

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

Complainant: M.F.H. Fejlesztő Korlátolt Felelősségű Társaság of Budapest, Hungary

Complainant Counsel: Alexander Monic & Donna G. White of Osler, Hoskin & Harcourt LLP, Suite 1900, 340 Albert Street, Ottawa, Ontario, K1R 7Y6

Registrant: Viviana Rossi of 2294 Nelson Road, Bala, Ontario, P0C 1A0

Disputed Domain Name: intimissimi.ca

Panelist: Paul W. Donovan

Service Provider: Resolution Canada Inc.

DECISION

The Parties

1. The Complainant is M.F.H. Fejlesztő Korlátolt Felelősségű Társaság of Budapest, Hungary.
2. The Complainant is represented by Alexander Monic & Donna G. White of Osler, Hoskin & Harcourt LLP, Suite 1900, 340 Albert Street, Ottawa, Ontario, K1R 7Y6.
3. The Registrant is Viviana Rossi of 2294 Nelson Road, Bala, Ontario, P0C 1A0.

The Domain Name and Registrar

4. The disputed domain name is intimissimi.ca.
5. The Registrar with which the disputed domain name is registered is Hexonet Services Inc. of #104 – 7455 132nd Street, Surrey, British Columbia, V3W 1J8.

Procedural History and Rules

6. The Complainant commenced this 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 1.4) (“the Rules”) by a complaint dated January 9, 2014.

7. The service provider Resolution Canada Inc. determined that the complaint was in administrative compliance with the Policy and the Rules and forwarded a copy of the complaint to the Registrant on January 10, 2014.
8. The Registrant did not file any reply to the complaint, and the Panel was appointed on February 13, 2014.
9. The Panel finds that it was properly constituted pursuant to the Policy and the Rules, and that all of the requirements under the Policy and the Rules for the commencement and maintenance of this proceeding have been met.

Canadian Presence Requirements

10. The Panel finds that the Complainant is an Eligible Complainant (see paragraph 1.4 of the Policy) and has met the Canadian Presence Requirements by virtue of the fact that the Complainant is the owner of the trade-mark INTIMISSIMI (TMA573,828) and the trade-mark INTIMISSIMI Design (TMA853,798).

The Complaint

11. Pursuant to paragraph 4.1 of the Policy, to succeed in this proceeding the Complainant must prove, on a balance of probabilities, that:
 - (i) 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
 - (ii) the Registrant has registered the domain name in bad faith as described in paragraph 3.5 of the Policy.
12. The Complainant must also provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4 of the Policy. Even if the Complainant proves the first two elements of the test as set out in paragraph 11, above, and provides some evidence that the Registrant has no legitimate interest in the domain name, 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.

Is the Registrant's dot-ca domain name Confusingly Similar to a Mark in which the Complainant had rights prior to the date of registration of the disputed domain name and continues to have such rights?

13. The disputed domain name was registered on February 27, 2013.

14. The terms “Confusingly Similar” and “Mark” are both specifically defined in the Policy.
15. The Complainant has asserted rights in the trade-mark INTIMISSIMI and the trade-mark INTIMISSIMI Design based on paragraph 3.2(c) of the Policy which states that a Mark is: “a trade-mark, including the word elements of a design mark, that is registered in CIPO”.
16. The Panel finds that the Complainant has rights in the trade-mark INTIMISSIMI and notes that the trade-mark proceeded to registration in Canada on January 16, 2003, over ten years before the Registrant registered the disputed domain name. The registration is still in good standing with the Canadian Intellectual Property Office. The Panel finds it unnecessary to consider the Complainant’s alleged rights in the INTIMISSIMI Design trade-mark, in light of its findings regarding the Complainant’s rights in the INTIMISSIMI trade-mark.
17. A disputed domain name will be held to be 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 to be mistaken for the Mark.
18. In the Panel’s view, the disputed domain name is Confusingly Similar to the Complainant’s trade-mark INTIMISSIMI. In fact, it is identical.
19. The Panel is of the view that the Complainant has met its burden in establishing that the disputed domain name is Confusingly Similar to a Mark in which the Complainant had rights prior to the date of registration of the disputed domain name and continues to have such rights.

Did the Registrant register the domain name in bad faith?

20. Under paragraph 3.5 of the Policy, 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:
 - (i) 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 of registering the domain name, or acquiring the Registration;
 - (ii) 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;

- (iii) 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
- (iv) 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.

21. The Complainant has alleged bad faith with respect to each of the subparagraphs above. Each of these subparagraphs will be analyzed in turn.

Paragraph 3.5(a) Bad Faith

22. As noted above, paragraph 3.5(a) of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if 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 of registering the domain name, or acquiring the Registration.
23. The Complainant has provided evidence which demonstrates that the Registrant offered to sell the disputed domain name for \$7,500.00, an amount clearly in excess of the Registrant's actual costs of registering or acquiring the disputed domain name. In the absence of any reply from the Registrant, the Panel is of the view that it can infer that the Registrant registered the disputed domain name primarily for the purpose of selling it to the Complainant for an amount in excess of its actual costs.
24. The Panel finds that the Complainant has successfully established the bad faith of the Registrant under paragraph 3.5(a).

Paragraph 3.5(b) Bad Faith

25. As noted above, paragraph 3.5(b) of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if 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.

26. The evidence filed by the Complainant shows that the Registrant has registered many other domain names that consist of recognizable trade-marks that are registered in Canada, including EMPORIOARMANIWATCHES.CA, PHILIPMORRIS.CA, and WILLIAMHILL.CA.
27. The Panel finds that the Registrant has registered the domain name in bad faith as per paragraph 3.5(b) of the Policy. The Panel finds that the Complainant has supplied it with enough evidence that it finds on a balance of probabilities that the Registrant registered the domain name in order to prevent the Complainant from registering the Mark as a domain name. The Panel also finds on a balance of probabilities that the Registrant has engaged in a pattern of registering domain names in order to prevent persons who have rights in such marks from registering the marks as domain names. In the absence of any reply from the Registrant, the Panel is of the view that it can infer that the Registrant registered these other domain names for such a nefarious purpose.
28. The Panel finds that the Complainant has successfully established the bad faith of the Registrant under paragraph 3.5(b).

Paragraph 3.5(c) Bad Faith

29. The Complainant has also raised an allegation of bad faith pursuant to paragraph 3.5(c) of the Policy. As noted above, paragraph 3.5(c) of the Policy states that bad faith will be found where 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.
30. The Panel finds that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant. As noted by the Complainant, the disputed domain name resolves to a website which contains links to other companies that offer products similar to what the Complainant offers. We thank Complainant's counsel for finding it unnecessary to print out the websites associated with links to, for example, "Big Men Underwear" and "Lingerie for Men", since other excerpts from the website to resolve from the disputed domain name made it clear that competing products were in fact for sale at these sites (for example: "\$18 Corset Blow-out Sale www.corsetchick.com"). In our view, all of the above, when viewed in their

totality and in the absence of any reply from the Registrant, suggests that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant.

31. However, the Panel notes that for paragraph 3.5(c) of the Policy also requires that the Complainant be a “competitor” of the Registrant. The term “competitor” is not defined in the Policy or the Rules, but the Panel is of the view that where a Registrant uses its website to redirect users to competitors of the Complainant, such use supports a finding that the Registrant is a competitor of the Complainant.
32. The Panel finds that the Complainant has successfully established the bad faith of the Registrant under paragraph 3.5(c).

Paragraph 3.5(d) Bad Faith

33. The Complainant has also raised an allegation of bad faith pursuant to paragraph 3.5(d) of the Policy. As noted above, paragraph 3.5(d) of the Policy states that bad faith will be found where the Registrant 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.
34. As noted above, the disputed domain name resolves to a website which contains links to other companies that offer products similar to what the Complainant offers. The Complainant has introduced evidence to show referral fees are generated by the Registrant if the visitor to the site uses the links. In the absence of any reply from the Registrant, the Panel is of the view that it is able to infer that the Registrant has intentionally attempted to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant’s INTIMISSIMI trade-mark.
35. The Panel finds that the Complainant has successfully established the bad faith of the Registrant under paragraph 3.5(d).

Does the Registrant have a legitimate interest in the disputed domain name?

36. Paragraph 3.4 of the Policy provides a non-exhaustive list of various criteria that a panel is to consider in assessing legitimate interest. The Policy requires that the Complainant must provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. If the Complainant meets this burden, the Registrant will still succeed in the proceeding if it proves on a balance of probabilities that it has a legitimate interest in the disputed domain name.

37. Based on a review of the evidence and submissions, the Panel is of the view that the Complainant has met its initial burden of providing *some* evidence that the Registrant has no legitimate interest in the disputed domain name as described in paragraph 3.4. In particular, the Complainant has provided some evidence that the disputed domain name was not a Mark that the Registrant used in good faith and that the Registrant had rights in the Mark. The Complainant has also met its burden in showing that the disputed domain name is not a clearly descriptive or generic name associated with the wares or services offered on the website, and that the Registrant did not use the disputed domain name in good faith in association with a non-commercial activity. Finally, the Complainant has met its burden in showing that the disputed domain name is not the legal name of the Registrant or some other name by which it was commonly identified, nor was the disputed domain name the geographic name or the location of the Registrant's non-commercial activity or business.
38. As a result, the Panel finds that the Complainant has met its burden of showing *some* evidence that the Registrant had no legitimate interest in the disputed domain name under this subparagraph. The Panel is of the opinion that this finding is sufficient for the Complainant to meet its burden pursuant to paragraph 4.1(c) of the Policy.

Burden shifts to Registrant to prove Legitimate Interest on a balance of probabilities

39. Since the Complainant has met its burden pursuant to paragraph 4.1(c) of the Policy, the Registrant can only succeed in this proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name. Since the Registrant has not filed a reply to the complaint, the Panel is of the opinion that it is unable to find, on a balance of probabilities, that the Registrant has a legitimate interest in the disputed domain name pursuant to paragraph 3.4 of the Policy.

Summary of Findings

40. The Panel has found that the Complainant has proven, on a balance of probabilities, that the disputed 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 that the Registrant has registered the disputed domain name in bad faith as such term is described in paragraph 3.5 of the Policy. Further, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the disputed domain name, as that term is defined in paragraph 3.4 of the Policy, and that the Registrant has failed to meet its burden of proving, on a balance of probabilities, that it has a legitimate interest in the disputed domain name.

41. As a result of the above findings, the Panel orders that the disputed domain name intimissimi.ca be transferred from the Registrant to the Complainant.

DATE: March 5, 2014

A handwritten signature in black ink, appearing to read "Paul W. Donovan", written over a horizontal line.

Paul W. Donovan
B.A., M.A., LL.B.
Barrister & Solicitor
Trade-mark Agent