

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DECISION

Domain Name: tous.ca

Complainant: S. Tous, S.L.

Registrant: Gnanavannan Ratnasabapathi

Registrar: CA Registry

Service Provider: British Columbia International Commercial Arbitration Centre

Sole Panelist: Eric Macramalla

A. THE PARTIES

1. The Complainant is S. Tous, S.L. (the “Complainant”).
2. The Registrant is Gnanavannan Ratnasabapathi (the “Registrant”).

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is tous.ca (the “Domain Name”) and the Registrar is CA Registry.

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on June 12, 2015. The Date of Commencement of the proceeding was June 17, 2015.
6. The Registrant did not file a response.
7. On July 14, 2015, the Panel was appointed following the Complainant converting the Panel to a single member. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.
8. The identity of the Registrant was concealed by CIRA, which conceals the identity of domain name owners by default who are individuals. By way of correspondence dated June 16, 2015, CIRA revealed the identity of the Registrant as being as follows:

Name: Gnanavannan Ratnasabapathi

Email: gnanavannan@gmail.com

Phone: +1.6474394227

Street: 5631 Steels Avenue, Unit 3, Box- 137
City: Scarborough
Province/State: Ontario
Postal code/Zip code: M1V5P6

9. The Panel invited the Complainant to file Supplemental Submissions in keeping with Paragraph 11 of the Rules, which provides that a complainant may file additional submissions after learning the identity of the Registrant.
10. Following the Panel's invitation, the Complainant responded as follows:

In order to provide our comments in relation to the Registrant, it would be important to find out if he owns other ".ca" domain names with CIRA.

The ownership of several domains consisting of or containing well-known marks could be a clear indication of bad faith. As you know, CIRA does not allow to do searches by owner. However, we are aware that under special circumstances (like a CDRP process like the present one) CIRA is allowed to release this type of information. Consequently, we request to be informed of the ".ca" domains owned by the Registrant prior to the August 26, 2015 deadline mentioned in your below email.

11. The Panel advised the Complainant that it may request a registrant's domain name portfolio from CIRA.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

12. The Complainant is the owner of the Canadian trade-mark registration TOUS, Registration No. TMA656246. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

E. THE POSITIONS OF THE PARTIES

The Complainant's Position

13. The Complainant has argued as follows:
14. The Complainant is a company incorporated in Spain in 1973 and has owned the TOUS trademark since 1920. It holds a significant worldwide trademark portfolio. For most, if not all, of its over 90 years of history, the Complainant and/or its predecessors-in-title have traded in the marketplace under the name TOUS in Spain, and for the last 30 years internationally.
15. The Complainant, either directly or through its various subsidiaries and affiliated companies, designs, manufactures, and sells jewelry, apparel, and accessories for men, women, and kids. It offers diamond, gold, silver, stainless steel, and bridal jewelry, as well as watches, sunglasses, handbags, and fragrances. The company also provides baby, home, desk, and beauty products and sells its wares through its retail shops operated worldwide (in over 45 countries) as well as through its website www.tous.com.

16. The Complainant has experienced significant growth since its international expansion began in the middle of the 1990s. By 1994, The Complainant had over 50 shops in Spain and was a household name there. So the company opened its first international shop in Tokyo, Japan. Due to the great success of the experience overseas, countries like Germany, the United States and Mexico followed. By January 2003, the company was selling its products in 22 countries, including Venezuela, Puerto Rico, Dominican Republic, Guatemala, Portugal and Andorra. Its revenue for the prior year, 2002, was around 60 million Euros. In 2004, Tous reached the 200 point-of-sale mark and opened stores in iconic cities such as New York and Paris.
17. By the time the Registrant registered the domain name on January 1, 2006, the Complainant was established as a global player and a household name in the international fashion industry.
18. With presence in 45 countries and more than 400 shops worldwide (including in cities like Montreal, New York, México, Paris, Moscow, Auckland, Hong Kong or Tokyo), the Complainant has become a global player in the fashion industry and has become a truly international brand.
19. The Complainant not only registered the TOUS trademark prior to the registration of the disputed domain name but also started selling its product in Canada prior to the domain name registration date.
20. The Complainant has provided sample promotional materials from 2005 and 2006 used in Canada and featuring the TOUS trademark.
21. The Complainant opened its first store in Canada in 2005.
22. In sum, the Complainant has been active in the Canadian market long before the disputed domain was registered by the Registrant.
23. The Registrant has resolved the Domain Name to a pay-per-click website featuring sponsored links to competitors of the Complainant.
24. A complaint under the Policy was successfully filed against the Registrant regarding the domain name myshaw.ca. The panel in that case also found that the Registrant had engaged in a pattern of abusive domain name registrations.
25. The Domain Name is confusingly similar with the TOUS Trademark. The Registrant does not have a legitimate interest in the Domain Name as it is not licensed, or otherwise authorized, to use the TOUS Trademark. The Registrant registered the Domain Name in bad faith, alleging all bad faith factors under the Policy.
26. The Complainant is the owner of numerous trademark registrations that issued to registration well before tous.ca was registered.
27. The Complainant is seeking the transfer of the Domain Name.
28. As previously noted, the Registrant did not file a response.

F. DISCUSSION & REASONS

29. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:
- (a) the Registrant's 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 of the Policy; 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 of the Policy.

CONFUSINGLY SIMILAR - PARAGRAPH 3.3

30. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

Rights in the Marks & Rights that Predate the Domain Name Registration Dates

31. Where the Complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use. In cases where a trade-mark registration matured to registration after the domain name registration date, or the Complainant is relying on common law rights, it must establish rights that predate the domain name registration.
32. The Complainant's Registration No. TMA 593,364 issued to registration on January 10, 2006, which is after the Domain Name registration date of January 5, 2006. For this reason, the Panel is somewhat puzzled by the Complainant's claim that its trademark registration easily predates the registration date of the Domain Name, when in fact that is not the case. Further, the Complainant points to the 2003 Canadian application date for TOUS as evidence of an earlier registration date. This is simply an incorrect interpretation as the application date is not the material date; rather it is the registration date.
33. The Complainant has also directed the Panel's attention to trademark registrations in other jurisdictions that issued to registration before the Domain Name was registered. Foreign trademark registrations, however, are an irrelevant consideration under the Policy, with the focus being exclusively on Canadian trademark rights. While perhaps the wisdom of such a narrow interpretation of trademark rights may be questioned given the global nature of domain names, the Policy does not consider foreign cases.
34. That being said, the Complainant has established prior trademark rights.

Confusingly Similar

35. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
36. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
37. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant’s corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant’s marks based upon the appearance, sound or the ideas suggested by the mark.
38. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-mark Act*, when assessing the likelihood of confusion between marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.
39. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy’s summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.
40. The domain name tous.ca is identical to the TOUS Trademark. Accordingly, there can be no question that for the purpose of the Policy, the Domain Name is confusingly similar with the TOUS Trademark.
41. Under the circumstances, the Panel concludes that the Domain Name is confusingly similar with the Complainant’s TOUS Trademark given that the Domain Name so nearly resembles the TOUS Trademark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for the mark.

Conclusion - Confusion

42. The Panel finds that the Domain Name is confusingly similar with the TOUS Trademark in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

BAD FAITH REGISTRATION

43. The Complainant has alleged all bad faith factors under the Policy. With respect to Paragraph 3.5(a), (b) and (c), the Complainant has provided no evidence of these claims. Specifically, there is no evidence that the domain name is being sold for a profit, that the Registrant has engaged in a pattern of unauthorized domain name registrations and that the Registrant is a competitor offering goods or services that rival those offered by the Complainant.
44. After being provided with the name of the Registrant, the Complainant noted in its Supplemental Submissions that the domain name portfolio of the Registrant was “not available”. Unfortunately, this is in fact not correct. CIRA will provide a party with a registrant’s domain name portfolio should the request be made in contemplation of filing a Complaint under the Policy. Further, a prospective complainant does not need the name of the Registrant as CIRA will still provide all domain names in a particular portfolio even if the identity of the Registrant is concealed. Accordingly, the Complainant was in a position to request the portfolio prior to filing its Complaint, as well as after being invited to file Supplemental Submissions.
45. The Complainant has relied on the Registrant’s registration of myshaw.ca, which was ordered transferred away from the Registrant during CDRP Proceedings. The panel in that case also concluded that the Registrant had engaged in a pattern of abusive registrations. While the Panel finds this interesting, it does not establish a pattern of abusive domain name registrations. The Panel would have been interested in reviewing the Registrant’s entire portfolio.
46. In any event, whether a pattern could be established or not, it will not alter the Panel’s ultimate decision.
47. The Complainant has also alleged that resolving the Domain Name to a pay-per-click website featuring sponsored links to competitors of the Complainant constitutes bad faith as per Paragraph 3.5(d). This section provides that bad faith will be found where the Registrant has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s marks as to the source or sponsorship.
48. Indeed, it is a well-established principle that pointing a domain name containing a third party trademark to a pay-per-click website may give rise to a finding of bad faith. These websites put a registrant in a position to reap a financial benefit by way of referral fees.
49. In this instance, however, the Panel cannot make a finding of bad faith. Canada is a bilingual country, with its two official languages being English and French. Both official languages of Canada have equality of status under the law.
50. While it is certainly the case that pointing a third party trademark to a pay-per-click website featuring competitor links can constitute bad faith, that principle is not absolute and has its limits. The word “tous” is a very commonly used French word that translated into English means “all”. Even in the face of corresponding trademark rights and a sponsored link site, the Panel is not prepared to allow a

single party to claim exclusive or even superior rights over such a commonly used term as “tous”. This is even the case if a registrant has engaged in unauthorized domain name registrations in the past, which may be the case here. Having a history as a cybersquatter does not instantly mean that all domain name registrations in a portfolio were performed in bad faith. The Panel has difficulty envisioning a scenario where it would order the transfer of all.ca and this case is no different.

51. The Panel’s views may differ if the trademark was inherently more distinctive or had acquired a significant level of distinctiveness by way of extensive use in Canada. However, in this instance, the trademark had only been used in Canada for a short period of time at the time of the domain name registration date.
52. Given the Panel’s conclusion that bad faith has not been established, it will not consider the issue of legitimate interest.

Decision

53. For the reasons set out herein, the Panel decides this dispute in favour of the Registrant.
54. For these reasons the Complaint regarding the domain name tous.ca is dismissed.

Dated at Ottawa, Ontario, Canada, this 24th day of September, 2015.



Eric Macramalla
Sole Panelist