

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

DISPUTE NUMBER:	BCICAC FILE: 2222-CIRA
COMPLAINANT:	KATE SPADE LLC
REGISTRANT:	EMILE BOULANGER
DISPUTED DOMAIN NAME(S)	katespadeoutlet.ca (“Disputed Domain Name”)
REGISTRAR:	HEXONET SERVICES INC.
SERVICE PROVIDER:	BRITISH COLUMBIA INTERNATIONAL COMMERCIAL ARBITRATION CENTRE (“Provider”)
PANEL:	LESLIE E. MAEROV, FCI Arb., Q. Arb.

Decision Date: June 26, 2020

THE PARTIES:

The Complainant is Kate Spade LLC, a company incorporated in the State of Delaware, United States of America, and is represented by Kestenberg Siegal Lipkus LLP, of Toronto, Canada. The Registrant is Emile Boulanger, of France, who has not responded to the Complaint and is not represented.

THE DISPUTED DOMAIN NAME AND REGISTRAR:

The Disputed Domain Name in issue is “katespadeoutlet.ca” which was registered on October 29, 2016, and expires October 3, 2020. The Registrar is Hexonet Services Inc.

PROCEDURAL HISTORY:

This complaint (“Complaint”) was filed with the Provider as recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“Policy”), in accordance with the CIRA Dispute Resolution Rules (“Resolution Rules”) on May 22, 2020. The Complainant paid the Provider the applicable fee for submission of the Complaint at the time of submitting the Complaint to the Provider. The Complaint was determined to be in administrative compliance with the Resolution Rules and this proceeding was deemed commenced on May 26, 2020.

The Registrant's identity is not published in the public WHOIS database, and within the time limited by Rule 4.3 of the Resolution Rules, on May 22, 2020, the Provider sent a request for registrar verification to the Registrar to determine the identity, including the mailing address and contact email of the Registrant, together with a request that the domain name be put on a Registrar lock. On May 22, 2020, the Registrar confirmed the identity of the Registrant and its mailing address and contact email, and confirmed that the disputed domain name was placed on a Registrar lock.

Pursuant to Rule 4.4 of the Resolution Rules, on May 25, 2020, the Provider notified the Registrant at the email address for the administrative contact of record in the Registrant Information at madeinputian@hotmail.com and also at postmaster@katespadeoutlet.ca of the commencement of this proceeding, and advised the Parties of the name and contact details of the Administrator. Also on May 25, 2020, the Provider gave notice to the Registrant that he was required to respond to the Complaint not later than February 16, 2020, in accordance with the Policy and Resolution Rules.

The Registrant has not responded to the Complaint within the time limited, and the Complainant elected under Rule 6.5 to convert to a single member panel. Prior to my appointment I submitted a Statement of Independence and Impartiality to the Provider, declaring that there are no circumstances that would give rise to justifiable doubts as to my independence and impartiality, as required by the Resolution Rules. On June 18, 2020, I was appointed as a single member Panel.

When the Registrant does not respond to the Complaint, the Panel is required to decide the proceeding for the resolution of this dispute on the basis of the Complaint.

JURISDICTION:

By obtaining registration of a domain name in the dot-ca country code top level domain name registry operated by CIRA, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and Resolution Rules. This is an administrative proceeding pursuant to the Policy and Resolution Rules.

In order to bring a proceeding under the Policy, a complainant must satisfy the Canadian Presence Requirements for Registrants contained in CIRA Policies, Rules and Procedures, which require that the applicant must meet at least one of the listed requirements.

The Complainant satisfies one of those requirements by being the owner of a trademark which is the subject of a registration under the Trademarks Act (Canada), R.S.C. 1985, c. T-13. Satisfaction of this requirement limits permission to register a dot-ca domain name consisting of or including the exact word component of that registered trademark. The Complainant is the owner of trademarks TMA509501, TMA629164 and TMA715794 for “KATE SPADE” for use in association with clothing, footwear, leather goods, textiles, sunglasses, eye frames, cosmetics and accessories, among other goods and services (“Kate Spade Marks”). The Kate Spade Marks were registered in Canada between 1999 and 2008. TMA509501 was registered on March 17, 1999, and expires on March 17, 2029, TMA629164 was registered on December 31, 2004, and expires on December 31, 2029, and TMA715794 was registered on June 3, 2008, and expires on June 3, 2023.

The Complainant is therefore an eligible complainant.

FACTUAL BACKGROUND:

Background facts as submitted by the Claimant, and accepted by me as probative are summarized as follows:

The Complainant has been engaged in the production, manufacturing and sale of goods in association with one or more of the Kate Spade Marks since as early as 1994 in Canada, and has used one or more Kate Spade trademarks in association with its goods in the United States and throughout the world. It operates more than 150 retail shops and outlets across Canada and the United States.

Kate Spade is the Complainant’s identity and it has become a well-known brand name in luxury fashion in Canada and globally. Customers have come to associate the Kate Spade Marks with Complainant’s high quality products. As a result, significant goodwill is attached to the Kate Spade Marks.

The Disputed Domain Name “katespadeoutlet.ca” was first registered on October 29, 2016, and expires on October 3, 2020. It resolves to an active website that advertises discounted, and according to the Claimant, counterfeit Kate Spade goods.

The Complainant became aware of the Disputed Domain Name in or around January, 2020, and delivered a Cease and Desist letter to the website owner on January 24, 2020. There was no response to the Complainant, nor was the infringing material removed from the katespadeoutlet.ca website. A copy of this letter was submitted as evidence in this proceeding.

The Complainant delivered a Notice of Phishing and Fraud Abuse to the Registrar on February 24, 2020, but did not receive a response. Follow up notices were sent on March 26, 2020, May 6, 2020, and May 18, 2020, but there was no response. Copies of these notices were submitted as evidence in these proceedings.

Finally, the Complainant delivered a Notice of Trademark Infringement to the Disputed Domain Name’s Host Server on January 31, 2020, February 7, 2020, February 28, 2020, April 17, 2020, May 6, 2020 and May 11, 2020, but did not receive a response by the time of filing of the Complaint. Copies of these notices were submitted as evidence in these proceedings.

The Registrar continues to redirect users to a website selling counterfeit goods bearing the Kate Spade Marks. The Complainant has submitted evidence that its brand protection experts have determined that the website to which the Disputed Domain Name resolves sells counterfeit goods and goods that have not been authorized by the Complainant, and submits that the use of the Kate Spade Marks is unauthorized.

Given the date that the Complainant discovered the existence of the web site at katespadeoutlet.ca, and its subsequent efforts to resolve its objection to the sale of counterfeit goods using the Kate Spade identity through administrative means, I find that this proceeding has been commenced in a timely fashion.

RELIEF REQUESTED:

The Complainant requests that the ownership of the Disputed Domain Name be transferred to the Complainant immediately.

APPLICABLE LAW:

As directed by Rule 12.1, I will render a decision on the basis of the evidence and argument submitted, in accordance with the Policy, the Resolution Rules and any rules and principles of the laws of Ontario, Canada.

DISCUSSION & ANALYSIS:

In order to succeed in this proceeding, the Complainant is required to prove, on a balance of probabilities, that:

- (a) The Disputed Domain Name is Confusingly Similar to the Complainant's Mark in which the Complainant had rights prior to the date of registration of the Disputed Domain Name and continues to have such Rights.

To be confusingly similar, the Disputed Domain Name must so nearly resemble the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark. A Mark is defined as, in part: a trademark, that has been used in Canada by a person, for the purpose of distinguishing the wares, services or business of that person from the wares, services or business of another person. The Complainant has established that as the owner of the Kate Spade Marks, and providing evidence that it markets its wares on its web site visible in Canada using the Kate Spade Marks, it is the owner of a trademark that has been used in Canada for the purpose of distinguishing its wares from the wares of another person.

The Complainant must have had rights in the Mark prior to the date of registration of the domain name and continue to have such rights. The Complainant satisfies the definition of a Mark by way of its ownership rights to the Kate Spade Marks. The Complainant's rights to the trademark significantly preceded the registration of the Disputed Domain Name, as the Kate Spade Marks have been used in Canada as early as 1994, and the first of its Marks was registered as a trademark in 1999, while the Disputed Domain Name was not registered until October 2016. Those Marks continue to be valid and in effect at least until their present expiry dates. Pursuant to par. 1.2 of the Policy, the Disputed Domain Name means the domain name excluding the dot-ca suffix.

In order to be confusingly similar, the domain name must so nearly resemble the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark. The test for “confusingly similar” is “one of first impression and imperfect recollection”. See *Government of Canada, on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, CDRP Decision 00341, May 27, 2003, par. 66. An Internet user who has knowledge or recollection of the Mark might easily mistake the Disputed Domain Name as being somehow affiliated with or owned by the Complainant. Since the Disputed Domain Name contains the exact wording of the Kate Spade Marks there could be no doubt that it is confusingly similar to the Kate Spade Marks.

Including the word “outlet” in the Disputed Domain Name does not differentiate it from the Kate Spade Marks. Incorporation of a trademark in its entirety together with other non-distinctive words is not sufficient to differentiate the domain name from a Mark. See *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020 August 26, 2004, p.5. Further, the addition of the word “outlet” is more likely to cause confusion because the Complainant operates outlet stores in Canada and globally where it sells its own legitimate goods. The Kate Spade official website allows a user to search for a store by “shop type”, enabling consumers to search for Kate Spade Outlets in Canada and the United States. Adding the word “outlet” adds to the potential for Internet customers to confuse the Registrant’s website with the Complainant’s website. “outlet” is not distinctive in this context. See *Skechers USA Inc. II v. Hyatt Cortez*, CDRP Decision 341 September 24, 2019, p.17, where the disputed domain name was “skecherscanadaoutlet.ca”.

Finally, the Complainant’s website katespade.com, screen prints of which have been tendered as evidence, has a distinctive layout and features vibrant, colourful images. The Registrant’s website, screen prints of which has been tendered as evidence, is at first glance identical, even including some of the pictures that are used by katespade.com as well as identical names of goods offered for sale.

In conclusion, by incorporating the whole of the Complainant’s well known, widely used and publicized Mark, the Disputed Domain Name is likely to lead

persons visiting the website to conclude that it is associated with the Complainant.

- (b) The Registrant has registered the Disputed Domain Name in bad faith, as described in par. 3.5 of the Policy.

Evidence of any of the non-exhaustive circumstances described in par. 3.5 of the Policy is evidence that a Registrant has registered a domain name in bad faith. The Complainant may satisfy this requirement by providing evidence that 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.

The evidence before me indicates that the Complainant has no relationship or association with the Registrant, and that the Registrant is not an authorized retailer of Kate Spade branded products that are owned by the Complainant. The Registrant did not register the Disputed Domain Name with the consent or approval of the Complainant and the Registrant has not been licensed or otherwise permitted to use any of the Kate Spade Marks within the Disputed Domain Name or the website to which it resolves. The Registrant has no business relationship with the Complainant and the Registrant's website is clearly attempting to divert unsuspecting customers looking for authentic Kate Spade branded goods to the unauthorized website offering counterfeit goods featuring trademarks identical to the Claimant's, and to profit from an implication that it is a website of the Complainant or an authorized dealer. See *Skechers USA INC II. v. Hyatt Cortez*, DCA-2121-CIRA, at para. 20. There is no evidence that the Disputed Domain Name was used for any legitimate non-commercial or fair use.

I find that the use of the Mark "KATE SPADE" in the Registrant's domain name and on the Registrant's commercial website meets the circumstances outlined for bad faith.

In addition, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

Par. 3.4 of the Policy identifies 6 non-exhaustive circumstances that, if proved, demonstrate that the Registrant has a legitimate interest in a domain name. There is no evidence before me that indicates that the Registrant satisfies any of those circumstances, nor is there any other evidence that would indicate that the Registrant has any legitimate interest in the Disputed Domain Name. To the contrary, the Complainant has provided evidence that it is the sole owner of the Kate Spade Marks, and that it has not authorized the use of those Marks to the Registrant, nor has it authorized the use of the words “Kate Spade” to the Registrant for use in the Disputed Domain Name.

Further, the evidence is that the only use in Canada of the Disputed Domain Name by the Registrant is in association with the advertising and sale of counterfeit goods whose source is other than the legitimate owner of the Kate Spade Marks.

Accordingly I find that the Complainant has satisfied the requirement that the Registrant has no legitimate interest in the Disputed Domain Name.

DECISION:

For the reasons set out in this decision, I have found that the Complainant has satisfied all the requirements under the Policy in order to be successful in this proceeding. As previously indicated, the Complainant is in compliance with the Canadian Presence Requirements for Registrants contained in CIRA Policies, Rules and Procedures which would allow it to be the registrant of a dot-ca domain name containing the exact words of the Kate Spade Marks.

I order that the Disputed Domain Name “katespadeoutlet.ca” be transferred to the Complainant immediately.



LESLIE E. MAEROV
Single member panel
June 26, 2020