

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

Complainant: Fresh Intellectual Properties Inc.

Complainant Counsel: John R. Renaud and Judith A. Powell

Kilpatrick Stockton LLP

Attorneys at law

Suite 2800-1100 Peachtree Street

Atlanta GA 30309-4530

Registrant: Sweets and Treats

Disputed Domain Name: 1800flowers.ca

Registrar: Internic.ca Corp.

Panelist: Barry C. Effler C. Arb.

Service Provider: British Columbia International Commercial Arbitration Centre
(the “BCICAC”)

BCICAC File Number: DCA-790-CIRA

The Parties

1. The Complainant is Fresh Intellectual Properties Inc. a corporation organized under the laws of the State of Delaware with its principal place of business located at 1600 Stewart Avenue, Westbury, New York, U.S.A.
2. The Registrant is Sweets and Treats with its Administrative and Technical contact being shown as Mike Shepley, 1305 Andover Drive, Oshawa, Ontario. Whether this is a corporation or simply a business name of Mike Shepley is not known.

The Domain Name and Registrar

3. The disputed domain name is 1800flowers.ca.
4. The Registrar with which the disputed domain name is registered is Internic.ca Corp. The domain name was registered on November 8, 2000.

Procedural History

5. On July 9, 2004, the Complainant filed a complaint against the Registrant with the BCICAC requesting that the Registrant’s right to ownership of the domain name, 1800flowers.ca, be arbitrated in accordance with CIRA’s Domain Name Dispute Resolution Rules (the “Rules”) and that an order be made pursuant to the CIRA

- Domain Name Dispute Resolution Policy (the “Policy”) that the registration of the Disputed Domain Name be transferred to the Complainant.
6. The BCICAC as service provider determined that the complaint was in administrative compliance with the Policy and Rules and by letter to the parties hereto dated July 15, 2004 confirmed the commencement of the dispute resolution process. Service was made by sending the Complaint by Express Post to the Registrant’s address and by email to the Registrant’s Administrative contact of record email address as provided for on the Registration Information for the domain name.
 7. The Registrant failed to respond to the complaint within the time period provided under Rule 5.1, or at all.
 8. The BCICAC advised the Complainant of the lack of response by the Respondent and in accordance with Rule 6.5, the Complainant gave notice to the Service Provider, BCICAC to convert to a single member Panel.
 9. The BCICAC by letter dated May 11, 2005 named this writer, Barry C. Effler as the Panel for this arbitration.
 10. As the Complaint was filed in English and as the Registrant has not responded, English is the designated language of the proceeding.
 11. Rule 5.8 of the Rules applies to this case since no response has been filed and the Panel is determining the matter on the basis of the Complaint as filed by the Complainant.

Eligible Complainant

12. The Policy in Paragraph 1.4 states as follows:
“**1.4 Eligible Complainants.** The person initiating a Proceeding (the “**Complainant**”) must, at the time of submitting a complaint (the “**Complaint**”), satisfy the Canadian Presence Requirements for Registrants (the “**CPR**) . . . in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“**CIPO**”) and the Complainant is the owner of the trade-mark.”
13. The Complainant owns the following two Canadian Trade-marks:
 - a. Registration no. TMA 517,288
1-800-FLOWERS (and Design)
registered September 29, 1999

- b. Registration no. TMA 518,269
800-FLOWERS
registered October 20, 1999

14. Accordingly, I find that the Complainant is an eligible complainant as the disputed domain name includes all of the elements included within the trademarks. I do not find the presence or lack of a “dash mark” to be material to this finding.

Background Facts

15. Beginning in 1988, the Complainant, through its affiliate, 1-800-Flowers.com, Inc. has provided a floral product and gift delivery service to customers in Canada by means of a telemarketing system under the 1-800-FLOWERS and 1-800-FLOWERS.com names and marks. The Complainant, as owner of the two marks, licenses them to its affiliate 1-800-Flowers.com, Inc.
16. Since 1995, Complainant and its licensed affiliates, has made its goods and services available through an internet site using the domain name “1800flowers.com”. At this website Complainant also provides information on a variety of topics including flower arrangement, gift giving advice and plant maintenance. Three additional domain names owned by 1-800-Flowers.com, Inc. redirect to the 1800flowers.com site, namely “1-800-flowers.ca”, “800flowers.ca” and “800-flowers.ca”.
17. According to the complaint, Complainant’s 1800flowers.com website has received critical acclaim for its quality, including designations by Net Guide, Point and PC Computing as one of the best sites on the World Wide Web and most recently named as one of “the best places to shop online” by *The Wall Street Journal*. The site has over 58,000,000 page views per month. Over the past three years, over 1 million hits originated from users of domains with a “.ca” suffix.
18. Over 39,500 on-line affiliates promote the Complainant’s marks and website by displaying 1800FLOWERS.COM banners on their sites and enabling their users to visit the Complainant’s site by clicking on the banner link. Under a licensing

agreement, these affiliates are entitled to a percentage of any sales that originated from their website. As of 2003, 1,562 of these affiliates reside in Canada.

19. The Complainant has spent in the past three years over \$100,000,000 in marketing in connection with the marks, through television, radio, print, and on-line.

20. The high degree of consumer recognition and goodwill has resulted in substantial sales in Canada. Within the past four years, US \$6,378,634.00 of sales has resulted from orders sent to recipients in Canada.

Analysis of CIRA Policy Provisions

Policy Paragraph 4.1 provides:

“4.1 Onus. To succeed in the 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;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

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 3.6.”

Confusingly Similar 4.1 (a) test

21. The domain name 1800flowers.ca is virtually identical to the Complainant’s 1-800-Flowers trade-mark. The presence of the “.ca” suffix does not alleviate the potential confusion as the Policy at paragraph 1.2 specifically deals with this point:

“. . .For the purposes of this Policy, “**domain name**” means the domain name excluding the “dot-ca” suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA.”

22. An excellent discussion of what is Confusingly Similar occurred in *Glaxo Group Limited v. Defining Presence Marketing Group Inc.*, CIRA decision no. 00020.

Quoting from page 4 of the decision:

“As held by the Panel in *Government of Canada on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, the test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection:

Accordingly, for each Domain Name the Complainant must prove on a balance of probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect recollection

5

of it, would likely mistake the Domain Name (without the .ca suffix) for Complainant’s corresponding mark based upon the appearance, sound or the ideas suggested by the Mark

In other words, the test is whether the average Internet user with an imperfect recollection of the ZYBAN Mark who wishes to access a website operated by the Complainant either by entering a domain name including the ZYBAN mark into the address bar of an Internet browser, or by entering the key terms of the domain name into an Internet search engine, would likely be confused as a matter of first impression with the Disputed Domain Name (see *Great Pacific Industries. v. Ghalib Dhalla* CIRA Dispute Number 00009, April 21, 2003, pp.20-21)

In addition it has been held that a Registrant may not avoid confusion by appropriating another’s entire mark in a domain name (*Canadian Broadcasting Corporation/Société Radio-Canada v. William Quan*, British Columbia International Commercial Arbitration Centre, Case No. 00006) “

23. I find that incorporating the entirety of the words and numbers of the Complainant’s marks within the domain name 1800flowers.ca is Confusingly Similar within the meaning of the Policy. The presence or absence of a “dash” is not such a difference as to differentiate the domain name from the marks in the mind of the average Internet user with imperfect recollection.

24. The domain name in dispute was registered on November 8, 2000 which is after the date of registration of both of the Complainant’s marks which were registered in 1999.

25. Therefore, Paragraph 4.1 (a) requirements have been met by the Complainant.

Bad Faith test 4.1 (b) as set out by paragraph 3.7 requirements

26. To meet the requirement to establish Bad Faith on the part of the Registrant, the Complainant must meet one of the three possible tests set out in Paragraph 3.7

of the Policy. The Complainant herein submitted it met the test of Paragraph 3.7 (c) which provides:

“(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.”

27. The Registrant operates a web site for the domain name 1800flowers.ca at which it provides links to many other web sites, some of which are competitors of the Complainant. This site draws traffic away from the Complainant’s site.

28. Further, the Complainant uses three other “.ca” domains as part of its marketing and to assist its Canadian customers to locate its main site. These domain names are owned by 1-800-Flowers.com, Inc. and redirect to the 1800flowers.com site, namely “1-800-flowers.ca”, “800flowers.ca” and “800-flowers.ca”.

29. I find it reasonable to assume that potential customers typing in the phrase “1800flowers.ca” for the first time are intending to go to the Complainant’s web site. I am prepared to draw the inference that the registrant is intending to benefit from the good will and marketing of the Complainant’s web site and related marks. This will help towards a finding of Bad Faith but is not sufficient. The Policy requires that I find the domain name was acquired “primarily for the purpose of disrupting the business of the Complainant. . .”.

30. The diversion of business away from a company and to its competitors is clearly disruptive. It causes the loss of revenue and may affect the goodwill of a company in its trade-marks if the services and goods of the competitor are inferior or poorer than those of the company. This is the case here. The registrant’s web site provides links to direct competitors of the Complainant. It also provides links to sites that provide coupons for reductions in price for goods at the Complainant’s web site that cause the Complainant to

unnecessarily reduce its prices. I agree with the analysis in Sleep Country Canada Inc. v. Pilfold Ventures Inc., CIRA decision no. 00027 at paragraph 21:

“21. The Complainant submitted that the “a Registrant’s purpose in registering a disputed domain name should be determined by common sense inferences from the Registrant’s conduct and other surrounding circumstances”.¹¹ The Panel finds that it is reasonable to infer the Registrant’s intention in registering a domain name from the use to which the Registrant puts the domain name after registration. The Registrant used the Confusingly Similar domain name on a web site that was dominated by links to mattress and bedding retailers who might compete for business with the Complainant. The adverse impact on, or disruption of, the Complainant’s business from the Registrant so using the Confusingly Similar domain name should have been obvious to the Registrant. I infer that this intention was formed by the Registrant as the domain name was first registered. Further, the dominant use on that web site of links to businesses competing with the Complainant supports the further inference that the Registrant registered the domain name “primarily for the purpose of disrupting the business of the Complainant”.¹²”

31. Therefore, Paragraph 4.1 (b) requirements have been met by the Complainant.

No legitimate interest test 4.1 (c) as set out in Paragraph 3.6

32. Paragraph 4.1 (c) of the Policy provides: “. . .and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.”

33. Paragraph 3.6 of the Policy provides:

“3.6 Legitimate Interests. The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

- (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 used the domain name in Canada in good faith in association with any 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 used 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."

34. The tests set out in Paragraph 3.6 are not met by the Registrant in this case.

- (a) The Registrant had no rights to any mark of the Complainant and I have already ruled there is Bad Faith.
- (b) The domain name is not descriptive of any wares or services. It is based on the telephone number controlled by the Complainant.
- (c) The domain name is not generic in any language.
- (d) The domain name is being used for commercial activity and not in good faith.
- (e) The domain name has nothing to do with any name of the registrant.
- (f) The domain name is not a geographical place name.

No legitimate interest established by the Registrant

35. The Complainant has met the onus placed on it by Paragraph 4.1 (a), (b) and (c) of the Policy. This paragraph still requires a further review of whether the Registrant has met the test that "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." For the same reasons as set out above, I find that the Registrant has not established on a balance of probabilities that it has any legitimate interest in the domain name.

Order

36. For the reasons as set out, The Panel orders that the disputed domain name 1800flowers.ca be transferred from the Registrant to the Complainant.

This order made at Winnipeg, in Manitoba on the 9th day of June, 2005.

Original signed by Barry C. Effler

Barry C. Effler LL.B., C. Arb.