

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

Dispute Number: DCA-1314-CIRA
Domain Name: www.bellapierre.ca
Complainant: The Excite Group, Inc.
Registrant: Zucker International Marketing Inc.
Panel: David Wotherspoon (Chair), Peter Cooke and Bradley Freedman
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

A. THE PARTIES

1. The Complainant is The Excite Group, Inc., a company with an office at 15155 Stagg Street, Unit A, Van Nuys, California, 91405-1309, USA.
2. The Registrant is Zucker International Marketing Inc., a company with an office at 1881 Steeles Avenue W., Suite 371, Toronto, Ontario, Canada, M3H 0A1.

B. THE DOMAIN NAME AND REGISTRAR

3. The domain name at issue is www.bellapierre.ca (the "Domain Name").
4. The Domain Name was registered on October 1, 2006.
5. The Registrar of the Domain Name is Canadian Domain Name Services Inc.

C. PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre ("BCICAC") is a recognized service provider pursuant to paragraph 1.5 of the CIRA Domain Name Dispute Resolution Policy v. 1.2 (the "Policy") of the Canadian Internet Registration Authority ("CIRA").
7. According to the information provided by BCICAC, the procedural history of this proceeding is as follows:
 - (a) The Complainant filed a complaint in relation to the Domain Name pursuant to the Policy on May 6, 2011 (the "Complaint").

- (b) In a letter dated May 10, 2011, BCICAC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.
 - (c) On June 2, 2011, the Registrant requested a time limit extension for delivering its response to the Complaint. BCICAC extended the deadline for filing the response until June 22, 2011, pursuant to paragraph 5.4 of the CIRA Domain Name Dispute Resolution Rules Version 1.3 (the “Rules”).
 - (d) On June 20, 2011, BCICAC received a letter from counsel for the Registrant requesting an additional ten-day extension for the Registrant to file its response to the Complaint. BCICAC also received a letter from counsel for the Complainant objecting to the requested second extension. BCICAC declined to grant the requested second extension.
 - (e) The Registrant filed its response to the Complaint on June 22, 2011 (the “Response”). BCICAC reviewed the Response and forwarded it to the Complainant on June 23, 2011.
8. The Panel was appointed on June 24, 2011.
 9. As required by paragraph 7.1 of the Rules, each Panelist has declared to BCICAC that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.
 10. Pursuant to paragraph 12.2 of the Rules, in the absence of any exceptional circumstances, the Panel is required to submit its decision to BCICAC by July 15, 2011.
 11. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13.2 of the Rules, to a need to alter the progress of this proceeding.

D. ELIGIBILITY OF COMPLAINANT

12. The Complainant satisfies the CIRA Canadian Presence Requirement for Registrants, as stipulated by paragraph 1.4 of the Policy, as the Complaint is the owner of the registered Canadian trade-mark identified at 20(d) hereof.

E. RELIEF REQUESTED

13. The Complainant requests that the Domain Name registration be transferred from the Registrant to the Complainant.

F. APPLICABLE LAW

14. As directed by paragraph 12.1 of the Rules, the Panel will render its decision based upon the rules and principles of the laws of Ontario and the laws of Canada applicable in Ontario.

G. A PROCEDURAL ISSUE

15. On June 27, 2011, the Panel received an unsolicited letter from the Complainant's counsel making further arguments and enclosing a draft affidavit. The letter included an offer by the Complainant to file the affidavit as supplemental evidence, if invited to do so by the Panel, pursuant to Rule 11.1.
16. Later that day, the Panel received an unsolicited email from the Registrant's counsel objecting to the submission of additional evidence by the Complainant.
17. Paragraph 1.1 of the Policy explains that the purpose of the Policy 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".
18. Consistent with the stated purpose of the Policy, the Rules contemplate that, in most cases, the complainant and the respondent will each have only one opportunity to submit evidence and argument. Paragraph 11.1 of the Rules specifies the limited circumstances in which the parties may submit additional evidence or argument. It reads, in relevant part, as follows:

Further Submissions. In addition to the Complaint and the Response, the Panel may request, in its sole discretion, further evidence or argument from either of the Parties. Unless the Panel makes such a request, neither Party shall have the right to submit additional evidence or argument except that if the Response contains a claim for costs under paragraph 4.6 of the Policy, the Complainant may respond to the claim in less than one thousand (1000) words within five (5) days after receipt of the Response.

19. In the circumstances, the Panel has determined that it will not invite either party to submit further evidence or argument. Accordingly, the Panel has not considered any of the additional evidence offered by counsel for the Complainant.

H. FACTS

20. The undisputed facts relevant to the Panel's decision are set forth in the Complaint and its schedules, and are as follows:
- (a) The Complainant is in the business of manufacturing and selling natural mineral cosmetics under the BELLA PIERRE brand in Canada, the United States and elsewhere.

- (b) The Registrant is a former distributor of the Complainant's products in Canada.
 - (c) The Respondent registered the Domain Name on October 1, 2006.
 - (d) The Complainant is the owner of the trade-mark BELLA PIERRE registered in Canada for use in association with cosmetics (No. TMA792,100). The Complainant filed its application for registration of that trade-mark on January 29, 2010, and the trade-mark was registered on March 3, 2011.
21. As previously mentioned, the fundamental issue in this proceeding is whether the Complainant had rights in the BELLA PIERRE trade-mark prior to the date on which the Domain Name was registered.
22. In light of the Panel's decision, it is neither necessary nor appropriate for the Panel to make further findings of fact.

I. DISCUSSION AND FINDINGS

23. Policy paragraph 4.1 sets forth the onus on a complainant. It provides, in relevant part, as follows:

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.

24. As the Complainant's BELLA PIERRE trade-mark was registered after the date on which the Domain Name was registered, the Complainant cannot rely upon its registration of the BELLA PIERRE trade-mark to meet its onus.

25. The Policy provides definitions of the terms "Mark" (paragraph 3.2) and "Rights" (paragraph 3.3). The relevant parts of those definitions are as follows:

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; ...

3.3 **Rights.** A person has “Rights” in a Mark if:

(a) *in the case of paragraphs 3.2(a) and 3.2(b), the Mark has been used in Canada by that person, that person’s predecessor in title or a licensor of that person or predecessor; ...*

26. The relevant definitions of “Mark” and “Rights” require that a trade-mark be “used”, a term that is defined in Policy paragraph 3.5 as follows:

3.5 **Use.** A Mark is deemed to be in “use” or “used” in association with:

(a) *wares: (i) if, at the time of the transfer of the property in or possession of the wares in the normal course of trade, the Mark is marked on the wares themselves or on the packages in which they are distributed or the Mark is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred; or (ii) at the time the wares are exported from Canada, if the Mark was marked in Canada on the wares or on the packages in which they are contained and the wares or packages are still marked when exported;*

(b) *services, if the Mark is used or displayed in the performance or advertising of those services;*

(c) *a business, if the Mark is displayed in the operating, advertising or promoting of the business; or*

(d) *a non-commercial activity, if the Mark is displayed in the carrying out, promoting or advertising of the non-commercial activity.*

27. According to these definitions, a complainant who relies upon an unregistered trade-mark as a “Mark” and asserts “Rights” in that Mark must prove that the trade-mark was in “use” or “used”, as those terms are defined in Policy paragraph 3.5, by the complainant or its predecessors or licensors before the disputed domain name was registered. In the present case, the Complainant must prove that the BELLA PIERRE trade-mark was a “Mark” in which the Complainant had “Rights” prior to the October 1, 2006 date on which the Domain Name was registered.

28. The Complaint contains the following statements regarding the Complainant’s use of the BELLA PIERRE trade-mark before the date on which the Domain Name was registered:

The Complainant has carried on business under the Trade-mark, BELLA PIERRE, in the United States since at least March 1, 2006, and in Canada since at least August 1, 2006.

The Complainant has used the Trade-mark in commerce in Canada since at least August 2006.

29. The Complaint is supported by the Affidavit of the Complainant's Chief Executive Officer, which contains the following sworn statements regarding the Complainant's use of the BELLA PIERRE trade-mark before the date on which the Domain Name was registered:

*5. **Marks and Wares.** The Complaint is based upon the Trade-mark, BELLA PIERRE, as registered in the Canadian Trade-mark Registration, in association with cosmetics. The Complainant is the owner of the Trade-mark in Canada and the United States and use [sic] the Trade-mark in other jurisdictions in association with cosmetics.*

*6. **Business of the Complainant.** The Complainant is in the business of manufacturing and selling natural mineral cosmetics. The Complainant has carried on business under the Trade-mark, BELLA PIERRE, in the United States since at least March 1, 2006, and in Canada since at least August 1, 2006. The Complainant sells its cosmetics to distributors, retailers and direct to consumers around the world, including Canada, the United States, the United Kingdom, continental Europe, and Australia.*

30. The Complaint is also supported by a printout from the Canadian Trade-marks Database, which indicates that the Complainant claims that the BELLA PIERRE trade-mark was used in Canada since August 1, 2006.
31. The Complaint and related materials do not contain any evidence that the BELLA PIERRE trade-mark was "used" in association with wares, services, or a business in any of the ways specified in Policy paragraph 3.5.
32. The Registrant has not submitted any evidence to contradict the Complainant's statements or evidence regarding the Complainant's use of the BELLA PIERRE trade-mark before the date on which the Domain Name was registered. Rather, the Registrant has submitted that the Complainant's "bald assertions" regarding use of the BELLA PIERRE trade-mark are insufficient, because they are not supported by "evidence of use". For the reasons set forth below, the Panel agrees with the Registrant's submissions.
33. Where a complainant relies upon an unregistered trade-mark, Policy paragraph 4.1(a) requires the complainant to prove, on a balance of probabilities, that the trade-mark is a "Mark" in which the Complainant had "Rights" prior to the date of registration of the disputed domain name. To meet that onus, a complainant must adduce some evidence from which the panel can make a finding that the complainant's trade-mark was used in one of the various ways specified in Policy paragraph 3.5. A simple assertion by a complainant that it has carried on business under a trade-mark or has used a trade-mark in commerce, without details regarding the specific manner in which the trade-mark was used in association with wares, services or a business, is not sufficient, because it does

not allow the Panel to make a finding of fact that the trade-mark was “used”, as that term is defined in Policy paragraph 3.5.

34. In previous decisions under the Policy, other panels have noted that a complainant’s bare assertion of use of a trade-mark is not sufficient to satisfy the requirements of the Policy. For example, see *Toyota Canada Inc. v. Sproul* (June 2, 2010), CIRA Decision No. 152, at paras. 42 and 46; and *Family Honda v. Bartello and Cairo*, (December 14, 2009) CIRA Decision No. 00142, at para. 13.
35. The Complaint contains statements that the Complainant has “carried on business under the Trade-mark” and “has used the Trade-mark in commerce in Canada”. The supporting Affidavit of the Complainant’s Chief Executive Officer contains similar statements. Those statements do not refer to any of the specific kinds of use required by Policy paragraph 3.5, and do not provide the Panel with sufficient evidence upon which to make a finding that the unregistered BELLA PIERRE trade-mark was a “Mark” in which the Complainant had “Rights” prior to the registration of the Domain Name.
36. For those reasons, the Complainant has failed to prove, 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, as required by Policy paragraph 4.1(a).
37. In the circumstances, it is neither necessary nor appropriate for the Panel to address any other issues.

J. CONCLUSION

38. The Panel finds that the Complainant has not met the burden assigned to it under paragraph 4.1(a) of the Policy. In particular, the Complainant has not proven, on a balance of probabilities, that it had Rights in the BELLA PIERRE trade-mark prior to the date of registration of the Domain Name.
39. Accordingly, the Panel holds that the Complainant has not established its claim, and is not entitled to the remedy set forth in the Complaint.

K. ORDER

40. For the reasons set forth above, the Panel declines to make any order with respect to the Domain Name.

David Wotherspoon (chair)

Peter Cooke

Bradley Freedman

Arbitrators
July 15, 2011