

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Domain Name: CHEAPMONDAY.CA

Complainant: Weekday Brands AB
Registrant: Whitfield Leslie
Registrar: HEXONET Services Inc.

Panel: David Lametti (sole panelist)

Service Provider: Resolution Canada

DECISION

A. The Parties

1. The Complainant is Weekday Brands AB (“Weekday” or “the Complainant”), a limited liability company registered in Sweden. Its corporate address is Kanalgatan 1 573 31, Tranås, Sweden. The Complainant is wholly owned by Hennes & Mauritz AB. The Complainant’s authorized representative is Cecilia Borgenstam, Melbourne IT Digital Brand Services AB, Saltmätargatan 7, SE 103 68, Stockholm, Sweden.

2. The Registrant is Whitfield Leslie, 7 Bayfield Street, Richmond Hill, Ontario, L4C 3Y2. The Registrant’s identity was initially undisclosed to the general public under its CIRA registration. Upon initiation of the proceeding, it was released to Resolution Canada.

B. The Domain Name and Registrar

3. The domain name at issue is CHEAPMONDAY.CA.

4. The domain name is registered with HEXONET Services Inc., whose address is #104 - 7455 132nd Street Surrey, B.C., V3W 1J8, Canada.

C. Procedural History

5. On 21 August 2012, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada. The Complainant elected to have the matter heard by a single-member panel. The Provider served notice of the Complaint to

the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* (version 1.4) [“Rules”].

6. No response was received from the Registrant.

7. The Provider therefore moved to have the Complaint treated as uncontested, and appointed a panelist, all as governed by the Rules.

D. Panel Member Impartiality and Independence Statement

8. As required by paragraph 7 of the Rules, the panelist has declared to the Provider that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

E. Canadian Presence Requirement

9. Weekday’s trademark CHEAP MONDAY is registered in Canada and thus satisfies the Canadian Presence Requirement as stated in paragraph 1.4 of the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) [“Policy”].

F. Factual Background

10. The Cheap Monday brand, with its characteristic skull logo, was created in 2004 by Weekday. It was first used in association with the production of 800 pairs of jeans. In 2008, Weekday was bought by Hennes & Mauritz, and is now wholly owned by them. In 2009, Cheap Monday opened its very first store in Copenhagen. Since then, the range of the wares sold and the number of stores have both increased greatly. Today the Cheap Monday brand carries fashion collections for men and women. The collections also include baby, accessories, glasses, shoes and underwear. In terms of reach, the Cheap Monday brand can be found in more than 35 countries, in about 1800 stores around the world with agents and distributors. In Canada alone Cheap Monday clothes can be found in 39 stores. As regards the wide range of products, tmark is especially well-known in the fashion industry as regards clothing and apparel.

11. Weekday maintains an extensive web site under the domain name cheapmonday.com.

12. Weekday registered the first CHEAP MONDAY trademark in Canada on 5 October 2009, and later registered two other CHEAP MONDAY marks in Canada. These marks are filed for an extremely wide range of products, centred around mainly fashion and clothing items and accessories, office products and supplies, kitchen and dining products, and travel supplies.

13. There is no evidence in the record of when the Registrant first filed the cheapmonday.ca domain. The website attached to this domain name as first registered resolved to a “parking page” in which various services and products were advertised, and contained links to “pay-per-click” sites, including unauthorized links to both the Complainant’s sites and those of its competitors. The website had sponsored links,

including a link to the SEDO website where the domain name was listed as being for sale by auction.

14. On 8 June 2012, the Complainant, through its parent company Hennes & Mauritz, first attempted to contact the Registrant using a cease and desist letter sent via the CIRA home page. In that letter, the Complainant requested a voluntary transfer of the domain name and offered compensation for registration expenses. No response was received. A reminder was sent via the CIRA Online Form, on 15 June 2012 and on 29 June 2012. Again, there was no response.

15. On 2 August 2012, a new registration for the domain name was filed apparently as a result of a transfer. It is this registration date that now appears as the registration date in the Who Is search.

16. In order to freeze the domain name and avoid further delays the Complainant chose to file a complaint according to the CIRA domain dispute process. The current website to which the domain name resolves has similar content as did the previous site, e.g. sponsored links and with a link to the SEDO auction site where the domain name cheapmonday.ca still listed as up for sale. Once again, this “parking page” includes adverts for various services and products, and contains links for “pay-per-click” sites, including unauthorized links to both the Complainant’s sites and those of its competitors.

17. The Complainant filed this Complaint on 21 August 2012.

G. CIRA Domain Name Dispute Resolution Policy Requirements

18. The *CIRA Domain Name Dispute Resolution Policy* (version 1.3) [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint:

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 3.5;

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 . . .

19. The Panel will deal with each criterion in turn.

H. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

20. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

21. The Complainant must establish trademark rights that precede the domain name registration date. The Complainant has shown the date of the registration of CHEAP MONDAY trademark in Canada (in 2009), and the first use of the mark internationally (in 2004). The first Registration of the domain name in Canada is unknown to the Panel. It was clearly registered before the cease and desist letter was sent to the Registrant in June 2012. Presumably the Complainant had the exact information at that time, although there is no mention of the domain name registration date in the letter. On 2 August 2012, the Registrant’s attempted transfer of the domain name effectively erased the original registration date on the Who Is webpage and inserted the later date of 2 August 2012.

22. In the particular facts and circumstances in this case, and while I do not do so lightly or hastily, I am prepared to draw the inference that the domain name registration must have been subsequent to the date the first trademark registration in Canada. I draw this inference for a number of reasons. First, the Complainant drafted the cease and desist letter in a rather standard fashion, relying heavily in its reasons on the fact of owning the registered trademark in Canada. In asking for a transfer, the Complainant’s basic framing assumption appears to be that there is no question of any potential claim of prior registration of the domain name. The Complainant is not relying at all on its prior reputation and known goodwill as it might have done had the registration of the domain name been earlier than that of the mark. Second, and most importantly, it is the Registrant’s later action of transferring ownership of the domain name – seemingly done in bad faith and in order to shift the domain name owner in the face of possible action by the Complainant, a practice known as “cyber-flight”—that has deprived the Complainant and Panel of information that otherwise would be available on the Who Is database. This activity is suspicious, and it should not be used to give the Registrant a procedural advantage. Third, as regards the particular timeline of the case, it is certainly likely that the domain name registration came after the trademark registration, and that even if it did not, the unregistered mark was likely used and sufficiently well-known in Canada to have

grounded the Complainant's claim. In general, the CHEAP MONDAY mark was (and is) sufficiently well known in Canada, and its distinctiveness in the ascendant. Finally, the Registrant has not responded and thus the Panel is entitled to draw such inferences against it.

23. Paragraph 3.3 of the Policy defines "confusingly similar" in the following terms:

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.

24. I need not deal with the implications of the words "shall only consider" as they do not arise in this matter. The question of confusion is, in my view, straightforward.

25. For the purposes of this proceeding, the domain name at issue is identical to the Complainant's trademarks. The domain name is composed of two words put together, the whole of which is identical to the two words comprising the registered trademarks belonging to the Complainant.

26. Thus, the Panel finds that the Registrant's domain name CHEAPMONDAY.CA is confusingly similar with the Complainant's registered mark in which the Complainant had rights prior to the registration of the essentially identical domain name.

I. Was the Registration of the Domain Name Made in Bad Faith?

27. In order to succeed in the second stage of the test set out in paragraph 4.1, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.5 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith, generally if one of the following four conditions is met:

For the purposes of paragraphs 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 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 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 on-line 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.

28. There are two significant changes to be noted in this latest iteration of the Policy. First, the list of general criteria for bad faith behaviour is no longer closed. As with "legitimate interest", these four criteria are exemplars of certain kinds of behaviour, and thus make possible other acts demonstrating bad faith.

29. The second change is directly relevant to this matter. Paragraph 3.5(d) adds *intentionally attempting to attract users* for commercial gain as a listed criterion of bad faith where such is done by "creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement" of what the Registrant has to offer – it seems in the widest sense – on its website.

30. The Complainant's argument is effectively framed under paragraphs 3.5(c) and (d). The website to which the domain name resolved were pages with sponsored links and in which various services were offered and products sold, including products of the Complainant and a competitor, with no attempt to dispel any confusion that might have been caused. The website also listed the domain name at issue as being "for sale" on the SEDO website. (On the SEDO website the listed opening bid for the domain name is 6,200 EUROS, a price much higher than the Registrant's registration costs.)

31. Given that the CHEAP MONDAY mark was distinctive enough and was beginning to be increasingly well-known, the Registrant would have had constructive notice of its existence prior to registering the domain name, as inferred above in the discussion of the registration date of the domain. It then becomes logical to reach the conclusion that the domain name was registered precisely to capitalize on the accumulated goodwill of the Complainant's marks by intentionally creating the impression of a false association, sponsorship or endorsement with or through them (paragraph 3.5(d)) in order to increase

internet traffic to the website and thus generate “pay-per-click” revenue. One could also raise the argument, under the head of paragraph 3.5(c), that the registration was undertaken “primarily for the purpose of disrupting the business of the Complainant”.

32. As a whole, this argument is convincing. Interpretations of the predecessor provision under the previous Policy, the equivalent of current paragraph 3.5(c), focusing on “primarily for the purpose of disrupting”, held that such opportunistic traffic diversion could be sufficient in some circumstances to constitute bad faith. In this case, where the Registrant makes no effort to dispel any confusion or presumption of a link created by his use of the trademarks in registering and using this domain name, the conclusion of bad faith may be reasonably inferred. In addition, in this case competitors to Weekday are also among the links and the domain name itself is listed as being up for auction on a linked site.

33. Even more compelling is the application of the new paragraph 3.5(d), an addition that likely was meant precisely to apply to this situation. While the use of a pay-per-click business model is not in bad faith *in se*, in some instances the manner or method of attracting traffic to such sites will run afoul of paragraph 3.5(d). One such instance is using a domain name *intentionally* to attract users for commercial gain in a manner *likely to create confusion* as to source, sponsorship, affiliation or endorsement. This would in my view constitute bad faith where the linking site does not clearly and sufficiently dispel ambiguities as regards the presumptive link to the trademarks. Put another way, the paragraph appears to imply that while some degree of initial interest confusion might still be tolerated (i.e., when *not* intentional and not done “by creating a likelihood of confusion”), it will only be tolerated where it is clear on reaching the site of the domain name in question that the use of domain name was done effectively in good faith and not done to simply piggyback on the domain name’s popularity for the purposes financial gain. That there is a conceptual link between this new criterion of good faith to some sort of legitimate interest or legitimately-believed interest in using the domain name to attract traffic seems to be intuitively and analytically obvious.

34. The Complainant has cited a number of WIPO decisions that point to this result. While helpful, it suffices to rely on the wording of the CIRA Policy and cases decided under it to reach the same result more directly [see *e.g.*, *Canadian Broadcasting Corporation v. Ghalib Dhalla*, DCA-964-CIRA “hockeynightincanada.ca”; and *General Motors LLC v. Thompson*, DCA-00191-CIRA “chevroletorlando.ca”].

35. In this case, it appears on the evidence that the only reason to use the confusing domain name was to draw traffic to the web site for commercial gain, profiting from the goodwill in the Weekday trademarks. This was done intentionally and in a manner which does not sufficiently dispel any notion of confusion as to source, sponsorship, affiliation or endorsement.

36. Therefore this Panel concludes that the Registrant acquired the domain name CHEAPMONDAY.CA in bad faith under both paragraphs 3.5(c) and 3.5(d) of the Policy.

J. Does the Registrant Have a “Legitimate Interest” In the Domain Name?

37. The third element of the test set out in paragraph 4.1 of the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. This inquiry tries to find some more or less objective or ascertainable link between the Registrant and the domain name in question, aside from mere registration, and which is legitimate. Paragraph 3.4 of the Policy, as revised, now states:

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 evidence presented, shall demonstrate that the Registrant has a legitimate interest in a 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 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 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 Registrants includes, but is not limited to, use to identify a web site.

38. The first four criteria contain an element of good faith in assessing the behaviour of the Registrant, while the last three point to more objective facts linking the domain name to the Registrant. It is to be noted that this definition is also no longer a closed, restrictive

list that was the case in the previous version of the Policy, but rather illustrates the primary examples of the kinds of association between a registrant and the domain name that would be found legitimate. It may now be appropriate for parties or for a panel to look beyond these stated criteria in determining the kinds of facts and behaviour that constitute a legitimate interest.

39. In terms of the procedure required under the Policy, the Complainant must provide some evidence that none of these or similar interests can reasonably apply to the Registrant. (Obviously a panel must be wary of the fact that a complainant may not have incentive to best identify and characterize a registrant's possible legitimate links, and examine the facts accordingly.) The burden would then shift to the Registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs, as well as, in the amended version, other legitimate interests not so listed.

40. The Complainant has introduced sufficient evidence of the Registrant having no legitimate interest as exemplified under any of the listed heads. The Complainant has not been able to identify any manner in which the registrant might have a legitimate interest in the domain name. In particular:

- the Registrant had neither permission or license, express or implied to use the marks, nor authorization, nor was there acquiescence on the part of the Complainant; and
- the Registrant does not use the domain name in a bona fide offering of goods and services

41. Regarding the offering of bona fide goods and services, and conceptually linked to the preceding discussion of bad faith, there is a growing consensus in domain name dispute resolution under the CIRA Policy that incorporating trademarks and domain names belonging to others into domain names in a manner likely to cause confusion or raise presumptive associations are *not* bona fide offerings of goods and services [*General Motors LLC v. Thompson*, DCA-00191-CIRA “chevroletorlando.ca”; *Canada Post Corporation v. Marco Ferro*, DCA-871-CIRA “canadapost.ca”; *AADAC v. Ashkay Solutions*, DCA-933-CIRA “aadac.ca”]. The practice of using “parking pages” with “pay-per-click” remuneration, paid to whomever, has been singled out as a non-bona fide practice where the intent was simply to capitalize on the goodwill of a popular trademark [*General Motors LLC v. Thompson*, DCA-00191-CIRA “chevroletorlando.ca”; *Canadian Broadcasting Corporation v. Ghalib Dhalla*, DCA-964-CIRA “hockeynightincanada.ca”]. The practice of “pay-per-click” or “click-through” remuneration models are not illegitimate business models in and of themselves; rather it is the confusion/illegitimate association that one uses to get the user to the desired site that is not *bona fide*, and thus not capable of constituting a legitimate interest in the name.

42. The Complainant having thus satisfied its initial burden of showing “some evidence” of “no legitimate interest” puts the onus on the Registrant to show a legitimate interest.

43. The Registrant has not responded, and thus fails to meet its burden of showing any legitimate interest in the domain name.

44. The Panel therefore concludes that the Registrant did not have a legitimate interest in the domain name CHEAPMONDAY.CA under paragraph 3.4 of the Policy.

K. Conclusion and Decision

45. The Complainant has established that the Registrant's domain name CHEAPMONDAY.CA is confusingly similar to the Complainant's registered Canadian trademarks.

46. The Complainant has established that the Registrant had registered the domain name CHEAPMONDAY.CA in bad faith, as defined in the Policy.

47. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name CHEAPMONDAY.CA. The Registrant has not established, as set out in the Policy, that it does have a legitimate interest.

48. For these reasons, the Complaint regarding the domain name CHEAPMONDAY.CA is successful.

L. Remedy

49. The Complainant has asked that the domain name at issue be transferred to it. The Panel hereby so orders.



David Lametti
Sole Panelist

October 12, 2012