

**IN THE MATTER OF THE COMPLAINT PURSUANT TO THE CANADIAN INTERNET
REGISTRATION AUTHORITY DOMAIN NAME DISPUTE RESOLUTION POLICY**

Domain Name: MYPILLOW.CA
Complainant: My Pillow Inc.
Registrant: Marie-Claude Dumais
Registrar: Go Daddy Domain Names Canada Inc.
Panellist(s): Teresa Scassa
Daria Strachan
Myra J. Tawfik (Chair)
Service Provider: Resolution Canada

DECISION

1. The Parties:

The Complainant is a company based in the United States of America. Its registered address is 343 East 82nd Street, Suite 100, Chaska, MN 55318 USA. Its authorized representative is Simonelli IP, P.L.L.C, P.O Box 935, Birmingham, MI 48012 USA

The Registrant is Marie-Claude Dumais. Her authorized representative is the firm of Robic, 100, Square-Victoria – Block E, 8th Floor, Montreal, Quebec H2Z 2B7.

2. The Domain Name and Registrar

The disputed domain name is MYPILLOW.CA and the Registrar is Go Daddy Domain Names Canada Inc.

3. Procedural History

On December 8, 2017, the Complainant initiated a complaint with Resolution Canada under the Canadian Internet Registration Authority (CIRA) Dispute Resolution Policy (CDRP) and the CIRA Domain Name Dispute Resolution Rules (the Rules). Resolution Canada is an approved Dispute Resolution Service Provider under the CDRP.

Pursuant to Rule 5.1, the Registrant was notified by Resolution Canada that it had 20 days to file 5 copies of a response to the Complaint. On December 27, 2017, the Registrant filed her Response.

Further to Rule 6.5, on January 15th, 2018, Resolution Canada appointed Teresa Scassa, Daria Strachan and Myra Tawfik (Chair) as panelists on the Complaint after having

received from them declarations of impartiality and independence. A notice of selection of panelists was sent to all parties at that date.

4. Eligible Complainant

The Complainant has a registered trademark in Canada and therefore meets the Canadian Presence Requirements for Registrants at s. 2(q).

5. Parties' Contentions

A. The Complainant:

The Complainant alleges the following:

Since March 8, 2013, it is the owner of the registered trademark MYPILLOW in association with pillows, registered in Canada under the *Trade-marks Act* RSC 1985 C. T-13 as amended. The registration identifies the date of first use in Canada as January 9, 2008.

It spends millions of dollars annually promoting its products in Canada and the United States.

The Registrant has registered a domain name that is confusingly similar to the Complainant's trade-mark. A WHOIS search conducted by the Complainant shows the date of registration of the domain name MYPILLOW.CA as March 2, 2010.

The Registrant has no legitimate interest in the domain name because the Registrant is not a licensee of the Complainant, does not have a trademark that includes 'my pillow' and does not sell pillows under mypillow.ca. Instead, the domain name redirects to the Registrant's primary business website www.ecoeteco.com where the Registrant does sell pillows.

Finally, the Registrant registered the domain name in bad faith because she has intentionally redirected traffic to her website www.ecoeteco.com where she sells pillows in competition with the Complainant.

Prior to initiating this complaint, the Complainant contacted the Registrant to request a transfer of the domain name and received no response.

The Complainant requests the transfer of the domain name MYPILLOW.CA.

B: The Registrant:

The Registrant alleges the following:

She has carried on a family business since 1996 selling eco-friendly bedding and beauty products. In 2007, she registered the domain name ecoeteco.com and set up the website www.ecoeteco.com to carry on business online. Among the products sold through this website are buckwheat pillows.

As a marketing tool to attract customers searching online for products similar to those she sells, the Registrant registered a number of domain names in both English and French to optimize her online visibility. These domain names, including MYPILLOW.CA, all redirect to the www.ecoeteco.com website, where she carries on business.

The Registrant was unaware of the existence of the Complainant when she registered the domain name.

Two years ago, she received a request from the Complainant to transfer the domain name on the basis of the Complainant's registered trademark, to which she did not respond.

6. Findings

Under paragraph 4.1 of the CDRP, the burden is on the Complainant to prove, on a balance of probabilities, that:

- 1) The Registrant's "dot-ca" domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights
- 2) The Registrant has registered the domain name in bad faith

And to provide some evidence that:

- 3) The Registrant has no legitimate interest in the domain name.

Under Rule 12.1, the Panel shall render its decision based on the CDRP and Rules, the evidence and arguments submitted and any relevant rules and principles of the laws of Ontario and the laws of Canada. Further, inferences can be drawn about the Registrant's motives in registering the domain name from the Registrant's conduct or other surrounding circumstances including the uses to which the domain name is put. See *Canadian Broadcasting Corp v. Quan* CIRA Dispute #00006 (2003); *Government of Canada v. Bedford* CIRA Dispute #00011 (2003)

6.1. Is the Registrant's domain name confusingly similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and in which Complainant continues to have such Rights?

3.2 Mark. A "Mark" is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person's predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;
- (b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person's predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;
- (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
- (d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

It is clear that the Complainant's registered trademark and the Registrant's domain name are confusing in that they are identical (with the exception of the .ca suffix) and used in association with similar goods. However, the Complainant registered its trademark in 2013, three years *after* the date of registration of the domain name. Therefore, in order to meet the first element under the CDRP, the Complainant must show, on a balance of probabilities, that it had acquired common law or unregistered rights in the Mark in Canada prior to the date of registration of the domain name.

The Complainant provided no supporting evidence of its use of the Mark in Canada prior to the date of registration of the domain name. In the absence of some corroborating documentation, the entry in the CIPO database alleging first use in Canada in 2008 is not sufficient to establish common law rights in a Mark for the purposes of the CDRP. This is even more the case where the trademark in question is largely descriptive, as it is here. Similarly, in the absence of any supporting evidence, the representation that the Complainant has spent millions of dollars on advertising and promotion in Canada and the US is not sufficient to demonstrate rights in the Mark in Canada at the relevant date. (See *Scouts Canada v. Morland* CDRP decision no. 277 (Resolution Canada – January 22, 2015).

The Panel finds that the Complainant has not discharged its burden of proof under this first element of the CDRP.

6.2 The Registrant has registered the domain name in bad faith

The Panel also finds that the Complainant has not established, on a balance of probabilities, that the Registrant registered the domain name in bad faith. The Complainant alleges bad faith under s. 3.5(d) of the CDRP in that the Registrant intentionally attracted internet users to her site by creating a likelihood of confusion with Complainant's Mark. The Complainant argues that there could be no other reason for the

Registrant to have registered a domain name identical to its trademark except for the purpose of inappropriately redirecting traffic to her www.ecoeteco.com website, which competes with the Complainant in the sale of pillows.

The Registrant filed an affidavit in which she solemnly affirmed that she was unaware of the existence of the Complainant at the time she registered the domain name. She offered an alternate explanation for her having registered MYPILLOW.CA in 2010, which the Panel finds credible.

The Panel considers the words MY PILLOW to be very descriptive of the goods. It is entirely plausible that someone who sells pillows would look to register a domain name like MYPILLOW without ever knowing of the Complainant's business, especially since the Complainant's primary base of operation is in the United States and there is no evidence of the Complainant having used or made its trademark known in Canada at the date of registration. The fact that the Registrant registered the domain name in French as MONOREILLER.CA further supports her claim that she was looking for variations on her products as a marketing strategy to attract as many potential customers to her www.ecoeteco.com website. She also stated that she had been intending to register PILLOW.CA but, finding it unavailable, she chose to register MYPILLOW.CA and MONOREILLER.CA instead.

6.3 The Registrant has no legitimate interest in the domain name

Finally, the Complainant must provide some evidence that the Registrant had no legitimate interest in the domain name. The Panel finds that the Complainant has not met its burden under the CDRP.

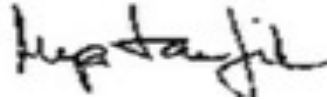
Under ss. 3.4(b) and (c) of the CDRP, a Registrant has a legitimate interest if it registers, in good faith, a domain name that is either clearly descriptive in English and French of the character of the wares or is the generic name in any language of the wares. As discussed in the previous section, the Complainant has not established bad faith on the part of the Registrant. Given that the words MY PILLOW for pillows are clearly descriptive of the character of the wares, the Registrant has a legitimate interest in the domain name.

7. Decision

The Complainant has failed to establish, on a balance of probabilities, the elements set out in s. 4.1 of the CDRP. The Complainant did not establish that it had rights in the Mark in Canada prior to the registration of the domain name, nor that the Registrant registered the domain name in bad faith and without a legitimate interest. As a result, the Complaint is dismissed.

Dated February 12, 2018

Teresa Scassa
Daria Strachan
Myra Tawfik

A handwritten signature in black ink, appearing to read "Myra Tawfik". The signature is written in a cursive style with some loops and flourishes.

Myra Tawfik (Chair), for the Panel