

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

Complainant:	Moncler S.p.A.
Complainant's counsel:	Luca Barbero
Registrant:	Michael Cohen
Panel:	Barry C. Effler
Service Provider:	British Columbia International Commercial Arbitration Centre
BCICAC File Number:	DCA-1628-CIRA

DECISION

The Parties, Domain Names and Registrar

1. The Complainant is Moncler S.p.A.
2. The Registrant is Michael Cohen.
3. The Domain Name at issue in this dispute is **moncler.ca**.
4. The Registrar is Namespro Solutions Inc.
5. The Domain name was registered by the Registrant on August 19, 2007.

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 January 5, 2015:

On December 3, 2014 the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.

In a letter dated December 4, 2014, the Centre as Service Provider, confirmed compliance of the complaint and commencement of the dispute resolution process.

As the Complaint with the attachments was filed exclusively online, therefore, the Centre delivered the Complaint to the Registrant only by email.

The Registrant has not provided a Response. 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 hereby appoints you, Barry Effler LL.B., LL.M., C, Arb. (Fellow), 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 Name 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:

Complainant in the present proceeding is Moncler S.p.A., one of the leaders in the field of luxury outerwear and sportswear....

Complainant has registered the trademark MONCLER since as long as 1963 and has been using it in more than 100 Countries for more than 50 years in connection with its products. Complainant registered the trademark MONCLER also in Canada and the first application dates as far back as 1964.

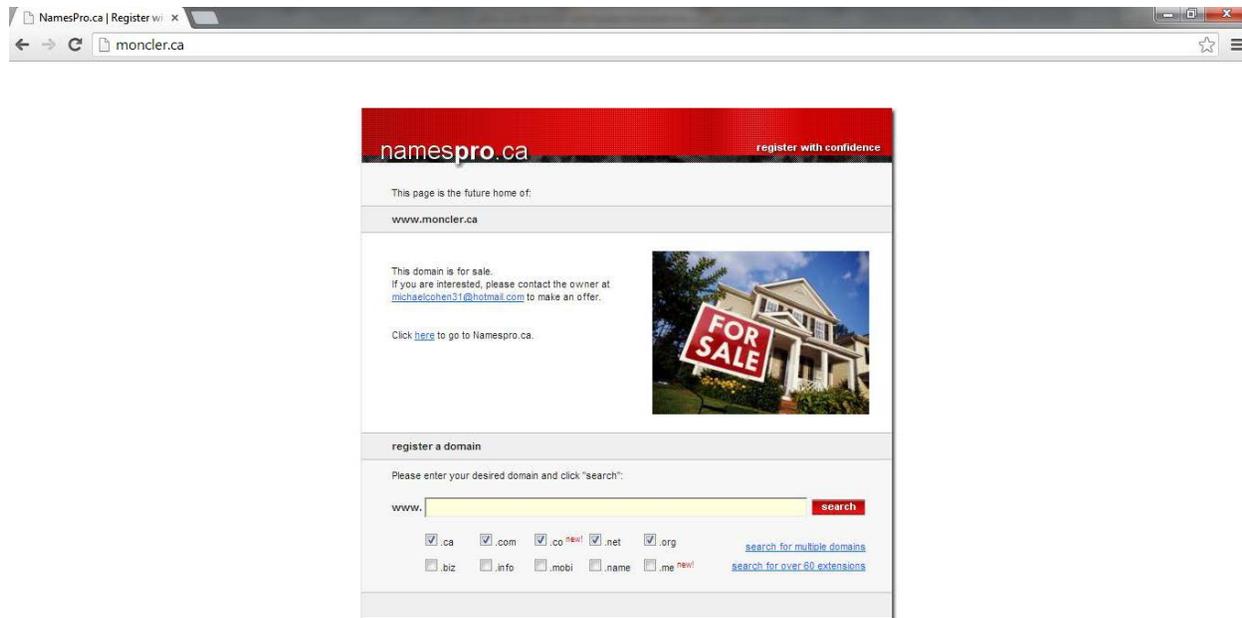
...

[T]he trademark MONCLER was and presently is strongly supported by global and local advertising campaigns. To provide the Panel with some figures indicatives of the advertisement investments undertaken by Complainant in Canada the volumes of advertisement in such Country for the Fall Winter season in year 2014/15 is estimated around 83.000 Euros.

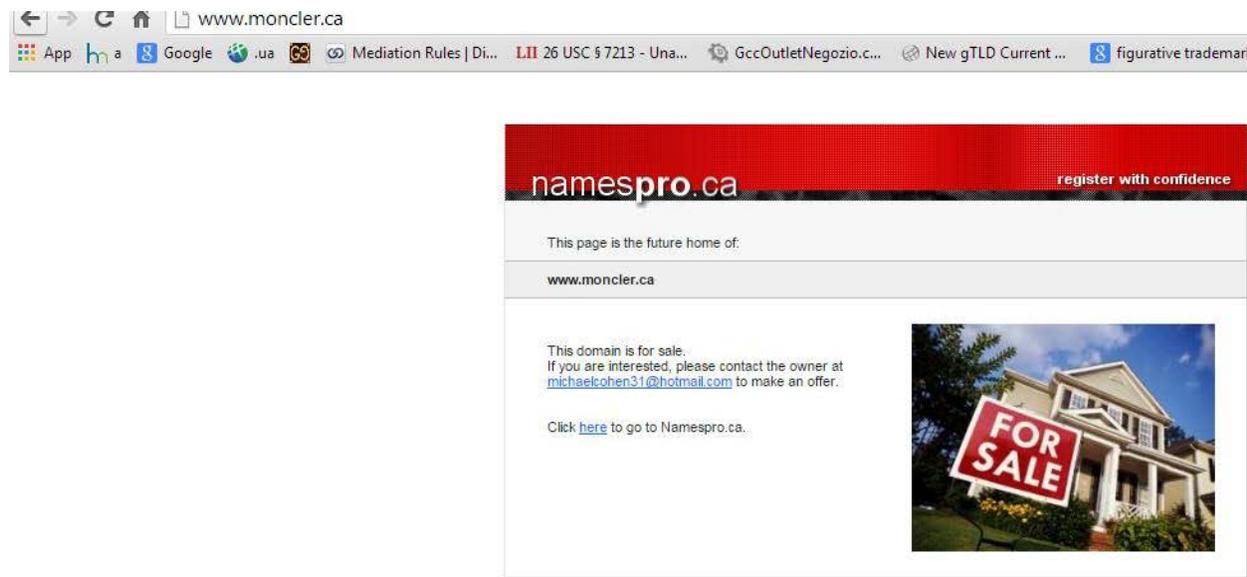
In light of the Complainant's significant investments in R&D, marketing, sales and distribution channels, as well as the existence of a truly impressive client base for these products, MONCLER is undisputedly a famous and well-known trademark worldwide, and also in Canada.

...

The Registrant registered <moncler.ca> without authorization of Complainant on August 19, 2007 and the Domain Name, at the time Complainant became aware of its registration, was redirected to a page publishing a notice that the domain name was available for sale



At the time of drafting of the present Complaint, the Domain Name is still redirected to a website publishing the notice that the Domain Name is offered for sale (see below)



Complainant became aware of such infringing registration and use of the Domain Name on January 29, 2013 when the Registrant contacted Complainant from his email address michaelcohen.gti@gmail.com with an unsolicited letter in order to offer for sale the domain name, . . . , stating:

"Hi Sir,

My name is Michael Cohen and I own the domain name www.moncler.ca. I would like to inform you that I have been offered a very important amount of money to sell

this domain name to a clothing company that wants to build a website specializing in selling winter coats and jackets. The reason I am contacting you is by respect to your brand name and to give you the opportunity to do business with me in any other ways. One of my desires would be to be able to build my own website affiliated to yours and be Moncler's agent for online sales in Canada.

Let me know what you think.

Regards,
Michael Cohen"

Complainant addressed subsequently, on November 14, 2013, a communication to the Registrant, aimed at ascertaining his intentions as to the Domain Name and at acquiring information on which were his projects related to <moncler.ca> and the possible availability and conditions to assign it. (Annex 5.2)

Respondent replied on November 17, 2013 (Annex 5.3) to said communication, stating:

"Hello, I already have a firm offer from a website that sells brand new Moncler coats, for 275,000\$. I need to take a decision in the coming weeks. Please let me know shortly if you have a more interesting offer.

Thank you,
Michael Cohen "

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 registered Canadian trade-mark numbers

- Canadian Trademark Registration for "MONCLER" (word mark) N. TMA142719 filed on November 27, 1964, registered on 19 November 1965, and duly renewed ...;
- Canadian Trademark Registration for "MONCLER" (word mark) N. TMA738848 filed on May 17, 2007 and registered on April 27, 2009 ...;
- Canadian Trademark Registration for "MONCLER" (word mark) N. TMA196935 filed on October 24, 1972 registered on January 25 1974, and duly renewed....

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. The trade-marks were all registered significantly earlier than the August 19, 2007 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 lines of sportswear using one or more of the registered trade-marks since at least 1964. 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 “MONCLER” 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 (a) 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:*

(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;

20. The Complainant’s evidence is that the Registrant wrote to the Complainant inviting the Complainant to make an offer to purchase the Domain Name in an amount greater than

\$275,000, the amount the Registrant was indicating he had already been offered for the Domain Name. This evidence meets the requirements of Paragraph 3.5 (a).

21. The Complainant has established evidence to meet the tests set out in Paragraph 4.1 (a) Confusing similar domain name to a trademark of the Complainant and (b) evidence of bad faith by the Registrant.
22. The Complainant appropriately disclosed to the Panel the correspondence between the Complainant's legal counsel and legal counsel representing the Registrant. One letter relevant to the determination of whether the Registrant may have a legitimate interest as set out in Paragraph 3.4 is a dated August 2, 2014 from Registrant's counsel to Complainant's counsel:

Dear Colleague,

Contrarily to your allegations, we reassert our client's legitimate intention when he acquired the domain name moncler.ca, such acquisition was made in good faith with no intent of selling it to your client for a higher price than his purchase price, or to any other this party for that matter.

The fact that it was listed "for sale" by his webhost is a complete error he had no knowledge of until your last email and our client is now seeking correction of same. He had no interest in selling it to any third party nor did he want his name and email to be publicly displayed.

We reiterate that our client had legitimate interests when registering the said domain name and still does as of this day as he is in the transport industry, which is far different from the industry of your client, and have completely different channels of business. He is still developing his business project and intends to use the domain name shortly.

In the meantime no active use has been demonstrated.

At no point has my client infringed your client's rights and our client has no intention to do so.

Our client would have no issue establishing his legitimate interest and his good faith before a court of law.

Our client is the rightful owner of the domain moncler.ca, but wishes to settle this matter amicably, to limit costs and delays. Our client is disposed to sell it

to yours at a price that is agreeable to both parties and invite your client to offer such price that he deems reasonable.

Please be sure that should your client pursue this matter further, our client has every intention of asserting his own rights and claims in a vigorous contestation of same.

Regards,

23. The Registrant has chosen to not participate in these proceedings and accordingly has not provided any evidence to the Panel in support of his position. His counsel in the letter above asserted that the offering of the Domain name for sale was an error and that he was seeking to correct that error. The evidence does not support this assertion. The Domain Name was still being offered for sale on December 3, 2014 when the Complainant filed its complaint. Further, the November 17, 2013 letter from the Registrant to the Complainant clearly is making an offer to sell the Domain Name for an amount far in excess of the reasonable costs of registering the Domain name.

24. The Registrant's counsel also indicated:

We reiterate that our client had legitimate interests when registering the said domain name and still does as of this day as he is in the transport industry, which is far different from the industry of your client, and have completely different channels of business. He is still developing his business project and intends to use the domain name shortly.

25. There is no evidence before this Panel that Mr. Cohen is in the transportation industry or that he has any business project that would make legitimate business use of the Domain Name. Further, Mr. Cohen's letter of January 29, 2013 stated a different purpose "One of my desires would be to be able to build my own website affiliated to yours and be Moncler's agent for online sales in Canada."

26. The test in paragraph 4.1 of the Policy is

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

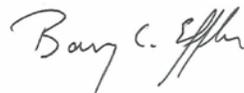
Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

27. An assertion by legal counsel unsupported by any evidence is not sufficient to establish a legitimate interest. The Complainant has met the onus to establish its case for the purposes of meeting the confusingly similar and bad faith requirements of paragraph 4.1 (a) and (b). The onus is on the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the Domain Name.
28. There is no evidence that any of the circumstances outlined in paragraph 3.4 of the Policy regarding legitimate interest apply and I am satisfied that the Registrant has no legitimate interest in the Domain Name.
29. I am satisfied that the Complainant has met the onus on it to succeed, as required by paragraph 4.1 of the Policy.

Order

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

Dated: January 26, 2015



Barry C. Effler, LL.B., LL.M., C. Arb. (Fellow)
Sole Panellist