

**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: G.L.P.
Registrar: Namespro Solutions Inc.
Panel: Bradley J. Freedman (sole panellist)
Service Provider: The British Columbia International Commercial Arbitration Centre
BCICAC File No.: DCA-1425-CIRA

DECISION

A. The Parties

1. The Complainant is American Girl, LLC, a company with an office in El Segundo, California, USA.
2. The Registrant is an individual who resides in Canada. In accordance with CIRA's Privacy Policy, the Registrant's identity is not disclosed in the publicly available WHOIS database for the Domain Name. Accordingly, the Registrant's identity will not be disclosed in this decision, and instead the Registrant will be referenced by the initials G.L.P.

B. The Domain Name and Registrar

3. The disputed domain name is americangirl.ca (the "**Domain Name**").
4. The Domain Name was registered on October 18, 2004.
5. The registrar of the Domain Name is Namespro Solutions Inc.

C. Procedural History

6. This is an administrative dispute resolution proceeding pursuant to the *CIRA Domain Name Dispute Resolution Policy* version 1.3 (August 22, 2011) (the "**Policy**") and the *CIRA Domain Name Dispute Resolution Rules* version 1.4 (the "**Rules**"), both issued by the Canadian Internet Registration Authority ("**CIRA**").

7. This proceeding is administered by British Columbia International Commercial Arbitration Centre (“**BCICAC**”), which is a recognized service provider pursuant to Policy paragraph 1.5.

8. According to the information provided by BCICAC, the initial procedural history of this proceeding is as follows:

- On September 24, 2012, the Complainant filed a complaint in relation to the Domain Name pursuant to the Policy (the “**Complaint**”).
- On September 27, 2012, BCICAC requested that Namespro Solutions Inc. (the registrar of the Domain Name) disclose the Registrant’s identity and contact information, as permitted by Rules paragraph 4.3, and in response Namespro Solutions Inc. provided the requested information.
- By letter and email dated September 27, 2012, BCICAC advised both the Complainant and the Registrant that the Complaint was in administrative compliance with the Policy and the Rules and delivered a copy of the Complaint to the Registrant in the manner prescribed by Rules paragraph 2.1.
- The Registrant failed to file a response to the Complaint by the applicable date.
- The Complainant did not make further submission to the Panel with respect to the issue of the Registrant’s legitimate interest (or lack thereof) in the Domain Name pursuant to Rules paragraph 11.1.
- The Complainant elected to have this matter proceed before a Panel comprised of a single arbitrator.
- On October 29, 2012, BCICAC appointed Bradley J. Freedman as sole panellist.

9. As required by Rules paragraph 7.1, the Panellist has submitted a declaration of impartiality and independence to BCICAC.

10. The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules.

11. Based upon the information provided by BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met.

12. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise to a need to alter the progress of this proceeding pursuant to Rules paragraph 13.2.

D. Eligibility of Complainant

13. The Complainant is an eligible complainant under Policy paragraph 1.4, because the Complaint relates to a registered trade-mark of which the Complainant is the owner.

E. Relief Requested

14. The Complainant requests that the Domain Name registration be transferred from the Registrant to the Complainant.

F. Applicable Law

15. In accordance with Rules paragraph 12.1, the Panel will render its decision based upon the rules and principles of the laws of Ontario and the laws of Canada applicable in Ontario.

G. Procedural Issues – Additional Submissions and Failure to Respond

16. The Complaint does not identify the Registrant. In the Complaint, the Complainant asserts that, in accordance with the CIRA Privacy Policy, the publicly available WHOIS database information for the Domain Name does not disclose the identity of the Registrant.

17. There is no indication in the Complaint whether the Complainant sought to invoke CIRA's *Request for Disclosure of Registrant Information - Rules and Procedures*, which provides for the disclosure of a domain name registrant's identity if a person reasonably believes in good faith that the domain name infringes the person's Canadian registered trade-mark.

18. After the identity of the Registrant was disclosed to the Complainant (through correspondence from BCICAC in October 2012), the Complainant did not seek to make further submissions to the Panel with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the Domain Name, as permitted by Rules paragraph 11.1.

19. To assist the Panel in determining this matter in accordance with the Policy and the Rules and to ensure that the parties are treated with equality and that each party is given a fair opportunity to present its case as required by the Rules, on November 8, 2012, the Panel issued a Direction inviting each of the Complainant and the Registrant to submit further evidence or argument as they consider appropriate with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the Domain Name. The Complainant was required to deliver its submissions by or before November 29, 2012. The Registrant was required to deliver the Registrant's submissions by or before December 20, 2012.

20. On November 12, 2012, the Complainant delivered its further submissions (which will be discussed below). The Registrant did not file any further submissions or otherwise respond to the Direction.

21. The Registrant's failure to respond to the Complaint or the Panel's Direction does not automatically result in a decision in favour of the Complainant. Rules paragraph 5.8 provides that if a registrant does not submit a response within the applicable period, the Panel shall decide the Proceeding on the basis of the complaint. While the Panel may draw appropriate inferences from a registrant's failure to respond to a complaint, the complainant must still satisfy the requirements of the Policy. See *SAO PAULO Alpargatas S/A v. Luca's World Inc.*, (2009) CIRA Decision No. 00131. There is no concept of a default award under the Policy or the Rules.

Accordingly, it is incumbent upon the Panel to assess the Complaint and determine whether the Complainant has satisfied the requirements of the Policy.

H. Facts

22. The undisputed facts relevant to the Panel's decision are set forth in the Complaint, and are as follows:

- The Complainant is in the business of marketing and selling dolls, toys and related wares under the AMERICAN GIRL brand.
- The Complainant is the owner of the Canadian registered trade-marks AMERICAN GIRL (registered June 22, 2000, TMA529682) and AMERICAN GIRL GEAR (registered March 4, 1999, TMA508826).
- The Complainant operates a successful commercial website using the domain name americangirl.com, which was registered in 1997 and is owned by the Complainant.
- The AMERICAN GIRL trade-mark is well known in Canada and has considerable reputation and goodwill.
- The Registrant registered the Domain Name on October 18, 2004, many years after the registration of the Complainant's AMERICAN GIRL trade-mark.
- The Domain Name resolves to a website that provides listings of sponsored links to various third party websites relating to dolls and related items, including websites operated by the Complainant's competitors. The website also contains a notice that the Domain Name is available for sale through a website at domainnamesales.com, which invites offers to purchase the Domain Name.
- In August 2012, the Complainant's legal counsel issued a cease and desist letter to the Registrant, which letter was delivered to the Registrant through a messenger service operated by CIRA. The Complainant did not receive a response to the cease and desist letter.

23. The dispositive issue in this proceeding is whether the Complainant has met its evidentiary onus regarding the Registrant's lack of a legitimate interest in the Domain Name. In light of the Panel's decision regarding that issue, it is neither necessary nor appropriate for the Panel to make further findings of fact.

I. Discussion and Findings

24. Policy paragraph 4.1 sets forth the onus on the Complainant, and reads as follows:

“4.1 **Onus.** To succeed in the Proceeding, 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 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.”

25. The dispositive issue in this proceeding is whether the Complainant has met its evidentiary onus regarding the third element of the test set out in paragraph 4.1 of the Policy - the Registrant’s lack of a legitimate interest in the Domain Name. In light of the Panel’s decision regarding that issue, it is neither necessary nor appropriate for the Panel to consider the first two elements of the test set out in paragraph 4.1 of the Policy.

26. Policy paragraph 4.1(c) requires a complainant to provide “some evidence” that a registrant has no legitimate interest in a disputed domain name “as described in paragraph 3.4”. Policy paragraph 3.4 provides a non-exhaustive list of circumstances that demonstrate that a registrant has a legitimate interest in a domain name, as follows:

“3.4 **Legitimate Interests.** For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

(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 registered 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 registered 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.

In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site."

27. Policy paragraph 1.2 provides that a reference to "domain name" in the Policy means a disputed domain name excluding the "dot-ca" suffix.

28. Rules paragraph 9.1(d) requires a panel to determine the admissibility, relevance, materiality and weight of the evidence.

29. Policy paragraphs 3.4 and 4.1(c) together require a more or less objective or ascertainable legitimate link between a registrant and a disputed domain name (without the "dot-ca" suffix) aside from mere registration. The criteria specified in Policy paragraphs 3.4(a), (b), (c) and (d) focus on a registrant's registration or use of a disputed domain name and require that the registration or use be "in good faith". The criteria specified in Policy paragraphs 3.4(e) and (f) relate to other kinds of legitimate links between the disputed domain name and the registrant or the registrant's activities. The listed criteria are non-exhaustive, and the parties or panel may look beyond the listed criteria to determine whether a registrant has a legitimate interest in a disputed domain name. See *General Motors LLC v. Thompson*, (2012) CIRA Decision No. 00191 and *Weekday Brands AB v. Leslie*, (2012) CIRA Decision No. 00201.

30. A plain reading of Policy paragraph 4.1(c) requires a panel to consider whether a registrant has a legitimate interest in a domain name based upon any of the criteria listed in Policy paragraph 3.4 or other circumstances. The fact that one or more of the listed criteria are not applicable is not determinative, since a legitimate interest may be established under any of the listed criteria or other circumstances. Further, the fact that a registrant may not have registered or used a disputed domain name in good faith (and therefore Policy paragraphs 3.4(a), (b), (c) and (d) are not applicable) does not mean that the registrant does not have a legitimate interest in the domain name under the criteria specified in Policy paragraphs 3.4(e) and (f) or otherwise. This view is consistent with a reading of Policy paragraph 4.1 as a whole, which treats as distinct elements bad faith registration of a disputed domain name and legitimate interest in a disputed domain name, and expressly provides that a registrant who registers a disputed domain name in bad faith may nevertheless succeed in a proceeding under the Policy by establishing that the registrant has a legitimate interest in the disputed domain name.

31. A complainant's burden regarding a registrant's lack of a legitimate interest in a disputed domain name is relatively light. Policy paragraph 4.1 requires a complainant to provide "some evidence" that a registrant has no legitimate interest in a disputed domain name, and then the burden shifts to the registrant to prove that it has a legitimate interest in the domain name. This approach reflects the fact that in most cases the nature of a registrant's legitimate interests, if any, in a domain name lies most directly within the registrant's knowledge. In most cases, a complainant can satisfy its evidentiary onus to provide "some evidence" that a registrant does not have a legitimate interest in a disputed domain name by undertaking reasonable, limited inquiries or conducting rudimentary Internet-based searches using the registrant's name and other contact details disclosed in the publicly available WHOIS database for the disputed domain name or otherwise obtained by the complainant.

32. In this case, the Complainant's submissions regarding the Registrant's alleged lack of legitimate interest in the Domain Name are comprised of assertions that closely follow the criteria listed in Policy paragraph 3.4. Those assertions are, in relevant part, as follows:

"There has never been any relationship between the Complainant and the Registrant, and the Registrant has never been licensed, or otherwise authorized to register or use, the AMERICAN GIRL Trade-marks in any manner whatsoever, including in, or as part of, a domain name.

...

The Domain Name has not been used as a Mark as defined by the Policy, namely "for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person". It follows that the Registrant cannot claim Rights in the disputed domain name.

In any event, the domain name americangirl.ca was not acquired in good faith or for a bona fide purpose. The Registrant acquired the Domain Name with a view to selling it to the Complainant for a profit. Further, it has been made to resolve to a website featuring sponsored links to competitors of the Complainant. This completely undermines any claim of good faith or legitimate interest.

...

The Registrant has not used americangirl.ca in good faith in association with any wares, services or business, and the Domain Name is not clearly descriptive in any of the senses stipulated by this paragraph.

...

The Registrant cannot claim a legitimate interest in the disputed domain name, as americangirl.ca is not generic of any wares, services or business, nor has the Domain Name been used in good faith or for a bona fide purpose.

...

The Registrant has never used the Domain Name in association with a non-commercial activity, and therefore cannot invoke paragraph 3.6(d) [sic] of the Policy. In any event, and as previously noted, the Domain Name has not been used in good faith.

...

"American Girl" is not a legal name, surname, or other reference, by which the Registrant is commonly identified, and accordingly, the Registrant cannot rely on paragraph 3.6(e) [sic] of the Policy.

...

The Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or place of business."

33. The Complaint is signed by the Complainant's legal counsel as the Complainant's authorized representative and contains the following statement: "The Complainant certifies that

the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate...".

34. After this proceeding was commenced and the identity of the Registrant was known to the Complainant, the Panel issued a Direction inviting each of the Complainant and the Registrant to submit further evidence or argument as they consider appropriate with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the Domain Name. The Complainant did not submit any evidence in response to the Direction. Rather, the Complainant delivered an email which reads, in relevant part, as follows:

"These submissions are further to the Direction of the Panel.

Subsequent to the filing of the Complaint, the identity of the Registrant was revealed to be [name omitted]. Please note that the identity of the Registrant does not alter or change the Complainant's position. It is maintained that the domain name should be ordered transferred given that the domain name is confusing with the AMERICAN GIRL Trade-marks, the domain name was registered in bad faith and the Registrant does not have rights or a legitimate interest in the domain name."

35. The Complainant's assertions regarding the inapplicability of the criteria for legitimate interest specified in Policy paragraphs 3.4(a), (b), (c) and (d) focus on the Registrant's alleged bad faith registration and use of the Domain Name, as demonstrated by documentary exhibits showing how the domain name was actually used by the Registrant. Those assertions together with relevant documentary exhibits are "some evidence" that the Registrant does not have a legitimate interest in the domain name based upon the criteria specified in Policy paragraphs 3.4(a), (b), (c) and (d).

36. The Complainant's assertions regarding the inapplicability of the criteria for legitimate interest specified in Policy paragraphs 3.4(e) and (f), which relate to links between the Domain Name and the Registrant or the Registrant's activities, are not supported by any documentary exhibits or other evidence and were made notwithstanding that the Complainant did not know the identity of the Registrant. The Complaint does not provide any factual basis for those assertions or explain how those assertions could be made by the Complainant given the Complainant's admitted lack of knowledge regarding the Registrant's identity when the Complaint was filed. For example, the Complaint does not indicate that the Complainant undertook investigations or conducted searches to determine whether the Registrant had a legitimate interest in the descriptive term "American Girl". As previously noted, the Complainant apparently did not seek to invoke CIRA's *Request for Disclosure of Registrant Information - Rules and Procedures* before filing the Complaint, and did not make further submissions regarding the issue of no legitimate interest after the Registrant's identity was disclosed by BCICAC to the Complainant.

37. The Panel finds that, in light of the Complainant's admitted lack of knowledge regarding the Registrant's identity when the Complaint was filed, the Complainant's assertions in the Complaint regarding the Registrant's alleged lack of legitimate interest in the Domain Name (which without the "dot-ca" suffix is the descriptive term "American Girl") regarding the criteria listed in Policy paragraphs 3.4(e) and (f) are unsubstantiated assertions that do not satisfy the "some evidence" requirement. The Panel also finds that the Complainant's email submission in

response to the Panel's Direction does not constitute evidence or otherwise cure the deficiency in the evidentiary record.

38. Policy paragraph 1.1 provides that the purpose of the Policy is to provide a forum in which cases of bad faith domain name registration can be dealt with relatively inexpensively and quickly. Nevertheless, a proceeding under the Policy affects the respective rights of the parties regarding a disputed domain name, and the Policy and Rules expressly require a panel to consider all of the evidence and argument presented in the proceeding and render its decision in accordance with the Policy, the Rules and applicable law. Accordingly, a panel must determine whether a complainant has met its onus regarding each of the elements specified in Policy paragraph 4.1, and if a complainant has failed to do so the panel must dismiss the complaint.

39. For the reasons set forth above, the Panel is compelled to conclude that the Complainant has failed to satisfy the onus to provide "some evidence" that the Registrant has no legitimate interest in the Domain Name as described in Policy paragraphs 3.4(e) and (f). Consequently, the Complaint cannot succeed.

40. In the circumstances, it is neither necessary nor appropriate for the Panel to address any other issues raised by the Complaint.

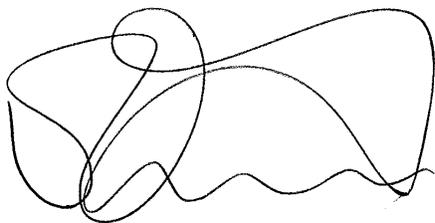
J. Conclusion and Decision

41. The Panel finds that the Complainant has not met the onus under Policy paragraph 4.1 to provide some evidence that the Registrant has no legitimate interest in the Domain Name as described in Policy paragraph 3.4.

42. Accordingly, the Panel holds that the Complainant has not established its claim and is not entitled to the remedy requested in the Complaint.

43. For those reasons, the Panel declines to make any order with respect to the Domain Name.

Dated January 9, 2013.



Bradley J. Freedman, sole panellist