

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

Complainant: Dress Barn Online, Inc.

Registrant: Supriyo Malaker

Domain Name: dressbarn.ca

Registrar: Go Daddy Domains Canada, Inc.

Arbitrator: David Wotherspoon

Service Provider: British Columbia International Commercial Arbitration Centre

BCICAC File: 2237-CIRA

DECISION

THE PARTIES

1. The Complainant is Dress Barn Online, Inc (“Dress Barn”), a corporation with a mailing address of 12 Greenway Plaza, 11th Floor, Houston, Texas, 77046, USA.
2. The Registrant is Supriyo Malaker, an individual with a mailing address of 30 Dunnigan Drive, Suffern, New York, 0709013, USA.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name at issue is dressbarn.ca (the “Domain Name”).
4. The Registrar of the Domain Name is Go Daddy Domains Canada, Inc.
5. The Domain Name was created on August 26, 2005.
6. The registration of the Domain Name lapsed on August 26, 2013.
7. The Registrant registered the Domain Name on or after August 26, 2013.

PROCEDURAL HISTORY

8. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (the “Policy”) of the Canadian Internet Registration Authority (“CIRA”).
9. This is a proceeding under the Policy, in accordance with the CIRA Dispute Resolution Rules (the “Rules”).
10. The Complainant filed a complaint with respect to the Domain Name pursuant to the Policy on June 17, 2020 (the “Complaint”).
11. In a letter dated June 19, 2020, the BCICAC confirmed compliance of the Complaint and commencement of the dispute resolution process.
12. The Complaint was delivered to the Registrant on June 19, 2020.

13. The Registrant did not provide a response within the timeframe required by the Rules. As a result, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator. Subsequently, the BCICAC appointed David Wotherspoon as sole arbitrator in the Complaint on July 15, 2020.
14. The Arbitrator is obliged to issue a decision on or prior to August 5, 2020.

ELIGIBILITY OF COMPLAINANT

15. The Arbitrator has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and Rules.

CANADIAN PRESENCE REQUIREMENT

16. The Complainant is the owner of the Canadian trademark registration for Dress Barn registered in the Canadian Intellectual Property Office (“CIPO”) on March 14, 2008 with Registration Number TMA709541 (the “Dress Barn Mark”).
17. The Complainant, as the owner of a trademark registered in Canada, meets the Canadian presence requirements.

FACTS

18. The Complainant’s began using Dress Barn as a trademark in 1962 in the USA and has been used in connection with retail outlet services in the field of women’s apparel.
19. In addition to the Dress Barn Mark, the Complainant is the owner of the USA trademark registration for Dress Barn registered in the U.S. Patent and Trademark Office on March 5, 1985 with Registration Number U.S. Reg. No. 1,323,805.
20. The Complainant has been using Dress Barn since at least March 2006 in Canada.
21. The Complainant also owns registrations for “Dress Barn” trademarks in several other countries, including Brazil, the European Union, Japan and Mexico.
22. The Dress Barn Mark was previously controlled by the Ascena Retail Group, Inc (“Ascena”). On February 19, 2020, Ascena announced the wind-down of the business operations of Dress Barn. The announcement also noted that Dress Barn’s intellectual property assets and its ecommerce business was sold and transitioned to its new owner, the Complainant. Despite the closing of physical Dress Barn stores, the Complainant still carries on ecommerce as “Dress Barn” online, through its website at dressbarn.com.
23. Ascena was the original registrant of the Domain Name. However, Ascena failed to renew the Domain Name and it lapsed on August 26, 2013. Subsequently, the Registrant registered the Domain Name on or after August 26, 2013.
24. The Complainant has spent hundreds of thousands of dollars on registration and enforcement activities to protect its marks for or incorporating “Dress Barn” and even greater amounts on marketing activities to promote its wares and services used in association with its marks.

25. The Complainant has built up a strong reputation and significant goodwill in the widely recognized Dress Barn Mark in connection with the Complainant's goods and services due to the Complainant's extensive use of its marks and name, its substantial promotional activities, and its registration of the Dress Barn Mark in Canada and other jurisdictions.
26. The Complainant has not licensed or otherwise authorized the Registrant to register or use "Dress Barn" as a domain name or for any other purpose.

THE POSITION OF THE PARTIES

The Position of the Complainant

27. The Complainant submits that the Domain Name is confusingly similar to the Dress Barn Mark; that the Registrant has no legitimate interest in the Domain Name; and that the Domain Name was registered in bad faith.

The Domain Names are Confusingly Similar to a Mark in which the Complainant Has Rights

28. "Dress Barn" is the predominant element in the Dress Barn Mark.
29. The Complainant and its customers refer to the Complainant as "Dress Barn".
30. The Domain Name is confusingly similar to the Complainant's Dress Barn Mark because the Domain Name is identical to the predominant element of the Dress Barn Mark in appearance and sound such that it is likely to be mistaken for the mark.
31. A person, as a matter of first impression, knowing the Complainant's Dress Barn Mark, and having an imperfect recollection, would likely mistake the Domain Name for the Dress Barn Mark.
32. The Domain Name consists only of "Dress Barn" and merely adds ".ca" to the end. The addition of ".ca" in the Domain Name does not prevent it from being confusingly similar.

Rights in the Mark Prior to the Domain Name Registration and Continuing Rights

33. The Complainant registered the Dress Barn Mark with CIPO on March 14, 2008 and established its rights in the Dress Barn Mark by virtue of the Canadian registration. The Complainant had rights in the Dress Barn Mark prior to the date of registration of the Domain Name on or after August 26, 2013 and continues to have such rights.

The Registrant Has No Legitimate Interest in the Domain Name

34. The Registrant has no legitimate interest in the Domain Name for the following reasons:
 - The Complainant has never assigned, granted, licenced, sold, transferred or in any way authorized the Registrant to use its mark;
 - The Registrant is not using the Domain Name in connection with an active website;

- The Domain Name was not registered in good faith in association with any wares, services or business that is clearly descriptive;
 - The “Dress Barn” name is not the generic name of any wares, services or business in Canada;
 - The Registrant has not used the “Dress Barn” name for non-commercial activity;
 - The “Dress Barn” name is not a reference by which the Registrant is commonly known; and
 - The “Dress Barn” name is not a geographical name of the location of the Registrant’s non-commercial activity or its place of business.
35. As a result of the Complainant’s long-term and continuous ownership and use of its marks, tradenames and domain names for or incorporating “Dress Barn” in connection with its business, the Complainant has built a strong reputation and significant goodwill in its marks and names. An objective bystander, including a person accessing the Domain Name, would naturally assume that the “Dress Barn” of the Domain Name was invoking, associated with, or licensed by the “Dress Barn” of the Dress Barn Mark, and therefore, by the Complainant.
36. The Complainant has never given the Registrant permission to use the Dress Barn Mark or names in any manner.
37. The Registrant has not used the Domain Name in any manner that would otherwise demonstrate any rights or legitimate interests in using the Domain Name.

The Domain Name Was Registered in Bad Faith

38. The Registrant’s registration of the Domain Name was in bad faith for the following reasons:
- The Registrant took advantage of a lapse in registration of an active domain name to register a domain name that comported the Complainant’s Dress Barn Mark that was clearly associated with the Complainant;
 - The Registrant is not using the Domain Name in connection with an active website (*i.e.*, the Registrant’s holding of the Domain Name constitutes passive holding); and
 - The Registrant’s actual or constructive knowledge of the Dress Barn Mark, the Complainant’s reputation and the Complainant’s success in North America.

The Position of the Registrant

39. The Registrant did not file a Response.

DISCUSSION AND FINDINGS

40. To succeed in the proceeding, the Complainant must prove, on a balance of probabilities, that:

- 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
- The Registrant has registered the domain name in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

- The Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Rights in the Mark Prior to the Domain Name Registration and Continuing Rights

41. The Complainant registered the Dress Barn Mark in Canada with CIPO on March 14, 2008. In addition, the evidence demonstrates that the Complainant has rights to the Dress Barn Mark, based on use and registration outside of Canada, which date back to 1985, years prior to the registration of the Domain Name. The Complainant continues to have such rights.

42. The Registrant registered the Domain Name after Ascena's lapse in registration on or after August 26, 2013.

43. I am satisfied that the Dress Barn Mark was registered before the registration of the Domain Name and accordingly the Complainant had rights in the Dress Barn Mark before the registration of the Domain Name. As the evidence demonstrates that the Complainant's rights remain in force, the Complainant continues to have such rights.

Confusingly Similar

44. To succeed in meeting its onus under ¶4.1(a), the Complainant must show that it has rights in a mark and that the Domain Name is "Confusingly Similar" to that mark.

45. A "Mark" includes:

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.

46. Pursuant to ¶3.3 of the Policy, in determining whether the Domain Name is "Confusingly Similar" to a Mark, the Arbitrator 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.

47. In *American Express Marketing and Development Corp v Nameshield Inc*, DCA-249-CIRA, the Panel held that the domain name was confusingly similar as it incorporated a well-known mark held by the complainant.
48. In *WhatsApp Inc v Hiba Alnatour*, DCA-1904-CIRA, the Panel held that the domain name, which consisted entirely of the complainant's mark excluding the dot-ca suffix was confusingly similar.
49. The Complainant is the registered owner of the "Dress Barn Mark" in Canada.
50. The Domain Name incorporates the distinctive portion of the Complainant's Dress Barn Mark. The fact that the whole of the distinctive element of the Complainant's trademark is incorporated in the domain name is sufficient to support a finding of confusing similarity (see *General Motors Acceptance Corporation v Bob Woods*, BCICAC Case No DCA-891-CIRA).
51. An Internet user who has knowledge or recollection of the Dress Barn Mark might easily mistake the Domain Name as being somehow affiliated to or owned by the Complainant (see *Canadian Broadcasting Corporation/Société Radio-Canada v William Quon*, BCICAC Case No 00006).
52. Accordingly, the Complainant has established on a balance of probabilities that the Domain Name is "Confusingly Similar" to the Complainant's Dress Barn Mark.
53. The Registrant has failed to provide any evidence to rebut this conclusion.

Bad Faith Registration

54. Pursuant to ¶3.5 of the Policy, any of the following circumstances will be evidence that a Registrant has registered a domain name in bad faith:
 - 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;
 - 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;
 - 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
 - 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.

55. As noted in ¶3.5 of the Policy, the list provided above is not exhaustive.
56. The phrase “disrupting the business of the Complainant” is satisfied where the use of the domain name creates a likelihood of confusion among end users to affiliation or sponsorship, and includes trademark infringement and passing off (*Great Pacific Foods Industries Inc v Ghalib Dhalla*, Case No 0009 at 20-21).
57. The evidence demonstrates that the Complainant’s mark was known in North America, including in Canada, and as such, at the time of the Registration of the Disputed Domain Name, the Registrant knew, or should have known, of the existence of the Dress Barn Mark. That the Domain Name was registered shortly after it became publicly available supports this conclusion.
58. The Registrant’s use of the Domain Name constitutes “disrupting” the Complainant’s business in the form of classic trademark or trade name confusion (*Standard Life Assurance Company of Canada*, Case No 00046).
59. There is no evidence to suggest that the Registrant is itself a direct business competitor of the Complainant – *i.e.*, the Registrant is not in the business of selling the products and providing the services that the Complainant provides.
60. The Registrant registered the Domain Name after Ascena failed to renew the registration, resulting in the registration lapsing. A registrant acts in bad faith where it registers a domain name that a complainant failed to renew, even if the domain name does not resolve to an active website (see *Bestway Holdings Ltd v Bkarato, AK Bkarato*, WIPO Case No. D2012-2485; see also *Christopher B. Bridges v Douglas Swift, Third-Party Solutions LLC*, WIPO Case No D2019-2083). Bad faith has also been found where the respondent registered the disputed domain name shortly after the complainant’s original registration expired (*Theodoor Gilissen Bankiers N.V. v AbdulBasit Malaani*, WIPO Case No D2013-1229).
61. The Registrant is not using the Domain Name in connection with an active website. Bad faith has been found in such circumstances (see *General Motors LLC v Tony Wilson*, CIRA Dispute No. 00182). In *General Motors LLC v Tony Wilson*, the trademark involved was “world famous”. While the Dress Mark Barn may not be “world famous” as in that decision, this is not necessary for a finding of bad faith.
62. I find that the Complainant has established, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith.
63. The Registrant has failed to provide any evidence to rebut this conclusion.

No Legitimate Interest in Domain Name

64. Pursuant to ¶3.4 of the Policy, any of the following circumstances will demonstrate that the Registrant has a legitimate interest in a domain name:
- The domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
 - 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;

- 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;
- 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;
- 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
- The domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In (d), "use" by the Registrants includes, but is not limited to, use to identify a website.

65. The Complainant has provided the following evidence to show that the Registrant has no legitimate interest in the Domain Name:

- The Complainant has never assigned, granted, licenced, sold, transferred or in any way authorized the Registrant to use its mark;
- The Registrant is not using the Domain Name in connection with an active website;
- The Domain Name was not registered in good faith in association with any wares, services or business that is clearly descriptive;
- The "Dress Barn" name is not the generic name of any wares, services or business in Canada;
- The Registrant has not used the "Dress Barn" name for non-commercial activity;
- The "Dress Barn" name is not a reference by which the Registrant is commonly known; and
- The "Dress Barn" name is not a geographical name of the location of the Registrant's non-commercial activity or its place of business.

66. I am satisfied that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

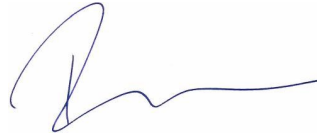
67. The Registrant has failed to provide any evidence to rebut this conclusion or submit a response that it has a legitimate interest in the Domain Name.

ORDER

68. I have concluded that the Complainant has met the requirements of ¶4.1 of the Policy.

69. Accordingly, and pursuant to ¶4.3 of the Policy, I order that the registration of the domain name *dressbarn.ca* be transferred to the Complainant by the Registrar, Go Daddy Domains Canada, Inc.

Dated: July 27, 2020

A handwritten signature in blue ink, appearing to read 'David Wotherspoon', is written above a horizontal line.

David Wotherspoon
Sole Arbitrator