

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-1665-CIRA
Domain Name: citizensofhumanity.ca
Complainant: Citizens of Humanity, LLC
Registrant: Essi Molesky
Panel: Elizabeth Cuddihy
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

The Parties

1. The Complainant is Citizens of Humanity, LLC of 5715 Bickett Street, Huntington Park, CA 90255, USA, (the Complainant).
2. The Registrant is Essi Molesky of 99 University Avenue, Kingston, Ontario, Canada, (the Registrant).

The Disputed Domain Name and Registrar

3. The Domain Name at issue is citizensofhumanity.ca, (the Disputed Domain Name).
4. The Registrar for the Disputed Domain Name is HEXONET, 2235-6900 Graybar Road, Richmond, BC, Canada.
5. The Disputed Domain Name was registered on June 17, 2011.

Procedural History

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognized service provider to the Domain Name Dispute Resolution Policy, (the Policy) and Rules, (the Rules) of the Canadian Internet Registration Authority, (CIRA).
7. The Complainant filed a complaint dated March 27, 2015, (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to the Complainant.

8. By letter dated March 27, 2015, BCICAC confirmed the Complaint to be in administrative compliance with the requirement of the Rules and the commencement of the dispute resolution process and forwarded copy of the Complaint to the Registrant in accordance with the Rules.
9. The Registrant did not provide a Response.
10. As permitted in the absence of a Response, the Complainant elected under Rule 6.5 to convert to a single arbitrator. On April 21, 2015, BCICAC appointed Elizabeth Cuddihy as Sole Panelist to determine the dispute, (the Panel).
11. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so doing.
12. As the Registrant did not provide a Response to the Complaint, the Panel shall decide the matter on the basis of the Complaint.

Canadian Presence Requirements

13. In order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot ca domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.
14. Section 2(q) of the Presence Requirements specifies that a Person who does not meet any of the conditions specified in section 2(a) to (p) inclusively, but who is the owner of a trade-mark which is the subject of a registration under the *Trade-Marks Act (Canada)* R.S.C. 1985, c.T-13 as amended from time to time, satisfies the requirement, provided the dot ca domain name consists or includes the exact word component of that registered trade-mark.
15. The Complainant is the owner of Canadian Trade-mark registration for CITIZENS OF HUMANITY registered in the Canadian Intellectual Property Office, (CIPO) on March 2014 as registration Number TMA873,008, (the CITIZEN OF HUMANITY Mark).
16. Accordingly, as the Complaint relates to the Disputed Domain Name which includes the exact word component of a Mark registered in CIPO and owned by the Complainant, the Presence Requirements are satisfied.

The Position of the Parties

The Complainant's Position

17. The Complainant designs, manufactures and sells apparel and other wares in the United States and elsewhere including Canada under numerous trademarks including the CITIZENS OF HUMANITY Mark registered in and for the United States of America on April 12, 2005 under No. 2,940,943 for apparel, namely jeans, pants, skirts, jackets, vests, tops, t-shirts and sweat shirts and on August 14, under No 3,280,372 for apparel, namely, bottoms, camisoles, cardigans, dresses, dungarees, jerseys, overalls, scarves, shirts, shorts, tank tops and trousers.
18. The Complainant filed for trademark registration of the CITIZENS OF HUMANITY Mark in CIPO on July 15, 2005 on various wares including those noted in paragraph 17 above based on the commercial use of that mark since at least May 2003 in the United States and Canada in connection with the wares noted therein. THE CITIZENS OF HUMANITY Mark was registered in CIPO on March 11, 2014 as Number TMA873,008.
19. The Registrant registered the Disputed Domain Name on June 17, 2011, six (6) years after the Complainant filed its trademark application for the CITIZENS OF HUMANITY Mark in CIPO based on commercial use of its Mark in connection with its products sold worldwide including in Canada.
20. The Disputed Domain Name is confusingly similar to the CITIZENS OF HUMANITY Mark in that it is identical to the CITIZENS OF HUMANITY Mark except for the use of lower case lettering, the deletion of the spacing between the words and the conjunction "of" and the addition of the ".ca" at the end.
21. Although the Disputed Domain Name was registered prior to the date of registration of the CITIZENS OF HUMANITY Mark in CIPO, the Complainant alleges that it had rights in the CITIZENS OF HUMANITY Mark well before the date of registration of the Disputed Domain Name by the Registrant, said rights being based on commercial use worldwide including in Canada and the United States of America since as early as May 2003.
22. The Complainant claims among other things that the Registrant is not an authorized seller or distributor of its products, is using the CITIZENS OF HUMANITY Mark on its website without the permission of the Complainant and has no legitimate interest in the Disputed Domain Name in accordance with paragraph 3.4 of the Policy.
23. The Complainant claims that the Registrant has registered the Disputed Domain Name in bad faith and relies on circumstances described in paragraph 3.5(a) of the Policy. In

particular, the Complainant alleges that the Registrant registered the Disputed Domain Name, primarily for the purpose of selling, renting, licensing or otherwise transferring the registration to the Complainant for a consideration in excess of the Registrant's actual costs of registering the Disputed Domain Name or acquiring the registration.

24. The Complainant, as owner of the CITIZENS OF HUMANITY Mark registered in CIPO, which mark was used in Canada and the United States of America under the identical registered trademark as that registered in CIPO prior to the registration of the Disputed Domain Name by the Registrant, claims that the Disputed Domain Name is confusingly similar to the CITIZENS OF HUMANITY Mark, in which the Complainant had rights prior to the registration of the Disputed Domain Name, that the Registrant registered the Disputed Domain Name in bad faith and that the Registrant has no legitimate interest in the Disputed Domain Name. Accordingly the Complainant requests and Order transferring the Disputed Domain Name to the Complainant forthwith.

The Registrant's Position

25. The Registrant did not file a Response.

Analysis and Findings

26. The purpose of the Policy as stated in paragraph 1.1 is to provide a forum by which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

Relevant provisions of the Policy are provided below

27. Paragraph 4.1 of the Policy provides:

4.1 Onus. To succeed in a 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 as described in paragraph 3.4.

28. Paragraph 3.2 of the Policy provides in part:

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;

(b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or that person's predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or

(d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

29. Paragraph 3.3 provides:

3.3 Confusingly Similar. 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.

30. Paragraph 3.4 provides:

3.4 Legitimate Interest: 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 the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the 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.

31. Paragraph 3.5 provides:

3.5 Registration in Bad Faith. For the purposes of paragraph 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.

32. In summary, to succeed in a proceeding, the Complainant must prove on a balance of probabilities that:

1. That the dot-ca domain name is confusingly similar to a Mark in which the Complainant had Rights prior to the registration of the domain name and continues to have such Rights;
2. The Registrant has registered the domain name in bad faith; and
3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the domain name.

Notwithstanding the above, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the domain name.

Confusingly Similar to a Mark

33. Evidence shows that the Complainant is the owner of the CITIZENS OF HUMANITY Mark as registered in CIPA as No. TMA873,008, on March 11, 2014.

34. In accordance with Paragraph 3.3 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 mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

35. The Disputed Domain Name incorporates the whole of CITIZENS OF HUMANITY Mark. The only difference between the CITIZENS OF HUMANITY Mark and the Disputed Domain Name is the non-distinctive elements of the Disputed Domain Name, being in lower case lettering and the omission of the spacing between the conjunction "of" and the words "citizens" and "humanity". As noted in 34 above, dot-ca is ignored.

36. In the Panel's view the differences noted are not *prima facie* sufficiently distinctive to distinguish the Disputed Domain Name from the Complainant's CITIZENS OF HUMANITY Mark.

37. It is a well-established principle that a domain name that wholly incorporates a Mark will be found to be confusingly similar to the Mark notwithstanding certain non-

distinctive elements such as noted in 35 above. Accordingly for the reasons noted above, the Disputed Domain Name is confusingly similar to the Complainant's CITIZENS OF HUMANITY Mark.

Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights

38. The Registrant registered the Disputed Domain Name on June 17, 2011. The date of the registration of the CITIZENS OF HUMANITY Mark owned by the Complainant in CIPO is March 11, 2014.

39. As early as 2003, the Complainant, under its trade-name Citizens of Humanity, (which is the exact wording of the CITIZENS OF HUMANITY Mark) has been manufacturing and selling worldwide including in Canada, its wares under the brand-name Citizens of Humanity, (again being the exact wording of the CITIZENS OF HUMANITY Mark). In addition to the CITIZENS OF HUMANITY Mark registered in CIPO, the Complainant is the owner of trade-marks, CITIZENS OF HUMANITY, registered in the United States of America on April 12, 2005 under No. 2,940,943 in relation to the following wares; namely, jeans, pants, skirts, vests, tops, t-shirts and sweat shirt and on August 14, 2007 under No. 3,280,372 in relation to the following apparel; namely, bottoms, camisoles, cardigans, dresses, dungarees, jerseys, overalls, scarves, shirts, shorts, tank tops and trousers, (the Complainant's trade-marks).

40. The Complainant has used in commerce worldwide and in Canada the Complainant's trade-marks (which are identical to the CITIZENS OF HUMANITY Mark) for the purpose of distinguishing its wares, among other wares, jeans, pants, skirts, jackets, vests, tops, t-shirts, shorts and sweat shirts since as early as May 2003 in Canada. The Complainant's trade-marks are identical to the CITIZENS OF HUMANITY Mark. The Complainant continues to use the Complainant's trade-marks and CITIZENS OF HUMANITY Mark in connection with its wares.

41. Since the 2011 revision of the Policy, the Policy no longer contains a definition of "Rights" as it is used in Paragraph 3.1(a) of the Policy. This definition was removed from the Policy as it had created overly technical and complex requirements in terms of what rights qualify for protection. This change brings the Policy and the Rules more in line on this issue with the Uniform Domain Name Dispute Resolution Policy used for top-level domain names and trade-mark law in Canada. Based on the Complainant's use of the Complainant's trade-marks, which are identical to CITIZENS OF HUMANITY Mark, worldwide including in Canada since as early as May 2003, the Complainant has had rights in CITIZENS OF HUMANITY Mark within the meaning of Paragraph 3.1(a) of the Policy since at least May 2003 and accordingly prior to the date of registration of the Disputed Domain Name, June 17, 2011.

42. Based on the above, the Panel is satisfied that the Complainant had Rights in the CITIZENS OF HUMANITY Mark prior to the registration of the Disputed Domain Name and continues to have such Rights.

Was the Disputed Domain Name registered in bad faith?

43. Referring to Paragraph 3.5(a) of the Policy, the Complainant alleges that the Registrant registered the Disputed Domain Name or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the registration to the Complainant for consideration in excess of the Registrant's actual costs of registering the Disputed Domain Name or acquiring the registration.

44. Evidence shows that following confirmation from CIRA as to the contact information of the Registrant, the Complainant, on February 10, 2015, through its solicitor, notified the Registrant in writing by email and in hard copy that the Registrant's maintenance of the Disputed Domain Name constituted an infringement of the Complainant's rights in the CITIZENS OF HUMANITY Mark and demanded that the Registrant immediately relinquish ownership and control of the Disputed Domain Name. The hard copy of demand sent to the address confirmed by CIRA was returned undeliverable. The Registrant's response to the email stated the following: "6000 US\$ for prompt transfer"

45. Further to that response, Complainant's solicitor sent a further email on February 11, 2015 to the Registrant demanding that the Registrant relinquish ownership and control of the Disputed Domain Name. No further communication was received from the Registrant.

46. Evidence shows that the webpage of the Disputed Domain Name purports to link the user to various types and brand names of jeans, including "Citizens of Humanity" jeans and links listed on the website takes the user to a webpage of third party websites that sell the actual brand named jeans. At the top right section of the webpage the following statement appears "BUY THIS DOMAIN-The domain citizensofhumanity.ca may be for sale by its owner!" Clicking the box "BUY THIS DOMAIN..." takes the user to the sedo.com webpage. On that website, the user can submit a bid to purchase the domain name, citizensofhumanity.ca.

47. The Complainant submits that 6000.00 US\$ is far in excess of the actual costs incurred to register the Disputed Domain Name. In addition the Complainant submits that the Registrant is using its well-known trade-mark as a means to attract traffic to the Registrant's website where it is also offering to sell the domain name.

48. Based on the above, the Panel is satisfied that the Complainant has satisfied its burden of proof of bad faith by the Registrant in accordance with Paragraph 3.5(a) of the Policy.

Legitimate Interest of the Registrant

49. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on the Complainant to provide "some evidence" that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although "some evidence" is not defined, it imposes, in the Panel's view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide "some evidence" of a negative.

50. The Complainant asserts that the Registrant displays the CITIZENS OF HUMANITY Mark on its website without the permission of the Complainant, that the Registrant is not an authorized seller or distributor of Citizens of Humanity apparel.

51. The Complainant further demonstrates, that the Registrant has never sought to register the CITIZENS OF HUMANITY Mark with CIPO, nor has the Registrant made any application to do so, that the Disputed Domain Name is not the geographical name of the location of the Registrant's business as the Registrant's address according to the records is an address at Queen's University in Kingston and that the Registrant has never been commonly known by the Disputed Domain name. In fact, a Google search of the Registrant, Essi Molesky turns up only domain name references and a claim by another company, Vanguard Trademark Holdings USA, LLC against the same Registrant, Essi Molesky for registration of a domain name in violation of its trademark rights.

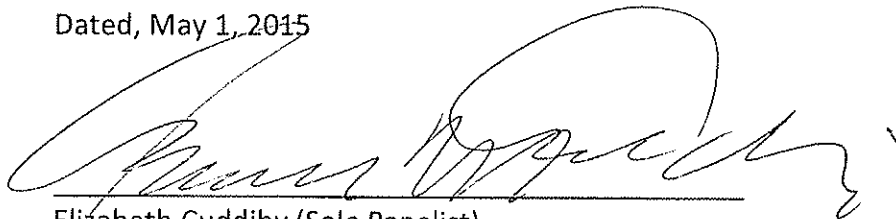
52. Based on all the evidence, the Panel is satisfied that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Disputed Domain Name as required by Paragraphs 3.4 and 4.1(c) of the Policy. The Registrant did not provide a Response to the Complaint and accordingly has not refuted such evidence.

53. Accordingly the Panel concludes that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision

54. For the reasons set out herein, the Panel decides in favour of the Complainant and orders the transfer of the Disputed Domain Name to the Complainant forthwith.

Dated, May 1, 2015



Elizabeth Cuddihy (Sole Panelist)