

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

Domain Name: jellybellys.ca
Complainant: Jelly Belly Candy Company
Registrant: Jack Green
Registrar: Go Daddy Domains Canada, Inc.
Panel: Sharon Groom
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. Jelly Belly Candy Company (the “**Complainant**”), is a company located in the United States.
2. The registrant for the domain name is Jack Green (the “**Registrant**”) who is located in Ontario, Canada.

B. The Domain Name and Registrar

3. The disputed domain name is jellybellys.ca (the “**Domain Name**”). The registrar for this domain name is Go Daddy Domains Canada, Inc. (the “**Registrar**”). The disputed Domain Name was registered on June 26, 2015 by the Registrant.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“**CIRA**”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “**Policy**”) and the *CIRA Domain Name Dispute Resolution Rules* (Version 1.5) (the “**Rules**”).
5. The history of the proceeding as provided by the dispute resolution service provider, Resolution Canada, Inc. (“**Resolution Canada**”), is that the Complainant filed a complaint on

June 12, 2020 against the Registrant with Resolution Canada requesting that the current registration of the Domain Name be transferred to the Complainant.

6. Resolution Canada served notice of the complaint on the Registrant Jack Green as required by paragraph 4.3 of the Rules. Service of the complaint was made by email on June 17, 2020.

7. The Registrant was given 20 days to file a response and no response was forthcoming. The panel was appointed on July 15, 2020.

D. Panel Impartiality and Independence

8. As required by paragraph 7 of the Rules, the panel has submitted to Resolution Canada a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

9. The Complainant is a company located in the United States. However it is the registered owner of various registrations for trademarks consisting of the words JELLY BELLY in Canada, including registration no. TMA275084 for the mark JELLY BELLY which was registered on December 17, 1982 for use in association with candy. The Domain Name includes the exact word component of this mark, therefore, the Complainant satisfies the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

10. The Complainant is a manufacturer and distributor of candy, including the JELLY BELLY jelly beans. The Complainant has fifty active trademark applications and registrations in Canada for marks incorporating the words JELLY BELLY.

11. According to CIRA's records, the Registrant of the Domain Name is Jack Green, and the company 416 Candies Inc. is also listed in the ownership information. The email address provided for the Registrant ends in suckerscandyco.com. According to the Complainant, the Registrant operates a candy company offering various candy, including candy bearing the JELLY BELLY trademarks, for sale at www.suckerscandyco.com. At the time of the complaint, the Registrant used the domain name jellybellys.ca to resolve to its website at www.suckerscandyco.com.

12. On March 31, 2020 a representative of the Complainant emailed the Registrant to request that he stop using the Domain Name. On April 9, 2020 the Registrant responded indicating that he had been in business since 1998 and had worked with a large spectrum of customers. He also said "Over the years we have accumulated some 400 .com and .ca! We have been offered as much as \$30,000 - \$50,000. For a couple and have rejected their offers! Today is a new day!". Counsel for the Complainant then sent a cease and desist letter on May 5, 2020 to the attention of Jack Green and did not receive a response within the two week period provided. This proceeding was then commenced.

G. CIRA Domain Name Dispute Resolution Policy

13. Paragraph 4.1 of the Policy requires that the Complainant establish 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 registered the domain name in bad faith as described in section 3.5; and

(c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

14. The Complainant must prove points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. 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 section 3.4 of the Policy.

H. Analysis

Rights to a Mark

15. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights (and continues to have rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name.

16. The Domain Name was registered on June 26, 2015, therefore this is the earliest possible relevant date for this analysis.

17. A "Mark" is defined in paragraph 3.2(c) of the Policy as:

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

18. The Complainant has submitted evidence of its registration of the trademark JELLY BELLY in forty-eight trademark registrations, and focused on three of these that were each registered well before the registration date of the Domain Name and were still active at the time of submitting the complaint. Therefore the panel finds that the Complainant has established that it had rights in the mark JELLY BELLY prior to the date of registration of the Domain Name, and continues to have these rights.

19. The Domain Name consists of the term JELLYBELLYS, which is the same as the Complainant's JELLY BELLY marks with only the addition of the letter S (to pluralize the words) which does not serve to distinguish the Domain Name from the marks. Therefore,

pursuant to paragraph 3.3 of the Policy, the panel finds that the Domain Name is confusingly similar to the mark JELLY BELLY as it so nearly resembles the mark in appearance, sound and in the idea suggested by the mark as to be likely to be mistaken for the mark.

Bad Faith

20. The Complainant also has to prove, on the balance of probabilities, that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds which constitute bad faith and it must be noted that these are not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.

21. The Complainant argues first that the Registrant's conduct constitutes bad faith pursuant to paragraph 3.5(b) of the Policy which states:

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.

22. In order to succeed on this ground the Complainant has to prove, on the balance of probabilities, 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. The sole evidence used by the Complainant to prove the pattern of registering domain names in order to prevent persons who have rights in marks from registering the marks as domain names, is the Registrant's own email which states "Over the years we have accumulated some 400.com and .ca!". However this does not prove that they were related to trademarks owned by others. They could be generic or coined words. Even the addition of the words in the Registrant's email "We have been offered as much as \$30,000 - \$50,000" does not indicate that they were related to third party trademarks as they could merely have been desirable domain names for other reasons. Therefore the panel does not find that the Complainant, on the balance of probabilities, has proved bad faith according to paragraph 3.5(b) of the Policy.

23. The Complainant also alleges that the Registrant has demonstrated bad faith pursuant to paragraph 3.5 (c) of the Policy which states:

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.

24. The Complainant states that the Registrant registered the Domain Name to disrupt the Complainant's business since the Domain Name redirects to the Registrant's own website, which offers competing candy products (as well as the Complainant's own products). It is reasonable to assume that potential customers searching for the Complainant's products online might well type

in a domain name using the term “jellybellys” instead of “jellybelly” and be redirected to the Registrant’s site, which could have the effect of disrupting the Complainant’s business. As the Registrant sells the Complainant’s products on its website, the Registrant must have been aware of the Complainant’s products and thus the registration of a domain name that incorporates the Complainant’s mark could not have been a coincidence. Also, the Registrant is a competitor of the Complainant as both distribute candy. Therefore the panel finds that the Complainant has proven, on the balance of probabilities, that the registration of the Domain Name was done in bad faith, as set out in paragraph 3.5(c).

25. The Complainant also argues that paragraph 3.5(d) of the Policy applies which states:

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.

26. The registration of a domain name so similar to the Complainant’s trademarks (the only difference being the addition of the letter S), when the Registrant has to be aware of the existence of the Complainant’s marks, since the Complainant’s products are being sold by the Registrant using that brand on the Registrant’s own website, leads to the inevitable conclusion that the registration of the Domain Name was a deliberate attempt to trade off the notoriety of the Complainant’s marks for commercial gain. Therefore the panel also finds that the Complainant has proven, on the balance of probabilities, that the registration of the Domain Name was done in bad faith pursuant to paragraph 3.5(d) of the Policy.

Legitimate Interest

27. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the domain name. Paragraph 3.4 lists six possible ways in which a Registrant may have a legitimate interest in a domain name which 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 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.

This list is not exhaustive as it is said to be "without limitation". Therefore neither party is bound by only those criteria.

28 The Complainant has established that it has rights in the mark JELLY BELLY, which is included in the Domain Name, and the Registrant has not shown that it owns any interest in this mark. Therefore there can be no legitimate interest under subsection (a). The term JELLY BELLYS has not been used in good faith by the Registrant in association with any wares, services or business and the term is not clearly descriptive as referred to in subsection (b), nor is it a generic term. So neither subsections (c) or (d) apply. There is no evidence that the Registrant has used the term in good faith for a non-commercial activity including, criticism, review or news reporting, so subsection (d) is not applicable. Finally, the Domain Name is not the name of the Registrant nor is it the name of a geographic place, therefore neither subsections (e) or (f) apply either.

29. The onus is on the Complainant to show "some evidence" that there is no legitimate interest. In this case, in addition to addressing each of the categories set out in paragraph 3.4, the Complainant has demonstrated that it owns trademark registrations for the mark JELLY BELLY which basically forms the totality of the Domain Name, and that the Registrant was aware of this trademark since it sold the Complainant's goods on its website. Also, the initial registration of the Complainant's JELLY BELLY trademark took place in 1982 which means that, on the balance of probabilities, the Registrant was likely aware of the mark when he registered the Domain Name in 2015. Thus the panel finds that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the Domain Name.

30. The Registrant has not rebutted the Complainant's evidence with any evidence of its own, therefore he has not proven, on the balance of probabilities, that he has a legitimate interest in the Domain Name.

I. Conclusion and Decision

31. In conclusion, the panel finds that the Complainant has rights in the mark JELLY BELLY which predate the registration of the Domain Name. The panel also finds that the Domain Name is confusingly similar to the Complainant's mark, that the Domain Name was registered in bad faith and that the Registrant has no legitimate interest in the Domain Name.

32. The panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name jellybellys.ca be transferred to the Complainant.

Dated: August 4, 2020

A handwritten signature in cursive script, appearing to read "Sharon Groom", is written over a solid horizontal line.

By: Sharon Groom (Sole Panellist)