

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

Domain Name: DAVIDYURMAN.CA

Complainant: David Yurman IP LLC

Registrant: Essi Molesky

Registrar: HEXONET Services, Inc.

Panelist: Daniel Anthony

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant in this matter is David Yurman IP LLC, a U.S.-based business.
2. The Registrant for the domain name is listed as Essi Molesky, with an address in Kingston, Ontario.

B. The Domain Name and Registrar

3. The disputed domain name is <davidyurman.ca> (the “Domain Name”). The Registrar for the Domain Name is HEXONET Services, Inc. The Domain Name was registered on June 17, 2011.

C. Procedural History

4. This is a proceeding under Version 1.3 of the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (the “Policy”) and Version 1.5 of the CIRA *Domain Name Dispute Resolution Rules* (the “Rules”).
5. The History of the proceeding, according to the information provided by the dispute resolution provider, Resolution Canada, Inc. (the “Provider”), is as follows:
 - The Complainant filed its Complaint against the Registrant with Resolution Canada, Inc., on April 7, 2020, requesting that the registration for the domain name <davidyurman.ca> be transferred to David Yurman IP LLC.

- The Provider confirmed that locks have been placed on the Domain Name and provided the Registrant's information to the Complainant on April 8, 2020.
- The Complainant knew the identity of the Registrant at the time of filing the Complaint, since it had obtained upon request the Registrant's identity from CIRA on March 10, 2020. CIRA also provided the Registrant's postal and email addresses to the Complainant. The Complainant requested the Registrant's identity after receiving an unreasonable offer for sale of the Domain Name from the Registrant via CIRA's messenger service on February 25, 2020. In that offer, the Registrant was only identified as "name pros."
- On June 24, 2020, Resolution Canada served notice of the Complaint to the Registrant as required by paragraphs 4 and 5 of the *Rules*. The Notice of Complaint informed the Registrant that they had 20 days from June 24, 2020, to respond to the Complaint.
- No response to the Complaint was filed by the Registrant.
- The Complainant elected to proceed by single member panel.

D. Panelist Impartiality and Independence

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

E. Eligibility

7. The Complainant, David Yurman IP LLC, is a company based in New York, New York. The Complainant holds the Canadian trademark registration for DAVID YURMAN (TMA549272) with respect to precious metal jewelry and watches. This mark was registered on August 3, 2001. The Complainant also owns another Canadian trademark registration for DAVID YURMAN (TMA994203). Either Canadian trademark registration for DAVID YURMAN is sufficient to establish that David Yurman IP LLC is eligible to bring this Complaint, pursuant paragraph 1.4 of the *Policy*.

F. Factual Background

8. The Complainant describes itself as "the owner of the well-known DAVID YURMAN luxury brand encompassing high jewelry collections, men's jewelry, luxury timepieces, fragrance and eyewear." The Complainant states that it owns trademark registrations comprised of DAVID YURMAN in jurisdictions throughout the world, including Canada. As noted above, the Complainant holds two Canadian trademark registrations for DAVID YURMAN. One of these marks is registered in association with precious metal jewelry and watches; the Complainant states to have used that DAVID YURMAN trademark in Canada since at least as early as October 1995. Through its claimed use and significant investment, the Complainant's DAVID YURMAN brand is said to have achieved public recognition and accrued goodwill in Canada and around the world. The above is supported by details provided in the Complainant's

cease-and-desist correspondence to the Registrant on February 24, 2020, and printouts from the Complainant's website <davidyurman.com>.

9. The Registrant registered the domain name <davidyurman.ca> on July 17, 2011. The Registrant did not respond to this Complaint, but the Complainant provided some information on the Registrant's activities in its submissions.

10. The Complainant alleges that "[t]he Domain Name points to a pay-per-click website featuring sponsored links to competitors of the Complainant, while prominently featuring the DAVID YURMAN trademark." Printouts of the Registrant's website <davidyurman.ca> and the Complainant's website <davidyurman.com> are provided in support. The Complainant also argues that the Registrant has listed the Domain Name for sale with Afternic.com, Inc., for \$9999 USD. A copy of this listing is included in the Complaint.

11. Since the ownership information was concealed at the Registry level, the Complainant issued a cease-and-desist correspondence to the Registrant via CIRA's messenger service on February 24, 2020. A response from the Registrant, requesting \$5500 USD for the transfer of the Domain Name, was received on February 25, 2020. The Complaint includes copies of this cease-and-desist correspondence, its receipt of delivery and the Registrant's response.

12. Upon request, CIRA provided the Registrant's dot-ca domain name portfolio to the Complainant on March 10, 2020. The Complainant provided CIRA's list in the Complaint and paired all the eleven listed domain names, including the disputed Domain Name, with their corresponding mark. To further support its allegation that "the Registrant is a serial cybersquatter," the Complainant provided two CDRP complaints brought by third-party brand owners against the same Registrant: respectively, *Citizens of Humanity LLC v Essi Molesky*, BCICAC Case No. 00282, and *Vanguard Trademark Holdings USA LLC v Essi Molesky*, BCICAC Case No. 00247. The domain name registrations subject of these disputes were ordered to be transferred to the brand owner.

G. CIRA Domain Name Dispute Resolution Policy Requirements

13. Paragraph 3.1 of the *CIRA Domain Name Dispute Resolution Policy* (CDRP) 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 no legitimate interest in the domain name as described in paragraph 3.4; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.

14. According to paragraph 4.1 of the CDRP, the Complainant must establish elements (1) and (2) above on a balance of probabilities. The Complainant must also provide "some evidence" that the Registrant has no legitimate interest in the Domain Name.

H. Analysis

Confusingly Similar

15. The Complainant must first establish that the disputed domain name is confusingly similar to a mark in which the Complainant has rights in Canada prior to the date of registration of the Domain Name, and that it continues to have such rights as of the date of the Complaint.

16. The Complainant's trademark is DAVID YURMAN and is a Mark in accordance with paragraph 3.2 of the *Policy*. The Domain Name is <davidyurman.ca>. The Complainant's rights in the trademark began well before the registration date of the Domain Name, and it continues to have rights in its mark. I rely on the Canadian trademark registrations to make this finding. According to paragraph 3.3 of the *Policy*, a domain name is confusingly similar to a Mark when it "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." As noted in *Coca-Cola Ltd v Amos B. Hennan*, BCICAC Case No. 00014, "[f]or the purposes of this Policy, 'domain name' means the domain name excluding the 'dot-ca' suffix." Applying that definition, the domain name is identical to the Complainant's registered trademark DAVID YURMAN.

17. Consequently, I find that the Complainant has met its burden of establishing, on a balance of probabilities, that <davidyurman.ca> is confusingly similar with the Complainant's trademark DAVID YURMAN. This factor of the test is met.

Legitimate Interest

18. Under subparagraph 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.

19. The Complainant submitted that there has never been any relationship between the Complainant and Registrant, and that it has never licensed or authorized the Registrant to register or use the mark DAVID YURMAN in any manner, including as a domain name. To the contrary, the evidence gathered by the Complainant is indicative of cybersquatting and bad faith; both are detailed below. In the absence of any responding submissions, I accept this evidence. Subparagraphs 3.4(a), (b), (c) and (d) – all requiring good faith – cannot be met. Furthermore, the two latter circumstances, enumerated under subparagraphs 3.4(e) and (f), are inapplicable. The Domain Name is not the legal name provided by the Registrant, nor the way the Registrant is commonly identified. The Domain Name is not a geographical name, and the Registrant is in Kingston, Ontario.

20. No other legitimate interest can be made out from the evidence. Accordingly, I find that the Complainant has readily met its burden to provide "some evidence" that the Registrant has no legitimate interest in the Domain Name.

Bad Faith

21. Several non-exhaustive bases for a finding of bad faith are set out in paragraph 3.5 of the *Policy*. The Complainant has advanced arguments under the bad faith grounds set out in subparagraphs 3.5(a), (b) and (d). Each of these is addressed below, but the Complainant only needs to provide one circumstance for bad faith.

22. Firstly, the Complainant submits that the Registrant registered the Domain Name for the purpose of selling, renting, licensing or otherwise transferring it to the Complainant for valuable consideration in excess of its actual registration costs. The Registrant offered directly to transfer the Domain Name to the Complainant in exchange for \$5500 USD, an amount which clearly exceeds the actual costs associated with domain name registration. The use of the Complainant's mark in the Domain Name and on its pay-per-click website featuring links incorporating the mark DAVID YURMAN suggests that the Registrant was targeting the Complainant at the time of the registration. Subparagraph 3.5(a) is met.

23. Secondly, the Complainant demonstrates, with CIRA's list of dot-ca domain name registrations under "Essi Molesky" and two CDRP decisions ruled against the Registrant, that the Registrant has engaged in a pattern of domain name registrations containing trademarks without the authorization of their owners. As few as two registrations, including the domain or domains in the dispute, have been found sufficient to establish a pattern under subparagraph 3.5(b) of the *Policy*: e.g., *Great Pacific Industries Inc v Ghalib Dhalla*, BCICAC Case No. 00009, and *Allergan Inc v Hiebert Net Inc*, BCICAC Case No. 00058. It is noted that the Complainant provided a list obtained from CIRA of ten .ca domains names held by the Registrant, nine of which correspond directly to third-party trademarks, thus readily establishing this bad faith circumstance.

24. Finally, the Complainant claims that the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to the Registrant's website by creating a likelihood of confusion with the Complainant's mark. The disputed Domain Name is exactly the Complainant's Mark and simply substitutes .ca for .com in the Complainant's authentic website www.davidyurman.com. The mark DAVID YURMAN is featured across in several of the pay-per-click links appearing on the website. In the absence of evidence to the contrary, I find that a significant number of the the Complainant's potential consumers are likely be confused as to whether the website hosted at the disputed Domain Name is affiliated with or endorsed by the Complainant. Subparagraph 3.5(d) of the *Policy* is also met.

25. This factor of the test is readily met.

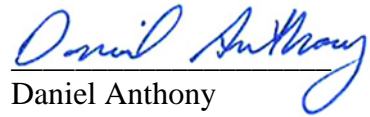
I. Conclusion and Decision

26. In conclusion, I find that the Complainant has rights in the mark DAVID YURMAN. I find that the Domain Name is confusingly similar to the Mark, the Registrant had no legitimate interest in the Domain Name and the Domain Name was registered in bad faith.

J. Remedy

27. The Domain Name should be transferred to the Complainant in accordance with paragraph 4.3 of the *Policy*.

Dated August 17, 2020

A handwritten signature in blue ink that reads "Daniel Anthony". The signature is written in a cursive style with a horizontal line underneath the name.

Daniel Anthony
Single member panel