

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN  
INTERNET REGISTRATION AUTHORITY (“CIRA”) DOMAIN NAME  
DISPUTE RESOLUTION POLICY (“THE POLICY”)**

**Complainant:** Reitmans Canada Limited / Reitmans Canada Limitee

**Complainant Counsel:** Laurent Debrun, Davies Ward Phillips & Vineberg LLP

**Registrant:** Pilfold Ventures Inc.

**Disputed Domain Name:** additionelle.ca

**Registrar:** DomainsAtCost Corp.

**Panelist:** Paul W. Donovan, B.A., M.A., LL.B. (“the Panel”)

**Service Provider:** ResolutionCanada Inc.

**DECISION**

**The Parties**

1. The Complainant is Reitmans Canada Limited / Reitmans Canada Limitee, a company incorporated in Canada pursuant to the *Canada Business Corporations Act* and having its head office at 1 Yorkdale Road, Suite 415, Toronto, Ontario, M6A 3A1.
2. The Complainant is represented by Mr. Laurent Debrun of Davies Ward Phillips & Vineberg LLP, located at 1501 McGill College, 26<sup>th</sup> floor, Montreal, Quebec, H3A 3N9.
3. The Registrant is Pilfold Ventures Inc., whose address is 26 Horetzky Street, Winnipeg, Manitoba, R2C 4L9.
4. The contact person for the Registrant is Mr. Shaun Pilfold.

**The Domain Name and Registrar**

5. The disputed domain name is additionelle.ca.
6. The Registrar with which the disputed domain name is registered is DomainsAtCost Corp., whose address is 43 Auriga Drive, Nepean, Ontario, K2E 7YE.

## **Procedural History**

7. The Complainant commenced this proceeding under the Policy and the CIRA Domain Name Dispute Resolution Rules (“the Rules”) by a complaint dated March 30, 2005.
8. The service provider determined that the complaint was in administrative compliance with the Policy and the Rules and forwarded a copy of the complaint to the Registrant on April 6, 2005.
9. The Registrant failed to provide a response within the time allowed pursuant to rule 5.1 of the Rules. Accordingly, pursuant to rule 5.8 of the Rules, the Panel shall decide the proceeding on the basis of the complaint.
10. The Panel finds that it was properly constituted pursuant to the Policy and the Rules, and that all of the requirements under the Policy and the Rules for the commencement and maintenance of this proceeding have been met.

## **Canadian Presence Requirements**

11. The Panel finds that the Complainant has met the Canadian Presence Requirements in that it is a corporation incorporated under the laws of Canada.

## **Facts**

12. According to the complaint, the Complainant is a publicly traded company on the Toronto Stock Exchange and operates a large chain of retail clothing stores in Canada. One of its divisions operates under the Addition-Elle name with 113 stores in Canada. The Complainant identifies itself as the leader in the Canadian market for women’s plus-size fashion apparel.
13. On or about January 2005, it came to the attention of the Complainant that the Registrant had registered and was using the disputed domain name.
14. According to the complaint, the Registrant’s contact person, Mr. Shaun Pilfold, never replied to the Complainant’s repeated efforts to contact him by telephone.
15. On January 14, 2005, the Complainant sent a letter to the Registrant by email and by registered mail, to the attention of Mr. Pilfold. In this letter, the Complainant informed the Registrant of its various trade-mark registrations and applications, all of which contain the words “Addition-Elle” or “Addition Elle”. The Complainant also made reference in the letter to its extensive use of these marks.

16. The Complainant requested in the letter that the Registrant take certain corrective action, including but not limited to assigning and transferring the disputed domain name to the Complainant.
17. The Complainant requested a response from the Registrant within 72 hours of receipt of the letter, failing which legal proceedings were threatened against the Registrant without further notice or delay.
18. According to the Complainant, no acknowledgement or reply to the January 14, 2005 letter was ever received from the Registrant.

### **The Complaint**

19. Pursuant to paragraph 4.1 of the Policy, to succeed in this 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 3.7 of the Policy.
20. The Complainant must also provide some evidence that:
  - (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6 of the Policy.

Even if the Complainant proves (a) and (b), on a balance of probabilities, and provides some evidence of (c), the Registrant will still 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 3.6 of the Policy.

### **Is the disputed domain name Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the disputed domain name and continues to have such Rights?**

21. The term "Confusingly Similar" and the words "Mark" and "Rights" are all specifically defined in the Policy.
22. The Complainant has asserted Rights in the following Marks:
  - (a) Trade-mark Registration for ADDITION-ELLE (TMA532,483), registered on September 11, 2000;

- (b) Trade-mark Registration for ADDITION-ELLE & Design (TMA260,738), registered on July 10, 1981;
- (c) Trade-mark Application for ADDITION ELLE MAKE A STATEMENT & Design (App. No. 1,236,170), filed on November 4, 2004;
- (d) Trade-mark Application for ADDITION ELLE FAITES VOTRE MARQUE (App. No. 1,236,174), filed on November 4, 2004;
- (e) Trade-mark Application for ADDITION ELLE LINGERIE (App. No. 1,232,541), filed on October 4, 2004

The Complainant also makes reference to the fact that it owns the domain names addition-elle.com, additionelle.com, and addition-elle.ca.

### **ADDITION-ELLE (TMA532,483)**

- 23. The Panel finds that the trade-mark registration for ADDITION-ELLE (TMA532,483) is a Mark as defined in paragraph 3.2(c) of the Policy, which defines a Mark as including: “a trade-mark, including the word elements of a design mark, that is registered in CIPO”.
- 24. Further, the Panel finds that the Complainant had Rights in the Mark prior to the date of registration of the disputed domain name and continues to have such rights.
- 25. According to the Complainant, the disputed domain name was registered by the Registrar on December 15, 2003.
- 26. A Complainant has Rights in a Mark according to the Policy, if, in the case of a registered trade-mark, “the Mark is registered in CIPO in the name of that person, that person’s predecessor in title or a licensor of that person”.
- 27. The ADDITION-ELLE (TMA532,483) Mark was registered on September 11, 2000, prior to the date on which the disputed domain name was registered. The Mark was registered in the name of a predecessor in title to the Complainant, and was subsequently assigned to the Complainant on October 6, 2003, which is also prior to the date on which the disputed domain name was registered. As such, the Panel finds that the Complainant had Rights in the ADDITION-ELLE (TMA532,483) Mark prior to the date of registration of the disputed domain name.
- 28. The Policy, however, requires that the Complainant continue to have such rights in the Mark. The Panel notes that the ADDITION-ELLE (TMA532,483) Mark is still in good standing before CIPO as a registered trade-mark, and the Complainant alleges that this mark is not only owned but

regularly used by the Complainant in Canada. In view of the evidence submitted in its complaint, the Panel accepts that the Complainant continues to have Rights in the ADDITION-ELLE (TMA532,483) Mark.

29. Finally, the Panel also finds that the disputed domain name is Confusingly Similar to the ADDITION-ELLE (TMA532,483) Mark.
30. The term Confusingly Similar is defined in paragraph 3.4 of the Policy as follows: “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 to be mistaken for the Mark”.
31. The Panel notes that the disputed domain name is identical to the ADDITION-ELLE (TMA532,483) Mark but for the hyphen which is present in the Complainant’s Mark but not present in the disputed domain name.
32. The Panel finds the omission of the hyphen in the disputed domain name to be of little, if any, significance. Previous decisions under the Policy have held that differences in syntax or punctuation have little or no relevance to the assessment of whether a domain name is Confusingly Similar with a Mark (see *Canadian Broadcasting Corporation / Societe Radio-Canada v. William Quon* (CIRA Dispute No. 00006), *Coca-Cola Ltd. v. Amos B. Hennan* (CIRA Dispute No. 00014), and *Sleep Country Canada Inc. v. Pilfold Ventures Inc.* (CIRA Dispute No. 00027).
33. The Panel finds that the disputed domain name so nearly resembles the ADDITION-ELLE (TMA532,483) Mark in appearance, sound or the ideas suggested by said Mark as to be likely to be mistaken for the ADDITION-ELLE (TMA532,483) Mark, and as such is Confusingly Similar as said term is defined in the Policy.
34. In summary, the Panel finds that the disputed domain name is, on a balance of probabilities, Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the disputed domain name and continues to have such Rights, namely, the Complainant’s ADDITION-ELLE (TMA532,483) Mark.
35. As a result of the finding above, it is not necessary for the Panel to review the other Marks relied upon by the Complainant to determine whether the test under paragraph 4.1(a) of the Policy has been met with respect to these Marks.
36. However, the Panel would like to comment on the three trade-mark applications relied on by the Complainant (App. No. 1,236,170, App. No. 1,236,174, and App. No. 1,232,541). In its complaint, the Complainant has not specifically pleaded or proven any use of the Marks in these three applications that is prior to the date of registration of the disputed domain

name. In fact, any allegation of use of the Marks in these three applications which is prior to the date of registration of the disputed domain name would appear to be directly contrary to the applications themselves, which are all based on either proposed use or on a date of first use which is subsequent to the date of registration of the disputed domain name. As such, the Panel notes that the Complainant would not have succeeded with its complaint with respect to these three applications, since it did not prove, on a balance of probabilities, that the Complainant has rights in these Marks prior to the date of registration of the disputed domain name. In any event, given the Panel's findings with respect to the Complainant's ADDITION-ELLE (TMA532,483) Mark, the Complainant has still met its burden under paragraph 4.1(a) of the Policy and the Panel now turns its attention to paragraph 4.1(b).

### **Did the Registrant register the domain name in bad faith?**

37. Under paragraph 3.7 of the Policy, the Registrant will be considered to have registered the disputed domain name in bad faith if, and only if, the Complainant is able to prove, on a balance of probabilities, one of the three items listed in subparagraphs (a) to (c) of paragraph 3.7 of the Policy. The Panel will review each of these subparagraphs in turn.

### **Burden of Proof**

38. Since providing direct evidence of a Registrant's bad faith intentions would place a difficult if not impossible burden on the Complainant, previous decisions under the Policy have held that the Panel is empowered to consider the surrounding circumstances and to draw inferences (see, for example, *Biogen Inc. v. Xcalibur Communication*, CIRA Dispute No. 00003; *Great Pacific Industries Inc. v. Ghalib Dhalla*, CIRA Dispute No. 00009; *Government of Canada v. David Bedford in his own name and doing business as Abundance Computer Consulting*, CIRA Dispute No. 00011; *Coca-Cola Ltd. v. Amos B. Hennan*, *supra*; *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.*, CIRA Dispute No. 00015; *Independent Order of Foresters v. Noredu Enterprises Canada Inc.*, CIRA Dispute No. 00017; *Glaxo Group Limited v. Defining Presence Marketing Group Inc.*, CIRA Dispute No. 00020; *ROW Limited Partnership v. Pilford Ventures Inc.*, CIRA Dispute No. 00024; *Sotheby's (Canada) Inc. v. PII Technologies and Keith Lihou*, CIRA Dispute No. 00026; and *Sleep Country Canada Inc. v. Pilford Ventures Inc.*, *supra*).

### **Paragraph 3.7(a) Bad Faith**

39. Paragraph 3.7(a) of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if:

- (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 licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration

#### **Analysis of Paragraph 3.7(a) Bad Faith**

- 40. The Complainant has produced no evidence in support of this subparagraph and the Panel finds that the Complainant has not met its burden with respect to subparagraph (a). The Panel is unable to find that the Registrant registered the domain name for the purposes listed in subparagraph (a).

#### **Paragraph 3.7(b) Bad Faith**

- 41. Paragraph 3.7(b) of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if:
  - (b) the Registrant registered the domain name or acquired the domain name 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.

#### **Analysis of Paragraph 3.7(b) Bad Faith**

- 42. The Panel finds that the Complainant has proven, on a balance of probabilities, that the Registrant has registered the domain name or acquired the domain name in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name.
- 43. In making this finding, the Panel agrees with the Complainant's submission that its main registered trade-mark, the ADDITION-ELLE (TMA532,483) Mark has been accepted in Canada as a distinctive mark and that the Complainant has positioned itself as a leader in the Canadian market of women's plus-size fashion apparel.
- 44. The Panel notes that the additionelle.ca web site on March 8, 2005 featured prominent links to "plus size clothing" and "plus size clothes". Since, in the Panel's opinion, the ADDITION-ELLE (TMA532,483) Mark is distinctive in Canada and is not used in a descriptive or generic sense, the logical inference

is that the Registrant was aware of the ADDITION-ELLE (TMA532,483) Mark when it registered the disputed domain name.

45. The Panel notes that the Registrant has not replied to the Complainant's letter or filed a response in this proceeding. While in the absence of any communication or response from the Registrant, it may be difficult if not impossible for the Complainant to positively prove the intention of the Registrant in registering the disputed domain name, the Panel finds that it is able to reasonably infer on the basis of the complaint and the surrounding circumstances that the Registrant has, on a balance of probabilities, registered the domain name in order to prevent the Complainant, or its licensor or licensee, from registering the Mark as a domain name.
46. The Panel also finds that the Complainant has proven, on a balance of probabilities, that the Registrant 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.
47. In support of this finding, the Panel notes that the Registrant in the present proceeding was also the Registrant in *Sleep Country Canada Inc., supra*.
48. In that decision, the Panel did not address subparagraph (b) of paragraph 3.7 of the Policy since the Complainant in that matter did not submit evidence directed at subparagraph (b).
49. The Panel in that matter did find bad faith under subparagraph (c) of paragraph 3.7 of the Policy and it also found that the disputed domain name was Confusingly Similar with the Complainant's Mark, and that the Registrant had no legitimate interest in the domain name. As a result, the Panel in that case ordered the domain name transferred from the Registrant to the Complainant.
50. The present Registrant also appears to be the Registrant in *ROW Limited Partnership v. Pilford Ventures Inc., supra*. Although the name of the Registrant in the present proceeding is Pilfold rather than Pilford, the Registrant in each case has the same address.
51. In that decision, the Complainant failed to allege bad faith. The complaint was not successful and the Panel made no order regarding the registration of the disputed domain name.
52. In neither of those cases did the Panel consider whether the Registrant registered or acquired the disputed domain name in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, since this particular allegation of bad



faith was not contained in either of the complaints from the respective Complainants on those two matters.

53. Notwithstanding the above, the Panel believes that the failure of the previous Panels to consider whether the Registrant registered or acquired the disputed domain name in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, should not prohibit this Panel from being able to assess whether the Registrant 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.
54. The Panel specifically notes that the finding of a pattern does not require a finding in a prior decision under the Policy that the Registrant had registered or acquired a domain name in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name. Rather, the present Panel is only required to find, on a balance of probabilities, that the Registrant 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.
55. The evidence in this complaint does not positively prove the intentions of the Registrant in registering the sleepcountrycanada.ca and cdplus.ca domain names which were the disputed domain names in the other two proceedings involving the Registrant. While in the absence of any communication with or reply from the Registrant in any of the Registrant's proceedings, it may be difficult if not impossible for the Complainant to positively prove the intention of the Registrant in registering the sleepcountrycanada.ca and cdplus.ca domain names, the Panel finds that it is able to reasonably infer on the basis of the present complaint and the surrounding circumstances that the Registrant has, on a balance of probabilities, registered those domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names. It is the Panel's finding that these three registrations constitute a "pattern" for the purposes of subparagraph (b) of paragraph 3.7 of the Policy.
56. The minor difference in the spelling of the corporate name of the Registrant in *ROW Limited Partnership, supra*, is considered by the Panel to be a spelling error in said decision, given the identical address in each instance. Should the Panel be wrong in this regard, and the Registrant in *ROW Limited Partnership, supra*, is a different corporation than the Registrant in the present proceeding, the Panel finds that the Registrant's registration of the present disputed domain name and the sleepcountrycanada.ca domain name is sufficient to constitute a "pattern" for the purposes of subparagraph (b) of paragraph 3.7 of the Policy.

57. The Panel notes that it would have been less likely to find such a pattern had the Panels in the *Sleep Country Canada Inc., supra*, and *ROW Limited Partnership, supra*, proceedings specifically heard and rejected an argument that the Registrant had registered or acquired a domain name in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name. In the circumstances, however, since the above noted Panels had not considered such an argument, the Panel finds that it is appropriate for it to consider such an argument notwithstanding that these particular domain names have already been the subject of decisions under the Policy which have failed to make such a finding, and, in one case, failed to even make a finding of bad faith.
58. The Complainant has therefore proven, on a balance of probabilities, that the Registrant has registered the domain name in bad faith pursuant to subparagraph (b) of paragraph 3.7 of the Policy. While the Complainant has therefore met its burden under paragraph 3.7, the Panel will nonetheless consider whether bad faith is also made out under subparagraph (c) of paragraph 3.7 of the Policy.

#### **Paragraph 3.7(c) Bad Faith**

59. Paragraph 3.7(c) of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if:
- (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

#### **Analysis of Paragraph 3.7(c) Bad Faith**

60. The Panel finds that the Complainant has proven, on a balance of probabilities, that the Registrant has registered the domain name primarily for the purpose of disrupting the business of the Complainant or its licensor or licensee, and that the Complainant or its licensor or licensee is a competitor of the Registrant.
61. The Complainant has submitted evidence that the Registrant uses its website to redirect Internet users to competitors of the Complainant. As an example, the Complainant has submitted evidence that those Internet users that click on the "plus size clothing" link are then offered an opportunity to link to a number of direct competitors of the Complainant.
62. As in the case of *Sleep Country Canada Inc., supra*, the Panel finds that such use supports a finding that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant.

Further, the Panel finds that the Registrant's use of the disputed domain name as a means to link Internet users to competitors of the Complainant, constitutes the Registrant as a "competitor" of the Complainant for the purposes of subparagraph (c) of paragraph 3.7 of the Policy.

63. As a result, the Panel finds the Complainant has therefore proven, on a balance of probabilities, that the Registrant has registered the domain name in bad faith pursuant to subparagraph (c) of paragraph 3.7 of the Policy.

**Does the Registrant have a legitimate interest in the disputed domain name?**

64. Paragraph 3.6 of the Policy provides an exhaustive list of the six criteria that a Panel is to consider in assessing legitimate interest. The relevant date of consideration is before the receipt by the Registrant of notice from or on behalf of the Complainant that a complaint was submitted (in this proceeding, April 6, 2005). The Policy requires that the Complainant provide *some evidence* that the Registrant has no legitimate interest in the disputed domain name. If the Complainant meets this burden, the Registrant will still succeed in the proceeding if it proves on a balance of probabilities that it has a legitimate interest in the disputed domain name.

**Paragraph 3.6(a) Legitimate Interest**

65. Under paragraph 3.6(a), the Registrant has a legitimate interest in the disputed domain name, if, prior to April 6, 2005:
- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark

**Analysis of Paragraph 3.6(a) Legitimate Interest**

66. The Panel finds that the Complainant has met its burden of showing some evidence that the Registrant had no legitimate interest in the disputed domain name under this subparagraph. There is nothing in the complaint that would suggest that the disputed domain name was used by Registrant as a Mark as that term is defined in paragraph 3.2 of the Policy. The disputed domain name does not appear to be a certification mark or an official mark, and is not a registered trade-mark in which the Registrant would have any Rights. In the Panel's opinion, the disputed domain name cannot even be considered to have been used by the Registrant as a trade-mark pursuant to subparagraph (a) of paragraph 3.2 of the Policy, since the domain name was not used "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".

67. In fact, the Complainant has produced some evidence of use of the disputed domain name for an alternate purpose than the purpose of distinguishing its wares or services, namely, for the purpose of confusing or misleading the customers or potential customers of the Complainant.
68. As a result, the Panel finds that the Complainant has met its burden of showing some evidence that the Registrant had no legitimate interest in the disputed domain name under this subparagraph. The Panel is of the opinion that this finding is sufficient for the Complainant to meet its burden pursuant to paragraph 4.1(c) of the Policy.

**Burden shifts to the Registrant to prove Legitimate Interest on a balance of probabilities**

69. Since the Complainant has met its burden pursuant to paragraph 4.1(c) of the Policy, the Registrant can only succeed in this proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name.

**Analysis – Legitimate Interest of Registrant**

70. The Panel is of the opinion that it is unable to find, on a balance of probabilities, that the Registrant has a legitimate interest in the disputed domain name under any of the six criteria identified in paragraph 3.6 of the Policy. In particular, the Panel finds, on a balance of probabilities, that the domain name is:
- (a) not a Mark in which the Registrant has Rights and has used said Mark in good faith, pursuant to subparagraph (a);
  - (b) not clearly descriptive pursuant to subparagraph (b);
  - (c) not generic in any language pursuant to subparagraph (c);
  - (d) not used by the Registrant in a non-commercial activity pursuant to subparagraph (d);
  - (e) not the legal name, name, surname, or other reference by which the Registrant was commonly identified, pursuant to subparagraph (e), and;
  - (f) not the geographic name of the location of the Registrant's non-commercial activity or place of business, pursuant to subparagraph (f).

## **Summary of Findings**

71. The Panel has found that the Complainant has proven, on a balance of probabilities, that the disputed 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 that the Registrant has registered the disputed domain name in bad faith as such term is described in paragraph 3.7 of the Policy. Further, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the disputed domain name as that term is described in paragraph 3.6 of the Policy, and that the Registrant has failed to meet its burden of proving, on a balance of probabilities, that it has a legitimate interest in the disputed domain name.

## **Order**

72. As a result of the above findings, the Panel orders that the disputed domain name `additionelle.ca` be transferred from the Registrant to the Complainant.

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Paul W. Donovan, B.A., M.A., LL.B.  
Sole Panellist

May 15, 2005