

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

Domain Name: MARSHALLMATTRESS.CA

Complainant: Marshall Ventilated Mattress Company Limited

Registrant: Dace Baxter

Registrar: (10dollar.ca) 10 Dollar Domain Names Inc.

Panelist: David Allsebrook

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant is a mattress manufacturing company named Marshall Ventilated Mattress Company Limited. The Complainant is an Ontario Corporation having its principal place of business in Toronto, Ontario.
2. The Registrant is Dace Baxter, the manager of a mattress retailer in London, Ontario called Mattress Depot.

B. The Domain Name and Registrar

3. The disputed domain name is <marshall mattress.ca>. The Registrar for the domain name is 10 Dollar Domain Names Inc. The disputed domain name was registered on December 6, 2013.

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 1.4) (the *Rules*).
5. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada, Inc. The date of commencement of the proceedings was May

12, 2014. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *Rules*, and the Registrant was given a 20 day period in which to file a response to the Complaint. The Registrar determined the response filed was not in administrative compliance with the Policy and Rules and that the defects were not cured. Accordingly the response was not considered by the panel. This panel was constituted to hear the matter on June 26, 2014.

6. The Complainant requests, as a remedy, that the disputed domain name be transferred to it.

D. Panelist Impartiality and Independence

7. As required by paragraph 7.2 of the *Rules* the panelists have submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

E. **Canadian Presence Requirements**

8. The Complainant is an Ontario Corporation having its offices in Toronto, Ontario. The Complainant is an eligible Complainant within the meaning of clause 2(d) of the Canadian Presence Requirements For Registrants, Version 1.3, and clause 1.4 of the *Policy*.

F. Background

9. The facts and exhibits provided are extensive and while I have considered them all, only key points are summarized here. The Marshall Ventilated Mattress Company Limited was founded in 1918 as a successor to The Marshall Mattress Company, which was founded in Toronto in 1900 by James Marshall to sell a mattress of his invention. It has continued in the mattress business ever since.

10. The Complainant lists a number of trade marks and trade names it has used for many years which consist of or include “Marshall Mattress” and provides extensive information about their use. It owns trade mark registration TMA 562500 for a trade mark which prominently includes the words “Marshall Mattress”. The Panel is satisfied that the name and trade mark “Marshall Mattress” has an association with the Complainant predating the registration of the domain name by decades.

11. The Complainant received a telephone inquiry from a mattress retailer located in London, Ontario named Mattress Depot, about the possibility of beginning to sell the Complainant’s mattresses. The call came on December 6, 2013.

12. On the same day, Dace Baxter, the manager of Mattress Depot, registered the domain name marshallmattress.ca.

13. Discussions arising from this inquiry continued thereafter. On February 22 Mr. Eric Warner, the Complainant’s Manager of Business development and Sales was visiting Mattress Depot when he was told by its owner Mr. Brouwer that Mattress Depot made a practice of

purchasing domain names associated with others and directing them to its own web site. Mr. Warner investigated and found that marshallmattress.ca was registered anonymously, and that when it was entered into a web browser, it resolved to www.cheapbeds.ca, the Mattress Depot web site. A prompt demand for the transfer of the domain name to the Complainant was refused. The Complainant declined to do business with Mattress Depot.

14. The Registrant is the owner of 43 domain names. The Compliant lists eight of these which it says pertain to well known commercial brands having no apparent relationship with Mattress Depot or Mr. Baxter. These include publixsupermarkets.ca, kijijifurniture.ca, kijijimattress.ca, artvan.ca, leggattandplatt.ca, springair.ca, dreamstarbedding.ca, jenningsfurniture.ca and aamattress.ca.

G. *CIRA Domain Name Dispute Resolution Policy* Requirements

15. Paragraph 4.1 of the *Policy* provides that to succeed, a Complainant must establish 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;

16. The Complainant is also required to provide "some evidence" that:

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

H. Analysis

Confusingly Similar

17. Under paragraph 3.1(a) of the *Policy*, the Complainant must establish on a balance of probabilities that the disputed domain name is confusingly similar to a mark of the Complainant's; that the Complainant had rights in that mark prior to the date of registration of the domain name, and that it continues to have such rights.

18. The Complainant's use of the word "Marshall" in numerous forms in connection with its mattresses going back to 1932 is demonstrated by the evidence. As well, the Marshall Mattress name and trade marks have been used for at least two decades. To give the earliest example, the name 'Marshall Mattress' appears prominently atop a magazine advertisement published in Toronto Life magazine in 1992 (exhibit 14-4).

19. I am satisfied that the Complainant had rights in the name Marshall Mattress before the December 6, 2013 registration date.

20. The test for “confusingly similar” is set out in paragraph 3.3 of the *Policy*. This test requires the panel to consider only “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.” In CDRP cases the .ca element of the domain name is omitted from consideration. The result is that the trade mark Marshall Mattress, in which the Complainant has rights, and the domain name marshallmattress.ca, are identical, but for a space between the words, which is of no consequence in distinguishing the two.

21. I therefore conclude that the Complainant has succeeded in establishing confusing similarity under paragraph 3.1(a) of the *Policy*.

Bad Faith

22. The Complainant must also establish on a balance of probabilities that the disputed domain name was registered in bad faith. Paragraph 3.5 of the *Policy*, sets out 4 broad categories of bad faith.

23. The Complainant argues that the Registrant has acted in bad faith within the meaning of paragraphs 3.5(a) to (d).

24. Under paragraph 3.5(d), a finding of bad faith will be made where the Complainant establishes that

(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.

24. The disputed domain name resolves to the Mattress Depot website which promotes Mattress Depot’s business (Exhibit 19). Mattress Depot’s business is the sale of mattresses and beds.

25. Internet users familiar with Marshall Mattress are being enticed to purchase from Mattress Depot in a manner likely to deceive them, by the use of marshallmattress.ca as a domain name resolving to the Mattress Depot web site selling mattresses by other manufacturers but not those of the Complainant. That this was intentional can be inferred from the timing of the registration to coincide with a business inquiry, the identity of the domain name and the trade mark, Mr. Brouwer’s disclosure, and Mr. Baxter’s practice of diverting Internet users by registering other well-known brands as his own domain names.

26. Because I have found bad faith registration under paragraph 3.5(d), I will not address the other arguments regarding bad faith that were advanced by the Complainant. I do note that the Complainant relies upon an email to its lawyer from info@cheapbeds.ca (Exhibit 2), which I have not considered because it is in the nature of a privileged settlement offer which would be inadmissible in legal proceedings.

Legitimate Interest

27. Under paragraph 4.1(c) of the CDRP, the Complainant must provide *some evidence* that “the Registrant has no legitimate interest in the domain name”. Paragraph 3.4 describes six circumstances in which a legitimate interest may arise, although this is not a closed list. The circumstances include:

- (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 used 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 used 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.

28. The Complainant is only required to meet the lower threshold of “some evidence” because it will often be difficult for a Complainant to know of all of the circumstances which might support a Registrant’s claim to a legitimate interest. Once the Complainant has provided “some evidence”, the Registrant may provide evidence of its own to establish any *bona fide* interest it might have in the disputed domain name.

29. The only use shown of marshallmattress.ca is to promote the Mattress Depot business by diverting customers seeking Marshall Mattress. This cannot give rise to a legitimate interest. On

the contrary, it may expose Mr. Baxter to liability and to an injunction to desist under the tort of passing off. There is nothing to suggest that any of the safe harbours in paragraph 3.4 listed above might apply to the Registrant.

30. I find that the Complainant has met its burden of providing “some evidence” that the Registrant has no legitimate interest in the disputed domain name. In the absence of a Response the Registrant has not established that it has a legitimate interest in the domain name.

I. Conclusion and Decision

31. In conclusion, I find that the Complainant has prior rights in the trade mark MARSHALL MATTRESS, and that the disputed domain name, <marshallmattress.ca> is Confusingly Similar with this mark. I also conclude that the Registrant has no legitimate interest in the domain name, and that he registered the domain name in bad faith.

32. I therefore find that the registration of the domain name <marshallmattress.ca > should be transferred to the Complainant Marshall Ventilated Mattress Company Limited.

Dated: July 16, 2014



David Allsebrook