

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

<b>Complainant:</b>	<b>Coulisse B.V.</b>
<b>Complainant's counsel:</b>	Richard S. Levy, De Grandpre Chait LLP
<b>Registrant:</b>	Diane Duplessis
<b>Panel:</b>	Barry C. Effler
<b>Service Provider:</b>	British Columbia International Commercial Arbitration Centre
<b>BCICAC File Number:</b>	DCA-1818-CIRA

**DECISION**

**DECISION SUMMARY:**

There is no inherent right given to trade-mark holders under the Rules and Policy to own dot ca domain names that include words that they have trade-marked.

The Complainant has a registered trade-mark registered well after the date of registration of the Domain Name and a date of use predating the registration of the Domain Name.

The Registrant is not a competitor of the Complainant and has owned the Domain Name for eight years and made no use of it.

A panel must look at all of the evidence available to it in order to determine if a domain name has been registered in bad faith. This should include an analysis of whether the registrant has demonstrated any legitimate purpose for the registration or if there are any possible legitimate uses. A significant factor may be whether the word portion of the trade-mark is actually a word in another language.

The onus is on the Complainant to prove bad faith and it has not done so.

**The Parties, Domain Names and Registrar**

1. The Complainants is Coulisse B.V. of The Netherlands.
2. The Registrant is Diane Duplessis of New Brunswick, Canada.
3. The Domain Name at issue in this dispute is **COULISSE.CA**.
4. The Registrar is Go Daddy Domains Canada, Inc.
5. The Domain Name was registered by the Registrant on September 30, 2008.

## 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 September 30, 2016:

On September 2, 2016 the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.

In a letter dated, September 6, 2016, 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 C. 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.
9. Reference to *Policy* herein means the *CIRA Domain Name Dispute Resolution Policy, version 1.3 (August 22, 2011)*. Reference to *Rules* herein means the *CIRA Domain Name Dispute Resolution Rules Version 1.5 (July 28, 2014)*.

**Eligibility of Complainant**

10. Coulisse B.V. is the owner of a registered Canadian trade-mark which it is alleging the Domain Name in dispute is the exact word component of such trade-mark. Paragraph 1.4 of the *Policy* requires that a complainant meet the Canadian Presence Requirement of the *Canadian Presence Requirements For Registrants version 1.3* “unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of the trade-mark.
11. The trade-mark in question is COULISSE and the Domain Name in dispute is COULISSE.CA which are identical as to the word portion. Accordingly I am satisfied as to the eligibility of Coulisse B.V. as a complainant.

**Relief Requested**

12. The Complainant requests that the Domain Name in dispute be transferred from the Registrant to the Complainant.

**Applicable Law**

13. 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

14. Background facts alleged by the Complainant and accepted by me as probative are quoted here from the Complaint: [edited to remove reference to exhibits provided with the Complaint for improved readability]:

Coulisse B.V., the owner of the registered mark COULISSE, was established in 1992, as an importer of product from the Far East. Since then it has grown into an international leading designer, manufacturer and supplier of window coverings for both made-to-measure products and the Do it yourself (DIY) market. Its product range comprises all possible types of window coverings - from roller, panel and vertical blinds to wood blinds, roman and pleated blinds. Its website is <http://coulisse.com>

Coulisse B.V. is headquartered in Enter, Netherlands, where it has its own design studio and technology centre. The Complainant has used the mark in Canada since as early as December 31, 2007. In 2012, Coulisse B.V established a hemispheric office in Miami Florida, where it also maintains a concept store. By the start of the second half of 2016 Coulisse B.V. has achieved sales of 50 million Euros, as indicated on its website at <http://coulisse.com/coulisse/brand-story/>

The complaint may be summarized as follows. Coulisse B.V. has used the mark in Canada since as early as December 31, 2007 which predates the creation date of the domain name, [coulisse.ca](http://coulisse.ca) on September 30, 2008....

Its registered mark COULISSE is used extensively and with great attention to detail in its marketing materials which includes: sample presentations, collection books and advertisements, as illustrated on the web page <http://coulisse.com/coulisse/marketing-team/>

The Complainant has been unable to register COULISSE.CA because the domain name is being "rented" by the anonymous holder. When COULISSE.CA is entered into a browser the search resolves to a so called "link-farm" site with the statement: FUTURE HOME OF SOMETHING QUITE COOL. When one clicks on the line beneath that, "If you're the site owner..." the page resolves to a login page of a company called cPanel. Web pages of this type will provide a link or list of links that purport to offer services. By clicking on one such link, the viewer is taken to a new page which may be only remotely connected to the service the viewer was originally searching for.

Counsel for the Complainant contacted cPanel with respect to the domain name [coulisse.ca](http://coulisse.ca) and received an email reply indicating that their relationship

is with the server where the site is hosted and not with the owner of the website....

Counsel for the Complainant then hired the registrar, Go Daddy, to get into contact with the registrant of the domain name registered by that registrar. But Go Daddy informed counsel that after 30 days of attempts it was unsuccessful in doing so.

15. The Complainant submitted evidence that it is the owner of the registered Canadian trade-mark number TMA897632, registered February 27, 2015, for the word "COULISSE" and claiming use in Canada since at least as early as December 31, 2007.

### Discussion and Findings

16. *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.*

17. 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; ...*

18. The Complainant established that it has rights in a trade-mark that was a “Mark” used prior to the date on which the Domain Name was registered. The trade-mark was registered on February 27, 2015, with a date of use of at least as early as December 31, 2007, which use is earlier than the date of registration of the Domain Name, being September 30, 2008. (see paragraph 15, above for details.)
19. 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 Complainants have claimed use since as early as December 31, 2007. The Complainants therefore meet this requirement.
20. I am satisfied that the Domain Name is confusingly similar to the Complainant’s Mark. The relevant key word “COULISSE” in the Domain Name is the same word as in the Mark, with the exclusion of the dot ca in the Domain Name. This meets the requirement of *Policy* paragraph 4.1 (a).
21. The Complainant must establish registration of the Domain Name in bad faith by the Registrant for the purposes of Paragraphs 4.1 of the *Policy*. Paragraphs 3.5 of the *Policy* outlines circumstances which if found shall be evidence that the Registrant has registered a domain name in bad faith. The paragraph expressly states that this list is without limitation.

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:*

22. I will examine each of the circumstances outlined in Paragraph 3.5 of the *Policy*.
- (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;*
23. The Complainant's evidence is:
- (a) that the Domain Name resolves to cPanel sign in page, and
- (b) attempts by the Complainant to purchase the Domain name were never responded to.
24. There is no evidence that the Registrant engaged in any of the activities outlined in Paragraph 3.5 (a) of the *Policy*. There is no attempt to sell the Domain name by the Registrant, even after inquiries requesting her to do so.
- (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;*
25. The Complainant submitted no evidence that the Registrant "*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*" as set out in Paragraph 3.5 (b). The Complainant submitted evidence about other people in countries other than Canada

who have registered other types of domain names different from dot ca using the word “coulisse” but no evidence linking the Registrant to them. There is no evidence that the Registrant owns any other domain names other than the one in dispute here.

*(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*

26. Regarding clause (c), the Complainant submitted no evidence that the Registrant is disrupting the business of the Complainant beyond the inherent disruption of owning the dot ca domain name. The Complainant operates in Canada using coulisse.com. There is no evidence that the Registrant is a competitor of the Complainant.

*(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.*

27. Clause (d) requires the Complainant to show that the Registrant has “intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website.” In this case, the Domain name resolves to a site saying “FUTURE HOME OF SOMETHING QUITE COOL” and allowing the site owner to click a link to a cPanel page for logging in to the site. I am unable to see how the Registrant obtains any commercial gain from internet users who go to coulisse.ca instead of the Complainant’s domain of coulisse.com. The landing page has no advertising and no links to any other businesses. This could change depending on the type of website that may be created in the future. However, the test is commercial gain at the time of this complaint.
28. Accordingly, the Complainant does not have the benefit of the deeming provisions of Paragraph 3.5. That is not finally determinative of the issue of bad faith as Paragraph 3.5 indicates these clauses are not the only factors that a panel may consider.

29. The Complainant cited the following for the Panel's consideration:

In the decision in Ford Motor Company of Canada, Ltd. v. Anatonia Ojo, DCA-1790-CIRA Dispute number 00318 published on August 29, 2016, the Arbitrator summarized the principles and tests for confusion and found that the domain name "fordparts.ca" was confusingly similar to the complainant's FORD trademark. He also found that an examination of whether the Registrant had a legitimate interest in the domain name in dispute and of whether the domain name was registered in bad faith led to conclusions in favour of the Complainant.

In the case of Mahée Perfums Inc v. Daniel Barros DCA 1784-CIRA, Dispute number 00315, also recently decided, the Arbitrator states at paragraph 23 that it is not necessary to demonstrate a malicious intention or an intention to harm in order to prove bad faith. In paragraph 24, he states that one must look at all the surrounding circumstances once it appears virtually impossible to demonstrate in a convincing manner the existence of bad faith.

In the present case, the Registrant has chosen to keep its identifying information private and to ignore all efforts by the Registrar GoDaddy to contact the Registrant in furtherance of an investigative procedure initiated by the Complainant's counsel. In the surrounding circumstances, this shows a strong likelihood that the Registrant is in bad faith.

30. As part of the process to serve the complaint, the name of the Registrant has now been disclosed to the Complainant.
31. A panel must look at all of the evidence available to it in order to determine if a domain name has been registered in bad faith. This should include an analysis of whether the registrant has demonstrated any legitimate purpose for the registration.
32. The Policy provides that once a complainant has established bad faith then the registrant may still succeed if it can show a legitimate use.

33. 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.*

34. Here I am looking to Paragraph 3.4 for examples of legitimate use to compare to the circumstances herein as part of determining if there is bad faith. If there is a legitimate usage, this would allow a registrant to succeed even with bad faith being established.

*3.4 Legitimate Interests. For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:*

*(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 registered 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 registered 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 paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.*

35. The Registrant has chosen to not participate in these proceedings and accordingly has not provided any evidence to the Panel in support of her position.
36. There is no evidence before this Panel that the Registrant has any business or personal project that would indicate a legitimate interest in the Domain Name.
37. 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 as defined by Paragraph 3.4.

Summarizing the circumstances:

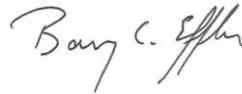
- (a) The Domain Name was registered on September 30, 2008;
  - (b) The Complainant has a registered trade-mark registered well after the date of registration of the Domain Name;
  - (c) The Complainant has a date of use predating the registration of the Domain Name;
  - (d) The Registrant has made no use of the Domain Name beyond having it resolve to a parked site that provides no links to any other sites and has no advertising;
  - (e) The Registrant has provided no evidence of legitimate use and the Domain Name itself is not such that it would meet any of the Paragraph 3.4 tests for legitimate use;
  - (f) There is no evidence that the Registrant is a competitor of the Complainant;
  - (g) The Registrant has not replied to any offer to purchase the Domain Name from her and has made no offers to sell the Domain name.
38. Purchasing a domain name and holding it for eight years, doing nothing with it, does not show bad faith by the Registrant, even with no evidence of legitimate use as defined by paragraph 3.4. She is not a competitor of the Complainant and so gains no commercial advantage by merely holding onto the Domain Name. "Coulisse" is a word in the French language. While there is no evidence from the Registrant, there are possible acceptable uses of the word in contexts that would not be bad faith. The onus is on the Complainant and looking at all the circumstances as a whole, I am unable to make a determination of registration of the Domain Name in bad faith.
39. If the word "coulisse" was completely fabricated and not a word in any language, that would have been a significant factor leading to making a finding of bad faith registration.
40. There is no inherent right given to trade-mark holders under the *Rules* and *Policy* to own dot ca domain names that include words that they have trade-marked. The onus is on the Complainant to prove bad faith and it has not done so.

41. It may be in the future the usage of the Domain Name may change. The Complainant is able to make a new complaint at that time if it believes it would be appropriate to do so.

Order

42. For the reasons set forth above, I dismiss the complaint.

Dated: October 20, 2016

A handwritten signature in black ink that reads "Barry C. Effler". The signature is written in a cursive style with a horizontal line through the middle of the name.

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