

IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY ("CIRA")
DOMAIN NAME DISPUTE RESOLUTION RULES

Complainant: **Burberry Limited**

Registrant: **Daniel Mullen, Daniel Mullen carrying on business as Virgin Enterprises Limited and the said Virgin Enterprises Limited**

Disputed Domain Name: **burberry.ca**

Registrar: **Burmac Business Systems Ltd.**

Service Provider: **British Columbia International Commercial Arbitration Centre**

Case No.: **DCA- 1100-CIRA**

DECISION

1. Parties and Disputed Domain Name

The Complainant is Burberry Limited, 18-22 Haymarket, London SW1Y 4 DQ, Great Britain. The Complainant is represented by Fabio R. Silva, Esq., Corporate & Intellectual Property Counsel, Burberry Limited, 1350 Avenue of the Americas, New York, NY 10019, United States of America.

The Registrant was named in the Complaint as Virgin Enterprises Limited, of P.O. Box 1900, Charlottetown, PE C1A 7N5, Canada. For reasons outlined in Part 2 of this Decision, I have described the Registrant as Daniel Mullen, Daniel Mullen carrying on business as Virgin Enterprises Limited, and the said Virgin Enterprises Limited.

The disputed domain name is **burberry.ca**. The Registrar of Record for that domain name is Burmac Business Systems Ltd.

2. Procedural History

This is an administrative proceeding pursuant to the CIRA Domain Name Dispute Resolution Policy (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules (the “Rules”). By registration of the domain name with the Registrar, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and Rules.

The history of this proceeding, according to information provided by the Service Provider, and as it has evolved since the case was sent to the Panel, is as follows:

- (a) A complaint under the Policy (the “Complaint”) in the English language was filed with the Service Provider by the Complainant on August 22, 2008;
- (b) The Service Provider reviewed the Complaint and found it to be in administrative compliance with the Policy and the Rules. On August 27, 2008, the Service Provider sent a letter to the Registrar advising the Registrant of the commencement of the proceedings and enclosing a copy of the Complaint, by email and courier;
- (c) The Registrant requested a 30 day extension for delivery of its Response. The Service Provider extended the deadline for the Response for 10 days, to September 26, 2008. The Registrant failed to deliver a Response by that date;
- (d) On October 6, 2008, the Service Provider advised the Complainant and the Registrant that the Response had not been received and that if the requisite 5 hard copies of the Response were not received by the Service Provider by the close of business on October 7, 2008, the Complainant would be allowed to elect to convert to a single arbitrator Panel. The hard copies of the Response were not received by the Service Provider by October 7, 2008. The Complainant elected to exercise its right to convert to a single member Panel and the Service Provider appointed the undersigned as the single Arbitrator;
- (e) Late in the day on October 8, 2008, 2 hard copies of the Registrant’s Response were delivered to the Service Provider, but the additional 3 hard copies of the

Response required by Rule 5.3 were not received, and the Service Provider advised the Panel and the parties that the Registrant was still not in administrative compliance with the Rules. The Service Provider sent to each of the Panel and the Complainant, in sealed envelopes, a hard copy of the Response, which could then be opened and referred to in the event that the Panel exercised its authority to grant an extension of time under Rule 1.4;

- (f) On October 14, 2008, 2 additional hard copies of the Response were received from the Registrant by the Service Provider;
- (g) By an Order made on October 14, 2008, the Panel brought to the attention of the parties the authority of the Panel to extend the time for sending a document or taking any other action as set out in Rule 1.4, and directed that if the Registrant wished to request an extension of time for delivery of its Response, the Registrant should submit a request to that effect by email to the Panel and the Service Provider by 4:00 o'clock p.m. MDT on October 16, 2008, and that the Complainant would have the right to respond to that request by email by 4:00 o'clock p.m. MDT on October 20, 2008;
- (h) The Panel then received copies of a number of emails exchanged between the Registrant and counsel for the Complainant, but did not receive submissions from either party as contemplated by the terms of its Order. As a result, the Panel advised the parties by email on October 21, 2008, that it was exercising its authority under the Rules to grant an extension of time such that the Registrant would be deemed to be in sufficient compliance with the Rules that the Panel would consider the Response in arriving at its decision. By an email dated October 22, 2008, the Complainant advised the Panel that the Complainant did not object to this;
- (i) The communications from the Panel to the Registrant referred to in subparagraphs (g) and (h) above, used the email address which had been used by Mr. Mullen in his communications with the Service Provider and the Complainant, and which is also specified as the Registrant's email contact address in the Response.

However, by an email to the Panel dated October 26, 2008 Mr. Mullen stated, *inter alia*, that he had not seen the email sending him the Panel's Order of October 14, 2008, until some time later, and when he did open the email, he did not open the attachment and had not appreciated until October 26, 2008 that the attachment was an Order from the Panel. He also said that after he sent the 2 hard copies to the Service Provider (apparently the two received on October 8) he also sent one to the Complainant.

- (j) Mr. Mullen also suggested in his October 26, 2008 email that the Service Provider was in error in finding that the Registrant was not in administrative compliance as of October 7, 2008, in advising the Complainant of its right to elect to change to a single arbitrator panel, and in appointing the undersigned as a single arbitrator panel. From the recital of the facts received from the Service Provider as above set out, it appears clear that the Service Provider was correct in proceeding as it did and in appointing a single arbitrator Panel.
- (k) Mr. Mullen further submitted in his October 26, 2008 email that because of the "errors" on the part of the Service Provider in finding him not to be in administrative compliance, a three-person panel should be appointed. However, he makes no reference to the Panel's email of October 21, 2008 advising the parties that the Panel would grant an extension of time to the extent that the Panel would have regard to the Registrant's Response. In fact, the Registrant is still not in strict compliance with the requirement of Rule 5.3 to submit 5 hard copies of the Response to the Service Provider.
- (l) Considering the facts as set out above, the provisions of Rules 1.3 and 1.4, the power of a Panel under Rule 9.1(a) to conduct a Proceeding "in such manner as it considers appropriate in accordance with the Policy and the Resolution Rules", and its obligation under Rule 9.1(b) to ensure that the Parties are treated with equality and that each party is given a fair opportunity to presents its case, this Panel has concluded that it is appropriate for it to proceed to Decision in this case, and that in doing so it should have regard to the Registrant's Response, even

though the Registrant was not in administrative compliance with the Rules. In arriving at the Panel's Decision as set below, this is what the Panel has done.

- (m) The circumstances leading to the description of the Registrant in section 1, above, are that the Complainant named the Registrant as Virgin Enterprises Limited, and annexed to the Complaint documentation showing Virgin Enterprises Limited as the original Registrant. However, in the emails exchanged as referred to in paragraph (g) above, the Complainant provided a copy of the results of a corporate search of Virgin Enterprises Limited, showing that that company had been dissolved on November 14, 2006, but had been revived on September 22, 2008. Thus, for a period of almost two years, including the initial stages of this Proceeding, it appears that Mr. Mullen was using the name Virgin Enterprises Limited although that company did not then exist. Therefore, although the Complainant named the Registrant as Virgin Enterprises Limited, and although the Service Provider considered that it should describe the Registrant as Daniel Mullen, I have concluded that an appropriate designation of the Registrant is **“Daniel Mullen, Daniel Mullen carrying on business as Virgin Enterprises Limited, and the said Virgin Enterprises Limited.”**

3. Facts

The Complainant carries on a global business involving the design, manufacturer, advertising, distribution and sale of wearing apparel, bags, scarves, cosmetics, perfumes, glasses, watches, and other accessories, under the Burberry name. The Complainant states that as of March 31, 2008, Burberry operated 368 retail locations consisting of 97 Burberry stores, 231 concessions and 40 outlet stores, and also sells its products to international wholesale customers including leading department stores, speciality retailers and franchise partners. The Complainant estimates that in the fiscal year ending March 31, 2008, total revenue for Burberry globally was nearly £1 billion. It sells goods in Canada through speciality department stores such as Holt Renfrew and Harry Rosen. The Complainant estimates that the total retail value of Burberry products sold from its top three wholesale customers in Canada in the fiscal year ending March 31, 2008 was in excess of \$22 million (CAD).

The Complainant is the owner of Canadian trademark **BURBERRY**, registration number TMDA40313. This trademark was registered on July 28, 1926 and was renewed on July 28, 1991 and July 28, 2006. The Complainant, and related companies, have obtained additional Canadian registered trademarks and registered trademarks around the world, which include the name **BURBERRY**. The Complainant states that it invests in the promotion and development of its Marks through television, print media and the internet, in Canada and elsewhere. It maintains direct control over the character and quality of the products and services associated with the **BURBERRY** Marks and the **BURBERRY** Marks are well known globally, including Canada.

As the owner of the Canadian trademark **BURBERRY**, the Complainant Burberry Limited satisfies the CIRA Canadian Presence Requirements.

4. Discussion and Findings

Paragraph 3.1 of the Policy provides that:

A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with a Policy and the Resolution Rules that:

- (a) The Registrant's dot-ca 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;
- (b) The Registrant has no legitimate interest in the domain name as described in paragraph 3.6; and
- (c) The Registrant has registered the domain name in bad faith as described in paragraph 3.7.

The Complainant makes these assertions in its Complaint.

The Mark

"Mark" is defined in paragraph 3.2 of the Policy as including "a trademark, including the word elements of a design Mark, that is registered in CIPO". The Complainant's trademark **BURBERRY** therefore is a Mark as defined in the policy.

Rights in the Mark

Under paragraph 3.3 of the Policy, a person has “Rights” in a Mark, *inter alia*, if the Mark is registered in CIPO in the name of that person, that person’s predecessor in title or a licensor of that person. In this case, the Mark is registered in the name of Burberry Limited, as it has been since its initial registration. The Registrant has provided corporate search information which appears to show that the company Burberry Limited which initially registered the trademark was dissolved some years later, and that on January 4, 1999, Burberrys Limited became Burberry Limited, the present registered owner of the Mark. The Complainant, Burberry Limited, as presently constituted, has Rights in the Mark, under paragraph 3.3(b), as the Mark is registered in CIPO in that name.

Confusingly Similar

Under paragraph 3.4 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 to be mistaken for the Mark.”

The Complaint alleges that the Mark has been used in commerce continuously since at least 1922. The name change to which the Registrant has referred in its Response, from Burberrys Limited to Burberry Limited took place on January 4, 1999. The disputed domain name, **burberry.ca** was not registered until October 9, 2004. The Complainant’s Rights to its Mark clearly predate the date of registration of the disputed domain name.

In this case, the disputed domain name and the Mark are identical except for the dot.ca appended to the domain name. Paragraph 1.2 of the Policy provides, in part:

For the purposes of this Policy, “domain name” means the domain name excluding the “dot-ca” suffix ...”

Therefore, the domain name is, by definition, Confusingly Similar to the Complainant’s Mark.

Legitimate Interest

The next question to be addressed is whether the Registrant has a “legitimate interest” in the domain name. Paragraph 3.6 of the Policy provides that a Registrant has a legitimate interest in

a domain name only if one or more of subparagraphs (a) to (f) of that paragraph applies. These subparagraphs are as follows:

- (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.

The explanation given by the Registrant in the Response on the issue of "legitimate interest" is as follows:

Since Respondent is known to provide e-mail services and website hosting for clients on sites such as kam.ca and at delaware.ca and derives income from these domains, there is both legitimate use and no conflict with CIRA policy in this regard.

In fact, such use is envisioned through 3.1(m): be wholly responsible for the use and operation of any third, fourth, or further sub-level domain to any second level Domain Name Registration in the Registrant's name, and the Registrant shall ensure that the use and operation of any such sublevel domain is conducted in compliance with this Agreement.

The Registrant fails to explain how the registration comes within any of categories (a) to (f) in paragraph 3.6, or why it should be entitled to use the Complainant's trademark for its alleged purposes.

The Complainant submits that the page *http://www.burberry.ca* has no content and that when either *http://burberry.ca* or *http://www.burberry.ca* are entered into the address bar of an internet browser, the results indicate that the page cannot be found, and that typing *www.burberry.ca* or *burberry.ca* into the address bar similarly results in a "Live Search" page in Internet Explorer, indicating that the page could not be found.

Under paragraph 4.1 of the Policy, the Registrant will succeed in a 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. The Panel finds that the Registrant has failed to show on a balance of probabilities that it has a legitimate interest in the domain name under any of the criteria set out in paragraph 3.6 of the Policy. On the other hand, the Complainant has, pursuant to the Policy, provided some evidence that the Registrant has no legitimate interest in the domain name.

Bad Faith

Section 3.7 of the Policy provides as follows:

3.7 Registration in Bad Faith.

For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only 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;

(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 name; or

(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.

The Complainant alleges that the criteria for registration in bad faith set out in paragraphs 3.7(b) and 3.7(c) apply in this case.

With regard to paragraph 3.7(b), the Complainant submits that according to a CIRA record dated February 12, 2007, Daniel Mullen, Virgin Enterprises Limited and NETNIC (whose Administrative Contact and Technical Contact in WHOIS searches are both Daniel Mullen) own at least 800 domain names, dozens of which correspond to registered Canadian trade-marks owned by third parties. Examples given by the Complainant include *oshkoshbgosh.ca*, *partycity.ca*, *sikorsky.ca*, *oral-b.ca*, *beachboys.ca*, *christies.ca*, *chubbychicken.ca*, *henkel.ca*, *greengiant.ca* and *guardianpharmacy.ca*. The Complaint attaches a list of all of the domain names registered by Daniel Mullen, Virgin Enterprises Limited and NETNIC, which covers some 16 pages.

The Complainant states that Daniel Mullen has been named as Respondent or as Respondent's Administrative and Technical Contact in a number of WIPO and BCICAC cases in which transfers of the domain names were ordered upon finding that the domain names were registered in bad faith. The Complainant alleges that the Registrant has a "well documented practice of registering domain names ..." which constitutes a pattern of registering domain names in order to prevent persons who have rights in Marks from registering the Marks as domain names. The Complainant cites several decisions in support of the submission that a history of registering other company's trademarks as domain names leads to the inference that the Registrant had registered the domain name in issue to prevent the Complainant from registering its mark: *Westinghouse Elec. Corp. v. Daniel Mullen BCICAC Case No. 00083*; *Viacom Int'l Inc. v. Harvey Ross Enterprises BCICAC Case No. 00015*; *The Diller Corp c/o Formica Corp. v. Lorenzo Salvalaggio BCICAC Case No. 00091*.

With regard to the criteria in paragraph 3.7(c) the Complainant submits that the Registrant registered the domain name primarily “for the purpose of disrupting the business of the Complainant ...” It submits that such disruption occurs when internet users encounter the domain name and are misled into believing that any activities of the Registrant are related to the Complainant, putting Complainant’s business reputation at risk by the Registrant’s conduct over which the Complainant has no control. In support of this submission the Complainant cites: *The Toronto-Dominion Bank v. TM Watchdog* BCICAC Case No. 00048 (CIRA 2005); *Indep. Order of Foresters v. Noredu Enters. Canada Inc. Resolution Canada* Case No. 00017 (CIRA 2004); *Glaxo Group Ltd. v. Defining Presence Marketing Group, Inc.*, BCICAC Case No. 00020 (CIRA 2004). The Complainant submits that the Registrant is competing with the Complainant for internet traffic and is trading on the reputation of the Complainant and the good will associated with the **BURBERRY** Mark by exploiting the internet traffic intended for a domain name corresponding to the Complainant’s Mark.

In its Response, the Registrant has not responded to the allegations of bad faith made by the Complainant, except to provide explanations with respect to why he was unsuccessful in his defence of several WIPO cases.

The Panel concludes that the Complainant has satisfied the onus on it to show that the Registrant registered the domain name in bad faith, in that it registered the domain name in order to prevent the Complainant from registering its Mark as a domain name as set out in paragraph 3.7(b) of the Policy. Having found registration in bad faith under paragraph 3.7(b) it is unnecessary for the Panel to decide whether bad faith under paragraph 3.7(c) has also been established.

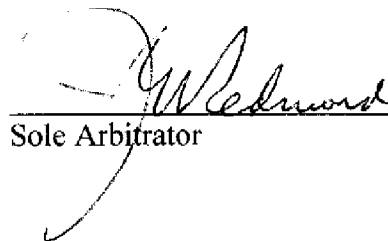
Additional Submissions of the Registrant

The Registrant’s Response includes some submissions which, although they could conceivably be of relevance in proceedings in some other forum, do not appear to this panel to be relevant to determination of the issues before the Panel in this Proceeding. For example, the Registrant complains that Mr. Silva, the person named by the Complainant as its contact person, is not a Canadian citizen or permanent resident of Canada and does not have the right to act as a lawyer in Canada. Neither the Policy nor the Rules require the Complainant’s Representative to be a Canadian citizen or to be registered in Canada, or to be a lawyer authorized to practice law in

Canada. The Registrant also alleges that the Complainant has improperly registered as a domain name *burbery.ca*. That may be pertinent to the validity of that domain name, but does not appear to bear on the issues to be decided under the Policy in this Proceeding. As well, the Registrant raises matters which seem to attack the validity of the Complainant's trademark which are outside the jurisdiction of this Panel to deal with.

Conclusion and Decision

The Complainant having proven on a balance of probabilities that the 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 registered the domain name in bad faith as described in paragraph 3.7(b) of the Policy, and having adduced some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6, and the Registrant having failed to prove on a balance of probabilities that it has a legitimate interest in the domain name, the Panel concludes that the Complaint is successful and orders and directs that the Registration of **burberry.ca** be transferred to the Complainant by the Registrar, Burmac Business Systems Ltd.


Sole Arbitrator

DATED October 30, 2008.