

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY
COMPLAINT

Dispute Number: DCA - 1934 - CIRA
Domain Name: paylesshoes.ca
Complainant: Payless ShoeSource Worldwide, Inc.
Registrant: Antonia Ojo
Panel: Elizabeth Cuddihy
Service Provider: British Columbia International Commercial Arbitration
Centre

DECISION

The Parties

1. The complainant is Payless ShoeSource Worldwide, Inc. of 3231 SE Sixth Avenue, Topeka, Kansas, United States of America, 66607 (the Complainant).
2. The Registrant is Antonia Ojo according to the CIRA WHOIS database (the Registrant).

The Disputed Domain Name and Registrar

3. The Domain Name at issue is paylesshoes.ca (the Disputed Domain Name).
4. The Registrar for the Disputed Domain Name is BareMetal.com Inc.
5. The Disputed Domain Name was registered on December 5, 2004.

Procedural History

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognized service provider to the Domain Name Dispute Resolution Policy, (the Policy) and the Rules, (the Rules) of the Canadian Internet Registration Authority, (CIRA).
7. On November 17, 2017, the Complainant filed a complaint dated November 13, 2017 on November 17, 2017, (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to the Complainant.

8. BCICAC confirmed the Complaint to be in administrative compliance with the requirement of the Rules and the commencement of the dispute resolution process and forwarded copy of the Complaint to the Registrant in accordance with the Rules.
9. The Registrant did not provide a response within the timeframe required by the Rules.
10. The Complainant elected to convert to a single arbitrator in accordance with Rule 6.5 and the BCICAC nominated Elizabeth Cuddihy to act as sole arbitrator to determine the matter.
11. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so doing.
12. As there was no Response to the Complaint, the Panel shall in accordance with Rule 5.8 decide the Proceeding on the basis of the Complaint.

Canadian Presence Requirements

13. In order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot-ca domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.
14. The Complainant is the owner of several Canadian Trade-mark registrations upon which the Complaint is based and which include or incorporate the element PAYLESS registered in the Canadian Intellectual Property Office (CIPO) and include among others PAYLESS registered as Number TMA485,373 in CIPO November 6, 1997, PAYLESS SHOES & ACCESSORIES registered as Number TMA473,088 in CIPO March 19, 1997 and PAYLESS SHOE SOURCE registered as Number TMA485,137 in CIPO October 31, 1997, collectively (the Complainant's Mark).
15. The Complaint relates to a Disputed Domain Name, which includes the whole of the exact word component of the Complainant's Mark registered in CIPO. Accordingly, the Presence Requirements are satisfied.

The Position of the Parties

The Position of the Complainant

16. The Complainant was founded in the United States in 1956 in Topeka, Texas and is a leading retailer of footwear and related accessories. The Complainant opened its first retail location in Canada in 1997. Currently the Complainant has over 200 PAYLESS SHOESOURCE retail locations in Canada in all ten provinces.
17. The Complainant's stores in Canada are located in a variety of settings, from urban to rural including regional malls, shopping centers, central business districts and free standing buildings. The footwear sold in the Complainant's stores in Canada includes all kinds of

footwear, including men's, women's and children's shoes, hosiery and related personal accessories. The Complainant's Mark is displayed on exterior store signage for all its retail stores in Canada and is also displayed on its receipts to customers and bags used by customers to carry their purchases from the stores. The Complainant's sales in Canada since 2008 are in the range of \$180,000,000 a year which represents in excess of 25,000,000 pairs of footwear sold in the aggregate in Canada in association with the Complainant's Mark since 2008. The Complainant is the owner of the domain name payless.com and owns and maintains a Canada-specific website <Canada.payless.com> and is active on social media on Facebook, Twitter and Instagram, among others.

18. The Complainant submits that the Registrant registered the Disputed Domain Name on December 5, 2004 and thereafter began operating a corresponding website under the Disputed Domain Name. The Complainant further submits that the Disputed Domain Name resolves to a "parked" website that displays a number of advertisements and hyperlinks which link to various websites, including providers of shoes and accessories that are direct competitors of the Complainant. These competitors are not affiliated with the Complainant and provide goods which compete with the Complainant. The Complainant further submits that the Disputed Domain Name is confusingly similar to the Complainant's Mark in which the Complainant had rights prior to the registration of the Disputed Domain Name and continues to have such rights, and further that the Registrant has no legitimate interest in the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith in accordance with paragraph 3.5 of the Policy.

19. Accordingly, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

The Position of the Registrant

20. The Registrant did not file a Response.

Analysis and Findings

21. The purpose of the Policy as stated in paragraph 1.1 is to provide a forum in which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

Relevant provisions of the Policy are provided below

22. Paragraph 4.1 of the Policy provides:

4.1 Onus. To succeed in a Proceeding, the Complainant must prove, on a balance of probabilities, that:

(a) 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; and

(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

23. Paragraph 3.2 of the Policy provides in part:

3.2 Mark. A "Mark" is

(a) a trade-mark, including the word elements of a design mark, or a tradename 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 that person's predecessor in title, for the purpose of distinguishing the 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).

24. Paragraph 3.3 provides:

3.3 Confusingly Similar: In determining whether a domain name is "Confusingly Similar" to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

25. Paragraph 3.4 provides:

3.4 Legitimate Interest: For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the domain name:

(a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

(b) the Registrant registered the domain name in Canada in good faith in association with wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;

- (c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a web site.

26. Paragraph 3.5 provides:

3.5 Registration in Bad Faith. For the purposes of paragraph 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant, or the licensor or licensee for valuable consideration in excess of the Registrant's actual costs in registering the domain name or acquiring the Registration;
- (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
- (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or
- (d) the Registrant has intentionally attempted to attract, for commercial gain, internet users to the Registrant's website or other location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

27. In summary, to succeed in a proceeding, the Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a Mark in which the Complainant had Rights prior to the registration of the Disputed Domain Name and continues to have such Rights;
2. The Registrant has registered the Disputed Domain Name in bad faith; and

3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

Notwithstanding the evidence presented that the Registrant has no legitimate in the Disputed Domain Names, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the Disputed Domain Names.

Confusingly Similar to a Mark

28. Evidence shows that the Complainant is the owner of the Complainant's Mark, and the Complainant's Mark was registered in CIPO as noted in paragraph 14 above.

29. In accordance with paragraph 3.3 of the Policy, a domain name is confusingly similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

30. The Disputed Domain Name is a misspelling of the Complainant's Mark, PAYLESS combined with the word "shoes" and incorporates the entire word of the Complainant's Mark. The Complainant submits that the fact that the Registrant is successful in diverting users through typing errors or misspelling clearly demonstrates that the Disputed Domain Name is confusingly similar to a mark. The Complainant refers to the case of *AMAZON.com Inc. vs David Abraham*, DCA-784-CIRA, where the Panel found that typo-squatting is intended to cause confusion for Internet users in order to lure them to the registrant's website. In that case the domain names <amzon.ca>, <amamazon.ca>, <amazopn.ca>, <amazn.ca> and <amazons.ca> were all found to be confusingly similar to the AMAZON Mark.

31. The Panel agrees. Accordingly for the reason stated above, the Disputed Domain Name is confusingly similar to the Complainant's Mark.

Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights

32. The Disputed Domain Name was registered on December 5, 2004.

33. As noted in paragraph 14 above, the Complainant owns Canadian registered trademarks issued as early as March 19, 1997. In addition evidence shows that the Complainant's common law rights and statutory rights to the Complainant's Mark based on use and registered rights date back years prior to the registration of the Disputed Domain Name and continues to have such rights.

34. The Panel is satisfied that the Complainant's Mark was registered well before the registration of the Disputed Domain Name and accordingly had Rights in the Complainant's Mark well before the registration of the Disputed Domain Name and as the evidence shows that the Complainant's rights are active, the Complainant continues to have such Rights.

Was the Disputed Domain Name registered in bad faith?

35. The Complainant alleges that the Registrant would have been well aware, at the time of registration of the Disputed Domain of the Complainant's business in view of the Complainant's well-established reputation in Canada where the Registrant is based.

36. The Complainant further alleges that the Registrant has used and registered the Disputed Domain Name in bad faith, because the Registrant registered the Disputed Domain Name to exploit the goodwill of, and cause confusion with, the Complainant's Mark, and to disrupt the business of the Complainant. The Complainant further submits that the Registrant's use of the Complainant's Mark in the Disputed Domain Name to attract users to the Registrant's website through consumer confusion with the Complainant's Mark, thereby creating traffic to the Registrant's website and obtaining advertising revenue from third parties, is evidence of bad faith use and registration.

37. Further, the Complainant submits that the Registrant has never been licensed to, nor has it ever authorized the use of, the Complainant's Mark in any manner, in Canada or otherwise, including in, or as part of a domain name or the Disputed Domain Name, nor has the Complainant provided consent to the use or display of the Complainant's Mark at the website of the Disputed Domain Name.

38. The Complainant further submits that given that the Complainant's Mark, through extensive use and advertising by the Complainant, has become distinctive of the Complainant's products, it is reasonable to conclude that the Registrant was clearly aware of the Complainant's Mark and business and of the likely confusion the Disputed Domain Name and the Registrant's website would generate with the Complainant's business.

39. Evidence shows that the Disputed Domain Name resolves to a pay-per-click parking page with links categorized under headings that falsely suggest a connection with the Complainant's business and lead also to websites of competitors. In so doing, the Registrant, without authority to do so, has intentionally attempted to attract, for commercial gain, internet users to the Registrant's website by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Registrant's website, thereby competing with the Complainant for Internet traffic that was intended for a domain name corresponding to the Complainant's Mark and unfairly exploiting the goodwill attached to the Complainant's Mark.

40. The practice is also disruptive because internet users encountering the Disputed Domain Name are misled into believing that the Registrant's business is a business of the Complainant or at least is endorsed, sponsored or approved by the Complainant. It is well established that resolving a domain name to a customized internet portal with a view to reaping a commercial advantage by attempting to capitalize on customer confusion constitutes *prima facie* evidence of bad faith (See *mrappliance.ca*, BCiCAC, 2011, Case No. 00165; and *Sittercity.ca*, BCiCAC, 2011 Case No. 00169).

41. Based on all the circumstances demonstrated in the material and all the evidence provided by the Complainant, the Panel is satisfied that the Complainant has proven bad faith registration of the Disputed Domain Name as required by the Policy.

Legitimate Interest of the Registrant

42. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on the Complainant to provide “some evidence” that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although “some evidence” is not defined, it imposes, in the Panel’s view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide “some evidence” of a negative.

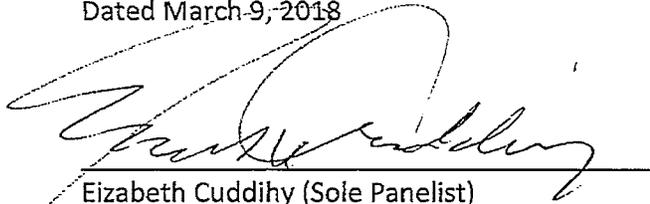
43. The Complainant has provided evidence in respect of the non-exhaustive list contained in paragraph 3.4 of the Policy that the Registrant has no legitimate interest in the Disputed Domain Name. The Registrant did not provide a Response and accordingly the Complainant’s evidence is not refuted.

44. Based on the evidence provided which is not refuted by the Registrant, the Panel is satisfied that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision

45. For the reasons set out herein, the Panel decides in favour of the Complainant and orders the transfer forthwith of the Disputed Domain Name to the Complainant.

Dated March 9, 2018



Elizabeth Cuddihy (Sole Panelist)