

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

Domain Name: HALLOWEENCITY.CA

Complainant: Amscan Holdings, Inc.
Registrant: Diane Hamilton
Registrar: Go Daddy Domains Canada Inc.

Panel: David Lametti (sole panelist)

Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is Amscan Holdings, Inc., a company registered in the State of Delaware, and whose registered head office address is 80 Grasslands Road, Elmsford, New York, 10523, USA. Their authorized representative is Eryn Y. Troung, Esq., Campolo, Middleton & McCormick, LLP, 4175 Veterans Memorial Highway, Suite 400, Ronkonkoma (Bohemia), New York, 11779, USA.

2. The Registrant is Diane Hamilton, whose contact address is 1206 Mona Road, Mississauga, Ontario, L5G 2Z7. The Registrant's agent in dealings with the Complainant was Shawn Hamilton, whose address is listed as 923 Oxford Street, Toronto, Ontario, M8Z 5T3.

B. The Domain Name and Registrar

3. The domain name at issue is HALLOWEENCITY.CA.
4. The domain name is registered with Go Daddy Canada Inc.

C. Procedural History

5. On 13 November 2013, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, ResolutionCanada. The Complainant elected to have the matter heard by a single-member panel. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* (version 1.4) ["Rules"].

6. No response was received from the Registrant.

7. The Provider therefore moved to have the Complaint treated as uncontested, and appointed a panelist, all as governed by the Rules.

D. Panel Member Impartiality and Independence Statement

8. As required by paragraph 7 of the Rules, the panelist has declared to the Provider that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

E. Canadian Presence Requirement

9. Amscan's trademarks HALLOWEEN CITY, incorporating both the words "Halloween City" and a related design and logo, are registered in Canada and thus satisfy the Canadian Presence Requirement as stated in paragraph 1.4 of the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) ["Policy"].

F. Factual Background

10. Amscan sells party supplies in Canada and the United States. It had been using the unregistered HALLOWEEN CITY mark in Canada since at least 1977. The trademark has been associated with the sale of Halloween party supplies including costumes, party and decorations, balloons, cups, plates, party favours and other related party paraphernalia. Amscan has a number of stores in Canada, and uses the domain names and websites HALLOWEENCITY.COM and HALLOWEENCITYCANADA.COM.

11. The Registrant registered the domain name at issue on 12 July 2011.

12. The Registrant, through Shawn Hamilton, initially offered the domain name, as well as two other domain names linked to its major competitors, to the Complainant on 16 March 2013. On 14 June 2013, Shawn Hamilton asked for \$30,000 US as its "final" price for the three names.

13. The Complainant registered the trademark HALLOWEEN CITY with CIPO on 31 October 2013.

14. The Complainant filed this Complaint on 13 November 2013.

G. CIRA Domain Name Dispute Resolution Policy Requirements

15. The *CIRA Domain Name Dispute Resolution Policy* (version 1.3) ["Policy"] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint:

To succeed in the 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 . . .

16. The Panel will deal with each criterion in turn.

H. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?

17. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a "mark" for the purposes of the Policy:

A "Mark" is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

18. The Complainant must establish trademark rights that precede the date of the domain name registration by the Registrant. The Complainant has so established. Its common law trademark rights, based on use of the mark in Canada from 1977 onwards, were put into evidence and not contested.

19. Paragraph 3.3 of the Policy defines "confusingly similar" in the following terms:

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.

20. In this case the domain name is effectively identical to the trademark, its two component words being the same as the two words of the trademark, and thus “confusingly similar” is easily established.

21. Thus the Panel finds that Registrant’s domain name HALLOWEENCITY.CA is confusingly similar with the Complainant’s unregistered HALLOWEEN CITY mark in which the Complainant had rights prior to the registration of the substantially similar domain name.

I. Was the Registration of the Domain Name Made in Bad Faith?

22. In order to succeed in the second stage of the test set out in paragraph 4.1, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.5 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith, generally if one of the following four conditions is met:

For the purposes of paragraphs 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.

23. Paragraph 3.5(a) is most directly relevant to this dispute. The Registrant offered the domain name, along with two other domain names closely resembling trademarks used by the Complainant's competitors, to the Complainant for a price – \$30,000 US – well in excess of the costs of such registration. Such a practice has long been considered a clear indicium of bad faith under the Policy.

24. It is also the case, on these facts, that the Registrant violated paragraph 3.5(b) of the Policy, as it has registered three domains – that of the Complainant and those of two of its competitors – that appear to prevent legitimate right holders from registering domain names based on their prior rights. That there are three names so registered is sufficient evidence of a pattern, as well as a strategy in which each right holder is played off against the other.

25. Therefore this Panel concludes that the Registrant acquired the domain name HALLOWEENCITY.CA in bad faith as defined under both paragraphs 3.5(a) and 3.5(b) of the Policy.

J. Does the Registrant Have a “Legitimate Interest” in the Domain Name?

26. The third element of the test set out in paragraph 4.1 of the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. This inquiry tries to find some more or less objective or ascertainable link between the Registrant and the domain name in question, aside from mere registration, and which link is legitimate. Paragraph 3.4 of the Policy states:

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 evidence presented, shall demonstrate that the Registrant has a legitimate interest in a 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.

27. The first four criteria contain an element of good faith in assessing the behaviour of the Registrant, while the last two point to more objective facts linking the domain name to the Registrant.

28. In terms of the procedure required under the Policy, the Complainant must provide some evidence that none of these or similar interests can reasonably apply to the Registrant. The burden then shifts to the Registrant to show that it has, on the balance of probabilities, either any one of these legitimate interests as defined under these subparagraphs, or any other potential legitimate interests not so listed.

29. The Complainant has introduced sufficient evidence of the Registrant having no legitimate interest as exemplified under any of the enumerated heads. The Complainant has not been able to identify any manner in which the Registrant might have a legitimate interest in the domain name. In particular:

- no use was being made of the domain name, and hence was not being used as bona fide offering of either commercial or non-commercial services or activity; and
- the domain name was not the name or surname of the Registrant, or otherwise associated with the Registrant, and was not linked geographically to any place of business.

30. The Complainant having thus satisfied its initial burden of showing "some evidence" of "no legitimate interest" puts the onus on the Registrant to show a legitimate interest.

31. The Registrant has not responded, and thus fails to meet its burden of showing any legitimate interest in the domain name.

32. The Panel therefore concludes that the Registrant did not have a legitimate interest in the domain name HALLOWEENCITY.CA under paragraph 3.4 of the Policy.

K. Conclusion and Decision

33. The Complainant has established that the Registrant's domain name HALLOWEENCITY.CA is confusingly similar to the Complainant's unregistered HALLOWEEN CITY trademark that had been established by use in Canada.

34. The Complainant has established that the Registrant had registered the domain name HALLOWEENCITY.CA in bad faith, as defined in the Policy.

35. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name HALLOWEENCITY.CA. The Registrant has not established, as required by the Policy, that it does have any legitimate interest.

36. For these reasons, the Complaint regarding the domain name HALLOWEENCITY.CA is successful.

37. The Complainant's representative is to be commended for concision and for efficiently and effectively framing submissions according to the requirements of the CIRA Policy.

L. Remedy

38. The Complainant has asked that the domain name at issue be transferred to it. The Panel hereby so orders.



David Lametti
Sole Panelist

December 23, 2013