

**IN THE MATTER OF A COMPLAINT PURSUANT
TO THE CANADIAN INTERNET REGISTRATION AUTHORITY ("CIRA")
DOMAIN NAME DISPUTE RESOLUTION POLICY ("the POLICY")**

Dispute Number: DCA-1918-CIRA
Complainant: CFA Properties, Inc.
Registrant: MSPStream Technologies Inc.
Disputed Domain Names: chick-fil-a.ca
Arbitrator: Mr. David Wotherspoon
Service Provider: British Columbia International Commercial Arbitration
Centre (the "BCICAC")

BCICAC FILE NUMBER: DCA-1918-CIRA

DECISION

The Parties

1. The complainant is CFA Properties, Inc., of 1105 N. Market Street, Wilmington, DE 19801, USA (the "Complainant").
2. The Registrant is MSPStream Technologies Inc., of 13 Pasadena Avenue, Suite 100, Brampton, Ontario, L6P 2W3, Canada (the "Registrant").

The Disputed Domain Name And Registrar

3. The Domain Name at issue is chick-fil-a.ca (the "Disputed Domain Name").
4. The Registrar of record for the Disputed Domain Name is Domain People, Inc.
5. The Disputed Domain Name was registered on April 22, 2014.

Procedural History

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

7. The Complainant filed a complaint on October 16, 2017, (the "Complaint") with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to the Complainant.
8. The BCICAC confirmed the Complainant to be in administrative compliance with the Rules and forwarded a copy of the Complaint to the Registrant via electronic transmission, in accordance with the Rules.
9. The Registrant did not provide a response within the timeframe required by the Rules, namely November 6, 2017.
10. On November 7, 2017, the BCICAC sent a letter to the Complainant and Registrant advising that the Registrant had failed to submit a response within the allotted time, and that the Complainant may elect to convert from a three-person tribunal to a single arbitrator, as permitted by Rule 6.5.
11. On November 13, 2017, the Complainant elected to convert to a single arbitrator, and notified the BCICAC and the Registrant accordingly.
12. Subsequently, on November 13, 2017, the Registrant contacted the BCICAC stating that the Complaint was not received by the Registrant. The Registrant requested a copy of the Complaint as well as an extension of time to file its response.
13. The Complainant objected to the Registrant's request for an extension of time to submit a response.
14. On November 16, 2017, the BCICAC appointed David Wotherspoon to act as the Arbitrator to determine the matter. The Arbitrator has signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.
15. On December 21, 2017, the Arbitrator exercised his authority under the Rules to extend the time for the Registrant to file its response to January 3, 2018, on the basis that the Arbitrator also encountered difficulties receiving the Complaint from the BCICAC via electronic transmission, which significantly delayed the Arbitrator's ability to render a timely decision.

16. On January 3, 2018, the Registrant agreed to transfer the Disputed Domain Name to the Complainant. The Registrant did not file a response to the Complaint.
17. On January 9, 2018, the Arbitrator wrote to both the Registrant and the Complainant via the BCICAC, asking whether that parties wished to terminate the Complaint pursuant to Rule 8.1 given that the Registrant had agreed to transfer the Disputed Domain Name, or if they wished the Arbitrator to issue an award.
18. On January 12, 2018, the Complainant requested that the Arbitrator issue an award.

Canadian Presence Requirements

19. In order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot-ca domain name, the Canadian Presence Requirements for Registrants, (the "Presence Requirements") require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.
20. The Complainant is the owner of numerous registrations in Canada for the trademark CHICK-FIL-A, both stylized and un-stylized, including the following registration numbers in the Canadian Intellectual Property Office ("CIPO"): TMA379,650; TMA435,186; TMA437,735; TMA438,751; and TMA902,831 (collectively, the "Complainant's Marks"). The Complainant's Marks are used in connection with restaurant services.
21. The Complaint relates to a Disputed Domain Name, which includes the whole of the exact word component of the Complainant's Marks registered in CIPO. Accordingly, the Presence Requirements are satisfied.

The Position Of The Parties

The Position Of The Complainant

22. The Complainant is a wholly owned subsidiary of Chick-fil-A, Inc., and licenses the Complainant's Marks to Chick-fil-A, Inc. for use. The Complainant is a leading restaurant services and food products provider, in 2012 becoming the top-selling quick service restaurant in the chicken segment, a position it continues to retain. The Complainant has for

decades continuously used the Complainant's Marks to identify its restaurant services, food products, and other related goods and services.

23. The Complainant operates or franchises more than 2,200 locations under the Complainant's Marks across the United States and in Calgary, Alberta. Its sales in 2014 were US \$6 billion and in 2016 were nearly US \$8 billion. The Complainant has consistently ranked as one of America's top retailers and fast-food chains in the United States.
24. In order to maintain its market position, the Complainant spends tens of millions of dollars a year in advertising and promotion of its brand. This figure in 2013, the year before the registration of the Disputed Domain Name, was \$15 million.
25. The Complainant's advertising and promotional efforts include national television broadcast advertising, print advertising, internet and social media advertising, and sponsorship of significant sporting events such as the Chick-fil-A Peach Bowl, an NCAA college football game. It has also, since 1998, promoted its restaurants and related goods through its website <chick-fil-a.com>.
26. The Complainant submits that Canadian residents have been exposed to the Complainant's brand through its restaurants and advertising and promotional efforts. For example, in 2012, approximately 108,000 individuals in Canada accessed the Complainant's dot-com website. The Complainant further submits that given the large volume of visitors from Canada to the United States each year, it is certain that a substantial number of Canadians dine at the Complainant's restaurants each year, given their popularity.
27. Accordingly, the Complainant takes the position that: the Disputed Domain Name is confusingly similar to the Complainant's Marks in which the Complainant had rights prior to the registration of the Disputed Domain Name and continues to have such rights; that the Registrant had no legitimate interest in the Disputed Domain Name; and that the Disputed Domain Name was registered in bad faith.
28. As such, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

The Position Of The Registrant

29. The Registrant did not file a response, but has offered to transfer the Disputed Domain Name to the Complainant.

Relevant Policy Provisions

30. Paragraph 4.1 of the Policy sets out the factors that must be proven by a Complainant:

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.

31. Paragraph 3.2 of the Policy provides:

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;

(b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person's predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;

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

(d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

32. Paragraph 3.3 provides:

3.3 “Confusingly Similar”. In determining whether a domain name is “Confusingly Similar” to a Mark, the Panel shall only consider whether 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.

33. Paragraph 3.4 provides:

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.

34. Paragraph 3.5 provides:

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;
- (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.

Analysis And Findings

Confusingly Similar

35. Evidence shows that the Complainant is the owner of the Complainant's Marks which are registered in CIPO. The Complainant's un-stylized CHICK-FIL-A trademark was registered in CIPO as No. TMA 437,735 on December 30, 1994.
36. In accordance with paragraph 3.3 of the Policy, 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 assessing the domain name, the dot-ca suffix is ignored.
37. The Disputed Domain Name incorporates the entirety of the Complainant's CHICK-FIL-A trademark.
38. The Complainant submits that where a domain name identically reproduces a well-known Mark, it is sufficient to establish that the domain name is confusingly similar as required by the Policy.
39. In support, the Complainant refers to the case of *American Express Marketing and Development Corp. v. Nameshield Inc.*, DCA-249-CIRA {americanexpresscreditcards.ca}, where the Panel held that the domain name was confusingly similar as it incorporated a well-known Mark held by the complainant.
40. The Complainant's position is further supported by *WhatsApp Inc. v. Hiba Alnatour*, DCA-1904-CIRA {whatsapp.ca}, citing *Zevia LLC v. Cook Creative*, DCA-1693-CIRA {zevia.ca}, where the Panel held that the domain name, which consisted entirely of the complainant's Mark, excluding the dot-ca extension, was confusingly similar.
41. Accordingly, the Disputed Domain Name is confusingly similar to the Complainant's Marks.

Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights

42. The Disputed Domain Name was registered on April 22, 2014.
43. As noted above, the Complainant's un-stylized CHICK-FIL-A trademark has been registered in Canada in CIPO since December 30, 1994. Further, the evidence shows that the Complainant's common-law rights and statutory rights to the Complainant's Marks based on use and registered rights worldwide date back to the 1980s in some countries.
44. As such, the Arbitrator is satisfied that the Complainant's Marks were registered well before the registration of the Disputed Domain Name and accordingly had Rights in the Complainant's Marks well before the registration of the Disputed Domain Name and, as the evidence shows that the Complainant's rights are active, the Complainant continues to have such Rights.

Registration in Bad Faith

45. The Complainant relies on paragraphs 3.5(a) and (c) of the Policy in support of bad faith registration of the Disputed Domain Name by the Registrant. The Arbitrator notes that the Policy provides that "if any of the circumstances, in particular but without limitation, if found by the [Arbitrator] to be present, shall evidence that a Registrant has registered a domain name in bad faith."
46. The Complainant alleges that the Registrant registered the Disputed Domain Name to trade on the Complainant's well-known CHICK-FIL-A trademark. It argues that the Registrant's passive holding of the Disputed Domain Name (i.e. it's failure to use, attempt to sell, or contact the Mark holder) evidences this intention. In support, the Complainant relies on *Amazon.com, Inc. et al*, DCA-1600-CIRA {amazonfirephone.ca}.
47. It further argues that an inference must be drawn that the Registrant targeted the Complainant's Marks, given the well-known nature, uniqueness, spelling and appearance of the Complainant's Marks.

48. The Complainant also submits that the Registrant has registered the Disputed Domain Name in bad faith pursuant to paragraph 3.5(c) given that the Disputed Domain Name contains the Complainant's CHICK-FIL-A trademark in its entirety and is being passively held by the Registrant, which prevents the Complainant from making use of it in the promotion of its Canadian operations, thereby disrupting its business.
49. The evidence shows that the Complainant's Marks are well-known globally, including in Canada, and as such, at the time of Registration of the Disputed Domain Name, the Registrant knew, or should have known, of the existence of the Complainant's Marks.
50. The evidence also shows that the Registrant has failed to respond to the Complainant's cease and desist letters. A Respondent's failure to respond to cease and desist letters may properly be considered a factor and strong support for finding bad faith registration (see *Payless ShoeSource Worldwide, Inc. v. Dan Cox*, DCA-1929-CIRA {paylessshoes.ca}).
51. Based on all the circumstances demonstrated in the material and all the evidence provided by the Complainant, the Arbitrator is satisfied that the Complainant has proved bad faith registration of the Disputed Domain Name as required by the Policy.

Legitimate Interests of the Registrant

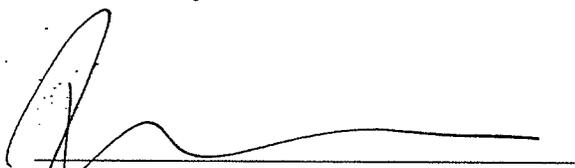
52. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Arbitrator may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on the Complainant to provide "some evidence" that the Registrant did not have a legitimate interest in the Disputed Domain Name.
53. The Arbitrator is satisfied, based on the bad faith analysis above, that the Complainant has provided evidence that the Registrant has no legitimate interest in the Disputed Domain Name. The Respondent has also failed to submit a response to rebut the Complainant's allegations or argue that it has a legitimate interest in the Disputed Domain Name.

54. Accordingly, the Arbitrator finds that the Complainant has met its burden of proof with respect to paragraph 3.1(b) of the Policy, and that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision and Order

55. For the foregoing reasons, in accordance with Paragraph 4.3 of the Policy, the Arbitrator orders that the Disputed Domain Name be transferred to the Complainant.

Dated January 17, 2018



David Wotherspoon

