

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

Domain Name: jockey.ca
Complainant: Jockey International, Inc.
Registrant: Ingenuity.Net Services Corp.
Registrar: Go Daddy Domains Canada, Inc.
Panellist: Sharon Groom
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, Jockey International, Inc. is a corporation located in the US.
2. The Registrant for the domain name is Ingenuity.Net Services Corp., at 1 Glengarry Way, Sydney, Australia.

B. The Domain Name and Registrar

3. The disputed domain name is jockey.ca. The Registrar for this domain name is Go Daddy Domains Canada, Inc. The disputed domain name was registered on February 26, 2003. The administrative contact for this domain name is listed as Web Master at 1 Glengarry Way, Sydney, NSW, 2000 Australia.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.1) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.2) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution provider, Resolution Canada, Inc., is that the Complainant filed a complaint against the Registrant with Resolution Canada, Inc. requesting that the current registration of the domain name jockey.ca be transferred to Jockey International, Inc. The Complaint was dated April 19, 2011.

6. Resolution Canada, Inc. served notice of the Complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the Complaint was made by e mail to webmaster@sandali.com on April 21, 2011 and also sent by courier on that day to the registered address of the Registrant which is c/o Stuart A. Moir, Lawyer, 1201-11871 Horseshoe Way, Richmond, B.C. V7A 5H5.

7. The Registrant was given twenty days to file a response but no response was filed.

8. The Complainant has elected to proceed before a panel consisting of only one panellist.

D. Panellist Impartiality and Independence

9. As required by paragraph 7 of the Rules, I have submitted to Resolution Canada, Inc. a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

10. The Complainant, Jockey International, Inc., is a US company. However it owns two Canadian trade-mark registrations for the mark JOCKEY, namely registration no. UCA 4651 and TMA 119,982, which mark is contained in the disputed domain name. As such it meets the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

11. The Complainant was founded in 1876 as a hosiery business and then expanded into underwear. It has been selling men's underwear since the 1930's in Canada, and in the 1960's and 1970's it expanded to include other clothing for men and boys and in the 1980's expanded to include clothing for women, including underwear.

12. The Complainant is the owner of various JOCKEY marks including the registrations for JOCKEY, registration no. UCA 4651 which was registered on May 1 1935 for men's underwear comprising shirts and shorts, and has been used since August 17, 1934, as well as the registration for JOCKEY, registration no. TMA 119,982, which was registered on October 10, 1960 for various clothing including ladies briefs and tops and nightwear, and has been used since October 26, 1960. The Complainant provided specimens of use of these marks in association with the registered wares, and also uses the marks in its website www.jockey.com, which received 6 million hits in 2010 from internet visitors.

13. The Complainant states that the domain name jockey.ca is used in association with a website which redirects customers to third party providers of sex toys, alternative dating websites, lingerie, sexual accessories and other adult products and services.

G. CIRA Domain Name Dispute Resolution Policy

14. Under paragraph 3.1 of the Policy it 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 3.7; and

(c) the Registrant has no legitimate interest in the domain name as described in section 3.6.

15. According to paragraph 4.1 of the Policy the Complainant must establish 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.

H. Analysis

Confusingly Similar

16. The Complainant has to show that it has rights in a mark (and continues to have these rights) that is confusingly similar to the domain name and that these rights pre-date the date of registration of the disputed domain name.

17. The date of registration of the domain name is February 26, 2003, therefore this is the relevant date for this analysis.

18. The Complainant states that it has used the mark JOCKEY in Canada to identify its wares since 1934 and indeed the initial trade-mark registration dates from 1935. The Complainant provides images of underwear and clothing bearing the JOCKEY mark, as well as packaging and hangtags. In addition the Complainant provided copies of pages from its website jockey.com showing the JOCKEY mark. It therefore appears that the Complainant uses this mark to distinguish its wares from those of others. This mark therefore satisfies the definition of a "mark" in subparagraph 3.2(a) of the Policy.

19. The Complainant has "rights" in this mark as it is the party that has used it in Canada (see subparagraph 3.3(a) of the Policy). These rights predate the date of registration of the disputed domain name as the mark was first used as of 1934, which is prior to the relevant date of February 26, 2003. This is supported by the fact that the Complainant registered JOCKEY as a trade-mark in Canada in 1935 based on use since 1934. The Complainant has also provided evidence showing that this mark is still in use.

20. The Complainant has thus established rights in the mark JOCKEY since prior to 2003, and has demonstrated that it continues to have these rights. The question then is whether this mark is confusingly similar to the domain name jockey.ca. The test for this is whether the domain name in question so nearly resembles the mark in appearance, sound or in the ideas suggested by it as to be likely to be mistaken for the mark. The test is whether, on the balance of probabilities, the domain name is "likely" to be mistaken for the mark.

21. In this case I find that the domain name is likely to be mistaken for the Complainant's mark as it consists of the entire registered mark JOCKEY without any alteration. Therefore, the Complainant has successfully met the criteria of paragraph 3.1(a).

Legitimate Interest

22. Paragraph 3.6 provides six possible ways in which a Registrant may have a legitimate interest in a domain name.

23. In 3.6(a), the Registrant may have a legitimate interest in a domain name if, before receiving the notice from the Complainant, the domain name was a Mark, used by the Registrant in good faith and the Registrant had Rights in the Mark. The only definition of Mark in the Policy that might have application in this situation is that the domain name is a trade-mark, used in Canada by a person for the purpose of distinguishing the wares, services or business of that person from those of another.

24. While the Registrant does not sell the various wares and services for which links are provided on its website, it does provide the service of consolidating these links into one site, for people that might be interested in such wares and services. Therefore I think that the Registrant is providing a service.

25. The next question is whether the domain name is being used as a Mark to distinguish the Registrant's services from those of others. The domain name JOCKEY.CA is shown at the top of the web page and the links to the various third party pages leading to third party sites selling wares and services are on the left hand side. The domain name is shown in regular, small type and is not next to the star logo which also appears on the page. The use of the domain name is so small and insignificant on the page that it could easily be overlooked. Therefore, it does not appear as though the domain name is being used as a trade-mark to distinguish the Registrant's services from those of others. Therefore it does not fit within the definition of a Mark found in the Policy.

26. However, even if it was being used as a trade-mark and thus satisfied the definition of a Mark, I do not think that the Registrant could be said to be using the mark in good faith. The JOCKEY trade-mark has been used by the Complainant and registered on the publicly available Trade-marks register for such a long time in association with underwear and other garments, and as a result has gained such goodwill and recognition, that someone commencing a site advertising, among other things, underwear, must have been aware of the Complainant's mark. Therefore, it cannot be a coincidence that the word JOCKEY was chosen for this site as it bears no natural connection with any of the wares and services advertised on the site except through its association with the Complainant's wares, namely underwear. I therefore find that any use that might have been made by the Registrant of the domain name jockey.ca as a mark, would not have been in good faith. Thus the requirements of paragraph 3.6(a) have not been met.

27. Also, even if I had found that the domain name was being used as a Mark, the domain name is not clearly descriptive of the character or quality of the wares or services in association with which it is being used, the conditions of, or the persons employed in, the production of the wares or services, or the place of origin of the wares or services. Nor is it the generic name of the wares

or services in any language. Therefore this Registrant's use does not fall under paragraphs 3.6(b) or (c). Nor was the Registrant using the domain name in good faith in association with criticism, review or news reporting (paragraph 3.6(d)). Finally, the domain name is not the legal name or other identifier of the Registrant (3.6(e)), nor is it the geographical name of the location of the Registrant's non-commercial place of business (3.6(f)). Therefore, none of the criteria in paragraph 3.6 have been satisfied and I find that the Complainant has provided some evidence that the Registrant had no legitimate interest in the domain name.

Bad Faith

28. The Complainant has to show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.7 deals with the grounds which constitute bad faith.

29. With regard to paragraph 3.7(a), this is met if the Complainant can show that the domain name was registered primarily for the purpose of (amongst other things) selling it back to the Complainant. The Complainant argues that the mere registration and use of this domain name in association with such inflammatory wares and services is a method of inducing the Complainant to purchase the domain name, as the Complainant is likely to want to stop its mark from being used in association with such wares and services. The Complainant argues that one should not require a direct offer to sell the domain name as a necessary element of this ground of bad faith conduct, and that it is possible to conclude that the Registrant's primary purpose was to initiate the sale of this domain name based on the Registrant's other actions.

30. I think that the Complainant makes a very good case for the premise that there may be circumstances where the Registrant's actions demonstrate that the domain name was registered primarily for the purpose of selling it back to the Complainant, without the necessity of showing an actual offer to sell. However, in this situation I think that the fact that the Registrant has owned the domain name for 8 years, and presumably has been using it for most of them, contradicts the Complainant's submission since the Registrant would presumably have tired of waiting for the Complainant to make an offer by now. Therefore there must be some other incentive keeping the Registrant using this domain name and this seems to go against the presumption that the Complainant is asking me to draw. I therefore find that the Complainant has not shown that there is bad faith due to paragraph 3.7(a), on the balance of probabilities.

31. With regard to paragraph 3.7(b), the registration of this domain name has prevented the Complainant from registering its mark as a .ca domain name. Also, the Complainant has demonstrated that the Registrant also owns a number of other domain names related to well known trade-marks, such as aeoplan.ca, airecanada.ca, timhortens.ca and warlmart.ca. Therefore I find that the evidence indicates that the Registrant has engaged in a pattern of registering domain names to prevent rightful owners of marks from registering them as domain names.

32. I therefore find that the Complainant has demonstrated, on the balance of probabilities, that the Registrant has registered this domain name in bad faith to prevent the Complainant from registering its marks as a domain name, and that the Registrant has engaged in a pattern of registering domain names for this purpose. I therefore do not need to consider paragraph 3.7(c).

I. Conclusion and Decision

33. In conclusion, I find that the Complainant does have rights in the mark JOCKEY which predates the registration of the domain name. I also find that the domain name is confusingly similar to the Complainant's mark and that the Registrant had no legitimate interest in the domain name. Finally, I find that the Complainant has shown that the Registrant registered the domain name in bad faith.

34. I therefore order, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name jockey.ca be transferred to the Complainant, Jockey International, Inc.

Dated June 13, 2011.

Sharon Groom

A handwritten signature in black ink, appearing to read "Sharon Groom", written over a horizontal line.

Sharon Groom
June 13, 2011