

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY (“CIRA”) DOMAIN NAME
DISPUTE RESOLUTION POLICY (“POLICY”)**

Complainant: Mabel’s Labels Inc.
Registrant: Layer 227 Inc.
Disputed Domain Name: mabelslabels.ca
Registrar: Tucows.com Co.
Panel: Denis Magnusson (sole panellist)
Service Provider: Resolution Canada

DECISION

Parties

The Complainant is the Mabel’s Labels Inc., a business corporation with its business office in Hamilton Ontario. The Registrant is Layer 227 Inc. of Oakville Ontario.

Disputed Domain Name and Registrar

The disputed domain name is mabelslabels.ca, registered on March 6, 2007. The Registrar is Tucows.com Co.

Procedural History

The Complainant filed this Complaint with the Provider Resolution Canada which found the Complaint in compliance with the CIRA *Domain Name Dispute Resolution Rules* (“Rules”) and transmitted the Complaint to the Registrant.

The Registrant filed no Response. Rules 5.8 provides that when no Response is submitted, “the Panel shall decide the Proceeding on the basis of the Complaint . . .”

Under Rules 6.5, no Response having been submitted, the Complainant opted to have this matter adjudicated by a sole panellist. The Provider appointed the undersigned Denis N. Magnusson as the sole Panellist to decide this matter.

Relief Requested

The Complainant requested that the Panel order that the ownership of the domain name be transferred from the Registrant to the Complainant.

The Complainant

Mabel’s Labels Inc was founded in 2002 and incorporated in 2004. The Complaint states that “Mabel’s Labels designs, manufactures and distributes personalized label products directly to customers worldwide through its websites mabel.ca and mabelslabels.com. The trade name Mabel’s Labels has been used from the company’s inception to distinguish it and its products from other label businesses and products. The name is used in its websites, email addresses, advertising, marketing and selling of its products. . . . Mabel’s Labels products and the company itself feature in countless print, television and online media outlets, have celebrity endorsements and have won numerous high profile

awards including, most recently, an RBC Canadian Women Entrepreneur Award. It is the highest profile personalised children's label company in North America.

The Registrant

The Registrant is Layer 227 Inc., the Administrative Contact for which is Frank Porreca. The Complaint states:

Mr Porreca is married to Laura Porreca, owner and president of Loveable Labels (www.lovablelabels.ca), a direct competitor in the personalized label manufacturing and selling business. CIRA administrative contact for both lovablelabels.ca and mabelslabels.ca is Frank Porreca, using the same Oakville postal address. Further, Mr. Porreca is listed elsewhere as a contact for Lovable Labels and uses the email address frank@lovablelabels.ca, indicating that his involvement with that company extends beyond that of domain name administrative contact.

Onus on Complainant

Policy 4.1 requires that:

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 3.7;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

[Emphases added]

(a) Confusingly Similar

Marks in Which Complainant Had and Has Rights

Policy 3.2(d) defines "Mark" as including a trademark registered in the Canadian Intellectual Property Office ("CIPO"). The Complaint states that:

"Mabel's Labels" is a registered trademark of Mabel's Labels Inc., registered on November 25, 2005 with the Canadian Intellectual Property Office, Registration Number TMA653511.

The form of the registered trademark is actually a design of what might be seen as a black label, with the words "Mabel's labels" in white in stylized children's writing. The date of this trademark registration, November 25, 2005, is prior to the date of the disputed domain name registration, March 6, 2007. This trademark registration remains in force and the Complainant continues to use this trademark in its business.

Confusingly Similar

Policy 3.4 defines “Confusingly Similar”:

A domain name is 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.

In assessing confusingly similar, the Panel is to disregard the .ca suffix attached to the domain name. Previous CIRA domain name dispute resolution decisions have ruled that capitalization, spacing and punctuation in the Complainant’s Mark should generally have little or no weight in assessing Confusingly Similar. This is so as converting a Complainant’s Mark into a Confusingly Similar domain name will necessarily involve not including capitalization, spacing and punctuation in the domain name form. Similarly, in this case, the Panel finds that the design elements of the Complainant’s trademark, its ostensible label form and its stylized writing lettering, are of no weight in assessing Confusingly Similar. The dominant feature of the registered trademark, the feature that would be remembered by the potentially confused ordinary consumer, is the wording, “Mabel’s labels”.

Thus, the Complainant’s Mark, the registered trademark featuring “Mabel’s labels”, is essentially identical to the disputed domain name “mabelslabels.ca”. This establishes that the domain name is Confusingly Similar to the Complainant’s Mark.

b) Bad Faith

Policy 3.7 has a restrictive definition of what can constitute the Registrant’s necessary Bad Faith in registering the domain name. That definition states that there will be Bad Faith, “*if, and only if*” one or more of three specific circumstances obtain. The Complainant submitted that the Registrant had registered the domain name in Bad Faith in the sense of Policy 3.7(c):

“the Registrant registered the domain name . . . primarily for the purpose of disrupting the business of the Complainant, . . . who is a competitor of the Registrant”.

Competitor

The Administrative Contact for the corporation which is the Registrant of the domain name is Frank Porreca. The Complaint states that:

Mr Porreca is married to Laura Porreca, owner and president of Loveable Labels (www.lovablelabels.ca), a direct competitor in the personalized label manufacturing and selling business. CIRA administrative contact for both lovablelabels.ca and mabelslabels.ca is Frank Porreca, using the same Oakville postal address. Further, Mr. Porreca is listed elsewhere as a contact for Lovable Labels and uses the email address frank@lovablelabels.ca, indicating that his involvement with that company extends beyond that of domain name administrative contact.

On these facts the Panel finds that the Registrant is a competitor of the Registrant.

Primarily for the Purpose of Disrupting the Business of the Complainant

The Complaint states:

[The registration of the disputed domain name] is . . . part of a systematic attempt to disrupt the business of a competitor. Loveable Labels has a history of illegally

appropriating from Mabel's Labels trademarked product names and copying verbatim marketing materials and strategies created by Mabel's Labels Inc. The registrant has demonstrated no intention of creating a website using said domain name since registering it in 2007. Rather, the registrant's motivation is to deprive the trademark holder of its rightful use of the domain name. Mr Porreca has knowingly prevented Mabel's Labels Inc from registering the name, despite written requests to him on August 19, 2009 and February 10, 2010, that he demonstrate good faith by transferring the domain name to Mabel's Labels Inc.

Since the phrase 'Mabel's Labels' is specific to Mabel's Labels Inc. and not a generic name in any language, the registrant has no legitimate claim to it. Mr. Porreca knowingly registered a trademarked name with which he has no legal association.

Applying Rules 5.8, these statements are sufficient to demonstrate that the registration of the domain name was done primarily for the purpose of disrupting the business of the Complainant.

c) Legitimate Interest

Under Policy 4.1(c) the Complainant has the burden of providing some evidence that "the Registrant has no legitimate interest in the domain name as described in paragraph 3.6". Paragraph 3.6 stipulates that the Registrant has a Legitimate Interest in a domain name "if, and only if" the Registrant has one or more of the six specific interests set out in Policy 3.6.

Considering those six specific interests in the light of the facts of this case makes it very clear that the Registrant has no such Legitimate Interest in the domain name.

DECISION AND ORDER

The Complaint succeeds. The Panel orders the ownership of the disputed domain name mabelslabels.ca to be transferred to the Complainant.

March 27, 2010

Denis N. Magnusson (sole panel member)