

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

Domain Name: BENCHCLOTHING.CA
Complainant: Americana International Ltd.
Registrant: Bench Clothing Store Inc.
Registrar: Go Daddy Domains Canada, Inc.
Panelist: Teresa Scassa
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant is the U.K. incorporated company Americana International Ltd. The Complainant's principal place of business is in North Manchester, U.K.
2. The Registrant, Bench Clothing Store, Inc., did not respond to the Complaint.

B. The Domain Name and Registrar

3. The disputed domain name is <benchclothing.ca>. The Registrar for the domain name is Go Daddy Domains Canada, Inc. The disputed domain name was registered on December 9, 2011.

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 August 14, 2013. 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. No response was received. The Provider then selected a sole panelist in accordance with the process set out in the *Rules*.

6. The Complainant was represented by counsel, who provided a thorough and detailed submission.

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

D. Panelist Impartiality and Independence

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

E. Canadian Presence Requirements

9. Because the Complainant is a company based outside of Canada, it must satisfy the Canadian presence requirements by virtue of its Canadian trademark rights. Article 2(q) of the CIRA Canadian Presence Requirements for Registrants, Version 1.3, provides that a company that owns a trademark registered in Canada can satisfy these requirements where the matter involves “a domain name consisting of or including the exact word component of that registered trade-mark”. The Complainant, Americana International Ltd. is the owner of the Canadian registered trademark BENCH (Registration No. TMA663637). This mark was registered on May 3, 2006 for use in relation to a wide range of clothing and luggage-related goods. In this case, the disputed domain name BENCHCLOTHING.CA includes the Complainant’s BENCH word mark. The Canadian Presence Requirements have been met.

F. Factual Background

10. The Complainant is the owner of the BENCH clothing brand, which was founded in 1987. In addition to the Canadian registered trademark for the word BENCH, the company also holds registrations for other BENCH-related marks, including a number of design marks that incorporate the word BENCH. Clothing bearing the BENCH marks is sold worldwide; according to the Complainant, there are more than 5000 BENCH sales locations around the world, 13 of which are in Canada. In addition to retail outlets, the company’s goods are also sold online. In Canada, the official website is found at <www.bench.ca>. The Complainant submits that considerable sums of money are spent on the marketing and promotion of BENCH brands around the world and through a full range of media, including social media.

11. The Registrant registered the disputed domain name BENCHCLOTHING.CA on December 9, 2011. The Complainant has provided copies of the home page and other pages of the website to which this domain name resolved. These pages have a clear heading: BenchClothing.ca. They appear to relate to an online shopping site on which both Bench and Lululemon clothes are featured. The Complainant submits that they made a purchase of Bench clothing from the website prior to filing the complaint, and that the clothing they received in fulfillment of their order was counterfeit, having been neither manufactured for or by Bench. The Complainant also provided a screen shot of text from the website. This text claims that the website is operated by “a trustworthy and professional Manufacturer of the hot selling Bench and Lululemon clothing.” This company, which is referred to as Bench Clothing Co. Ltd, is said to have been established in China in 2007.

G. *CIRA Domain Name Dispute Resolution Policy Requirements*

12. Paragraph 4.1 of the *CIRA Domain Name Dispute Resolution Policy, Version 1.3* (CDRP) 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.

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; and

H. Analysis

Confusingly Similar

13. The Complainant must first 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.

14. The test for “confusingly similar” set out in paragraph 3.3 of the Policy 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.” The test is considered to be one of first impression and imperfect recollection (Government of Canada v. Bedford, May 27, 2003, <http://www.cira.ca/assets/Documents/Legal/Dispute/2003/00011govt-of-canada-En.pdf>).

15. In this case, the Complainant is the owner of the registered trademark BENCH. The disputed domain name is benchclothing.ca. The Complainant submits that the addition of further words, letters or symbols to a trademark incorporated in a domain name will not prevent a finding of confusing similarity. It is certainly the case that the addition of words or letters will not automatically preclude such a finding, although there may be circumstances where the addition of words to a trademark will dispel any confusing similarity. For example, a trademark that is a word capable of multiple meanings may be used in conjunction with other words in such a way that there is no confusing similarity with the trademark at issue. However, in this case, the word that is added to “bench” in the domain name effectively describes a broad category of goods in relation to which the BENCH mark is used. Rather than dispel confusion, the addition of the word “clothing” would seem to enhance any confusion by capturing not only the mark itself but also the wares in association with which the mark is commonly used. I find that the domain name is confusingly similar to the Complainant’s registered trademark. The Complainant’s rights in this mark predate by many years the Registrant’s registration of the disputed domain name, and the Complainant continues to have rights in the mark.

Bad Faith

16. A complainant must also establish on a balance of probabilities that the disputed domain name was registered in bad faith. Paragraph 3.5 of *Version 1.3* of the *Policy*, sets out the principal categories of bad faith, but this is not a closed list of circumstances in which bad faith registration may be found.

17. The Complainant argues that the Registrant has acted in bad faith within the meaning of paragraph 3.5(c) of the policy. Under paragraph 3.5(c), a finding of bad faith will be made where the Complainant establishes that

(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.

18. Under paragraph 3.5(c) the Complainant must demonstrate on a balance of probabilities that the Registrant registered the domain name *primarily for the purpose* of disrupting the business of the Complainant and that the Complainant and Registrant were competitors. In this case, it would appear that the disputed domain name BENCHCLOTHING.CA was registered with the explicit objective of selling unauthorized merchandise, and of doing so in a way that conveyed the impression that the merchandise was both genuine and in some way authorized by the Complainant. The

screenshots from the website clearly show that clothing purporting to be BENCH brand clothing is offered for sale from the site, and the screenshot of the information about the website suggests an intent to mislead. For example, the Registrant uses the name Bench Clothing Co. Ltd. on the web page. It describes itself as “a trustworthy and professional Manufacturer of the hot selling Bench and Lululemon clothing”. In doing so, it clearly creates the impression that it is an authorized manufacturer of these goods.

19. These activities on the part of the Registrant are disruptive of the business of the Complainant. The deliberate targeting of the Complainant’s goods from the Registrant’s web site must have been a motivating purpose for the registration of the disputed domain name. In my view, the Complainant has succeeded in establishing bad faith under paragraph 3.5(c).

20. I note that in my view the facts of this case would also support a finding of bad faith under paragraph 3.5(d), which provides that bad faith registration may be found where:

(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.

21. Here, the Registrant would appear to be motivated by commercial gain to attract to its websites internet users who are searching for the Complainant’s products. It has done so by creating a likelihood of confusion not only in its choice of domain name, but also in the presentation of information on its website.

Legitimate Interest

22. As noted above, under sub-paragraph 4.1(c) of the Policy, the Complainant must provide *some evidence* that “the Registrant has no legitimate interest in the domain name”. Paragraph 3.4 identifies 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.*

23. “Some evidence” is a relatively low threshold because of the difficulty that a Complainant might have in knowing the basis on which a Registrant might claim a legitimate interest. It is up to the Registrant to rebut the Complainant’s evidence with evidence of its own regarding any *bona fide* interest it might have in the disputed domain name. Where, as in this case, the Registrant does not respond to the Complaint, the issue turns on whether the Complainant has been able to satisfy its relatively low burden of showing the absence of a legitimate interest.

24. The Complainant argues that there is no relationship between it and the Registrant that would give the Registrant a licence or authority to use their BENCH mark in the way in which it has done. The Complainant has also provided evidence that the website to which the domain name resolved was used to sell unauthorized merchandise. The Complainant also provided some evidence that it had put the Registrant on notice of its concerns regarding the disputed domain name and the website to which it resolved, in the form of letters to both the Registrant and the Registrant’s Internet Service Provider on December 12, 2012.

25. The first four subparagraphs of paragraph 3.4 of the Policy all require good faith in the use either of the Mark that is incorporated in the domain name or of the domain name itself. The Complainant has demonstrated that the use by the Registrant of the BENCH mark and of the disputed domain name appears to involve the unauthorized sale of goods in a manner that creates confusion as to their source. There is no good faith use here that could found a legitimate interest under these paragraphs. Further, there is nothing to suggest that the domain name is either the legal name of the Registrant or “other reference by which the Registrant was commonly identified” as required by subparagraph 3.4(e). Indeed, the Complainant has provided the fruitless results of its searches in California (as per the address of the administrative contact person) and in Canada for a business registration for Bench Clothing Store Inc.; the company does not appear to be registered in either jurisdiction. The domain name similarly does not appear

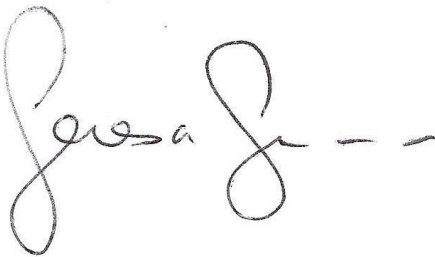
to be the geographical name of the location of the Registrant's place of business as is required to establish a legitimate interest under paragraph 3.4(f).

I. Conclusion and Decision

26. In conclusion, I find that the Complainant has rights in the mark BENCH. I find that the disputed domain name BENCHCLOTHING.CA is confusingly similar to that mark, that the Registrant had no legitimate interest in the domain name, and that it registered the domain name in bad faith.

27. I therefore find that the registration of the domain name BENCHCLOTHING.CA should be transferred to the Complainant Americana International Ltd.

Dated: September 17, 2013

A handwritten signature in cursive script, appearing to read "Teresa Scassa", followed by a horizontal line.

Teresa Scassa