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

CASE NO.:	DCA-1476-CIRA
DISPUTED DOMAIN NAME:	swarovskishop.ca
COMPLAINANT:	Swarovski Aktiengesellschaft
REGISTRANT:	Unknown
REGISTRAR:	Go Daddy Domains Canada Inc.
SERVICE PROVIDER:	British Columbia International Commercial Arbitration Centre (BCICAC)
PANEL:	James E. Redmond (Chair); Barry C. Effler; Hugues Richard.

DECISION

The Parties

1. The Complainant is Swarovski Aktiengesellschaft, of Droschistrasse 15, Triesen FL-9495, Liechtenstein, represented by Janet M. Fuhrer, Timothy C. Bourne and V. Joy Mauthe of Rideout & Maybee LLP of 100 Murray Street, 4th Floor, Ottawa, Ontario, K1N 0A1.

2. The identity of the Registrant is not available in the WHOIS database because the registration is "privacy protected".

Procedural History

3. This is an administrative proceeding pursuant to the Canadian Internet Registration Authority (CIRA) Dispute Resolution Policy (CDRP) and Domain Name Dispute Resolution Rules (the Rules). The Complainant commenced this proceeding by

submitting its Complaint to the Service Provider on March 11, 2013. The Service Provider advises that the Complaint was reviewed and found to be in administrative compliance with CIRA's requirements under Rule 4.2. The Service Provider further advises that a copy of the Complaint was forwarded to the Registrant by letter and email, but that attempts to deliver the Complaint to the Registrant by courier were unsuccessful. The Registrant has not provided a response.

4. The Service Provider advised the Complainant on April 2, 2013 that the Registrant had failed to submit a response within the allowed time, and that the Complainant could therefore elect to convert from a three-person tribunal to a single arbitrator. The Complainant advised the Service Provider on April 9, 2013 that it did not wish to convert to a sole arbitrator. The Service Provider then selected as panelists James E. Redmond, as Chair, Barry C. Effler and Hugues Richard. As required by CIRA Rule 7.1, the panelists have each declared that they are able to act impartially and independently and that there are no circumstances known to them that would prevent any of them from so acting.

5. The Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met and that the Panel was properly constituted and appointed in accordance with the Policy and the Rules

Complainant's Eligibility

6. The Complaint relates, *inter alia*, to trade-marks registered at the Canadian Intellectual Property Office (CIPO) and the Complainant is the owner of the trade-marks. The Panel finds that the Complainant is an eligible complainant under paragraph 1.4 of the Policy.

The Complaint

7. In accordance with paragraph 3.1 of the Policy, the Complaint alleges 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;

(b) The Registrant has no legitimate interest in the domain name as described in paragraph 3.4, and

(c) The Registrant has registered the domain name in bad faith as described in paragraph 3.5.

Factual Background

8. Since the Registrant has submitted no response to the Complaint, the Panel will decide this matter on the evidence and submissions put forward by the Complainant, together with reasonable inferences arising therefrom.

9. The Complainant claims to be the world's leading producer of cut crystal, genuine gemstones and created stones and that its business roots extend back to 1892. The Complainant's evidence is that the Complainant's trade-mark SWAROVSKI originated from the name of one of company's founders, Daniel Swarovski. The SWAROVSKI Mark has been used in Canada since at least 1930, in association with numerous crystals and gemstone products, including natural and synthetic gemstones, glass stones, beads and pendants for jewelry. The SWAROVSKI Mark has been used in Canada since at least July, 2004 in association with retail services for gemstones, jewelry, decorative articles primarily made of glass, bags and clothing. The SWAROVSKI Mark has existed on the Canadian Trade-marks Register since at least 1983.

10. The Complainant further states that in 2011 it had approximately € 2.2 billion in world-wide sales for cut crystal, genuine gemstones, created stones, premium jewelry and premium gemstones as well as decorative objects, lighting and home and fashion accessories including eyeglasses and sunglasses bearing the trade-mark SWAROVSKI, some of which sales occurred at SWAROVSKI boutiques in Canada, other authorized retailers in Canada or through the website located at http://www.swarovski.com. It has extensively advertised the SWAROVSKI brand and SWAROVSKI products since the adoption of the brand in 1895, and advertises through various media including print advertisements in major publications around the world, television and radio advertisements.

11. The Disputed Domain Name was registered on July 12, 2011.

12. The evidence shows that the Complainant has registered in the Canadian Intellectual Property Office the trade-mark SWAROVSKI under Nos. TMA 280,868; TMA 766,968; and TMA 799930 (the SWAROVSKI Mark). The Complainant has also registered the trade-mark SWAROVSKI & Design (the SWAROVSKI Design Mark) at the Canadian Intellectual Property Office under No. TMA 527,837. The Complainant is also the owner of registered trademarks TMA 510,022 and TMA 766,388, which consist of a swan design (SWAROVSKI Swan Design Marks). Each of these registered trade-marks constitutes a Mark under the terms of paragraph 3.2 of the policy.

Confusingly Similar

13. Paragraph 3.3 of the Policy directs that a panel, in determining whether a domain name is confusingly similar to a Mark, "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."

14. In this case, the Disputed Domain Name includes the Complainant's trade-mark SWAROVSKI but adds "shop" and ".ca". Paragraph 1.2 of the Policy provides that for the purposes of the 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. Therefore, the inclusion of the ".ca" in the Disputed Domain Name does not prevent it from being confusingly similar.

15. The Complainant's evidence shows that the Registrant, following registration of the Disputed Domain Name, used a website, "http://www.swarovskishop.ca," to which the Disputed Domain Name resolved, to offer SWAROVSKI products for sale. The term "shop" is descriptive of the offering of products for sale. The Complainant cites as authorities determining that the inclusion of descriptive or non-distinctive terms in a domain name will not preclude the domain name from being found confusingly similar with a complainant's mark, *Citrix Online LLC v. Media Vision Network Inc.*, CIRA Decision 175 (2011); and *The Exite Group Inc. v. Zucker International Marketing Inc.*, CIRA Decision 176 (2011). The Panel concludes that the use of the word "shop" within

the domain name is clearly descriptive of the Registrant's services, and will not preclude the domain name from being found confusingly similar with the Complainant's Marks.

16. The Panel finds that the Disputed Domain Name is Confusingly Similar to the Complainant's Marks.

Registration in Bad Faith

17. Under paragraph 3.1 of the Policy the Complainant must show, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith. Paragraph 3.5 of the Policy sets out the circumstances which, "in particular but without limitation," shall be evidence that the Domain Name was registered in bad faith. The evidence shows that prior to receiving a cease and desist letter from the Complainant, the Registrant was using the Disputed Domain Name to advertise and sell goods using the Complainant's SWAROVSKI name and trade-marks, without authorization from the Complainant. After receiving the cease and desist letter, the Registrant removed content from the website to which the Domain Name resolved and offered to sell the Domain Name to the Complainant at a price of $10,000. The evidence also shows that the Registrant was the registrant of several other domain names, which were comprised of or contained marks or the dominant portions of marks that were the subject of registrations by others of Canadian trade-marks or that had been used extensively by their owners in Canada.

18. These facts support a finding that the actions of the Registrant come within the categories of facts showing registration in bad faith as set out in paragraphs 3.5 of the Policy. The fact that the Registrant had previously engaged in a pattern of registering domain names comprised of or containing marks or the dominant portions of marks that were the subject of Canadian trade-mark registrations, supports a reasonable inference that the Disputed Domain Name was registered for the purpose of preventing the Complainant from registering its Mark as a domain name, within the meaning of paragraph 3.5(b).

19. Further, it is clear from the evidence that by using the Disputed Domain Name to offer for sale products under the SWAROVSKI name, the Registrant intentionally attempted to

attract, for commercial gain, Internet users to the Registrant's website 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 the product or service on the Registrant's website or location, within the meaning of paragraph 3.5(d) of the Policy. The fact that the Registrant began offering Swarovski products for sale only after the registration of the Disputed Domain Name does not prevent the application of paragraph 3.5(d) (*The Exite Group,* supra).

20. The Panel concludes that the Disputed Domain Name was registered in bad faith.

Legitimate Interests

21. The Panel finds that the Complainant has met the onus upon it to provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4 of the Policy. The Registrant, having failed to file any response to the Complaint, has failed to meet the reverse onus upon it under paragraph 4.1 of the Policy to prove on a balance of probabilities that it has a legitimate interest in the Disputed Domain Name. Paragraph 3.4 lists circumstances which, "in particular but without limitation", will demonstrate that the Registrant has a legitimate interest in the Domain Name. Each of paragraphs 3.4(a), (b), (c) and (d) requires that the Respondent shall have used the Mark which is in issue in good faith. The Panel has already found that the Registrant did not register or use the Mark in good faith. Further, the Complainant's evidence is that it did not authorize anyone, including the operator of the website to which the Disputed Domain Name resolves, to sell or distribute any products or services in association with the trade-marks SWAROVSKI, SWAROVSKI & Design and SWAN DESIGN in association with the Disputed Domain Name or the website http://www. swarovskishop.ca., which negates any suggestion that the Registrant had any Rights in the Marks. Nor does the Disputed Domain Name comprise the legal name of the Registrant and is not a name, surname or other reference by which the Registrant was commonly identified and was not the "geographical name of the location of the Registrant's non-commercial activity or place of business".

22. The Panel finds that the Registrant has no legitimate interest in the Disputed Domain Name.

Conclusions and Order

23. For the reasons given above, the Panel finds that the Complaint is successful, and orders and directs that the registration of the Disputed Domain Name be transferred to the Complainant.

Dated this 6th day of May, 2013.

James E. Redmond (Chair), Barry C. Effler, Hugues Richard