

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

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| Complainant: | Dixie Consumer Products LLC |
| Complainant's counsel: | Antonio Turco |
| Registrant: | Xavier Alexander |
| Panel: | Barry C. Effler |
| Service Provider: | British Columbia International Commercial Arbitration Centre |
| BCICAC File Number: | DCA-1592-CIRA |

DECISION

The Parties, Domain Names and Registrar

1. The Complainant is Dixie Consumer products LLC, whose principal office is in Atlanta, Georgia.
2. The Registrant is Xavier Alexander, with an address in Toronto, Ontario.
3. The Domain Name at issue in this dispute is **dixie.ca**.
4. The Registrar is CA Registry.
5. The Domain name was registered by the Registrant on January 27, 2004.

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 July 25, 2014:

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

On May 28, 2014 the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.

The Complaint was reviewed and found to be compliant. By letter and email dated May 30, 2014 the Centre so advised the parties and forwarded a copy of the Complaint to the Registrant by FedEx. (confirmation is attached).

The Registrant did not file a response by June 19, 2014 pursuant to CIRA Rule 5.1. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

The Centre advised the Registrant that the registrant may send a written request to accept the late response, which will be forwarded to the appointed arbitration panel. It will be up to the sole discretion of the panel to elect to accept the late submission.

The Centre hereby appoints you, Barry C. Effler, LL.B., LL.M., C. Arb., as sole arbitrator in the above-referenced matter.

7. As required by paragraph 7.1 of the Rules, I have declared to BCICAC that I can act impartially and independently in this matter as there are no circumstances known to me which would prevent me from so acting.
8. I am 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

9. I have reviewed the material submitted by the Complainant and am satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy. It is the owner of a registered Canadian trade-mark in which the exact word component of such trade-mark is the same as the Domain name in dispute.

Relief Requested

10. The Complainant requests that the Domain Names in dispute be transferred from the Registrant to the Complainant.

Applicable Law

11. As directed by paragraph 12.1 of the Rules, I will render my decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

Background Facts

12. Background facts alleged by the Complainant and accepted by me as probative are quoted here from the Complaint:

15. Headquartered in Atlanta, Georgia, U.S.A. , the Complainant is one of the world's most widely recognized and respected manufacturers and marketers of cups, plates, cutlery, bowls, napkins, dispensers and related tabletop items.

16. For nearly one hundred (100) years, Complainant has offered consumer products, including, among other items, plates, cups, bowls, cutlery, napkins, dispensers and related tabletop items under the famous and well-known DIXIE Trade-mark....

17. The Complainant is the owner of the DIXIE Trade-mark in many countries around the world, including Canada. The Complainant uses the DIXIE Trade-mark in connection with sales of the DIXIE Products. . . .

18. To date, Complainant has spent many millions of dollars in promoting its DIXIE Products in association with the Trade-mark. These marketing and advertising efforts include national and international television, radio, print and Internet campaigns. The Complainant also maintains an active presence at trade shows and conferences.

19. To promote its DIXIE Products, since at least as early as 2005, the Complainant has maintained an active Internet presence. The Complainant is the registrant of the domain name dixie.com, which is the Complainant's main website for the company.

. . . .

21. The Registrant registered the Domain Name on January 27, 2004 and thereafter began to operate a corresponding website under the Domain Name. To the knowledge of the Complainant, the Domain Name previously resolved to a "parked" website that displayed a number of advertisements and hyperlinks under the heading "Sponsored Listings". . . .

22. The hyperlinks on the Registrant's Website linked to various websites, including to third party providers of products which compete with the DIXIE Product, such as cup dispensers and coffee cups. Specifically, the "Sponsored Listings" included links to direct competitors of the Complainant, such as Eco-Packaging. These third party providers are not affiliated with the Complainant and provide wares which compete with the DIXIE Product

23. In addition, . . . , at some points the Registrant's Website also displayed links to the Complainant or its Products. . . .

24. On September 24, 2013, the Complainant, through its solicitors, put the Registrant on notice of the Complainant's rights in its DIXIE Trade-mark, and its intent

to assert and protect these rights, by the Complainant's correspondence dated September 24, 2013 sent using the CIRA Message Delivery Form. No response was received by counsel for the Complainant. . . .

25. After the correspondence was sent on September 24, 2013, the Registrant modified the content on the Website to no longer contain the links to third parties, but at least as of December 2, 2013, the Website instead contained a solitary link inviting internet users to "contact the owner of this domain". Internet users clicking the link are then redirected to a website where users can make an offer to purchase the Domain Name. . . .

26. More recently, as of the date of filing this Complaint, the Registrant has again modified the Website to remove all active content.

. . . .

37. The Domain Name is identical to the DIXIE Trade-mark as it wholly incorporates the DIXIE Trade-mark and no additional distinguishing features. The Registrant has never been licensed or authorized to use the DIXIE Trade-mark in any manner.

38. The Registrant, at the date of the registration of the Domain Name, had no rights in the DIXIE Trade-mark, and continues to have no rights in the DIXIE Trade-mark. . . .

13. The Complainant submitted evidence that it is the owner of numerous trade-marks throughout the world. Of particular relevance to this dispute, the Complainant is the owner of the several registered Canadian trade-marks for different wares and services:

- (a) UCA 19833 for the word "DIXIE", registered July 20, 1944 (date of first use in Canada June 17, 1917);
- (b) TMA 614,765, registered July 13, 2004 for the word "DIXIE" (use in Canada since at least as early as June 30, 2002 on wares);
- (c) TMA 830,769, registered August 28, 2012 for the word "DIXIE" (used in Canada since at least as early as January 31, 2004).

Discussion and Findings

14. Policy paragraph 4.1 sets forth the onus on a complainant. It provides 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.

15. The Policy provides a definition of the term "Mark" (but as amended no longer defines Rights):

3.2 **Mark.** *A "Mark" is:*

(a) *a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person's predecessor in title, 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; ...*

16. The Complainant is the owner of a registered Canadian trade-mark in which the exact word component exactly matches the Domain Name excluding the dot ca portion of the domain name. The Complainant established that it has rights in a trade-mark that was

a “Mark” prior to the date on which the Domain Name was registered. One trade-mark was registered significantly earlier than the January 27, 2004 date of registration of the Domain Name. (see paragraph 13, above for details.)

17. The relevant definition of “Mark” requires that a trade-mark be “used”. The term “use” is no longer defined in the Policy. As indicated in the Background Facts set out above, the Complainant has been advertising and selling its products using one or more of the registered trade-marks since at least 1917 and all three trade-marks referenced in paragraph 13, above, were in use prior to the date of registration of the Domain Name. The Complainant therefore meets this requirement.
18. I am satisfied that the Domain Name is confusingly similar to the Complainant’s Mark. The relevant key word “DIXIE” in the Domain Name is the same word as in the Mark, with the exclusion of the dot ca in the Domain Name.
19. I am satisfied that the Complainant has established bad faith by the Registrant for the purposes of paragraphs 4.1 of the Policy by showing circumstances meeting paragraphs 3.5 (d) of the Policy.

Paragraph 3.5 of the Policy:

3.5 Registration in Bad Faith. *For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:*

...

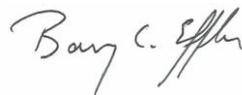
(d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website or other on-line location, by creating a likelihood of confusion with the Complainant’s Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant’s website or location or of a product or service on the Registrant’s website or location.

20. The Complainant's evidence is that "The hyperlinks on the Registrant's Website linked to various websites, including to third party providers of products which compete with the DIXIE Product, such as cup dispensers and coffee cups. Specifically, the "Sponsored Listings" included links to direct competitors of the Complainant, such as Eco-Packaging. These third party providers are not affiliated with the Complainant and provide wares which compete with the DIXIE Product . . . (Complaint, paragraph 22).
21. The Complainant states it has no business relationship with the registrant, see paragraph 37 of the Complaint quoted under Background Facts, above.
22. There is no evidence that any of the circumstances outlined in paragraph 3.4 of the Policy regarding legitimate interest apply. I am satisfied on a balance of probabilities that the Registrant has no legitimate interest in the Domain Name as it has no business relationship with the Complainant and there is no evidence of any other form of legitimate use by the Registrant.
23. I am satisfied that the Complainant has met the onus on it to succeed, as required by paragraph 4.1 of the Policy.

Order

24. For the reasons set forth above, I order the Domain Name in issue to be transferred to the Complainant.

Dated: August 14, 2014



Barry C. Effler, LL.B., LL.M.
Sole Panellist