



## NATIONAL ARBITRATION FORUM

### DECISION

American Signature, Inc. v. Sharm Scheuerman  
Claim Number: FA0603000653347

#### PARTIES

Complainant is **American Signature, Inc.** ("Complainant"), represented by **Kathryn E. Smith**, of **Wood, Herron & Evans, LLP**, 2700 Carew Tower, 441 Vine Street, Cincinnati, OH 45202. Respondent is **Sharm Scheuerman** ("Respondent"), 9200 Milliken Ave, Suite 3309, Rancho Cucamonga, CA 91730.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**roomstoday.com**>, registered with **Melbourne It, Ltd.** d/b/a **Internet Names Worldwide**.

#### PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

#### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on March 3, 2006; the National Arbitration Forum received a hard copy of the Complaint on March 6, 2006.

On March 5, 2006, Melbourne It, Ltd. d/b/a Internet Names Worldwide confirmed by e-mail to the National Arbitration Forum that the <**roomstoday.com**> domain name is registered with Melbourne It, Ltd. d/b/a Internet Names Worldwide and that Respondent is the current registrant of the name. Melbourne It, Ltd. d/b/a Internet Names Worldwide has verified that Respondent is bound by the Melbourne It, Ltd. d/b/a Internet Names Worldwide registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On March 6, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of March 27, 2006 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@roomstoday.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On April 5, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

#### **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

#### **PARTIES' CONTENTIONS**

A. Complainant makes the following assertions:

Complainant owns U.S. Trademark Application Serial No. 78/703,691 for the mark **ROOMS TODAY** covering the following goods and services:

Furniture, mattresses and box springs, home and office decorating accessories, home and office furnishings, in International Class 20; and

Retail furniture store services, electronic retail furniture store services, catalog, mail, and phone order retail furniture store services, all of the foregoing in the field of furniture; home and office decorative accessories; home and office furnishings; mattresses and box springs; clocks; lamps and lighting fixtures; mirrors; figurines; bathroom accessories; bed, bath, kitchen, and table linens; beverage ware and dinnerware; shower curtains; bath mats; curtains; draperies and drapery hardware; window coverings; wall hangings; and rugs and carpets, in International Class 35.

Complainant filed its application for the **ROOMS TODAY** mark in the U.S. Patent and Trademark Office ("USPTO") on August 30, 2005. Complainant filed an allegation of use with the USPTO relative to this application on February 14, 2006,

reciting its use of the **ROOMS TODAY** mark in connection with the above-listed goods and services since at least as early as September 2004.

Complainant acquired the entire right title and interest throughout the world in and to the **ROOMS TODAY** trademark, service mark, and trade name by way of an assignment and agreement reached with a predecessor in interest. That predecessor in interest, now an exclusive licensee of Complainant, currently operates retail furniture stores under the **ROOMS TODAY** trademark, service mark, and trade name in the states of Louisiana and Texas. Complainant will commence its own retail furniture store operations in the state of Michigan under the **ROOMS TODAY** trademark, service mark, and trade name in June 2006. Additionally, Complainant will re-brand certain stores it currently operates under its registered mark **VALUE CITY FURNITURE** to operate under the **ROOMS TODAY** trademark, service mark, and trade name in Michigan as early as Summer 2006. Complainant also intends to open retail furniture stores under the **ROOMS TODAY** mark in Philadelphia, PA as early as November 2006.

Additionally, Complainant also owns the domain name [ROOMSTODAYFURNITURE.com](http://ROOMSTODAYFURNITURE.com).

## **FACTUAL AND LEGAL GROUNDS**

This Complaint is based on the following factual and legal grounds: ICANN Rule 3(b)(ix).

### **[a.] Respondent's Domain Is Identical And Confusingly Similar to Complainant's ROOMS TODAY Trademark**

The primary basis for this Complaint is Complainant's existing rights and investment in the **ROOMS TODAY** trademark, as described above. Complainant has established that it has rights in the **ROOMS TODAY** mark through continuous use of the mark in commerce in connection with its furniture and retail furniture store services. Additionally, as described above, Complainant has a pending trademark application for the **ROOMS TODAY** mark with the United States Patent and Trademark Office. Complainant expects that its application will proceed on to issuance in due course. *See SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that Complainant's trademark or service mark be registered by a government authority or agency for such rights to exist); *see also Great Plains Metromall, LLC v. Creach*, FA 97044 (Nat. Arb. Forum May 18, 2001) ("The Policy does not require that a trademark be registered by a governmental authority for such rights to exist."); *see also Tuxedos By Rose v. Nunez*, FA 95248 (Nat. Arb. Forum Aug. 17, 2000) (finding common law rights in a mark where its use was continuous and ongoing, and secondary meaning was established); *see also Fishtech v. Rossiter*, FA 92976 (Nat. Arb. Forum Mar. 10, 2000) (finding that the complainant had common law rights in the mark FISHTECH, which it had used since 1982).

Respondent's ROOMSTODAY.com domain name is identical and confusingly similar to Complainant's **ROOMS TODAY** mark because the domain name incorporates Complainant's mark in its entirety and contains no other terms except for the required Internet suffix, <.com>. Therefore, the domain name is identical to the Complainant's mark. *See, e.g., Technology Properties, Inc. v. Burris*, FA 94424 (Nat. Arb. Forum May 9, 2000) (finding that the domain name <radioshack.net> is identical to the Complainant's mark, RADIO SHACK).

Given the close similarities of the ROOMSTODAY.com domain name to Complainant's **ROOMS TODAY** mark and name, the domain name should be considered confusingly similar to Complainant's mark and primary identifier. ICANN Rule 3(b)(ix)(1); ICANN Policy ¶4(a)(i).

**[b.] Respondent's Use of the ROOMSTODAY.com Domain Will Cause Initial Interest Confusion**

Respondent's use of the domain name ROOMSTODAY.com is also likely to cause initial interest confusion between Complainant's protected mark and Respondent's domain name by initially luring a consumer to an internet site that is not authorized by or affiliated with Complainant, and that promotes goods and services that are directly competitive with Complainant's goods and services. Indeed, such confusion has been held to be a basis for finding a violation of Complainant's rights. *See, e.g., Ciccone v. Parisi*, D2000-0847 (WIPO Oct. 12, 2000); *see also Thomas & Betts Int'l, Inc. v. Power Cabling Corp.*, AF-0274 (eResolution Oct. 23, 2000).

Complainant has spent a significant amount of time and money in its efforts to obtain, register, and promote the **ROOMS TODAY** brand in the United States. As Complainant continues to develop its **ROOMS TODAY** brand on an increasingly widespread basis, and the goods and services sold thereunder, the brand will enjoy greater recognition and association with Complainant. Therefore, Respondent's continued use of the ROOMSTODAY.com domain name to redirect internet users to Respondent's MYLIVINGSPACES.com retail furniture store website (described in more detail hereinbelow), will confuse Complainant's customers and potential customers into believing that Complainant and Respondent are somehow connected when they are not.

**[c.] Respondent Has No Rights Or Legitimate Interests in the ROOMSTODAY.com Domain Name**

Complainant does not know of any trademark or other intellectual property rights, or any other legitimate interest held by Respondent in the ROOMSTODAY.com domain name. ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii). There is also no evidence that Respondent is commonly known by the disputed domain name, or by the name or mark "Rooms Today," pursuant to Policy ¶4(c)(ii). The WHOIS registration information corresponding to the ROOMSTODAY.com domain name also fails to imply that

Respondent is commonly known by the name. *See Tercent Inc. v. Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating, “nothing in Respondent’s WHOIS information implies that Respondent is ‘commonly known by’ the disputed domain name” as one factor in determining that Policy ¶4(c)(ii) does not apply); *see also Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that Respondent does not have rights in a domain name when Respondent is not known by the mark).

Furthermore, Respondent should not be held as having rights or legitimate interests in the ROOMSTODAY.com domain name because it is using Complainant’s mark in a confusingly similar domain to attract Complainant’s customers to Respondent’s website. The use of domain names that are identical and confusingly similar to Complainant’s mark in order to attract internet users to Respondent’s website has not been found to be a bona fide offering of goods or services pursuant to Policy ¶4(c)(i). *See Big Dog Holdings, Inc. v. Day*, FA 93554 (Nat. Arb. Forum Mar. 9, 2000) (finding no legitimate use when Respondent was diverting consumers to its own website by using Complainant’s trademarks).

As noted above, Complainant is currently using the term **ROOMS TODAY** as a mark, as the name of its retail furniture stores, and as a component of its internet domain name, ROOMSTODAYFURNITURE.com. By contrast, Respondent has not made any known use of the term “ROOMS TODAY” as a trademark or a domain name, or otherwise. In fact, when a user types in a browser the ROOMSTODAY.com domain name, the user is immediately directed to the Respondent’s website, [www.MYLIVINGSPACES.com](http://www.MYLIVINGSPACES.com). It does not appear that Respondent currently uses, or ever has used, the term “ROOMS TODAY” as a trademark or a domain name, or otherwise, or in connection with any ongoing business.

Therefore, Complainant submits that Respondent does not have any rights or legitimate interests in the ROOMSTODAY.com domain name.

Complainant requests that the Panelist also take the following additional facts into consideration (ICANN Policy 4(c)):

- (i.) To Complainant’s knowledge, Respondent has not made any good faith offering of goods or services in connection with the ROOMS TODAY trade name or mark, or the ROOMSTODAY.com domain name;
- (ii.) To Complainant’s knowledge, Respondent has not been commonly known by the ROOMSTODAY.com domain name, or the ROOMS TODAY mark, and has not acquired any rights in or to the ROOMS TODAY trademark; and
- (iii.) To Complainant’s knowledge, Respondent has not made a legitimate noncommercial or fair use of the domain name, or any other use of the domain, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

(iv.) Respondent holds itself out as a competitor of Complainant, and uses the ROOMSTODAY.com domain name to promote and sell its own goods and services from the MYLIVINGSPACES.com website to which the domain links. Respondent's goods and services are directly competitive with Complainant. As shown by a printout of the page which appears when a user types in the ROOMSTODAY.com URL, Respondent identifies itself on its website under the name "Living Spaces Furniture," and promotes itself as a retailer of discounted furniture and accessories for the home, including mattresses, living room, bedroom, dining room, children's rooms, entertainment room, and the home office. Respondent provides links on its MYLIVINGSPACES.com website to third party brand furniture retailers, including Berkline, Ashley Furniture Industries, Inc., Najarian Furniture, Kathy Ireland Home, Tempur-Pedic Mattress, Stanton International, and others. On this basis, a visitor to Respondent's ROOMSTODAY.com domain could easily be mistakenly lead to believe that Complainant is responsible for assembling and providing the retailer links referenced on Respondent's website, when it is not, or that Complainant and Respondent are somehow affiliated, when indeed they are not.

**[d.] Respondent Registered the ROOMSTODAY.com Domain in Bad Faith**

Generally, the Panel looks at "the totality of circumstances" to determine if Respondent's bad faith in registering a domain is apparent. *See, e.g., Twentieth Century Fox Film Corp. v. Risser*, FA 93761 (Nat. Arb. Forum May 18, 2000) (finding that in determining if a domain name has been registered in bad faith, the Panel must look at the "totality of circumstances"). The following circumstances would seem to compel a finding of bad faith and the transfer of the ROOMSTODAY.com domain to Complainant:

**(i.) Respondent Knew or Should Have Known of Complainant's Rights in Complainant's ROOMS TODAY Trademark**

When Complainant became aware of Respondent's registration for the ROOMSTODAY.com domain, Complainant sent a letter on December 30, 2005 to the domain name owner listed in the registration, Mr. Sharm Scheuerman. In its letter, Complainant identified its ownership and use of the **ROOMS TODAY** mark and name in connection with furniture and retail furniture store services. Complainant also noted in its December 30<sup>th</sup> letter that Respondent's ROOMSTODAY.com domain name was due to expire on March 1, 2006. Complainant even offered to pay Respondent \$1,500 to purchase the domain outright.

Respondent never responded to Complainant's letter. Instead, Respondent renewed its domain name on March 1, 2006 for another year. Throughout this period, Respondent has continued to use the ROOMSTODAY.com domain to redirect internet

users to Respondent's website at MYLIVINGSPACES.com. Respondent's failure to respond to Complainant's letter, coupled with its continued use of the ROOMSTODAY.com domain, all with knowledge of Complainant's rights in the **ROOMS TODAY** mark, is clear evidence of Respondent's bad faith intentions. Other panels have inferred from such knowledge a respondent's bad faith intentions. *See Zappos.com, Inc. v. RENATA Svensdotter*, FA 624407 (Nat. Arb. Forum February 22, 2006) (where Respondent's failure to respond to cease and desist letters sent by Complainant's counsel was viewed as evidence of registration and use of ZAPPOSSHOES.com domain name in bad faith under the UDRP). *See also Document Technologies v. International Communications, Inc.*, D2000-0270 (WIPO June 6, 2000) (Respondent's knowledge of complainant's mark at the time of registration of the domain name suggests bad faith).

(ii.) **Respondent Had Actual Knowledge of Complainant's Rights in Complainant's ROOMS TODAY Trademark**

Other UDRP panels have held that a party's continued use of a domain name with constructive and/or actual notice of a trademark holder's rights is evidence of a party's bad faith. The fact that Respondent registered and continues to use a domain name that is identical and confusingly similar to Complainant's mark, with knowledge of Complainant's rights in the **ROOMS TODAY** mark, is evidence of bad faith registration and use. *See Digi Int'l v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002) (holding that "there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively).

(iii.) **Respondent's Use of the ROOMSTODAY.com Domain Name Is With Explicit Intent of Diverting Business From Complainant to Respondent**

Respondent's continued use of the ROOMSTODAY.com domain name appears to be with the intent of diverting business away from Complainant, and/or to confuse customers who seek out Complainant's business concern and/or Complainant's goods or services on the internet. By virtue of the ubiquitous nature of the internet, the public will inevitably be confused as to source, or as to the identity of the provider of services offered under the same or essentially similar names.

Respondent has appropriated Complainant's mark to refer Internet users to Respondent's website, at MYLIVINGSPACES.com, at which Respondent promotes goods and services that are directly competitive with Complainant. Other UDRP Panels have found that this is evidence of bad faith registration and use pursuant to Policy ¶4(b)(iii). *See EBAY, Inc. v. MEODesigns*, D2000-1368 (Dec. 15, 2000) (finding that the respondent registered and used the domain name <ebay.com> in bad faith where the respondent has used the domain name to promote competing auction sites); *Puckett, Individually v. Miller*, D2000-0297 (WIPO June 12, 2000) (finding that the respondent

has diverted business from the complainant to a competitor's website in violation of Policy ¶4(b)(iii)).

(iv.) Because Respondent is not affiliated with or connected in any way with Complainant, it is further believed that Respondent renewed and continues to use the domain name in bad faith.

Whatever Respondent's intent in registering the domain name, Respondent's actions have disrupted Complainant's business. Respondent's actions are injurious to Complainant because Respondent may attempt to attract, for Respondent's own commercial gain, internet users to Respondent's website or to some other on-line location owned or controlled by Respondent, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

For the foregoing reasons, Respondent's continued use and registration of the ROOMSTODAY.com domain should be held to be in bad faith.

B. Respondent failed to submit a Response in this proceeding.

## **FINDINGS**

Complainant, American Signature, Inc., is a licensor of a business entity that currently operates retail furniture stores under the ROOMS TODAY mark in Louisiana and Texas. Complainant plans on commencing its own retail furniture store operations in Michigan under the ROOMS TODAY mark in June 2006. Complainant also plans on re-branding certain stores that it currently operates in Michigan under its registered VALUE CITY FURNITURE mark to operate under the ROOMS TODAY mark as early as the Summer of 2006. Moreover, Complainant intends to open retail furniture stores under the ROOMS TODAY mark in Philadelphia, Pennsylvania as early as November 2006. Complainant presently holds a domain name registration for the <roomstodayfurniture.com> domain name.

Complainant provides its application for an intent to use registration of the ROOMS TODAY mark with the United States Patent and Trademark Office ("USPTO"), but does not currently hold a valid registration with the USPTO for the mark. The amendment to the application indicating it has been using the mark since September 2004 was not provided.

Respondent registered the <roomstoday.com> domain name on March 1, 2003. Respondent's disputed domain name redirects Internet users to a retail furniture website located at the <mylivingspaces.com> domain name, which offers products in competition with Complainant's business.

## DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

While it is evident that Respondent's <roomstoday.com> domain name is identical to Complainant's name pursuant to the Policy, Complainant has not established any rights in the ROOMS TODAY mark that precede Respondent's registration of the disputed domain name. Complainant's pending *intent to use* registration for the ROOMS TODAY mark with the USPTO does not establish Complainant's rights in the mark. *See ECG European City Guide v. Woodell*, FA 183897 (Nat. Arb. Forum Oct. 14, 2003) ("Complainant's mere application to the USPTO to register the ECG mark is insufficient to establish rights to the mark."); *see also Razorbox, Inc. v. Skjodt*, FA 150795 (Nat. Arb. Forum May 9, 2003) ("Complainant's pending trademark application does not in and of itself demonstrate trademark rights in the mark applied for."). The pending registration simply indicates Complainant is not presently using the ROOMS TODAY mark.

In light of Complainant's inability to provide any evidence of a registration for the ROOMS TODAY mark, Complainant must demonstrate that it has common law rights in the mark that precede Respondent's registration of the disputed domain name. *See Molecular Nutrition, Inc. v. Network News and Publ'ns*, FA 156715 (Nat. Arb. Forum June 24, 2003) (approving of and applying the principals outlined in prior decisions that recognized "common law" trademark rights as appropriate for protection under the Policy

“if the complainant can establish that it has done business using the name in question in a sufficient manner to cause a secondary meaning identifiable to Complainant's goods or services”); *see also Cyberimprints.com, Inc. v. Alberga*, FA 100608 (Nat. Arb. Forum Dec. 11, 2001) (finding that the complainant failed to prove trademark rights at common law because it did not prove the CYBERIMPRINTS.COM mark was used to identify the source or sponsorship of goods or services or that there was strong customer identification of the mark as indicating the source of such goods or services).

Complainant asserts it established rights in the ROOMS TODAY mark by purchasing it from another entity. No information about that purchase is provided and the Panel cannot determine when Complainant's predecessor in interest acquired its marks in the mark (although it might be reasonable to infer Complainant's predecessor in title began using the mark in September 2004). Complainant fails to offer any evidence it has rights that precede Respondent's registration of the <roomstoday.com> domain name on March 1, 2003. Complainant specifically states that it has used the ROOMS TODAY mark in connection with its business since at least as early as September 2004 (and its application to the United States Patent and Trademark Office indicates it only *intends* to use the mark). Yet, according to the WHOIS information, Respondent registered the <roomstoday.com> domain name on March 1, 2003, predating Complainant's rights by over one year. Therefore, the Panel finds Complainant has not demonstrated rights in the ROOMS TODAY mark that precede Respondent's registration of the <roomstoday.com> domain name, and thus has failed to satisfy Policy ¶4(a)(i). *See Trujillo v. ISoft Corp.*, FA 171259 (Nat. Arb. Forum Sept. 10, 2003) (“As Complainants have not shown that their rights pre-date Registrant's domain name, Complainants have not satisfied paragraph 4(a)(i) of the Policy.”); *see also Transpark LLC v. Network Adm'r*, FA 135602 (Nat. Arb. Forum Jan. 21, 2003) (finding that the complainant failed to satisfy Policy ¶4(a)(i) because the respondent's domain name registration predated the complainant's rights in its mark by nearly two years).

The Panel finds Policy ¶4(a)(i) has not been satisfied.

As a result of Complainant's failure to establish the first element of the Policy, it is unnecessary to address the claims under the remaining two elements. *See Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (Nat. Arb. Forum Sept. 20, 2002) (finding that because the complainant must prove all three elements under the Policy, the complainant's failure to prove one of the elements makes further inquiry into the remaining element unnecessary).

## DECISION

Having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the <roomstoday.com> domain name **REMAIN WITH** Respondent.



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist  
Dated: April 19, 2006

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