

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

Domain Name: <sittercity.ca>
Complainant: Sittercity Incorporated
Registrant: Mile Mocilac
Registrar: Go Daddy Domains Canada, Inc.
Panelist: Patrick D. Flaherty
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

Parties

The complainant is Sittercity Incorporated (the "Complainant"), a Delaware corporation, the principal office of which is located at 20 West Kinzie St. #1500, Chicago, Illinois, U.S.A., 60654. The registrant is Mile Mocilac (the "Registrant"), whose administrative contact is located at 21381-85 Court, Langley, British Columbia, Canada, V1M 2G3.

Domain Name and Registrar

The domain name that is the subject of this proceeding is <sittercity.ca> (the "Domain Name"). The registrar of the Domain Name is Go Daddy Domains Canada, Inc. (the "Registrar"), a British Columbia, Canada corporation.

Governing Policy and Rules

This is a proceeding under the Canadian Internet Registration Authority (CIRA) Domain Name Dispute Resolution Policy (Version 1.2) (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (Version 1.3) (the "Rules").

It is important to note that the CIRA recently implemented a revised Policy (Version 1.3) and revised Rules (Version 1.4) (together, the "Revised Policy and Rules"), each of which is effective as of August 22, 2011 (the "Effective Date"). According to paragraphs 1.8 and 1.2 of the Revised Policy and Rules, respectively, the version of the policy and rules in effect at the time a proceeding is initiated will apply to that proceeding. As a result, because this proceeding was initiated before the Effective Date, the Policy and Rules, as referenced above, apply to this decision.

Procedural History

The history of this proceeding, according to the information provided by the dispute resolution service provider, British Columbia International Commercial Arbitration Centre (BCICAC), is as follows:

- (a) On July 4, 2011, the Complainant filed a complaint (the "Complaint") with the BCICAC regarding the Domain Name.
- (b) Having determined that the Complaint was in administrative compliance with the requirements of the Policy and the Rules, the BCICAC delivered a copy of the Complaint to the Registrant. Pursuant to Rule 5.1, the Registrant was required to deliver a response (the "Response") by July 25, 2011.
- (c) By way of email correspondence on August 4, 2011, the Registrant requested an extension of time in which to deliver its Response and an extension was granted by the BCICAC to August 15, 2011, pursuant to Rule 5.4.
- (d) On August 16, 2011, the BCICAC, having acknowledged receipt of the Registrant's Response as of August 15, 2011, determined, on several grounds, that the Response was not in administrative compliance with the Rules.
- (e) As per paragraph 5.6 of the Rules, the BCICAC was not obligated to submit a non-compliant Response to the panel for consideration, nor did it choose to do so.
- (f) Accordingly, Rule 5.8 applies to this proceeding and the panel is permitted to determine the matter on the basis of the Complaint, as filed by the Complainant.
- (g) The Complaint was filed in English, which is the language of this proceeding in accordance with paragraph 10.1 of the Rules.
- (h) As permitted, given the absence of a Response, the Complainant elected under paragraph 6.5 of the Rules to convert from a three member panel to a single member panel.
- (i) As a result, on September 6, 2011, pursuant to Rule 6.5, the BCICAC appointed a panel (the "Panel") comprised of Patrick D. Flaherty (the "Panelist").
- (j) The Panelist has delivered to the BCICAC a Statement of Impartiality and Independence, as required by Rule 7.2.
- (k) Absent exceptional circumstances, the Panel was required to deliver its decision on or before September 27, 2011.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding, unless

otherwise noted, have been met. The Complainant was represented by legal counsel throughout this proceeding. The Respondent was not represented by legal counsel.

Background

The Panel proceeds on the basis of the following facts set forth below as established in the evidence submitted by the Complainant.

Since as early as August 2005, the Complainant has provided online database services in Canada, in the area of connecting individuals with local providers of care services such as babysitters, nannies, senior care providers, house sitters, dog walkers and tutors. These services are offered on a website operated by the Complainant at the URL <sittercity.com>. The Complainant registered this domain name on May 6, 2000.

The Complaint is based on the Complainant's trade-mark "SITTERCITY" (the "Mark") registered in the United States under Serial Number 78541086 on December 13, 2005, and in Canada under No. TMA 749,181 on October 1, 2009. According to the Complainant, the Mark is advertised, promoted, and known throughout Canada since at least 2005 within the care services industry. Furthermore, the Mark is unique, and there are no other SITTERCITY-formative marks registered in Canada except that of the Complainant, nor is the Mark associated with any other services except those of the Complainant.

The Registrant registered the disputed Domain Name on February 18, 2009 (before the Complainant's registration of the trade-mark in Canada) and thereafter began to operate a corresponding website under the Domain Name. The Registrant is currently using the Domain Name in connection with a website that provides numerous links to other websites in areas such as early childcare training, child day care management, and daycare job employment. According to the Complainant, these topics contain links to various competing websites, including third party providers of services similar to the services provided by the Complainant.

The Complainant, through its solicitors, put the Registrant's administrative contact, Mile Mocilac, on notice of the Complainant's trade-mark rights to the Mark, and its intent to assert and protect these rights, by the Complainant's correspondence dated April 15, 2011, sent using the CIRA message delivery service. As part of this correspondence, the Complainant offered to pay the Registrant a sum of money in exchange for the transfer of the Domain Name. As of the filing of the Complaint, the Complainant's solicitors had not received a response to this correspondence from the Registrant.

Positions of the Parties

1. Complainant

In accordance with Policy Paragraph 4.3, the Complainant seeks an order requiring the Domain Name to be transferred to it on the following bases:

(a) The Registrant's Domain Name is confusingly similar to the Mark, which the Complainant had rights to prior to the date of registration of the Domain Name and continues to have such rights.

- (i) The Complainant is the owner of the Mark, registered in the United States Patents and Trademarks Office (USPTO) and the Canadian Intellectual Property Office (CIPO).
- (ii) The Mark was used in Canada by the Complainant before the registration of the Domain Name.
- (iii) The Domain Name is identical in appearance, and in sound and ideas suggested, as the Mark.
- (iv) Accordingly, the Domain Name is confusingly similar to the Mark.
- (v) Given that the Domain Name is identical to the Mark and the Mark has developed goodwill throughout Canada, there is little doubt that consumers would likely mistake the Domain Name for the Mark.

(b) The Registrant has no legitimate interest in the Domain Name.

- (i) The Registrant's Domain Name does not fall within any of the six instances of legitimate interest set forth in Policy paragraph 3.6.
- (ii) The Registrant has never been licensed or authorized to use the Mark and has no right to use it.
- (iii) The Registrant was aware at the time of registering the Domain Name of the Complainant's prior rights in the Mark and of the Complainant's business in view of the Complainant's significant use of and reputation in the Mark in Canada and the United States for several years prior to the registration of the Domain Name.
- (iv) The Registrant is using the Domain Name to attract users to its website through consumer confusion with the Mark and website, and to obtain advertising revenue by posting various third party links on its website to redirect consumers. In doing so, the Registrant is unfairly and illegally exploiting the goodwill attached to the Mark.
- (v) The Domain Name was registered and used to mislead internet users into believing that the Registrant's business associated with the Domain name is a business of the Complainant, or is at least endorsed, sponsored or approved by the Complainant, which is not the case.
- (vi) The Domain Name is not a generic word in Canada nor is the Mark the generic name of the Registrant's "services" of providing a website with the

Complainant's third-party links. By virtue of use and advertising, the Mark has become distinctive of its services.

- (vii) The Domain Name is not being used in association with a non-commercial activity, but rather in connection with a website the only purpose of which is to advertise the goods/services of other others and generate revenue as a result.
 - (viii) The Domain Name is not comprised of the legal name of the Registrant, nor of the geographical name of the location of the Registrant's non-commercial activity or place of business.
- (c) **The Registrant registered the Domain Name in bad faith as described in Policy paragraph 3.7.**
- (i) The Registrant's primary purpose in registering the Domain Name was to disrupt the Complainant's business. In doing so, the Registrant has acted in bad faith.
 - (ii) The Registrant has used and registered the Domain Name in bad faith because it did so to attract users to its website through confusion with the Complainant's Mark and website, thereby creating traffic to its own website and obtaining advertising revenue from third parties.
 - (iii) The Registrant has used and registered the Domain Name in bad faith because the registration of the Domain Name prevents the Complainant from reflecting its Mark in a corresponding dot-ca domain name, which is the very means through which the Complainant conducts business.

2. Registrant

As noted, the Registrant failed to file a compliant Response with the BCICAC, and therefore has provided no information or submissions to have the Complaint dismissed.

Discussions and Findings

1. The Policy

The Policy applies only to disputes involving alleged bad faith registration of domain names in the dot-ca country code top level domain. According to Policy paragraph 4.1, the Complainant will succeed only where it proves, on a balance of probabilities, that:

- (a) The Registrant's dot-ca Domain Name is "Confusingly Similar" (as defined in Policy paragraph 3.4) to a "Mark" (as defined in Policy paragraph 3.2) in which the Complainant had "Rights" (as defined in Policy paragraph 3.3) 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 Policy paragraph 3.7.

Further, the Complainant must provide some evidence that:

- (c) The Registrant has no legitimate interest in the Domain Name as described in Policy paragraph 3.6.

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 he has a legitimate interest in the Domain Name as described in Policy paragraph 3.6.

2. Confusing Similarity Between the Domain Name and the Complainant's Mark

The Complainant has succeeded in proving, on a balance of probabilities, that the Domain Name is "Confusingly Similar" to a Mark in which the Complainant had rights to prior to the registration of the Domain Name.

Under Policy sub-paragraphs 3.2(a), a mark that has been used in Canada by a person for the purpose of distinguishing the wares, services or business of that person is considered to be a "Mark" in which the Complainant has "Rights". Since on the material submitted by the Complainant, the Mark was used in Canada at least as early as August, 2005, and the Domain Name was not registered until February 2, 2009, the Complainant's rights existed prior to the registration of the Domain Name.

For the purposes of determining whether a Domain Name is confusingly similar to a Mark, Policy paragraph 1.2 indicates that the "dot-ca" suffix of the Domain Name should not be considered. Absent the "dot-ca" suffix, the Domain Name is identical to the Complainant's trade-mark and accordingly the two are clearly confusingly similar. Policy paragraph 3.4 provides that:

A domain name is "Confusingly Similar" to a Mark if 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.

In determining whether a domain name is confusingly similar to a trade-mark, the test to be applied is one of resemblance based upon first impression and imperfect recollection.' Here, the Domain Name and the Mark are identical and there can be no doubt that the two are therefore confusingly similar within the meaning of the Policy.

Government of Canada on behalf of Her Majesty the Queen in Right of Canada v. David Bedford, BICCAC, Case No. 00011, 2003 at para. 67. See also: *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC, Case No. 00020, 2004 [*Glaxo Group Ltd.*].

3. Bad Faith Registration

Policy paragraph 3.1(c) requires the Complainant to prove, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith, as described in Policy paragraph 3.7. For the reasons that follow, the Panel is of the opinion that the Complainant has met this burden.

Policy paragraph 3.7 sets forth an exhaustive list of criteria for determining whether a registrant registered a domain name in "bad faith":

For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:

- (a) The Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;
- (b) The Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names; or
- (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.

The Complainant's argument under this provision is that, pursuant to sub-paragraph (c), the Registrant registered the Domain Name primarily for the purpose of disrupting the Complainant's business, who is a competitor of the Registrant.

Given the language and interpretation of this provision, in order to satisfy the requirements of Policy sub-paragraph 3.7(c), the Complainant must establish that:

- i. the Registrant was aware of the Complainant's trade-mark rights prior to registering the Domain name;
- ii. the Registrant's primary purpose in registering the Domain Name was to disrupt the Complainant's business; and
- iii. the Complainant is a "competitor" of the Registrant.

(a) The Registrant was aware of the Complainant

As demonstrated by the evidence submitted by the Complainant, the Registrant was aware of the Complainant's trade-mark rights in SITTEERCITY prior to registering the domain name, given the Complainant's established reputation in Canada, where the Registrant is based.

Furthermore, the Complainant's Mark, through use and advertising by the Complainant, has become distinctive of the Complainant's services such that the Registrant would have clearly been aware of the Complainant, and of the likely confusion generated by the Domain Name and corresponding website.

(b) The Registrant's purpose was to disrupt the Complainant's business

As has been previously observed, a complainant will rarely have direct evidence of the purpose for registration. Rather, a Registrant's purpose may be determined by common sense inferences from the Registrant's conduct and other surrounding circumstances.²

Furthermore, "disruption" for the purposes of Policy sub-paragraph 3.7(c) occurs when internet users encountering a domain name are misled into believing that a registrant's business associated with the domain name is a business of the complainant, or at least endorsed, sponsored or approved by the Complainant.³

With respect to the Registrant's purpose, the Registrant's website as it now operates contains links to websites at which the Complainant's competitors offer their services. This suggests that the Registrant's purpose in registering the Domain Name was to disrupt the Complainant's business.⁴

In terms of the effect on the Complainant's business, the registration of the Domain Name by the Registrant is preventing the Complainant from registering its Mark as a dot-ca name, in a country in which it is the owner of a trade-mark registration for the identical trade-mark. As a result, the Complainant's ability to advertise its business to the Canadian market is being unfairly interfered with. This is particularly so as the use of a website is the very means through which the Complainant offers its information and services to customers.

In my opinion, the Complainant has put forward sufficient evidence to establish the inference that the Registrant registered the Domain Name because he was aware of the Complainant's well-established trade-mark rights and intended to and has in fact disrupted the Complainant's business in so doing. In particular, it is reasonable to infer that when internet users encountering the Domain Name will be misled into believing that the Registrant's business associated with the Domain Name is a business of the Complainant, or at least endorsed, sponsored or approved by

²*CBC v. William Quon*, BCICAC, Case No. DCA 681-CIRA, 2003.

³ *The Toronto Dominion Bank v. TM Watchdog*, BICCAC, Case No. 00048, 2005. See also: *I.O.F. v. Noredu Enterprises Canada Inc. (Forester College of Technology)*, Resolution Canada, Case No. 00017, 2004 and *Glaxo Group Ltd.*, *supra* note 1.

⁴See: *Lee Valleys Tools Limited v. Pilfold Ventures Inc.*, Resolution Canada, 2005.

the Complainant. As a consequence, the Complainant's business reputation is unfairly put at risk by the Registrant's business conduct, over which the Complainant has no control.

(c) The Registrant is a "competitor"

Policy sub-paragraph 3.7(c) requires in addition that the Registrant be a "competitor" of the Complainant. It has been held in past proceedings brought under the Policy that "a competitor is someone who acts in opposition to another, including competing for internet users, and that there is no requirement that the registrant be a commercial business competitor or someone that sells competing products."⁵

On the facts before us, the Registrant is a "competitor" of the Complainant. That is, by providing links to providers of care services that compete with the services provided by the Complainant, the Registrant has made himself a competitor of the Complainant. In any case, the Registrant is clearly competing for internet traffic with the Complainant since his use of the domain name that is identical to the Complainant's mark is likely to cause confusion that the Complainant's website can be accessed through <sittercity.ca>.⁶

As a result of the foregoing, the Panel is of the opinion that the Complainant has met its burden of proving, on a balance of probabilities, that the Registrant has acted in bad faith.

4. No Legitimate Interest in the Domain Name

The Complainant must provide "some evidence" that the Registrant has no legitimate interest in the Domain Name, as described in Policy paragraph 3.6. If the Complainant satisfies this evidentiary burden, the onus shifts to the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the challenged domain name. The Panel is of the opinion that the Complainant has provided sufficient evidence to discharge its burden.

Legitimate interest is found "if, and only if," before the Complaint was filed, the Domain Name meets the criteria of one or more of the six instances set out in the Policy. Policy paragraph 3.6 sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It provides as follows:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

- (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

⁵*Glaxo Group Ltd, supra* note 1.

⁶ The Panel notes that this approach is consistent with the analyses found in *Bell Canada v. Archer Entreprises*, BCICAC, Case No. 00038; *Great Pacific Industries Inc v. Ghalib Dhalla*, BCICAC, Case No. 00009; and *Glaxo Group Ltd., supra* note 1.

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.

In paragraphs 3.6 (b), (c), and (d) "use" by the Registrant includes, but is not limited to, use to identify a web site.

The legitimate interest criteria set forth in Policy paragraphs 3.6(a), (b), (c), and (d) are satisfied only if the Registrant's use was in "good faith", a term which is not defined by the Policy.

The Complainant has put forward evidence that the Registrant does not satisfy any of the requirements of paragraph 3.6 and therefore does not have a legitimate interest in the Domain Name. In particular, the Complainant has put forward evidence to show that the Domain Name was not a Mark in which the Registrant had rights; that the Domain Name was neither the generic name for nor descriptive of the Registrant's services; that the website did not constitute non-commercial activity; and that the Domain Name was not the Registrant's name or the geographical location of the place where he provides services.

Accordingly, the onus shifts to the Registrant to prove, on a balance of probabilities, that he has a legitimate interest in the Domain Name. However, given that this matter is being determined in the absence of a response by the Registrant, the Registrant has provided no basis on which to discharge its onus.

As a result, the Panel is satisfied that the Complainant has provided sufficient evidence to demonstrate that the Registrant has no legitimate interest in the Domain Name.

Conclusion and Decision

The Complainant has proven, on a balance of probabilities, that the Domain Name is Confusingly Similar to the Mark and that the Registrant registered the Domain Name in bad faith as described in paragraphs 3.4 and 3.7(c) of the Policy, respectively. Furthermore, the Complainant has adduced sufficient evidence to demonstrate that the Registrant has no legitimate interest in the Domain Name as described in Policy paragraph 3.6.

For these reasons, the Complaint is successful and the Panel orders and directs that the registration of <sittercity.ca> be transferred to the Complainant by the Registrar, Go Daddy Domains Canada, Inc.

Patrick D. Flaherty

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Patrick D. Flaherty

Sole Panelist

Date: September 20, 2011

