

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

Domain Name: americangirl.ca
Complainant: American Girl, LLC
Registrant: Geraldine Laverne Page
Registrar: Namespro Solutions Inc.
Panel: Sharon Groom (Chair), Jay Josefo, Alessandro Colonnier
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, American Girl, LLC is a corporation located in the United States.
2. The Registrant for the domain name is Geraldine Laverne Page located in Vancouver, B.C.

B. The Domain Name and Registrar

3. The disputed domain name is americangirl.ca. The Registrar for this domain name is Namespro Solutions Inc. The disputed domain name was registered on October 18, 2004.

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 americangirl.ca be transferred to American Girl, LLC. The Complaint was dated August 1, 2013.
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 August 8, 2013.

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 three panellists.

D. Panellist Impartiality and Independence

9. As required by paragraph 7 of the Rules, each panellist has submitted to Resolution Canada, Inc. a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

10. The Complainant, American Girl, LLC is a U.S. company. However it owns a Canadian trade-mark registration for the mark AMERICAN GIRL, registration no. 529,682 which is included 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 a wholly owned subsidiary of Mattel, Inc., the well known designer and manufacturer of toys. The Complainant was founded in 1986 and in the past 3 years has enjoyed gross sales in excess of \$1.6 billion in association with the same of books, dolls, clothes, toys and accessories. The Complainant also has operated the website americangirl.com since 1997. In addition to the trade-mark AMERICAN GIRL mentioned above, the Complainant also owns a registration for AMERICAN GIRL GEAR, which was registered in 1999 under registration no. 508,826.

12. The disputed domain name americangirl.ca was registered on October 18, 2004. Initially it lead to a pay per click site with sponsored links to competitors of the Complainant. There was also a notice on the site indicating that the domain name was for sale.

13. The Complainant sent a cease and desist letter to the Registrant dated August 17, 2012. As the identity of the Registrant was hidden, it was sent via CIRA's Messenger Service. No response was received.

14. On September 24, 2012 the Complainant filed a CDRP Complaint with the British Columbia International Commercial Arbitration Centre. The Registrant did not submit a response and the case was presided over by a sole panelist. The panelist in that case found that the Complainant had failed to establish some evidence that the Registrant had no legitimate interest in the domain name. The Complainant had failed to ascertain the identity of the Registrant and therefore, in the panelist's opinion, any representations made by the Complainant as to lack of legitimate interest were "unsubstantiated assertions that do not satisfy the "some evidence" requirement." The panelist therefore held that the Complainant had not established its claim and was not entitled to have the domain name transferred.

15. The Complainant refers to two previous decisions, *Bowring & Co. Inc. v. Eric Maddeaux*, Case No. 00116 and *Excite Group, Inc. v. Zucker International Marketing Inc.*, Case No. 0176,

as support for the concept that a Complainant can bring a second complaint concerning a domain name when the earlier complaint was unsuccessful. In the case of *Bowring*, the panel was of the view that there was nothing in the Policy which prohibited a second complaint, especially when the first complaint had not been fully determined as the Complainant had not satisfied the panel that it had rights in the mark which would make it an eligible complainant. The panel stated that there could be situations where a second complaint should not be considered, such as where a complainant is merely commencing the complaint to harass or intimidate a registrant.

16. In the case of *Excite*, the panel considered whether the doctrines of *res judicata* and *functus officio* barred the second complaint. The panel found that the Policy does not expressly permit the filing of a further complaint for the same domain name between the same parties, but it also did not expressly prohibit such a complaint. The panel concluded that there are circumstances in which a second complaint may be brought, such as in that case, where the Rules and Policy had undergone substantive revision since the first complaint had been decided and the changes would have a material impact on the outcome of the decision.

17. This panel agrees that the Policy does not prohibit a second complaint regarding the same domain name involving the same parties. It also considers that each such complaint must be reviewed on its own merits and if it appears that the claim is being brought to harass the registrant, as may be the case where the complainant has not brought any new evidence or analysis to the table, then it should not be allowed to proceed. However if those circumstances are not present, then the complainant should be permitted to bring a new complaint.

18. In this case, the previous decision went against the Complainant on the basis that it had not convinced the panelist that the Registrant had no legitimate interest, because the Complainant had not found out the identity of the Registrant prior to the decision being rendered. In the current complaint, the Complainant has not only produced the name of the Registrant, but has provided substantial new evidence concerning the Registrant's activities, which new facts we think would have had a material impact on the outcome of the decision, had they been before the prior panel. We are therefore prepared to consider this second complaint.

19. Following the determination of the first complaint, the Complainant sent a further cease and desist letter to the Registrant and various e mails, all of which went unanswered. The Complainant also hired an investigator to search for Geraldine Laverne Page, and the investigator was not able to find any evidence of someone by that name. Sometime after the second cease and desist letter, and the first domain name decision, the domain name was deactivated, then it was hyperlinked to a Facebook account in the Registrant's name. This appeared to be a sham site, as it seemed contrived, and showed images of a Canadian flag and an American flag, with maps of Vancouver and Washington, presumably to show that the Registrant was an "American girl". Therefore it appeared to the Complainant to be a blatant attempt to show some legitimate use of the domain name.

G. CIRA Domain Name Dispute Resolution Policy

20. 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.

21. 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

22. 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.

23. The date of registration of the domain name is October 18, 2004, therefore this is the relevant date for this analysis.

24. The Complainant registered its mark AMERICAN GIRL in Canada in 2000 and has provided evidence demonstrating its use, as well as substantial sales figures indicating that the mark is still in use in Canada. The mark AMERICAN GIRL therefore satisfies the definition of a "mark" in subparagraph 3.2(a) of the Policy.

25. 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 registered in 2000, which is prior to the relevant date of October 18, 2004.

26. The Complainant has thus established rights in the mark AMERICAN GIRL since prior to 2004, and has demonstrated that it continues to have these rights. The question then is whether this mark is confusingly similar to the domain name americangirl.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.

27. In this case the domain name consists of the entire mark AMERICAN GIRL. Therefore the panel finds that the domain name is likely to be mistaken for the Complainant's mark as it incorporates the whole of the Complainant's 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

28. 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.

29. In this case the domain name used to resolve to a parked pay per click website, and now resolves to the Facebook account. We agree with the Complainant that the fact that the Registrant does not appear to have any identity that an investigator could find, combined with the fact that the domain name only recently resolved to a Facebook account, which seems to have been set up for the sole purpose of justifying the use of such a domain name, indicates that the current use of the domain name is nothing more than a transparent attempt to legitimize the domain name.

30. We do not believe that such use shows that the domain name was a mark, used in good faith by the Registrant and that the Registrant had rights in the mark. Therefore paragraph 3.4(a) is not satisfied. Nor do we conclude that the domain name was registered in good faith in association with any wares, services or business, so the Registrant's use cannot fall under subparagraphs 3.4(b) or (c). The Registrant was not 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 a name, surname or other reference by which the Registrant was commonly identified (despite the Facebook page, which in our opinion is not legitimate) (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 the panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the domain name.

Bad Faith

31. 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 not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.

32. The Complainant argued that the Registrant's conduct constituted bad faith under sections 3.5(a) and 3.5(d). We shall address each of these in turn.

33. Under section 3.5(a), bad faith will be presumed where the Registrant registered or acquired the domain name primarily for the purpose of selling the registration to the Complainant, or the Complainant's licensee or competitor, in excess of the Registrant's actual costs in registering the domain name or acquiring the registration. The Complainant states that the fact that the Registrant initially had a notice on the website offering it for sale, where users who clicked on that site were directed to domainnamesale.com, implies that the Registrant intended to offer the

domain name for sale in excess of the acquisition costs. The Complainant states that the fact that the domain name now points to a Facebook account does not negate that initial intention.

34. The panel agrees that a notice on a website offering it for sale and directing the user to a domain name website indicates that the Registrant is attempting to sell the domain name. Also, the fact that the domain name never seemed to be actually used for a legitimate purpose, and was identical to a well known trade-mark, suggests that the primary purpose for acquiring the domain name was to subsequently sell it to the Complainant, or a competitor or licensee of the Complainant. If that was indeed the purpose behind the acquisition of the domain name, then it is also likely that the Registrant intended to sell the domain name at a profit. Therefore the panel finds that the criteria set out in section 3.5(a) have been met and that the domain name was registered in bad faith.

35. The Complainant also contends that the facts support a finding of bad faith according to subsection 3.5(d) as the Registrant, in using a pay per click site, was using the domain name for commercial gain, to attract users to her 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.

36. The Complainant's mark has been registered in Canada since 2000, and is currently well known in association with the sale of toys and accessories. Therefore it seems likely that the Registrant would have been aware of the Complainant's mark at the time the domain name was registered in 2004 and that this was the motivation behind its registration. The Registrant therefore seems to have chosen this domain name for the purpose of commercial gain, as the likelihood of confusion with the brand AMERICAN GIRL will drive internet traffic to the Registrant's website. The recent transfer of the domain name to a Facebook site does not alter this finding.

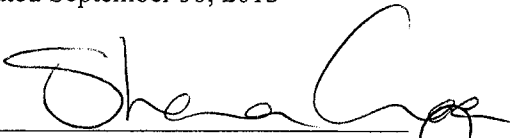
37. We therefore find that the Complainant has demonstrated, on the balance of probabilities, that the Registrant has registered this domain name for commercial gain, to attract users to her website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Registrant's website and that this use therefore constitutes evidence of bad faith under section 3.5(d).

I. Conclusion and Decision

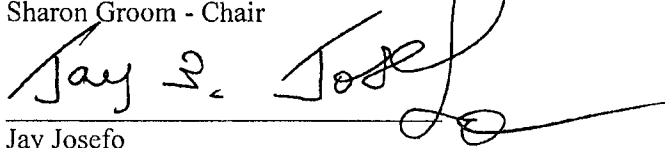
38. In conclusion, the panel finds that the Complainant does have rights in the mark AMERICAN GIRL which predate the registration of the domain name. It also finds that the domain name is confusingly similar to the Complainant's mark and that the Registrant had no legitimate interest in the domain name. Finally, it finds that the Complainant has shown that the Registrant registered the domain name in bad faith.

39. The panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name americangirl.ca be transferred to the Complainant, American Girl, LLC.

Dated September 30, 2013



Sharon Groom - Chair



Jay Josefo



Alessandro Colonnier