

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

Complainant:	Sterling Jewellers, Inc.
Complainant Counsel:	Leota L. Tennant
Registrant:	Private Registration
Registrant's Counsel:	Eric Macramalla
Panel:	Barry C. Effler (Chair), James E. Redmond, W.A. Derry Millar
Service Provider:	British Columbia International Commercial Arbitration Centre
BCICAC File Number:	DCA-1431-CIRA

DECISION

The Parties, Domain Names and Registrar

1. The Complainant is Sterling Jewellers, Inc., a corporation incorporated in Delaware and giving as its address an address in Akron, Ohio, USA.
2. The Registrant is an individual whose identity is known to the Panel but who has requested privacy.
3. The Domain Name at issue in this dispute is JARED.CA.
4. The Registrar is Namespro Solutions Inc.
5. The Domain Name was registered by the Registrant on April 26, 2001.

Procedural History

6. The procedural history of this matter was set out in a letter from the British Columbia International Commercial Arbitration Centre to the Panel herein dated October 31, 2012:

The British Columbia International Commercial Arbitration Centre (BCICAC) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (CDRP) of the Canadian Internet Registration Authority (CIRA).

The above named Complainant has filed a Complaint with respect to the above-referenced domain name in accordance with the CDRP on October 4, 2012.

The Complaint was reviewed and found to be compliant. By letter and email dated, October 9, 2012, BCICAC as Service Provider so advised the parties and forwarded a copy of the Complaint to the Registrant.

The Registrant delivered its Response, in compliance with the Policy and Rules, to the Centre on October 29, 2012.

The Registrant's Response was reviewed by the BCICAC and delivered to the Complainant on October 29, 2012.

The Complaint and the Responses were filed in English, which shall be the language of the proceeding.

In accordance with Paragraph 6 of the Rules, the Provider shall appoint a three-person Panel, with consideration to the nominees of the parties, and select a Chair.

The BCICAC names W.A. Derry Millar and James E. Redmond as panelists. Barry C. Effler is named as Chair of the Panel.

7. Following the appointment of the Panel, the Complainant requested and received permission from the Panel to file a response with respect to the issue of costs pursuant to Rule 11.1. This Complainant's Response was received on November 5, 2012.
8. As required by paragraph 7.1 of the Rules, each Panellist has declared to BCICAC that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.
9. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13.2 of the Rules, to a need to stay or terminate the progress of this proceeding.

Eligibility of Complainant

10. The Panel has reviewed the material submitted by the Complainant and is satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy, because it meets the Canadian Presence Requirements as the owner of a registered Canadian trade-mark.

Relief Requested

11. The Complainant requests that the Domain Name JARED.CA be transferred from the Registrant to the Complainant.
12. The Respondent requests his costs in the amount of \$5,000 pursuant to paragraph 4.6 of the Policy, alleging bad faith of the Complainant in commencing the Complaint.

Applicable Law

13. As directed by paragraph 12.1 of the Rules, the Panel will render its decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

Facts

14. The undisputed facts relevant to the Panel's decision as set forth in the Complaint and its schedules, are as follows:
- (a) The Complainant is in the retail jewellery business and opened its first store in 1993 using the JARED mark. The Complainant is now operating in the United States and in Canada.
 - (b) The Complainant started operating a website using the JARED.COM domain name in 1994.
 - (c) The Registrant was not known to the Complainant as the registration was privacy protected.
 - (d) The Registrant registered the Domain Name on April 26, 2001 and has made no use of the Domain Name from then to the date of the Complaint. The Domain Name is parked and does not provide any referral from the parking site.
 - (e) The Complainant is the owner of registered Canadian trade-mark TMA727808 registered November 5, 2008 for JARED, for "Wares: Jewelry" and claiming a priority filing date of November 22, 2005 based on United States Application no. 76/650,767.
 - (f) The Complainant is the owner of registered Canadian trade-mark TMA727810 registered November 5, 2008 for JARED THE GALLERIA OF JEWELRY, for "Services: Retail jewelry store services" and claiming a priority filing date of January 10, 1995 based on United States Registration no. 1,872,975.
15. Additional facts relevant to this decision provided by the Registrant in his Response are as follows:
- (a) The Registrant had a son born in October, 2000 whose first name is Jared. This is supported by the submission of a copy of the son's Canadian passport.

Discussion and Findings

16. Policy paragraph 4.1 sets forth the onus on a complainant. It provides, in relevant part, 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.*

17. The Panel finds that the Domain Name of JARED is Confusingly Similar to the registered Canadian trade-mark of JARED, being identical with the exception of the addition of the dot ca.

18. The Complainant is the owner of a registered Canadian trade-mark for JARED which was registered AFTER the date of registration of the Domain Name and which claims priority based on a previous United States trade-mark back to November 22, 2005. This does not meet the requirements of paragraph 4.1 (a).

19. The Complainant's second registered Canadian trade-mark is for JARED THE GALLERIA OF JEWELRY and is also registered after the date of registration of the Domain Name. This trade-mark claims priority, based on prior United States usage, as of January 10, 1995. The term "Mark in which the Complainant had Rights" is not defined. The question of whether a trade-mark registered after a domain name, but which has a claimed priority prior to the date of registration of the domain name based on a foreign trade-mark, is unclear. This Panel will not analyze or make a finding regarding whether the Complainant meets the test in paragraph 4.1 (a) since this Complaint fails on other grounds to be reviewed below.

20. None of the circumstances described in paragraph 3.5 are present to allow a finding that the Registrant registered the Domain Name in Bad Faith as required in paragraph 4.1 (b). The Domain name has been parked and not used since 2001. The Registrant has not contacted the Complainant at any time and in particular has not sought to sell the Domain name to the Complainant.
21. Paragraph 3.4 of the Policy outlines certain circumstances whereby a Panel may make a finding that a registrant has a legitimate interest in the domain name for the purposes of paragraph 4.1 (c) of the Policy. This list is to assist a Panel and is not exhaustive. Of relevance here is sub-paragraph (e):

(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;

22. The Domain Name does not meet the exact requirements of sub-paragraph (e) as it does not comprise the legal name or surname of the Registrant herein. Note that the Domain Name is the exact first name of the son of the Registrant. The Registrant has provided the following explanation regarding the registration and non-use of the Domain Name in paragraph 16 of his Response to the Complaint::

I created and registered a domain name for my son. I'm proud of the fact that he has the opportunity to create his own unique presence on the internet thru his own domain name. There is no and has been no maliciousness or intent on our part to harm Sterling Jewelers in anyway by registering of the Canadian domain name of JARED.CA. Up until today I had no idea they existed – sorry Sterling Jewelers!

23. Credence is lent to this explanation by
- (a) the lack of usage of the Domain Name to date,
 - (b) the close timing of the date of registration of the Domain Name to the date of birth of the Registrant's son; and
 - (c) the fact that "Jared" is a common first name¹.

¹ The name "Jared" was the 56th most common name in the year 2000, based on evidence submitted from the U.S Social Security Administration website by the Registrant.

The Panel finds it unnecessary to make a finding as to whether the Registrant has a legitimate interest in the Domain Name under paragraph 3.4 of the Policy, because the Complaint fails in any event on the issue of bad faith.²

24. The Panel finds that the particular circumstances of non-use of the Domain name combined with a reasonable explanation of the reason for registration of the Domain Name leads to the conclusion that this registration is not made in bad faith and was made with a legitimate interest intended. Therefore, the Complaint fails to meet the requirements of the Policy to obtain the remedy requested.
25. Policy paragraph 4.6 outlines the standard that must be met by a registrant seeking costs after successfully defending a complaint:

*4.6 **Bad Faith of Complainant.** If the Registrant is successful, and the Registrant proves, on a balance of probabilities, that the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of any Registration which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect of any Registration with any Provider until the amount owing is paid in full to the Provider.*

26. The Complainant owned a Canadian trade-mark identical to the Domain Name. This trade-mark was registered after the Domain Name was registered. The trade-mark is not inherently distinctive and in fact is based on a common first name. There is thus a rebuttable presumption of reverse domain name hijacking, which is essentially what paragraph 4.6 is about.
27. The Complainant has a registered Canadian trade-mark and has usage in the United States back to 1994. The name of the Registrant was privacy protected and the lack of usage of the name gave the Complainant no indicia of there being any legitimate usage or basis for the registration of the Domain name. The Complainant in paragraph 5 of its Reply regarding the issue of costs argues:

² The Registrant cites a case with very similar fact situation in which the domain name in question “gail.com” was registered based on the first name of the registrant’s wife. See *Gail Guarulhos Indústria e Comércio Ltda. v. Kevin Watson*, WIPO Case No. D2006-0655,

5. Under these circumstances, an honest belief in these two elements, (1) that under the Policy the JARED mark is confusingly similar to the Complainant's mark and that Complainant may have priority in the domain name based on its trademarks in the United States and Canada and (2) that Registrant did not have a readily apparent legitimate interest in the domain name, should be sufficient to establish a colour of right.

28. The Panel accepts this submission and is satisfied that the Complainant acted with a colour of right in filing the Complaint.

Conclusion

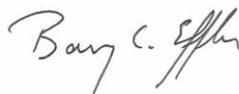
29. The Panel finds that the Complainant has not met the burden assigned to it under paragraph 4.1(b) of the Policy. In particular, the Complainant has not proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith.
30. Accordingly, the Panel holds that the Complainant has not established its claim, and is not entitled to the remedy set forth in the Complaint.
31. The Panel finds that the Registrant has not met the burden assigned to it under paragraph 4.6 of the Policy. In particular, the Registrant has not proven, on a balance of probabilities, that the Complainant acted unfairly and without colour of right in filing the Complaint.

Order

32. For the reasons set forth above, the Panel dismisses the Complaint and declines to make any order with respect to costs.

Dated: November 16, 2012

Barry C. Effler (Chair), James E. Redmond, and
W.A. Derry Millar



Barry C. Effler (Chair) for the Panel