

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

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Domain Name: etro.ca  
Complainant: Etro S.p.A.  
Registrant: Robert A. Segarra  
Registrar: DomainPeople, Inc.  
Panellist: Sharon Groom  
Service Provider: Resolution Canada, Inc.

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**DECISION**

**A. The Parties**

1. The Complainant, Etro S.p.A. is a corporation located in Italy.
2. The Registrant for the domain name is Robert A. Segarra located in Toronto, Ontario.

**B. The Domain Name and Registrar**

3. The disputed domain name is etro.ca. The Registrar for this domain name is DomainPeople, Inc. The disputed domain name was registered on October 29, 2003.

**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 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 etro.ca be transferred to Etro S.p.A.. The Complaint was dated January 31, 2012.
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 on February 8, 2012.

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, Etro S.p.A., is an Italian company. However it owns two Canadian trademark registrations, namely registration no. 239,756 for ETRO Design and registration no. 296,021 for ETRO, both of which are 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 is engaged in the design and sale of fashion items such as clothing, accessories and perfume. It has been active in the fashion industry since the 1980's, has a global reputation, and registered the two trade-marks referred to above in Canada in 1980 and 1984 respectively.

12. The Complainant registered the domain name etro.com on June 21, 1996 and since then has registered numerous other "etro" domain names. These domain names resolve to websites promoting the Complainant's wares and services.

13. The Complainant states that the domain name etro.ca leads to the website [www.rasphoto.com/fashion](http://www.rasphoto.com/fashion) which promotes the Registrant's photography business.

**G. CIRA Domain Name Dispute Resolution Policy**

14. Under paragraph 4.1 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 3.5; and
- (c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

15. 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 October 29, 2003, therefore this is the relevant date for this analysis.

18. The Complainant registered its marks ETRO and ETRO design in Canada in 1984 and 1980 respectively and states that it has been using these marks since that time in association with its fashion business. The Complainant provides copies of pages from its website at [www.etro.com](http://www.etro.com) demonstrating current use of the mark ETRO. It is apparent that the Complainant uses this mark to distinguish its wares and services from those of others. The mark ETRO 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 and registered it in Canada. These rights predate the date of registration of the disputed domain name as the mark was first registered in 1980, which is prior to the relevant date of October 29, 2003. The fact that the mark still appears on the Complainant's website shows that the use of this mark is continuing.

20. The Complainant has thus established rights in the mark ETRO 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 [etro.ca](http://etro.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.

21. In this case I find that the domain name is likely to be mistaken for the Complainant's mark as it is identical to the mark. Therefore the Complainant has established, on a balance of probabilities, the facts required to support the requirements of paragraph 4.1(a) of the Policy.

### Legitimate Interest

22. Paragraph 3.4 provides six possible ways in which a Registrant may have a legitimate interest in a domain name, which shall be discussed below.

23. In this case the domain name resolves to the website [www.rasphoto.com/fashion](http://www.rasphoto.com/fashion). The domain name does not appear to be used by the Registrant as a trade-mark on his website, or in association with his business. Therefore paragraph 3.4(a) is not satisfied. Also, the Registrant does not appear to have used the domain name in good faith in association with any wares, services or business. Therefore this Registrant's use does not fall under subparagraphs 3.4(b) or (c). Nor was the Registrant using the domain name in good faith in association with criticism, review or news reporting (paragraph 3.4(d)). Finally, the domain name is not the legal name or other identifier of the Registrant (3.4(e)), nor is it the geographical name of the location of the Registrant's place of business (3.4(f)). Therefore, none of the criteria in section 3.4 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

24. The Complainant has to show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.5 deals with the grounds which constitute bad faith and it must be noted that these are no longer exhaustive; it is open to the panellist to find other grounds which lead to a conclusion of bad faith conduct.

25. I do not find any evidence that the Registrant's activities support bad faith under subparagraph 3.5(a) as there is no evidence that the Registrant offered to sell the domain name to the Complainant for more than the Registrant's actual costs in registering it.

26. With regard to subparagraph 3.5(b), the registration of this domain name has prevented the Complainant from registering its mark as a .ca domain name. But the Registrant does not appear to have engaged in a pattern of registering domain names to prevent rightful owners of marks from registering them as domain names. Therefore bad faith is not shown under this ground either.

27. I do not find that the facts support a finding of bad faith under subsection 3.5 (c), as, while the business of the Complainant may have been disrupted, the Registrant is not a competitor of the Complainant.

28. However I believe that the facts do support a finding of bad faith according to subsection 3.5(d). The Complainant's mark had been registered in Canada since as early as 1980 and used globally in the fashion business. The Registrant is supposedly a photographer working in the fashion business. Therefore it is highly unlikely that the Registrant would have been unaware of the Complainant's mark at the time he registered the domain name in 2003. Indeed, since the mark ETRO has no other connection to the Registrant, and there was no other reason to choose it, it appears that this mark was chosen as his domain name solely due to the notoriety of the ETRO brand and the resultant traffic that might then be diverted to the Registrant's website. The Registrant therefore seems to have chosen this domain name for the purpose of commercial gain, as the likelihood of confusion with the brand ETRO will drive internet traffic to the Registrant's website. In addition, as the Registrant portrays models on his website [www.rasphoto.com](http://www.rasphoto.com) and therefore purports to work in the fashion industry, the use of the well known brand ETRO is likely to lead consumers to the mistaken belief that the Registrant is affiliated with the Complainant, or sponsored by the Complainant.

29. I therefore find that the Complainant has demonstrated, on the balance of probabilities, that the Registrant has registered this domain name for commercial gain, to attract users to his website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Registrant's website.

### **I. Conclusion and Decision**

30. In conclusion, I find that the Complainant does have rights in the mark ETRO which predate 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.

31. I therefore order, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name etro.ca be transferred to the Complainant, Etro S.p.A.

Dated March 26, 2012

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

Sharon Groom