions contained in the Complaint or Reply were also repeated.

6. Discussions and Findings

1 Under paragraph 2 of the Policy, the Complainant is required to prove to the Expert on the balance of probabilities that (a) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and (b) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

2 An Abusive Registration is defined in paragraph 1 of the Policy as a Domain Name which either (a) 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 (b) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

3 Rights are defined under paragraph 1 of the Policy as:

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

4 The first question I have addressed is whether I ought to admit the parties' non-standard submissions (NSS). I have decided to do so. This is because the Respondent's NSS relates to a WIPO decision which was published after the Response was filed, and which could not therefore have been adduced as part of the Response. Equally, the Complainant's NSS was largely a response to the Respondent's NSS. It would not be fair to exclude the Complainant's NSS in such circumstances. Furthermore, I do not believe that by admitting this material either party has improved its case to the prejudice of the other party.

5 The next question that needs to be decided is whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6 There is no doubt in my view that the Complainant has acquired enforceable rights in respect of a name or mark which is identical or similar to the disputed domain name under the rules of the DRS. This finding is based on the fact that the Complainant is the registered proprietor of a number of word marks for “Maisons du Monde,” including the CTM registered under the number 005120481 on 19 May 2006. Indeed, the Respondent does not challenge the similarity between the disputed domain name and the Complainant's word marks registered for “Maisons du Monde”; rather he disputes whether any confusion would arise despite that similarity.

7 I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

8 The next issue to be determined is whether or not the Domain Name, in the hands of the Respondent, is an Abusive Registration. This means either that it was

registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or that the Domain Name has subsequently been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

- 9 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration under the Policy is as follows:

Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

as a blocking registration against a name or mark in which the Complainant has Rights;

or for the purpose of unfairly disrupting the business of the Complainant;

Circumstances indicating 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.

The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .auk 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.

- 10 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

10.1 *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;*

10.2 *been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or*

10.3 *made legitimate non-commercial or fair use of the Domain Name.*

- 11 The Respondent has denied any knowledge of the Complainant or its Rights at the time he registered the disputed domain name. I have approached this submission carefully in view of the serious allegations made against the Respondent, and the fact that the Respondent admits working in this sector as a director and part owner of Global Village Limited/Heritage Craft Limited since 1991. I have, however, concluded that the evidence adduced by the Complainant is insufficient to justify the inference that the Respondent was cognisant of the Complainant or its Rights at the relevant time, and had an abusive intent at the time of registration. There is insufficient evidence before me to establish on a balance of probabilities that the Maisons du Monde mark or name was widely known at the time of the Respondent's registration, or at least sufficiently well known as to be likely to have come to the attention of the Respondent prior to registration of the

Domain Name. The circumstances of the Respondent's registration do not therefore amount to an Abusive Registration in my view (as defined under the Policy).

- 12 In reaching this conclusion I have considered the submissions and evidence relating to:
 - 12.1 the date when the Complainant commenced trading (1996);
 - 12.2 the intensity of the Complainant's trade under the "Maisons Du Monde" marks prior to the registration of the disputed domain name (which trade appears to have been largely confined to France) ;
 - 12.3 the geographical spread of the Complainant's consumers prior to registration (which again appears confined to the French market);
 - 12.4 the scope and territoriality of the Complainant's trade mark rights, and domain name registrations at the material time;
 - 12.5 the nature of the Complainant's advertising and the media it used for its advertising prior to the registration of the domain name in issue.
 - 12.6 the reasons given by the Respondent for choosing the disputed domain name; and
 - 12.7 the Respondent's use of the disputed domain name, and his connection to various companies whose corporate names include "Maison Du Monde" or variations of that name, prior to receiving any notice of the Complainant's complaints in 2006.
- 13 I also note that the Respondent did not make any contact with the Complainant until several years after registering the disputed domain name. Furthermore, that contact was in response to a letter of complaint written by the Complainant's representatives in September 2006. This constitutes persuasive evidence in the circumstances of this case that the Complainant did not have any abusive intent at the date of registration.
- 14 I also note that, despite OHIM's criticisms of the evidence filed by the Respondent in connection with the opposition proceedings, OHIM found that the Respondent's use of "Maison du Monde" was genuine, albeit only of local significance.
- 15 Accordingly, in my view, the disputed domain name was not registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights. The evidence does not establish that the Respondent registered the disputed domain name with abusive intentions in mind (in the sense required under the DRS Policy). In my view, the evidence does not establish that the Respondent registered the domain name in dispute for the purposes of selling, renting or otherwise transferring it to the Complainant for excessive consideration, or for the purpose of unfairly disrupting the business of the Complainant (whether in an attempt to create confusion with the Complainant's business, or to misleadingly divert internet traffic) or otherwise.
- 16 However, that is not an end of the matter since a registrant's motives, intentions and conduct after registration of a domain name can constitute an abusive use within the meaning of the Policy. This can include offering to sell the domain name at an unjustified profit, unfairly disrupting the Complainant's business, or other abusive conduct. All these are in issue in these proceedings.

- 17 Taking each of the Complainant's submissions and evidence in turn (insofar as relevant to this head of abusive conduct):
- 18 The Complainant submits that that the Respondent's decisions to oppose the Complainant's CTM applications, and to apply to register a UK trade mark for Maison Du Monde are indicative of abusive conduct. The suggestion is that these were attempts to take unfair advantage of the Complainant, and were little more than spoiling tactics designed to extricate a premium for the domain names in issue.
- 19 Having read the various submissions made by the parties before OHIM that were included in the evidence before me, and OHIM's decision itself, and the other evidence and submissions relevant to this aspect of the Complaint, in my view it would be wrong to impute an improper motive to the Respondent in respect of his conduct before OHIM or the UK IPO.
- 20 The proceedings before OHIM and the UK IPO seem to me to have been genuine disputes between parties acting in good faith. Accordingly, in my view, there is insufficient evidence in respect of these proceedings to support a finding of abusive conduct in relation to the disputed domain name.
- 21 The Complainant's evidence and submissions in respect of other forms of abusive conduct can be distilled to the following grounds:
 - 21.1 that the Respondent's trade is fictitious, and that this establishes abusive conduct in respect of the domain name in issue. In that regard, the Complainant refers, for example, to the dissolution of Maison du Monde Limited (and other companies bearing similar names); to the alleged shutting down of the Respondent's website; to the length of time it was not operational; to the timing of its re-opening (allegedly immediately after the Complaint was filed); and to the lack of evidence of the Respondent's trade conducted under the Maison du Monde mark and domain over recent years.
 - 21.2 that the content of the Respondent's website has changed over the years, in ways which indicate abusive conduct. It refers, for example, to the past use of a large banner on the Respondent's website promoting free delivery to France; to the use of tabs which are alleged to emulate aspects of the Complainant's website; and to the alleged infringement of its copyright. The suggestion is that the Respondent is seeking to attract the Complainant's customers, and that this is also supported by the fact that the Respondent trades in furniture. It is hard to reconcile this submission with the allegation that the Respondent's trade is fictitious (as there would be little point attracting the Complainant's customers to a fictitious business) but nonetheless I will deal with each on its merits.
 - 21.3 that the Respondent's various offers in respect of his business (ranging between 5m euros and £10m sterling), as detailed in the correspondence between the parties, and his failure during the course of negotiations to provide financial information and material to justify the offer, is further evidence of the Respondent's real intention to "swindle" the Complainant. The Complainant contrasts these offers with the purchase price of £100,000 apparently paid by Spaceessence Limited for the goodwill and business of Maison Du Monde Limited. This is also said to constitute evidence of abusive conduct (albeit that the Complainant disputes the legal effect of this agreement).
- 22 It is important to recognise that the DRS system does not envisage a detailed analysis of factual disputes or the forensic calibration of conflicting accounts or

inconsistent versions of events. The DRS is intended to be a relatively simple, low cost and efficient system. It is paper based, and seeks to avoid the evidence and procedures of court litigation such as disclosure, witness statements, expert evidence and cross-examination. The DRS is not an appropriate forum for testing complex disputes nor is it designed to rule on questions concerning alleged infringements of copyright, trade marks or passing off infringements.

- 23 Against that background, and the limits of the DRS, I have found as follows in respect of the parties' submissions.
- 24 First, I am not persuaded on the evidence that the Respondent's trade or website is fictitious or has been created in an attempt to defeat the Complaint and/or is designed to take unfair advantage of or damage the Complainant's business, or its rights. In my view, the Respondent has used the disputed domain name in connection with a genuine offering of goods or services. I also note in particular the findings made by OHIM that the Respondent's trade was real on the evidence before that tribunal, albeit geographically confined.
- 25 I do not find the Complainant's evidence in respect of the alleged changes to the content of the Respondent's website as being sufficiently persuasive that the Respondent sought to adopt, or did in fact adopt, the Complainant's trading style over the internet via use of the domain name in issue. Nor was the Respondent's apparent failure to operate his website continuously evidence of abusive conduct in my view.
- 26 I should note that I make no finding on the allegation of copyright infringement, which is a matter for national courts. Nor do I make any finding in respect of the allegation that the Respondent has infringed the Complainant's trade marks.
- 27 Secondly, in my judgment, the Respondent was entitled to register the domain name when he did, and to use it to sell furniture and related items, bearing in mind the limited territorial scope of the Complainant's Rights at the material time, the nature of the its trade, and that this is a first to file system.
- 28 Thirdly, while the price tag the Respondent put on his business during the course of negotiations may well have been very high, in my view the evidence indicates that the Respondent saw these negotiations as a genuine commercial opportunity rather than a means of "swindling" the Complainant. Furthermore, the offer was in respect of the Respondent's entire business, not simply in respect of the disputed domain name. In my judgment, the evidence adduced in respect of these negotiations and correspondence falls short of what is required to establish an illegitimate purpose on the part of the Respondent in respect of the disputed domain name within the meaning of the Policy.
- 29 Under the DRS Policy, one factor which may constitute an abusive registration is where 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 Complainant submits that the Respondent has registered companies with names that correspond to famous names. However, this is insufficient by itself to infer abusive conduct in the circumstances of this case.

Reverse domain name hijacking

- 30 Under the DRS Procedure, this is defined as using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name.
- 31 The evidence in my view does not establish the Complainant acted in bad faith in bringing this Complaint. In reaching this conclusion I have also taken into account the registration of domain names by the Complainant which are identical to the disputed domain name (other than in respect of immaterial elements, such as the country code designations or generic suffixes).
- 32 The evidence before me suggests that the Complainant has a genuine belief that the Respondent's use of the Domain Name amounts to an Abusive Registration. In the circumstances, in my view the Complainant was perfectly entitled to have its allegations tested under the DRS.

7. Decision

In the light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name but that the Domain Name, in the hands of the Respondent, is not an abusive registration, I direct that no action be taken in respect of the Complaint.

Signed Cerryg Jones

Dated 30 September 2011