

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

Dispute Number: DCA-2001-CIRA
Domain Name: *potterybarnbaby.ca*
Complainant: Williams-Sonoma Inc.
Registrant: Gad Bensabath
Registrar: Go Daddy Domains Canada, Inc.
Service Provider: British Columbia International Commercial Arbitration Centre
Panel: W.A. Derry Millar

DECISION

THE PARTIES

1. The Complainant is Williams-Sonoma, Inc., 3250 Van Ness Avenue, San Francisco, California, 94109, U.S.A. The Complainant is represented by Daniel Anthony of Smart & Biggar.
2. The Registrant is Gad Bensabath, Boutique Pinkiblu, 4278 Cote De Liesse Mont Royal, Montreal, QC H4N 2P7. The Registrant's email address is: gad@pinkieblue.com.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue ("**Domain Name**") in this proceeding is: *potterybarnbaby.ca*.
4. The Registrar is: Go Daddy Domains Canada, Inc.
5. The Domain Name was registered by the Registrant on July 6, 2014.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre ("**BCICAC**") is a recognized service provider pursuant to the *CIRA Domain Name Dispute Resolution Policy* ("**Policy**") of the Canadian Internet Registration Authority ("**CIRA**").
7. The BCICAC advised the Panel that the following procedural steps took place up to August 24, 2018 with respect to this Complaint:
 - (a) On July 25, 2018, the Complainant filed a Complaint pursuant to the Policy and the Rules.

- (b) The Complaint was reviewed and found to be compliant. By letter dated July 26, 2018, delivered by email, the BCICAC so advised the parties and forwarded a copy of the Complaint to the Registrant. As the Complaint with the attachments was filed exclusively online; the Centre delivered the Complaint to the Registrant only by email. Confirmation of delivery to the Registrant was received by the BCICAC on July 30, 2018.
 - (c) The BCICAC, by email dated August 16, 2018, to the Complainant and the Registrant, advised the Complainant that the Registrant had not provided a Response. As permitted given the absence of a Response, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
 - (d) The BCICAC received an email from counsel for the Registrant on August 21, 2018, requesting a time extension for filing a Response.
 - (e) The BCICAC advised counsel for the Registrant that in accordance with the CDRP Rules the BCICAC could not grant any extension for the Response at that time, as the request was made on August 21, 2018, and the deadline for the Response was August 15, 2018.
 - (f) The Complaint was filed in English, which shall be the language of the proceeding.
 - (g) W. A. Derry Millar was appointed as the sole arbitrator on August 24, 2018.
 - (h) The BCICAC provided the Panel with counsel for the Registrant's written request to accept the late Response dated August 21, 2018.
8. The following procedural steps took place after August 24, 2018:
- (a) The Panel by email dated August 27, 2018, provided the BCICAC, the Complainant and its counsel, the Registrant and its counsel with his Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality. The Panel requested the Registrant or its counsel to provide more information on why the Response was not delivered in the time provided in the Rules and requested a response by 1 pm on August 29, 2018. Counsel for the Registrant requested an extension for the delivery of the Registrant's additional submissions to the week of September 3, 2018. After receiving submissions on behalf of both the Complainant and the Registrant, the Panel extended the time for the Registrant's additional submissions to September 5, 2018 at 1 pm.
 - (b) Counsel for the Registrant provided the Panel with the Registrant's additional submissions by email dated September 5, 2018. Counsel for the Complainant provided its submissions by email dated September 6, 2018. Counsel for the

Registrant replied by email dated September 6, 2018. In his email, counsel for the Registrant raised an issue with a reference in the Complaint to a letter marked “strictly confidential and settlement-privileged.”

- (c) On September 6, 2018, the Panel granted the Registrant’s request for an extension of 20 days from September 6, 2018, for the delivery of the Registrant’s Response under Rule 5. The Panel also extended the time for the delivery of the Decision under Rule 12.2 of September 13, 2018, to a date 28 days after the delivery to the Panel of the Registrant’s Response.
 - (d) By email dated September 25, 2018, at 11:32 pm, counsel for the Registrant again raised an issue with the reference in the Complaint to the letter referred to in his email dated September 6, 2018, marked “strictly confidential and settlement-privileged” and requested that the Panel “suspend the present matter for a period of two weeks in order for our client to do the following: Decide if he wishes to make a request to change arbitrators; Decide if he wishes to address a complaint pursuant said actions.”
 - (e) By email dated September 26, 2018, at 11:18 am, the Panel advised the Registrant and its counsel that the Panel was not granting any further extensions nor suspending this matter and that the Response was due on September 26, 2018.
 - (f) By email dated September 26, 2018, at 2:19 pm, counsel for the Registrant stated: “With all due respect, giving the privileged information that you have been involuntarily exposed to, I do not think that you can continue your role as an arbitrator in the present matter. I therefore reiterate by the present my demand in order for the undersigned to discuss the matter with our client and” counsel for the Complainant.
 - (g) By email dated September 26, 2018, at 2:33 pm, the Panel advised counsel for the Registrant as follows: “Decision makers deal with this type of situation all of the time. The extension that I granted is to today. Under the CIRA Rules while I have the power to grant an extension of time, I have no power to grant a ‘suspension.’ I point out that you have known about this issue since August 21, 2018.”
 - (h) On October 1, 2018, the Panel asked the BCICAC whether it had received anything from the Registrant and was advised that it had received nothing after my email dated September 26, 2018, at 2:33 pm.
9. The Registrant has not filed a Response.
10. The Panel has reviewed all of the material submitted by the Complainant and the Panel is satisfied that the Complainant is an eligible Complainant under the Policy and Rules.

The Complainant as noted below is the owner of trademarks registered in Canada and therefore meets the Canadian Presence Requirements.

FACTS

11. The evidence of the Complainant establishes the following:

- (a) The Complainant is the owner of multiple trademark registrations for the trademark POTTERY BARN in Canada (as well as the United States and elsewhere), including the following registered trademarks in Canada:¹

Reg. No.	Trademark	Reg. Date
TMA558661	POTTERY BARN	1997-02-20
TMA576787	POTTERY BARN KIDS	2003-03-03
TMA779747	POTTERY BARN KIDS	2010-10-14

- (b) The Complainant is a premier specialty retailer of home and office furnishings and sells nationwide through retail stores, catalogues, and the internet. The Complainant's brands, including its Pottery Barn and Pottery Barn Kids lines of home furnishings and textiles, are among the most successful brands in the industry. From its beginnings in 1956 selling an array of expertly crafted products, the Pottery Barn brand, and later the Pottery Barn Kids brand, have expanded to hundreds of offerings from around the world; retail stores in Canada and international markets; a direct mail business that distributes millions of catalogues annually; and highly successful e-commerce sites, located at www.potterybarn.ca and www.potterybarnkids.ca.
- (c) The Complainant owns and uses the domain names to operate websites at www.potterybarn.ca and www.potterybarnkids.ca providing information about its goods and business under the POTTERY BARN Trademarks. The domain names potterybarn.ca and potterybarnkids.ca were created on December 20, 2000 and have been used in association with the POTTERY BARN Trademarks since at least November 2001.
- (d) The Pottery Barn and Pottery Barn Kids brands have sold billions of dollars' worth of merchandise worldwide. For example, the Pottery Barn brand's worldwide revenue has exceeded \$2 billion in each of the past three years, and the

¹ Collectively the "POTTERY BARN Trademarks."

Pottery Barn Kids brand's worldwide revenue has exceeded \$600 million in each of those years.

12. The evidence of the Complainant also establishes:

- (a) The Registrant's Domain Name POTTERYBARNBABY.CA was approved for registration on July 6, 2014.
- (b) The website available at potterybarnbaby.ca currently features click-through ads via Go Daddy's parked page program.
- (c) There is not, and has never been, any relationship between the Complainant and the Registrant. The Registrant has never been licensed or otherwise authorized to register or use the POTTERY BARN Trademarks in any manner whatsoever, including as part of a domain name.
- (d) There are no valid trademark registrations for the mark POTTERY BARN BABY on the Canadian Trademark Database records.
- (e) The Registrant is the owner of the domain pinkiblue.com, used in association with a website www.pinkiblue.com selling a variety of baby products. This is the Registrant's actual business.
- (f) Counsel for the Complainant made several e-mail attempts to contact the Registrant to discuss the transfer of the Domain Name to the Complainant. The Registrant did not respond to these e-mails and telephone contact with the Registrant was established on March 28, 2018. During this phone conversation, the Registrant responded by offering to sell this Domain Name.
- (g) The Complainant filed a Request for Domain Name Information with CIRA for domain names registered by the Registrant of the POTTERYBARNBABY.CA domain name. The current Registrant is the registrant of 39 dot-ca domain names.
- (h) A review of the domain names owned by the Registrant reveals that many of the .ca domain names are identical to, or confusingly similar to, third party trademarks in use prior to the registration date. The Complaint identifies seven .ca registrations by the Registrant as set out below that correspond to pre-existing third-party brands:

Registrant	Third Party Website
babyjoggerstrollers.ca	babyjogger.ca
babybjornbouncers.ca	babybjorn.ca
ergobabycarriers.ca	ergobaby.ca

bubuybaby.ca	buybuybaby.com
westcoastkid.ca	westcoastkids.ca
oeufnyc.ca	oeufnyc.com
bumbleride.ca	bumbleride.com

ANALYSIS AND FINDINGS

13. Under paragraph 3.1 of the Policy, a Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules 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;
- (b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.

14. Under paragraph 4.1 of the Policy, 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.

15. Paragraph 4.1 of the Policy also provides:

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.

16. As the Registrant did not file a Response, it has not provided any evidence that it has a legitimate interest in the Domain Name.

CONFUSINGLY SIMILAR - PARAGRAPH 4.1 (a) OF THE POLICY

17. The Complainant submits:

- (a) The Registrant's registered Domain Name, POTTERYBARNBABY.ca, is confusingly similar to the Complainant's Pottery Barn Trademarks.
- (b) POTTERY BARN is a "Mark" pursuant to subparagraphs 3.2(a) and (c) of the Policy, which was used in Canada and in which the Complainant enjoyed rights in Canada prior to the date of registration of the disputed Domain Name potterybarnbaby.ca on July 6, 2014.
- (c) The Complainant's trademark POTTERY BARN was first registered in Canada on February 20, 1997. Since that time, the Complainant has gained substantial and valuable goodwill in Canada in the POTTERY BARN Trademarks. Moreover, the Complainant has continuously sold its goods and services extensively throughout Canada through a number of Canadian stores, e-commerce websites and direct mail catalogue orders.
- (d) As the Registrant's Domain Name was only registered on July 6, 2014 and the earliest of the POTTERY BARN Trademarks was registered on February 20, 1997, the Complainant has enjoyed rights in the POTTERY BARN Trademark in Canada for at least 17 years prior to the registration of the Registrant's Domain Name, and continues to have such rights.

18. The Complainant further submits:

- (a) Paragraph 3.3 of the Policy provides that a domain name will be considered "confusingly similar" to a trademark if the domain name so nearly resembles the trademark in appearance, sound or the idea suggested by the trademark as to be likely to be mistaken for the trademark.
- (b) A number of panels have determined that the test for "confusingly similar" is not one of the trademarks being exactly the same as the domain name. Rather, the test is one of resemblance based on the first impression and imperfect recollection. Accordingly, the inclusion of additional words will not prevent a domain name from being confusingly similar to a trademark. This is particularly true with respect to domain names involving a complainant's well-known mark (in this case: POTTERY BARN) and non-distinctive terms (in this case: "baby").

- (c) As a result of the Complainant's extensive use and registration of its POTTERY BARN Trademarks, the term POTTERY BARN is known to identify the Complainant and its goods and services. Internet users are therefore likely to believe the Registrant's Domain Name is associated with the Complainant, given that it combines the Complainant's famous POTTERY BARN mark with a descriptive term referring the type of goods (i.e. baby furnishings).
- (d) In this case, the inclusion of the term "baby" in the Domain Name is particularly confusing since it merely replaces the term "kids" in the mark POTTERY BARN KIDS with the term "baby". The Complainant's website www.potterybarnkids.com features its household furnishings designed for children, and includes sections like "BABY & TODDLER". Consequently, it is likely that a person knowing the Complainant's POTTERY BARN Trademarks and, in particular, its POTTERY BARN KIDS brand would mistake the Domain Name as being associated with the Complainant's trademarks.

19. The Panel agrees that POTTERY BARN is a "Mark" within the meaning of paragraphs 3.2(a) and (c) of the Policy.

20. As noted above, the domain names potterybarn.ca and potterybarnkids.ca were created on December 20, 2000 and have been used in association with the POTTERY BARN Trademarks since at least November 2001.

21. The Complainant has established that the Registrant's Domain Name "*potterybarnbaby.ca*" is confusingly similar to the Complainant's Mark.

22. Paragraph 3.3 of the Policy defines "confusingly similar" as follows:

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 ideas suggested by the Mark as to be likely to be mistaken for the Mark.

23. The Panel agrees with the Complainant's submission that the test of whether a domain name is "confusingly similar" to a Mark is one of resemblance based on the first impression and imperfect recollection. The Panel also agrees that the inclusion of additional words will not prevent a domain name from being confusingly similar to a trademark. Adding the word "baby" to the Complainant's Mark "POTTERY BARN" or replacing the word "Kids" in the Complainant's Mark "POTTERY BARN KIDS" with "baby" does not make the Registrant's Domain Name any less "Confusingly Similar" to the Complainant's Marks.

24. The test to be applied in determining the issue of "confusingly similar" is set out in paragraph 66 of the decision in *Government of Canada v. David Bedford, c.o.b. Abundance Computer Consulting*²:

The test for "Confusingly Similar" under Policy paragraph 3.4 is one of resemblance based on first impression and imperfect recollection. Accordingly, for each domain name the Complainant must prove on a balance of the probabilities that a person, on a first impression, knowing the Complainant's corresponding mark only and having an imperfect recollection of it, would likely mistake the domain name (without the .ca suffix) for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark.

25. While there has been a minor change in the wording of what is now paragraph 3.3 of the Policy, the test as set out in *Government of Canada* case is still applicable. In the Panel's view, a person knowing the Complainant's Mark "POTTERY BARN" and/or "POTTERY BARN KIDS" only and "having an imperfect recollection of it would likely mistake the Domain Name (without the .ca suffix)", *potterybarnbaby*, "for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark."

Bad Faith - Paragraph 4.1(b) of the Policy

26. In order to establish bad faith, the Complainant must establish on the balance of probabilities, one of paragraphs 3.5(a), (b), (c) or (d) of the Policy.

27. Paragraph 3.5 defines "registration in bad faith" for the purposes of the Policy as follows:

For the purposes of paragraph 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;

² BCICAC Case No. 00011 (May 27, 2003). See also *Sittercity Inc. v. Mocilac CIRA* Dispute No. 00169 (2011 LNCIRA 8) at paras 18 to 20.

(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 is engaged in a pattern of registering domain names in order to prevent persons who have rights and 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.”

(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.

28. The Complainant relies on paragraphs 3.5(a), 3.5(b) and 3.5(d) for its submission that the Registrant registered the Doman Name in bad faith.

29. The Complainant submits that the Registrant is the owner of the domain pinkiblue.com, used in association with a website www.pinkiblue.com selling a variety of baby products. This is the Registrant's actual business. The Registrant is therefore a competitor to any third party selling baby products. In this regard, the Registrant has a long history of registering famous baby product brands as his own .ca domain names. The Registrant's activities clearly display bad faith intent.

30. The Panel finds that the Complainant has satisfied the requirements of paragraphs 3.5(b) and (d) of the Policy and is entitled to a finding that the Registrant has registered the Domain Name "*potterybarnbaby.ca*" in bad faith.

Bad Faith – Paragraph 3.5(a) of the Policy – Selling, Renting or otherwise transferring the Registration to the Complainant

31. Paragraph 3.5(a) of the Policy requires the Complainant to establish:

(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.

32. The Complainant submits that:
- (a) The Registrant registered the domain name for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant for valuable consideration in excess of the Registrant's actual costs in registering the domain name.
 - (b) Counsel for the Complainant made several email attempts to contact the Registrant to discuss the transfer of the Domain Name to the Complainant. The Registrant did not respond to these emails and telephone contact with the Registrant was established on March 28, 2018. During this phone conversation, the Registrant responded by offering to sell this Domain Name. Following this conversation, counsel for the Complainant indicated that the Complainant may be willing to reimburse the Registrant for out-of-pocket costs for registering the Domain Name. On April 27, 2018, counsel for the Registrant communicated a settlement proposal which stated that the Registrant would require payment of USD\$2,500 (approximately CAD\$3,200). On May 2, 2018, counsel for the Complainant re-stated that the Complainant would only consider reimbursing the Registrant for past registration fees paid to maintain the domain. Subsequent correspondence between counsel for the Complainant and Registrant did not result in an acceptable offer.
 - (c) Past CDRP decisions have found that an offer to transfer for a value as low as \$1,000 is sufficient to constitute a profit.

33. The Panel was provided with the email chain referred to in paragraph 31(b) above which commenced on December 6, 2017, with an email from the Complainant's US counsel to the Registrant objecting to his registration of the Domain Name, *potterybarnbaby.ca*, and requesting a transfer of the Domain Name to the Complainant. A further email was sent by US counsel to the Registrant on March 27, 2018. On April 24, 2018, as part of the same chain, an email was sent to counsel for the Registrant, Mr. De Louya, which was headed "For Settlement Purposes" and suggested a resolution subject to confirmation by the Complainant to reimburse the Registrant for any out-of-pocket costs for registering the Domain Name subject to the Registrant providing invoices or receipts showing the amount of the payments. The next email in the chain is an email dated April 25, 2018, from US counsel for the Complainant to counsel for the Registrant requesting a call back. On April 27, 2018, counsel for the Registrant by email to US counsel to the Complainant conveyed an offer marked "for settlement purposes and without prejudice" and stated in the body of the email: "the present offer is sent without

prejudice or admission, is strictly confidential and settlement-privileged and may not be invoked before any instance whatsoever.”

34. In my view, these emails between US counsel to the Complainant and counsel for the Registrant dated April 24, 2018, and April 27, 2018, marked “For Settlement Purposes” with respect to the email dated April 24, 2018, and marked “for settlement purposes and without prejudice” at the top of the email and “the present offer is sent without prejudice or admission, is strictly confidential and settlement-privileged and may not be invoked before any instance whatsoever” in the body of the email are subject to settlement privilege and, in the circumstances, are inadmissible.

35. Disregarding the settlement privileged emails, leaves the Complainant’s evidence that during a telephone call on March 28, 2018, the Registrant offered to sell the Domain Name. In the absence of anything else, there is no indication of whether the sale contemplated was for an amount equal to or greater than the costs incurred by the Registrant in registering the Domain Name.

36. The Panel is not satisfied on the balance of probabilities that 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 to a competitor of the Complainant or for valuable consideration in excess of the Registrant’s actual costs in registering the domain name, or acquiring the Registration.”

37. Accordingly, the Panel finds that bad faith has not been established under paragraph 3.5(a).

Bad Faith – Paragraph 3.5(b) of the Policy - Pattern of Unauthorized Registrations

38. Under paragraph 3.5(b), the Complainant must establish that:

(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 is engaged in a pattern of registering domain names in order to prevent persons who have rights and Marks from registering the Marks as domain names.

39. The Complainant submits that:

(a) The evidence establishes that the Registrant has registered 39 dot-ca domain names.

- (b) A review of the domain names owned by the Registrant reveals that many of the .ca domain names are identical to, or confusingly similar to, third party trademarks in use prior to the registration date.

40. The Complainant submits that the seven dot-ca set out above in paragraph 12(h) were registered in bad faith in addition to the Domain Name in issue in this proceeding. The Complainant provided in the table forming part of the Complaint the date of the bad faith registration based on the WHOIS and the actual brand owner's website. The Complainant also provided WHOIS particulars, Wayback Machine printouts showing prior use, and trademark particulars where available.

41. In the Panel's view, the only reasonable inference that can be drawn from the evidence presented by the Complainant is that "the Registrant registered the domain name ... to prevent the Complainant or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name."

42. The Panel is satisfied that the evidence provided by the Complainant establishes a pattern of registration which constitutes bad faith under paragraph 3.5(b) of the Policy. It is clear to the Panel that the Registrant is engaged in cybersquatting. The Panel finds that the registration of the Domain Name *potterybarnbaby.ca* and the other domain names referred to in paragraph 12(h) above by the Registrant constitutes a pattern of abusive registrations within 3.5(b) of the Policy.

43. The Panel finds that the Registrant acted in bad faith in registering the Domain Name *potterybarnbaby.ca*.

Bad Faith - Paragraphs 3.5(d) of the Policy - Capitalizing on its Mark

44. Under paragraphs 3.5(d), the Complainant must establish that:

(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.

45. The Complainant submits that:

- (a) The Domain Name currently directs to a Go Daddy parked page where Internet users can find a number of sponsored links to Complainants and various third-parties websites, including competitors of the Complainants offering children's household furnishings products which compete with those of the Complainants.

- (b) It is well established that a Registrant's use of a domain for a pay-per-click service constitutes "bad faith" for the purposes of subparagraphs 3.1(c) and 4.1(b).
- (c) The Registrant is the known owner of Boutique Pinkiblu, a retail store selling baby products. The e-mail address of the Registrant shown in Schedule L to the Complaint is gad@pinkiblu.com. A review of the list of .ca domain names with the same owner as the Domain Name provided by CIRA shows that many of these domain names are identical to, or confusingly similar to third party trademarks or brands which are associated with baby product retailers. The Complainant submits that the Registrant has developed a bad faith strategy of appropriating well-known baby product retailers, including the Complainant, by registering domain names which are identical to, or confusingly similar to the well-known marks and brands in order to divert Internet users away from the Registrant's well-known competitors.
- (d) The Registrant has attempted to attract, for the purposes of commercial gain, Internet users to the Go Daddy parked page at potterybarnbaby.ca by creating a likelihood of confusion with the Registrant's POTTERY BARN Trademarks.

46. The Panel agrees with the submissions of the Complainant and finds that the activities of the Registrant amount to bad faith under paragraph 3(d).

Legitimate Interests in Domain Name Paragraph 4.1(c) of the Policy and Paragraph 3.4 of the Policy

47. The Panel finds that the Complainant has met its burden under paragraph 4.1(c) of the Policy to provide some evidence that the Registrant does not have a legitimate interest in the Domain Name.

48. The Panel agrees with the submissions of the Complainant that:

- (a) With respect to paragraph 3.4(a):
 - (i) There is not, and has never been, any relationship between the Complainant and the Registrant.
 - (ii) The Registrant has never been licensed or otherwise authorized to register or use the POTTERY BARN Trademarks in any manner whatsoever, including as part of a domain name.
 - (iii) There are no valid trademark registrations for the mark POTTERY BARN BABY on the Canadian Trademark Database records.

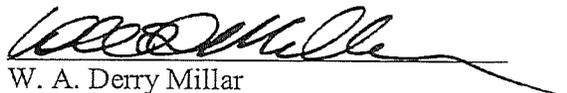
- (iv) The Registrant has no rights to the POTTERY BARN Trademark and is not using it in good faith. Therefore, subparagraph 3.4(a) does not apply.
- (b) With respect to paragraph 3.4(b) and (c):
 - (i) The mark POTTERY BARN is not descriptive in any sense, nor is it generic.
 - (ii) For both of these reasons, subparagraphs 3.4(b) and (c) do not apply.
- (c) With respect to paragraph 3.4(d):
 - (i) There is no indication that the Domain Name is being used for non-commercial activity.
 - (ii) Therefore, subparagraph 3.4(d) does not apply.
- (d) With respect to paragraph 3.4(e):
 - (i) There is no indication that the Domain Name is the legal name of the Registrant (Gad Bensabath).
 - (ii) Therefore, subparagraph 3.4(e) does not apply because POTTERY BARN is not, nor is it part of, the legal name of the Registrant.
- (e) With respect to paragraph 3.4(f):
 - (i) There is no indication that the Domain Name is a geographical name.
 - (ii) Therefore subparagraph 3.4(f) does not apply.

49. As noted in paragraph 16 above, as the Registrant did not file a Response, it has not provided any evidence that it has a legitimate interest in the Domain Name.

ORDER

50. The Complainant has met the requirements of paragraph 4.1 of the Policy. The Panel orders that the registration of the Domain Name "*potterybarnbaby.ca*" be transferred from the Registrant to the Complainant.

Dated: October 12, 2018.


W. A. Derry Millar

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