

ADMINISTRATIVE PANEL DECISION

Nichebox UK Limited v. Jonnmar Design House Limited
Case No. DIE2024-0003

1. The Parties

The Complainant is Nichebox UK Limited, United Kingdom, represented by Perani Pozzi Associati - Studio Legale, Italy.

The Registrant is Jonnmar Design House Limited, Ireland, internally represented.

2. The Domain Name and Registrar

The disputed domain name <clivechristian.ie> is registered with IE Domain Registry Limited (“IEDR”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 6, 2024, via email. On August 7, 2024, the Center transmitted by email to IEDR a request for registrar verification in connection with the disputed domain name. On August 8, 2024, IEDR transmitted by email to the Center its verification response confirming that the Registrant is listed as the registrant and providing the contact details. The Registrant sent emails to the Center on August 6 and 19, 2024.

The Center verified that the Complaint satisfied the formal requirements of the .IE Dispute Resolution Policy (the “IEDR Policy”), the WIPO Dispute Resolution Rules of Procedure for .IE Domain Name Registrations (the “Rules”), and the WIPO Supplemental Rules for .IE Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2.1 and 4.1, the Center formally notified the Registrant of the Complaint, and the proceeding commenced on August 22, 2024. In accordance with the Rules, paragraph 5.1, the due date for Response was September 19, 2024. The Response was filed on September 19, 2024.

The Center appointed Adam Taylor as the sole panelist in this matter on October 7, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On October 28, 2024, the Panel issued Procedural Order No. 1 (“PO1”) seeking further information from the Registrant about its alleged relationship with the Complainant as well as the circumstances surrounding

registration and use of the disputed domain name, and affording the Complainant an opportunity to comment thereon. The Registrant and the Complainant responded to PO1 on November 5, and 13, respectively. The Panel refers below to PO1, and the parties' responses thereto, insofar as the Panel considers them material to its decision.

4. Factual Background

The Complainant operates the CLIVE CHRISTIAN perfumes and furniture brand, founded in 1978.

The Complainant owns a number of registered trade marks for CLIVE CHRISTIAN including European Union Registration No. 002198075, registered on October 10, 2002, in classes 3, 8, 14, 20, 24, and 26.

The Complainant operates websites at "www.clivechristian.com" and "www.clivechristianfurniture.com".

The disputed domain name was originally registered on February 17, 2006, by an entity connected with the Registrant, most likely Clive Christian Ireland Limited ("CCI"), incorporated in the Republic of Ireland, which was in any case the registrant of the disputed domain name by November 11, 2012.

Unless otherwise stated, references to "the Registrant" below should be taken as including the owner and all other connected entities.

The Registrant has used the disputed domain name as an email address since at least 2008. The disputed domain name has never been used for a website.

CCI was dissolved on July 24, 2020.

CCI was still showing as the registrant of the disputed domain name on February 20, 2024. The disputed domain name expired at some point thereafter and was re-registered by the Registrant on May 2, 2024.

The Registrant supplies rugs.

On May 31, 2024, the Complainant's representatives sent a cease and desist letter to the Registrant asserting that the disputed domain name constituted a passive holding in bad faith and an infringement of intellectual property rights.

The Registrant's owner replied on May 31, 2024, claiming to have been "the owner and operator of Clive Christian France and Ireland for around 20 years" and that the disputed domain name had been used for a personal email address since 2005. The Registrant stated that the domain name had simply expired and been renewed.

On May 31, 2024, the Complainant stated that, according to its searches, the disputed domain name had not been renewed but had expired before it was registered anew in the name of the Registrant, and that the Registrant did not own any rights to the mark CLIVE CHRISTIAN "regardless of any past relationships that might or not have occurred, all of which are anyway now extinct and no longer effective". The Complainant added that registration of the disputed domain name infringed the Complainant's intellectual property rights, and that the fact that someone working in a company operating in a similar field to those of interest to the Complainant was using the disputed domain name for a personal email address "makes the violation even more concerning".

On June 5, 2024, the Registrant reiterated that the disputed domain name had been his email address since 2005 and that he used this "to communicate even with Mr Clive Christian himself".

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- the Registrant has not been authorised or licenced by the Complainant to register or use the disputed domain name;
- the Registrant's use of a disputed domain name confusingly similar to the Complainant's mark indicates that the Registrant had knowledge of the Complainant's mark at the time of registration of the disputed domain name and, in any case, a basic Google search would have yielded obvious references to the Complainant;
- the disputed domain name is not being used for any bona fide offering and constitutes a passive holding in bad faith;
- it is "objectively not possible" to understand what kind of legitimate use the Registrant could make of a domain name that exactly corresponds to the Complainant's trade mark;
- the Registrant claims to have been using the disputed domain name for an email address for a long time despite the domain name appearing to have been registered, rather than renewed, on May 2, 2024;
- the Registrant operates in a field that overlaps with that of the Complainant, as it is engaged in the sale of carpets for interiors whereas the Complainant's mark is used also for furnishings and tailor-made interior design services, and Clive Christian himself is a well-known interior designer; and
- accordingly the disputed domain name could be used to take advantage of the Complainant's fame, for example to enable interception of communications intended for the Complainant.

B. Registrant

The Registrant contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Registrant contends that:

- all of the Registrant's clients use the email address at the disputed domain name to communicate with the owner of the business and many do not possess the owner's phone number and would be unable to reach him if the email address stopped working;
- the Registrant's owner also owns Clive Christian France SARL, which operates the franchise that the Registrant bought from Clive Christian himself;
- while the owner failed to renew the disputed domain name immediately for personal health reasons, he did renew it quickly thereafter and is still using it for his business;
- the Registrant, which provides paid management services for Clive Christian France SARL, was the entity used to pay for the disputed domain name simply because the renewal had been invoiced by an Irish company;
- the Registrant has not threatened, or referred to, the Complainant's perfume business and "we are one of many Clive Christian Furniture businesses around the world"; and
- the Complainant filed this proceeding abusively in order to coerce a small entity.

In an email to the Center of August 6, 2024, after the Complaint was filed, the Registrant asserted that the Registrant's owner used the personal email address to communicate "with every Clive Christian client - and with Clive Christian Furniture (U[K])" since 2005. ¹

¹On November 29, 2024, the Registrant sent two late unsolicited emails to the Center, making additional unsupported, allegations. Paragraph 9.4 of the Rules gives the panel authority to determine the admissibility, relevance, materiality and weight of the evidence. The Panel declines to admit these very late submissions, which the Registrant has not attempted to justify. The Panel would add,

6. Discussion and Findings

Under paragraph 1.1. of the IEDR Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or misleadingly similar to a protected identifier in which the Complainant has rights;
- the Registrant has no rights in law or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered or is being used in bad faith.

A. Identical or Misleadingly Similar to a protected identifier in which the Complainant has rights

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for misleading similarity involves a reasoned but relatively straightforward comparison between the Complainant's protected identifier and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"),² section 1.7.

Under paragraph 1.3.1 of the IEDR Policy, "protected identifiers" include "trade and service marks protected in the island of Ireland". The Complainant owns the above-mentioned European Union trade mark, which has effect within the Republic of Ireland and therefore constitutes a protected identifier.

The entirety of the protected identifier is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the protected identifier for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the IEDR Policy has been established.

B. Rights in Law or Legitimate Interests

Paragraph 3.1 of the IEDR Policy provides a list of circumstances in which the Registrant may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in proceedings under the IEDR Policy is on the complainant, panels have recognised that proving a registrant lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the registrant. As such, where a complainant makes out a prima facie case that the registrant lacks rights or legitimate interests, the burden of production on this element shifts to the registrant to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the registrant fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

As to paragraph 3.1.1 of the IEDR Policy, for the reasons explained in detail in section 6C below, the Panel does not consider that the Registrant has established good faith preparations for, or indeed use of, the disputed domain name in connection with a good faith offering of goods, services or a business.

Nor is there any evidence that paragraphs 3.1.2 or 3.1.3 of the IEDR Policy are relevant in the circumstances of this case.

The Panel finds the second element of the Policy has been established.

however, that even if the emails had been allowed, they would have made no difference to the outcome of this case. The Panel also notes that such emails have caused delay to the publication of this Decision.

² Although [WIPO Overview 3.0](#) is directed to the Uniform Domain Name Dispute Resolution Policy ("UDRP"), given the similarity between the UDRP and the IEDR Policy, it is appropriate to have regard to these principles except to the extent that the Policy diverges from the UDRP.

C. Registered or Used in Bad Faith

Paragraph 2.1 of the IEDR Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered or used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and/or use of a domain name is in bad faith.

First, the Panel will consider whether or not the disputed domain name was registered in bad faith.

In the Panel's view, nothing turns on the fact that the Registrant re-registered the disputed domain name in 2024, following its unintentional lapse for a short period owing to illness of the Registrant's owner. The Panel will treat February 17, 2006 – when the disputed domain name was first registered by an entity connected with the Registrant – as the key date for the purposes of assessment of registration and of bad faith.

The circumstances surrounding registration of the disputed domain name are somewhat opaque.

In the Response, and pre-action correspondence, the Registrant's owner claimed to have been the owner and operator of "Clive Christian France" and "Clive Christian Ireland" for some 20 years. The Registrant did not provide any supporting documents. Nor did the Registrant provide any detail regarding the alleged relationship between the Parties, beyond claiming that Clive Christian France SARL (apparently meaning the French company Clive Christian SARL) was a "franchise" that the Registrant's owner had bought "from Mr Clive Christian himself".

When invited in PO1 to supply more detail, and supporting evidence, in relation to the alleged relationship between the parties, the Registrant:

- claimed that, from 2005 onwards, the following entities connected with the Registrant had entered into "franchise" contracts with the Complainant: "Clive Christian Ireland", "Clive Christian France", "Clive Christian Monaco" and "Clive Christian Saudi Arabia";
- did not respond to the request to explain the nature of the alleged franchise relationships;
- declined to provide the contracts or other documents embodying such relationships, saying that "I cannot disclose these publicly";
- did not respond to the request to disclose the correspondence between the Registrant and Clive Christian relating to the Registrant's alleged purchase of the Clive Christian France franchise from Clive Christian himself;
- when asked to supply the date(s) when the franchises in France and Ireland terminated plus any correspondence with the Complainant relating to such termination, simply stated: "Clive Christian France is still doing business. This is why I care."; and
- when asked to supply supported dated evidence if the Registrant claimed that it was currently operating a business that used the name "Clive Christian" or if it otherwise dealt with the Complainant's products, simply stated "Yes, we are running Clive Christian France SARL" and linked to official corporate details of "Clive Christian SARL", incorporated on March 18, 2008.

As regards the requests in PO1 for more information about its registration and use of the disputed domain name specifically, the Registrant:

- claimed to have registered the disputed domain name on February 17, 2006, because "we are a business named Clive Christian and we trade product by the name of Clive Christian";
- when asked to supply dated supporting evidence if the Registrant asserted that the Complainant expressly or impliedly authorised registration of the disputed domain name on February 17, 2006, simply stated: "I do not have this to hand. I will have to ask Clive Christian. This may take time.";
- when asked when the Registrant believed that the Complainant first became aware of the Registrant's ownership of the disputed domain name and to supply supporting dated evidence, e.g., the alleged emails whereby the Registrant allegedly used the disputed domain name as an email address "to communicate even with Mr Clive Christian himself" per the Registrant's email of June 5, 2024, simply responded: "I guess when they saw us registering it again after its 10 year term had expired. We only paid for it using our Irish company as the VAT was Irish VAT so we could claim it back";

- stated that it had never used the disputed domain name for a website, only email;
- when asked if the Registrant ever used the disputed domain name for emails unrelated to the franchise relationships with the Complainant, whether before or after termination thereof (if applicable), or for matters unrelated to the Complainant's products, simply stated "It is my work email"; and
- did not respond to the request to explain why, if the Registrant had used the disputed domain name for emails unrelated to the Complainant or its products, the Registrant considered such usage to be legitimate, and to supply dated evidence if the Registrant maintained that the Complainant had authorised or acquiesced in use of the disputed domain name in this manner.

In short, the Registrant has provided vague, evasive, and incomplete responses to PO1.

The Complainant's position is not entirely satisfactory either. While denying that the Registrant currently holds any authority to use the Complainant trade marks, the Complainant's submissions lack any indication that the Complainant has at least investigated the existence of any former relationship between the Parties concerning "Clive Christian Ireland" and/or the Registrant's alleged dealings with Clive Christian "himself".

The Complainant asserts that it never authorised the Registrant to register or use a domain name containing its trade mark, but all that the Complainant provides in support is a standard-form, undated, heavily-redacted trade mark licence that includes such a prohibition, but without any evidence that the Registrant ever agreed thereto.

So, for whatever reason, both parties have tiptoed around the existence and nature of their relationship, if any, regarding "Clive Christian Ireland".

However, it is clear that, even if there were such a relationship, it is now terminated, given that the Registrant implicitly accepted this in its PO1 response and, indeed, CCI was dissolved in 2020.

Furthermore, the Panel notes that, unlike with the UDRP, under the IEDR Policy it is sufficient for the Complainant to establish either registration or use in bad faith.

Accordingly, whether or not the Registrant was justified in registering and using the disputed domain name in the context of the alleged former "Clive Christian Ireland" relationship (as to which the Panel makes no finding), the Panel notes the following in relation to the Complainant's use of the disputed domain name thereafter.

First, in the Panel's view, the Registrant's use of the disputed domain name – comprising the Complainant's unadorned trade mark – for email carries a high a risk of implied affiliation with the Complainant just as it would if it had been used for a website.

Second, as indicated above, despite being specifically invited to do so, the Registrant has failed to provide any evidence of the existence of the alleged continuing "Clive Christian France" relationship, which the Complainant denies and which does not feature on the Complainant's international list of "showrooms" on its website.

Third, the Registrant has not provided any evidence that Clive Christian SARL has ever functioned as an unauthorised reseller of the Complainant's goods. As mentioned above, all that the Registrant has provided is a link to that company's official corporate details.

Fourth, even if the Registrant was, and has remained, a reseller of the Complainant's products through Clive Christian SARL, the consensus view is that to establish a bona fide offering of goods or services in such circumstances, a respondent must comply with certain conditions which include an obligation to use the disputed domain name to sell only the trademarked goods. [WIPO Overview 3.0](#), section 2.8. In the Panel's view, this requirement applies to use of the disputed domain name for email as well as for a website.

Whereas, here, although the Registrant's email of August 6, 2024, claimed to have used the email address to communicate "with every Clive Christian client - and with Clive Christian Furniture (U[K])", the Response

referred to use of the email address to communicate with “all clients of our business”. Furthermore, in its PO1 response, the Registrant did not deny use of the disputed domain name for emails unrelated to the Complainant or its products, simply stating: “It is my work email”. Nor did the Registrant reply to the follow-up question in PO1, asking why, if it had used the disputed domain name in this manner, the Registrant considered such usage to be legitimate, and inviting the Registrant to supply dated evidence if the Registrant maintained that the Complainant had authorised or acquiesced in use of the disputed domain name in this manner.

For the above reasons, the Panel concludes that the Registrant has used the disputed domain name in bad faith under the third element of the IEDR Policy.

The Panel would add that, in its Response, the Registrant sought to justify the disputed domain name on the grounds that “we are one of many Clive Christian Furniture businesses around the world”. In its response to the request in PO1 to provide dated evidence supporting this claim, the Registrant stated that “[t]here are many Clive Christian franchises worldwide which have come and gone, just like my businesses” and provided links to three “random examples”, namely websites/webpages at “www.clivechristianchicago.com”, “www.clivechristian.ru” and “www.facebook.com/clivechristian.se”. The Registrant also linked to the “FIND A SHOWROOM” page on the Complainant’s own site, which included a map with pins in various places including Chicago, Russia, and Sweden.

For its part, the Complainant claims that the “Clive Christian businesses” invoked by the Registrant are all retailers who operate under licence agreements with the Complainant, including provisions that prevent them from registering domain names that include the CLIVE CHRISTIAN trade mark. While the existence of the above domain names cited by the Registrant is somewhat inconsistent with this claim, it could be that the Complainant has specifically consented to the domain names, or perhaps they constitute breaches of the licence terms. In any case, the Panel does not consider that the registration and use of these domain names by the Complainant’s authorised retailers is of assistance to the Registrant in the absence of any evidence from the Registrant that they constitute some sort of Complainant consent to, or acquiescence in, the Registrant’s activities.

Finally, the Registrant claims that many of its clients do not possess the Registrant’s phone number and may be unable to reach the Registrant if its longstanding email address stops working. However, transfer of the disputed domain name is the usual outcome of successful cases under the IEDR Policy, as under the UDRP, notwithstanding the inconvenience potentially caused to registrants. Presumably the Registrant will take steps to minimise any disruption including by notifying its clients of any new email address before the old one becomes inactive.

The Panel finds that the Complainant has established the third element of the IEDR Policy.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 5 of the IEDR Policy and 14 of the Rules, the Panel orders that the disputed domain name <clivechristian.ie> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Dated: November 25, 2024