

Nominet UK Dispute Resolution Service

Complainant Reference Number:1212

**INTERFLORA (F.T.DA.A) BRITISH UNIT LTD -V-
SOFTDESIGN SERVES LTD**

Decision of Independent Expert

1. Parties:

Complainant Type Business
Complainant: Interflora (F.T.D.A) British Unit Ltd
Address: Interflora House
 Sleaford
 Lincolnshire
Postcode: NG34 7TB
Country: GB

Respondent: Softdesign Services Limited
Respondent name: Mr C Miralles
Address: Meridian House
 Suite 1
 Royal Hill
 Greenwich
 London
Postcode: SE10 8RT
Country: GB

2. Domain Name:

interflora-uk.co.uk (“the Domain Name”)

3. Procedural Background:

The Complaint was lodged with Nominet on 7th February 2002. Nominet validated the Complaint on 8th February and informed the Respondent to the Complaint, by notification dated 11th February 2002, sent by post and by e-mail, that it had 15 days within which to lodge a Response. No Response was received. Mediation was accordingly not pursued. The Complainant was informed accordingly and by letter dated 19th March 2002, the Complainant paid Nominet the appropriate fee for a decision of an expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On 21 March 2002, Antony Gold, 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.

4. Outstanding Formal/Procedural Issues (if any):

It is first necessary to deal with the fact that no response has been made by the Respondent. Under paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”), the Respondent is required to submit a response to Nominet within 15 days after the commencement of proceedings. Paragraph 15b of the Procedure provides that the Expert will proceed to a Decision on the Complaint if, in the absence of exceptional circumstances, a party does not comply with any time period laid down in the Procedure. There is no evidence before the Expert to indicate the presence of exceptional circumstances and a decision is accordingly made on the Complaint notwithstanding the fact that no response has been provided by the Respondent.

Paragraph 15c of the Procedure provides that if in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or the Procedure, the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate. Whilst it is not intended to draw any adverse inferences from the Respondent’s failure to respond to the Complaint, the starting point for this decision is that the facts asserted by the Complainant are correct.

5. The Facts:

The Complainant asserts that Interflora is well-known as the world’s leading florist relay service, having operated in the UK and throughout the world for over 75 years.

The Complainant has stated that Interflora Inc is the registered proprietor of a number of INTERFLORA trade marks in the UK and that these marks have been exclusively licensed to the Complainant. A copy of the license from Interflora Inc to the Complainant has been produced dated 7 December 1987 (albeit signed by the parties on 8 and 13 February 1988) together with details of 7 trade mark registrations for INTERFLORA, each registered on 16 December 1987, on behalf, of Interflora Inc in classes 16, 31, 35, 38, 39, 41 and 42 (“the Trade Marks”).

A Nominet WHOIS search shows that the Respondent registered the Domain Name on 11th April 2000. The Complainant asserts that the Respondent has used the Domain Name for, amongst other matters, ultimately to link to the website of a florist who was not an Interflora member. The Appendix to the Complaint which purports to set out evidence in support of this assertion is not entirely helpful on the point. A page interflora-uk.com is attached to the Complaint, which may be the link page to which the Complainant is referring. There are also attached pages from computingfuture.fsnet.co.uk to which the home page at interflora-uk.com may have linked. This contains brief details about Clare Florist. A further undated copy of a page from interflora-uk.com, shows a direct link to Clare Florist, which would appear to be a floral relay service.

The correspondence attached to the Complaint shows that the Complainant’s lawyers first wrote to the Respondent about its ownership and use of interflora-uk.com and the Domain Name by letter dated 1st May 2001. A chasing letter dated 14th May 2001 produced a response from the Respondent dated 21st May in which it indicated that it would transfer the two domain names to the Complainant “*in exchange for a financial consideration to be agreed*”. The Respondent indicated that it was not interested in using the names itself. By letter dated 6th June 2001, the Complainant’s lawyers offered to pay reasonable registration

costs up to a maximum of £100 for each of the domain names. After a further chasing letter, the Respondent replied by letter dated 6th July 2001 asserting *“Due to a high level of interest in our auction of the www.interflora-uk.com and www.interflora-uk.co.uk domain names, we feel that a price of £6,000 plus Vat for both would be appropriate for your client to offer for a smooth transition of these domains to be agreed”*. Again, disinterest was expressed by the Respondent in using the names for itself. Following a further letter sent by the Complainant’s solicitors on 22nd August 2001 declining this offer, the Respondent replied by letter dated 4th September 2001 denying various allegations made by the Complainant and repeating its earlier offer. It added; *“If your client is so concerned....I would strongly suggest that they seriously consider our offer of £6,000 for a smooth transition of these domain names NOW. The alternative for your client is to incur further costs, probably well above the reasonable price mentioned above in expensive lawyers’ fees achieving little results. We also believe that any court action would be counterproductive....”*.

6. The Parties’ Contentions:

Complainant:

The Complainant asserts that:

1. The Domain Name is identical to the Trade Marks and to the trading name of the Complainant. It contends that the element “-uk”, which it describes as a suffix, is descriptive and wholly generic.
2. The Domain Name is an Abusive Registration because;
 - (1) the name is being used primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant for a consideration in excess of the Respondent’s out-of-pocket costs. In this respect, the Complainant relies on the chain of correspondence referred to at section 5 above.
 - (2) the registration of the Domain Name takes unfair advantage of or is unfairly detrimental to the Complainant’s Rights. In this respect, the Complainant draws attention to the Court of Appeal decision in *British Telecommunications Plc v One in a Million* [1999] ETMR as authority for asserting that the mere placing on the Internet Register of a distinctive name made representations to persons who consulted the Register that the person who had done so was connected with or associated with the name registered and thus the owner of the goodwill in the name. The Complainant asserts that the Respondent has no legitimate claim to the goodwill and reputation in the INTERFLORA name. It says that the Respondent is not an INTERFLORA florist and that INTERFLORA members are bound by strict membership rules which control the use of the INTERFLORA name. It says that use of the Domain Name by non-INTERFLORA florists, such as Clare Florist, will confuse people into believing that the Domain Name is registered to, or authorised by, the Complainant and/or into believing that the florist is an INTERFLORA member and is in some way sponsored, affiliated, endorsed or authorised by Interflora. The Complainant says that there is a likelihood that use of the Domain Name will be unfairly detrimental to the Complainant’s rights by diluting the capacity of its INTERFLORA mark to indicate the origin and quality of Interflora members’ goods and services.

Respondent:

As explained above, the Respondent has not responded.

7. Discussion and Findings:

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert on the balance of probabilities, both that it has rights in respect of a name or mark identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in paragraph 1 of the Policy.

Complainant's Rights

The Complainant in this case has asserted that it has rights in the word INTERFLORA and that this name is identical to the Domain Name. In considering whether or not a name or mark is identical or similar to a domain name, it would usually be appropriate not to take into account the domain suffix, that is co.uk. The Complainant's contentions that the addition of "-uk" to the word INTERFLORA is a descriptive and generic addition is accepted, albeit that this element of the word is strictly part of the Domain Name, rather than a domain suffix. For this reason, the Domain Name complained of, that is Interflora-uk, is similar to, rather than identical to, the name in which the Complainant has rights, being INTERFLORA. However, this is sufficient for the purposes of satisfying the relevant requirement of paragraph 2.

The requirement that the Complainant has rights in the word INTERFLORA is established from the License Agreement with Interflora Inc appended to the Complaint coupled with the schedule of marks owned by Interflora Inc which are also attached to the Complaint. Although there is no evidence supplied to substantiate the assertion that "INTERFLORA is well known as the world's leading florist", it is accepted that the INTERFLORA name is very well known.

Abusive Registration

The Complainant also has to show that the Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines "Abusive Registration" as 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 unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. These include circumstances indicating that the Respondent ;

"3a i; 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".

The Respondent's conduct falls squarely within the provisions of this subsection. The Respondent's assertions in the correspondence referred to at section 5 above make it apparent that the Respondent has no intention of using the Domain Name for itself. It is not contending that it has any rights in the name or that the name was acquired by it on behalf of any party who was entitled to use the name. The most obvious users of the Domain Name would include the Complainant, although other legitimate users may include other parties with rights in the word INTERFLORA, such as Interflora Inc. The Respondent may have incurred some out-of-pocket costs in connection with its acquisition of the name and its use, but these are not documented and it is reasonable to suppose that they cannot have approached anything like the sum of £6,000 sought by it for transfer of the Domain Name to the Complainant. Accordingly, it is found that the primary purpose for which the Domain Name was registered was to sell, rent or otherwise transfer the Domain Name to the Complainant for a consideration in excess of the Respondent's documented out of pocket costs directly associated with the acquisition and use of the Domain Name.

In addition to its contentions under Section 3 (a) (i) of the Policy, the Complainant contends that the Domain Name is also an Abusive Registration for the reasons set out in section 6.2 (2) above and that, for those reasons as well the registration of the Domain Name "takes unfair advantage of and is unfairly detrimental to the rights of the Complainant". Accordingly, it is necessary to consider whether the Respondent's use of the Domain Name can be so categorised.

In developing its argument as to why registration of the domain name takes unfair advantage and is detrimental to the Complainant's rights, it is considered that some of the Complainant's evidence is misdirected, to the extent that it seeks to deal with the Respondent's actual use of the Domain Name.

First, the evidence appended to the Complaint is scant in establishing exactly what use has been made of the Domain Name. The evidence supplied shows that the Domain Name has been used, albeit there is no active site at present. However, the evidence appended to the Complaint does not clearly establish the actual use made of the Domain Name. Only a single page containing a banner with the words "Promotional Business Digital Cultural Legal" printed on 30th April 2001 is clearly from a site accessed through the Domain Name and, whilst a site at www.computingfuture.fsnet.co.uk contains a reference to Clare Florist to which traffic directed to the site at www.interflora-uk.co.uk may have been forwarded, this is unclear. Further, one of the pages to which the Complainant has alluded as containing the name Clare Florist is actually a site at www.interflora-uk.com and not a site accessed through the Domain Name.

The Complainant's reference to the One in a Million case at section 6 above is not persuasive in establishing that the requirement of use under Paragraph 1 (ii) of the Policy is satisfied simply by registration of the Domain Name. In the context of the rules of the Policy, the need to show use requires more than simply registration. If that were not the case, every domain name which had been registered should also be regarded as having been used simply by the fact of registration.

However, for the purpose of establishing that a domain name is an Abusive Registration, as defined in the Policy, the Complainant can show under Paragraph 1(i) of the Policy that the Domain Name 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. In this respect, it is material to note that at the time of registration of the Domain Name, being 11 April 2000, the Trade Marks had been registered for over 12 years and the Licence Agreement had been in effect for a similar period. Having regard to this fact, the expert is satisfied that the registration of the Domain Name took unfair advantage or was unfairly detrimental to the Complainant's Rights in that at the time when

the registration took place the Respondent cannot have had any proper basis for registering the Domain Name for such a well known and established name without the authority of the company which had rights in the name and nothing in the correspondence appended to the Complainant suggests that the Respondent was asserting that it had any authority to do so.

Before concluding, it is necessary to consider paragraph 4 of the Policy which indicates grounds by which a Respondent might demonstrate in its response that the Domain Name is not an Abusive Registration. These include, under paragraph 4 a i, that before being informed of the Complainant's dispute, 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 and 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.

(Paragraph 4 a ii relates to generic or descriptive names and is inapplicable).

The correspondence suggests that the Respondent must have been aware of the Interflora business and the value attached to the INTERFLORA name. There is no evidence to suggest that it could have thought other than that the Complainant would have disputed its right to the use of the Domain Name. It is not easy to second-guess what the Respondent might have said had it filed a Response, but there is nothing on the facts which are known which would suggest that the Respondent might have been able to avail itself of paragraph 4 a of the Policy.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration as defined by paragraph 1 of the Policy on the basis that the Respondent 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 and on the further basis that the Domain Name 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.

8. Decision:

In light of the findings that the Complainant has rights in respect of a name or mark which is similar to the Domain Name and that the Domain name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name *interflora-uk.co.uk* be transferred to the Complainant.

Antony Gold

Date