

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-1444-CIRA
Domain Name: <www.chicos.ca>
Complainant: Chico's Brands Investments, Inc.
Registrant: Veronica Jouaneh
Panel: David Wotherspoon (Chair), Elizabeth Cuddihy and John Rogers
Service Provider: British Columbia International Commercial Arbitration Centre (BCICIA)

DECISION

A. THE PARTIES

1. The Complainant is Chico's Brands Investments, Inc. (the "Complainant."). The Complainant is a specialty retailer of private branded clothing, footwear, headwear and accessories, whose principal office is located at 11215 Metro Parkway, Fort Myers, Florida, 33966, USA. The Complainant is represented by Eric Macramalla of the law firm Gowling Lafleur Henderson LLP located in Ottawa, Ontario.
2. The Registrant is Victoria Jouaneh (the "Registrant"). The Registrant is an individual, whose principal residence is located at 206 Roadhouse Blvd., Newmarket, Ontario, L3X 3KP. The Registrant is represented by Marcel Naud of the law firm ROBIC LLP in Montreal, Quebec.

B. THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue is <chicos.ca> (the "Domain").
4. The Domain was registered on April 4, 2007.
5. The Registrar of the Domain is Namespro Solutions Inc.

C. PROCEDURAL HISTORY

6. On December 6, 2012, the Complainant submitted a complaint (the "Complaint") to The British Columbia International Commercial Arbitration Centre ("BCICAC") as service provider pursuant to paragraph 1.5 of the Canadian Internet Registration Authority ("CIRA") Domain Name Dispute Resolution Policy v. 1.3 (the "Policy").
7. The Registrant submitted a response (the "Response") to BCICAC on January 15, 2013.
8. BCICAC selected David Wotherspoon, Elizabeth Cuddihy and John Rogers as panelists for this Complaint. David Wotherspoon was selected as the Chair.

E. FACTUAL BACKGROUND

9. The Complainant is the owner of two Canadian registered trade-marks: (i) CHICO'S, which was registered as number TMA561683 on May 9, 2002 in association with women's clothing; and (ii) CHICO'S PASSPORT, which was registered as number TMA561682 on May 9, 2002 in association with credit card discount services and retail clothing.
10. The Complainant's retail company was founded in 1983 and is now a publicly traded company on the New York Stock Exchange. The Complainant sells and advertises its products for sale on the website www.chicos.com. The Complainant has recorded sales of \$2.2 billion in 2001 and approximately \$5.8 billion since 2009.
11. The Registrant registered the Domain chicos.ca on April 4, 2007. The Domain is inactive, but the Registrant uses the Domain for email purposes.
12. The evidence demonstrates that the Registrant is an individual who is a stay-at-home mother with 5 children under the age of 7. The Registrant registered the Domain because her intent was to use the name to create a website for her family pictures. Her interest in the Domain was tied to the nickname "chicos" that the Registrant used to describe her five children to family and friends.
13. The Registrant holds one other domain name, namely <dallasmeetings.ca>.
14. In an email dated July 17, 2012 the Complainant, through counsel, informed the Registrant of its prior rights in the CHICO'S Mark and requested that the Registrant cease and desist from using the Domain.
15. The Registrant replied on July 27, 2012 asserting that the claims were invalid.
16. The evidence demonstrates that several emails were exchanged between the parties. On September 27, 2012, the Registrant wrote to counsel for the Complainant, Eric Macramalla, stating the reasons for interest in the Domain and the refusal to transfer the Domain to anyone.

F. COMPLAINANT'S SUBMISSIONS

17. The Complainant submits that the Registrant registered the disputed Domain in an attempt to attract for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade-mark CHICO'S Mark as to source of sponsorship.
18. The Complainant asserts that the Domain is identical to the Complainant's trade-mark and thus meets the standard to be considered confusingly similar.
19. The Complainant further asserts that it had rights to the mark prior to the registration of the Domain, and continues to have rights, under the CHICO'S Mark, and thus that the Domain meets the standard under paragraph 3.1(a) of the Policy.

20. The Complainant further asserts that the Registrant has no legitimate interest in the Domain as described in paragraph 3.4 of the Policy. The Complainant adds that there has never been any relationship between the Complainant and the Registrant and that the Registrant has never been licensed, or authorized to register or use the CHICO's Marks. The Complainant states that the Domain was not acquired in good faith or for a *bona fide* purpose and thus the Registrant cannot have a legitimate interest in the Domain as it has never been licensed or authorized to register the subject of the Domain. Further, the Domain falsely suggests a connection with the Complainant.
21. The Complainant finally asserts that the Domain was registered in bad faith, in line with paragraph 3.5(d) of the Policy and submits that the Registrant intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the CHICO'S trade-mark as to the source, sponsorship, affiliation or endorsement. The Complainant asserts that while the Domain is currently inactive, if it were ever put to use, it would likely result in potential consumers being confused or misled into believing the Registrant is somehow affiliated with, or endorsed by, the Complainant.
22. The Complainant seeks that the Domain be transferred from the Registrant to the Complainant.

F. REGISTRANT'S RESPONSE

23. The Registrant acknowledges that the Domain is confusingly similar to the CHICO'S Trade-mark. The Registrant assert however that this issue is not determinative of bad faith or legitimate interest with respect to the Domain since the CHICO's Trade-mark consists of a term with a generic meaning in the Spanish language.
24. Given the generic meaning of the Domain, the Registrant asserts that the confusing similarity cannot be relied upon to prove or infer that the Registrant knew about the Complainant or of its CHICO's Trade-mark, or its business when she registered the Domain. For the same reason, it should not be inferred that the Registrant registered the Domain in bad faith within the meaning of paragraph 3.5 of the Policy. The Registrant relies on the decision *UAP Inc. v. Jim Strater*, [CIRA-00154](#) regarding when it is appropriate to infer knowledge of a trade-mark at issue and how or why a registrant may come to adopt a domain name confusingly similar to a trade-mark.
25. The Registrant further asserts that the burden is on the Complainant to show bad faith, yet the Complainant has provided no evidence and made no argument regarding paragraph 3.5 (a), (b) and (c) of the Policy.
26. The Registrant says she has not used the Domain in association with a website, but that she uses it in association with one of her personal email addresses. The Registrant asserts that the inactivity of a domain name combined with a reasonable explanation of the reason for registration of the Domain Name leads to the conclusion that the registration was not made in bath faith and was made with a legitimate interest. The Registrant relies on UDRP decision *The Knot, Inc. v. Julia Bitton, The Nest*, D2006-0377 to list

circumstances which indicate a registrant's good faith use of a domain name. These circumstances include when the domain name reflects the registrant's nickname, if the registrant did not use the domain name in any way that references the complainant or its business, and that there are no circumstances to suggest the registrant has any antipathy towards the complainant or any motive to disrupt its business.

27. The Registrant notes that the Complainant's interest in the Domain coincides with the filing of a new trade-mark application by the Complainant for CHICO's in association with jewelry and footwear. The Registrant believes that the Complainant is attempting to gain rights in a domain name that matches its Trade-mark, but it neglected to register when it was available.
28. The Registrant asserts that while evidence that a domain name is not associated with an active website may satisfy the complainant's burden of proving some evidence that a registrant has no legitimate interest in a domain name, it should not be considered conclusive of whether a registrant, in fact, has a legitimate interest or not in that domain name. The Registrant submits that the Complainant has failed to provide some evidence that the Registrant has no legitimate interest in the Domain Name.
29. The Registrant finally asserts that even if the Panel was to find that the Registrant has no legitimate interest in the Domain, and that it is confusingly similar to the CHICO's Trade-mark, it should not be lead automatically to a conclusion of bad faith. According to the Registrant, the Complainant has not met all the requirements found at paragraph 4.1 of the Policy.
30. The Registrant therefore submits that the transfer of the registration requested be refused.

G. DISCUSSION AND FINDINGS

31. The Onus for the Complainant to succeed in the Proceeding is a heavy one. According to paragraph 4.1 of the Policy, the Complainant must prove on a balance of probabilities that:

(a) The Registrant's dot-ca Domain is confusingly similar to a Mark in which the Complainant has Rights prior to the date of the 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 paragraph 3.5 of the Policy;

and the Complainant must provide some evidence that:

(c) The Registrant has no legitimate interest in the Domain 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

32. It is not up to a registrant to justify its actions if it registers first. The Policy is based on the principle that the first to register the domain, gets priority over the domain. A complainant does not have automatic rights to a domain name simply because it registered the trade-mark earlier than the registrant registered the domain name. A complainant must establish its rights to the domain name.

Confusingly similar

33. At paragraph 3.2 of the Policy, a “Mark” is defined:

3.2 Mark. A “Mark” is:

...

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO;

34. Given the evidence presented by the Complainant, the Panel finds that it has established that CHICO’S is a “Mark” under the definition in paragraph 3.2(c) of the Policy.
35. For the purpose of determining whether a domain name is confusingly similar to a mark, paragraph 1.2 of the Policy indicates that the “dot-ca” suffix of the domain name should not be considered. Absent the “dot-ca” suffix, the Complainant’s trade-mark and the Domain are identical, albeit the apostrophe in the trade-mark. The absence of an apostrophe in the Domain does not however mitigate against finding of confusion (*McDonald’s Corporation v. Lei Wang*, WIPO Case No. D2012-0624).
36. Paragraph 3.3 of the Policy 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.
37. The Domain “chicos” is identical to the Complainant’s trade-mark “CHICO’S” in sound and is confusingly similar thereto within the requirements of the Policy.
38. The Registrant acknowledges that the Domain is confusingly similar to the CHICO’S trade-mark.
39. The Complainant’s registration of its trade-mark on May 9, 2002 pre-dates the registration date of the Domain on April 4, 2007.
40. The Panel therefore finds that the Complainant has met its burden under paragraph 3.1(a) that the Registrant’s Domain is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the Domain.

Legitimate interest

41. Paragraph 3.4 of the Policy lists 6 non-exclusive criteria upon which the Panel may find, upon all the evidence, that the Registrant has a legitimate interest in the Domain:
 - (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 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.
42. The Panel finds that under paragraph 3.4(d), the Registrant used the Domain in Canada in good faith in association with a non-commercial activity, namely as a personal email address.
43. The Panel finds that under paragraph 3.4(e), that the Registrant has provided evidence for using a Domain which comprised a reference by which the Registrant identifies her children.
44. The Registrant has provided sufficient evidence for a finding of legitimate interest.
45. In the result, the Panel finds that the Registrant has a legitimate interest in the Domain.

Bad faith

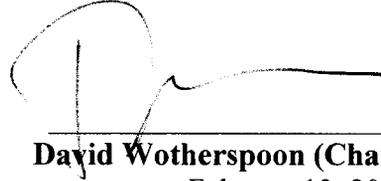
46. Prior to the amended Policy on August 22, 2011, then paragraph 3.7 of the Policy mandated that a Registrant will be considered to have registered a Domain in bad faith *if and only if* the Panel found that the Registrant's conduct fell within one of the enumerated sub-paragraphs of 3.7.

47. The August 22, 2011 revision of the Policy reduced this burden to manageable proportions.
48. Paragraph 3.5 of the current Policy now provides that the Registrant has registered a domain name in bad faith if any of the following circumstances, in particular but without limitation, are found by the Panel:
 - (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;
 - (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; or
 - (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.
49. The Panel finds from the Registrant's evidence that none of the circumstances listed in 3.5(a) through (c) apply.
50. The Complainant submits that the Registrant's registration supports a finding under paragraph 3.5(d) because the Domain is identical to the Mark. If the Domain was ever put to use, it would likely result in potential CHICO'S consumers being confused or misled into believing that the Registrant was somehow affiliated with, or endorsed, by the Complainant.
51. The Complainant further argues that inactivity of a domain name that incorporates a third party trade-mark may support a finding of bad faith.
52. The Registrant registered two domain names, namely chicos.ca and dallasmeeting.ca. Neither the Complainants, nor the Registrant have provided evidence pertaining to the domain registered as dallasmeeting.ca. The Panel can therefore only assess the use of the domain chicos.ca.

53. The terms “chico” and “chicos” are Spanish words with the generic meaning of “ young kid”. This term reflects the term of endearment the Registrant uses for her children. The Domain was chosen to reflect this reference to her children. It was chosen for independent reasons and does not support a commercial-use.
54. The Complainant relies upon the decision *Credit Counselling Society of British Columbia v. Solutions Credit Counselling Service Inc.*, BCICAC Case No. 00031 to assert that bad faith exists when a registrant intentionally attempts to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion with an already registered trade-mark. In this case, the registrant was found to be aware of the use by the Complainant and the registrant did not deny its knowledge and admitted to it. The registrant in this case did not provide any explanation for its registration of the domain name. It was therefore concluded that the domain name was registered with the view of attracting to itself business from those who had come to recognize the complainant’s mark and that this was for the purpose of disrupting the business of the complainant.
55. The Complainant equally relies upon the UDRP case *Hewlett-Packard Company v. Marcel Wieland*, NAF, Case No. FA95852 to demonstrate that a finding of bad faith can be made even if the disputed domain name did not resolve in an active site if it will result in consumer confusion. In this case it was decided that a finding of bad faith could be made where a respondent fails to provide any evidence to controvert a complainant’s allegation that it registered the domain name in bad faith and where any future use of the domain name would do nothing but cause confusion with the complainant’s mark, except in a few limited non-commercial or fair use situations.
56. The Panel finds that the cases relied upon by the Claimant are distinct from the case at hand. In both the cases mentioned above, the disputes involved a commercial use of the domain name. In the case at hand, the Domain is used for a non-commercial. Further, the Registrant has submitted evidence, such as the email correspondence between counsel for the Claimant and the Registrant demonstrating that the Registrant was unaware of the CHICO’s Trade-mark until she was contacted by the Complainant’s legal counsel. In the email correspondence, the Registrant provided reasons for her registration of the Domain. The Registrant’s evidence indicates that she was in fact unaware of the use by the Complainant when she registered the Domain and that she did provide an explanation for registration of that particular domain name. The Complainant has provided no evidence of the sort that the Registrant registered the Domain with the view of attacking the Complainant’s business.
57. Taking the evidence together, the Panel finds that the Complainant has not established on a balance of probabilities that the Registrant registered the Domain for the purpose of disrupting the business of the Complainant. The Complainant has not established on a balance of probabilities, in line with paragraph 3.5 of the Policy, that the Registrant registered the Domain in bad faith.

H. CONCLUSION AND DECISION

58. The Panel has found that the Complainant has not met the burden under paragraph 4.1 of the Policy. In particular, it is not demonstrated on a balance of probabilities that the Registrant has registered the Domain in bad faith.
59. The Panel accordingly finds that the Complainant has not established its claim, and should not have the order that it seeks.
60. Given the above, the Panel declines to make any order with respect to the Domain.



A handwritten signature in black ink, appearing to read 'David Wotherspoon', is written over a horizontal line. The signature is stylized with a large initial 'D' and a long horizontal stroke.

David Wotherspoon (Chair)
February 13, 2013