

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

**BCICAC FILE NO. 2221-CIRA**

DOMAIN NAME: katespade.ca  
COMPLAINANT: Kate Spade LLC  
REGISTRANT: Nameshield Inc.  
PANEL: Tina M. Cicchetti  
PROVIDER: British Columbia International Commercial Arbitration Centre (the “Centre”)

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**DECISION  
13 JULY 2020**

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**I. The Parties**

1. The Complainant is Kate Spade LLC, a company incorporated in the State of Delaware, United States of America, with offices located at 10 Hudson Yards, New York, NY 10001, USA.
2. The Registrant is Nameshield Inc., P.O. Box 1900, Charlottetown, PE, C1A 7N5 Canada. The Registrant’s authorized representative and contact person is Daniel Mullen.

**II. The Disputed Domain Names and Registrar**

3. The domain name at issue in this complaint is katespade.ca registered on 4 September 2010 (the “Disputed Domain Name”).
4. The registrar through which the Disputed Domain Names are registered is dot-ca-registry.ca (Burmec Business Systems Ltd.).

**III. Procedural Background**

5. On 22 May 2020, the Complainant filed a Complaint pursuant to the Policy and the Rules with the Centre, which is a recognized Provider.<sup>1</sup>
6. On 25 May 2020, the Centre confirmed administrative compliance of the Complaint with the Policy and the Rules; sent the Complaint to the Registrant in accordance with the

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<sup>1</sup> All capitalized terms in this decision that are not defined herein have the meaning set out in the Policy and/or the Rules.

Rules; and gave notice of commencement of the Proceeding to the Parties, the Registrar and CIRA. The Centre advised the Registrant that the deadline for its response was 15 June 2020.

7. On 15 June 2020, the Registrant requested an extension of time for filing the response to 22 June 2020 indicating two reasons for the request: an inability to get “the affidavit” from the user and lawyer unable to provide it on 15 June due to change in work hours due to COVID precautions.
8. The Complainant objected to any time extension noting that the Registrant’s request did not describe any exceptional circumstances.
9. Pursuant to Rule 5.4, the Centre granted four (4) days extension to the period for the Registrant’s Response extending the deadline to 4 pm PST on 19 June 2020.
10. The Registrant did not submit a response within the period for submission of a Response or the period extended pursuant to paragraph 5.4 of the Rules.
11. Following the deadline on 19 June 2020, the Registrant provided a certificate signed on behalf of the Registrant and the first page of the Response Transmittal Coversheet with the names of the parties and the Registrant’s nominees to administrative panel, but no response to the Complaint.
12. On 22 June 2020, the Centre wrote to the Parties to advise that the Registrant had failed to submit a formal response on time and that the Complainant could elect to convert from a three-person panel to a single member panel.
13. Also on 22 June 2020, the Centre wrote to the Registrant to acknowledge receipt of the email received after the deadline on 19 June 2020 and to advise that the Registrant could send a written request to accept the late response, which would be forwarded to the appointed arbitration panel.
14. As permitted by Rule 6.5 in the absence of a response, the Complainant elected to convert from a panel of three to a single member panel. The Centre appointed Tina M. Cicchetti (the “Arbitrator”) as panellist to decide the Complaint (the “Panel”).
15. On 22 June 2020, the Arbitrator signed the Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.
16. The Registrant made no request for its late response or any other response to be accepted by the Panel. As the Registrant did not submit a response, in accordance with Rule 5.8, the Panel shall decide the Proceeding on the basis of the Complaint.

**IV. The Applicable Law**

17. Pursuant to Rule 12.1, the Panel's decision shall be rendered on the basis of the evidence and argument submitted and in accordance with the Policy, the Rules and any rules and principles of the laws of Ontario and the laws of Canada applicable therein.

**V. Issues to be Determined and the Positions of the Parties**

18. The Complainant alleges that the Registrant is in violation of the Policy in that it has registered a domain name that is Confusingly Similar to Marks in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights in bad faith and without a legitimate interest in the domain name.

19. The Complainant seeks a decision transferring the Disputed Domain Name to it.

20. In accordance with paragraph 1.9 of the Policy, the Complainant represented and warranted that it satisfied the Canadian Presence Requirements ("CPR") for Registrants at the time of submitting the Complaint or the Complaint relates to a trade-mark registered in CIPO and the Complainant is the owner of the trade-mark; and that if CIRA transfers the Registrations that are the subject of the Proceeding to the Complainant, it will satisfy the CPR at the time of transfer.

21. In particular, the Complainant submitted evidence that it owns the trademark KATE SPADE, which is registered at the Canadian Intellectual Property Office ("CIPO") in connection with a number of different goods with registration numbers TMA509501, TMA629164 and TMA715794. This Mark is contained in the Disputed Domain Name. Accordingly, the Complainant has established that it satisfies section 2(17) of the CPR for Registrants as prescribed by the Policy.

**A. Issues to be Determined**

22. In order for the Complainant's Complaint to succeed, pursuant to paragraph 4.1 of the Policy, it must establish on a balance of probabilities that:

- a. The Registrant's dot-ca domain names are 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 of the Policy.

The Complainant must also provide some evidence that:

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

paragraph 3.4 of the Policy.

## **B. The Positions of the Parties**

### Complainant's Position

23. The Complainant, Kate Spade LLC, is the owner in Canada of the trademarks that are the subject matter of this Complaint (the "KATE SPADE Trademarks").
24. The Complainant's brand, KATE SPADE NEW YORK, was founded in New York, NY, USA in 1993 and is one of the most well-known fashion and luxury design houses with more than 150 retail shops and outlet stores across Canada and the United States.
25. The Complainant has been engaged in the production, manufacturing and sale of handbags, apparel, footwear, accessories, and fragrances, among other things, all in association with one or more of the KATE SPADE trademarks since as early as 1994 in Canada. Since its formation, the Complainant has used and registered several of its marks in Canada, the United States and throughout the world.
26. The Complainant has used its KATE SPADE trademark in Canada for over 25 years. As a result of such use, customers in North America and worldwide have come to associate the KATE SPADE mark with Complainant's high-quality products. Accordingly, Complainant has developed considerable goodwill in their well-known KATE SPADE trademarks.
27. The Complainant submits that it continues to invest considerably in the promotion and development of its Marks through marketing, advertising, social media and other internet channels in Canada and globally. The Complainant maintains direct control over the character and quality of their products and services associated with the KATE SPADE Marks.
28. KATE SPADE is registered in Canada for use in association with clothing, footwear, leather goods, textiles, sunglasses, eye frames, cosmetics, and accessories, among other goods/services. In addition to the specific trademarks noted in paragraph 21, above, the Complainant submitted evidence of numerous, additional KATE SPADE trademarks registered with CIPO.
29. The Complainant submits that the Registrant, Daniel Mullen, has engaged in a pattern of unauthorized domain name registrations for years and submitted evidence of previous CDRP decisions involving the Registrant and his unauthorized registration of domain names including those related to the well-known brands Burberry, Dell, Panavision and American Express.
30. The Registrant registered the Disputed Domain Name on 4 September 2010 and it expires on 3 September 2020.

31. The Complainant submitted evidence that the Disputed Domain Name, <katespade.ca>, resolves to a pay-per-click website consisting of related links, also using KATE SPADE trademarks, that resolve to external landing pages and search engines that appear to redirect users to various search engines.
32. The Complainant submits that the Disputed Domain Name is confusingly similar.
33. The Complainant says that it satisfies the definition of a Mark by way of its rights to its trademark, which significantly preceded the registration of the Disputed Domain name, which occurred 16 years after the Complainant's Marks began to be used in Canada.
34. The Complainant submits that in determining whether the Disputed Domain Names are Confusingly Similar to its marks, the Policy requires that the ".ca" portion of the domain name be excluded.
35. Referencing *FreemantleMedia North America Inc. v. Dave Leather*, BCICAC Case No. DCA-1207-CIRA, the Complainant argues that the test for "confusingly similar: is 'one of first impression and imperfect recollection'"; an internet user who has knowledge or recollection of the Mark might easily mistake the Disputed Domain Name as being somehow affiliated to or owned by the Complainant.
36. The Complainant submits that there is no avoiding confusion when the Complainant's entire KATE SPADE mark is appropriated in the Disputed Domain Name and relies on *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020 for this proposition.
37. The Complainant says that the Disputed Domain Name is Confusingly Similar to its Mark, as it is identical and the same in appearance, sound and ideas suggested and therefore likely to be mistaken for the Mark.
38. The Complainant submits that the Registrant has no legitimate interest in the Disputed Domain Name. It is not a Mark used by the Registrant in good faith (or at all) and the Registrant has no rights in the Mark.
39. The Complainant notes that the website is commercial in nature as it resolves to an apparent pay-per-click webpage and features additional components highlighting KATE SPADE trademarks.
40. The Complainant submits that the Registrant has registered the domain name in bad faith in that it was registered or acquired to prevent the Complainant from registering the Mark as a domain name as part of a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names.
41. The Complainant furnished evidence of CDRP and WIPO cases in which Daniel Mullen was ordered to transfer domain names upon a finding of registrations in bad faith, which it

says establish a pattern of bad faith registrations over a period of years.

42. The Complainant also submits that the Disputed Domain Name is likely to cause confusion among internet users, thereby putting the Complainant's business reputation at risk and that the Registrant has attempted to attract for commercial gain users to its website through this confusion.
43. The Complainant submits that the confusing similarity of the Disputed Domain Name combined with the lack of any explanation for why KATE SPADE was chosen for the Registrant's domain are suggestive of bad faith and indicate that the Registrant registered or acquired the Disputed Domain Name for the purpose of disrupting the Complainant's business.

#### Registrant's Position

44. The Registrant did not submit a response.

### **VI. Analysis and Decision**

45. As set out above, in order to succeed in its Complaint, the Complainant must establish on a balance of probabilities that the Disputed Domain Names are Confusingly Similar to a Mark in which it had Rights prior to the date of registration of the Disputed Domain Names and in which it continues to have such Rights. It must also demonstrate that the Registrant has registered the domain name in bad faith, as described in paragraph 3.5 of the Policy. Finally, the Complainant must provide evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4 of the Policy.

#### **A. Are the Disputed Domain Names Confusingly Similar to Complainant's Marks?**

46. Paragraph 3.3 of the Policy provides as follows with respect to what is to be considered "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.

47. Paragraph 1.2 of the Policy clarifies that "[f]or the purposes of [the] Policy, "**domain name**" means the domain name excluding the "dot-ca" suffix".
48. Thus, the inquiry will focus on whether <katespade> so nearly resembles the Mark as to be likely to be mistaken for the Mark.
49. The relevant portion of the definition of "Mark", which is found at paragraph 3.2 of the Policy provides as follows:

A “Mark” is: ...

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

50. The Complainant has established that its Mark, KATE SPADE, is registered in CIPO in connection with goods, services or both. Each of these registrations is current and were first registered in or before 1994.
51. The Disputed Domain Name, which was registered on 4 September 2010, is identical to the Complainant’s registered Mark.
52. The Panel agrees with the Complainant’s submission that the Registrant exploits the goodwill and the image of the Mark by using them in the Disputed Domain Name and that this may result in initial interest confusion among users of the Internet searching for the Complainant’s websites.
53. Accordingly, the Disputed Domain Name is Confusingly Similar to Complainant’s Marks. The Panel finds that the Complainant had rights in those Marks for more than 15 years before the date of registration of the Disputed Domain Name. The evidence also establishes that the Complainant continues to have and actively use such rights.

**B. Were the Disputed Domain Names Registered in Bad Faith?**

54. The Complainant has established the value and notoriety of its brand in the Canadian market, as well as in the United States and globally. The Complainant has satisfied the Panel that it is more likely than not that the Registrant was aware of the Complainant’s Marks when it registered the Disputed Domain Names.
55. Paragraph 3.5 of the Policy sets out a non-exclusive list of circumstances that “shall be evidence that a Registrant has registered a domain name in bad faith” for the purposes of paragraphs 3.1(c) (basis for complaint) and 4.1(b) (onus).
56. The specific circumstances set out in paragraph 3.5 of the Policy that the Complainant alleges are present are a combination of the following:
  - (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;
  - (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.

57. The Complainant submits that the Registrant, through its Authorized Representative, Daniel Mullen, has engaged in a pattern of cybersquatting by holding registrations for several other domain names that misappropriate the trademarks of well-known brands and businesses, which evinces bad faith registration and use.
58. The Complainant has established that Daniel Mullen holds in excess of 6000 domain names, including many that include common and well-known marks.
59. Further, the Panel finds that the Complainant has established, on a balance of probabilities, that the Registrant's Authorized Representative, Daniel Mullen, is a "serial cybersquatter" (see, in particular, *Panavision International, L.P. v. Daniel Mullen c/o/b Netnic Corporation*, 00378- Resolution Canada, 21 November 2018 at para. 33, and more generally, *Burberry Limited v. Burmac Business Systems Ltd.* DCA-1100-CIRA; *Dell Inc. v. NameShield Inc./Daniel Mullen* DCA-1677-CIRA; *American Express Marketing and Development Corp. v. Nameshield Inc., c/o Daniel Mullen* 00249-Resolution Canada. The panels in each of these cases found Daniel Mullen to have registered the disputed domain name(s) in bad faith pursuant to the Policy.
60. The Complainant submits that this pattern of behaviour (registering domain names that are confusingly similar to well-known Marks to which the Registrant has no legitimate interest) with the intention of attempting to attract, divert and drive Internet traffic (consumers interested in the Complainant's goods but confused by the Registrant's use of the Complainant's Mark) to the Disputed Domain Name for Registrant's commercial gain through pay-per-click websites that further use the Complainant's Mark evinces bad faith registration pursuant to the Policy.
61. The Panel agrees and finds that the Complainant has provided sufficient evidence that the Registrant registered the Disputed Domain Name in bad faith.

**C. Is there Evidence that the Registrant has No Legitimate Interest?**

62. The Policy provides that, even if the Complainant establishes that the Disputed Domain Names are Confusingly Similar and registered in bad faith and provides some evidence that there is no legitimate interest on the part of the Registrant, the Registrant will be successful if it proves on a balance of probabilities that it had a legitimate interest in the Disputed Domain Names.
63. As noted above, the Registrant has not provided a response and therefore has not submitted any proof of a legitimate interest pursuant to paragraph 3.4 of the Policy in the Disputed Domain Names.
64. Thus, in order to be successful, the Complainant must simply provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Names. The Complainant makes the following submissions in this regard:



- a. The Disputed Domain Name is not a Mark used by the Registrant in good faith and the Registrant does not have Rights in the Mark (section 3.4(a) of the Policy).
  - b. The Registrant does not appear to use KATE SPADE as a trademark or trade name.
  - c. The Disputed Domain Name is not 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 (section 3.4(b) of the Policy).
  - d. The Registrant has not used the Disputed Domain Name in Canada in good faith in association with a non-commercial activity, including, without limitation, criticism, review or news reporting (section 3.4(d) of the Policy).
  - e. The website is commercial in nature as it resolves to an apparent pay-per-click webpage and features additional components highlighting KATE SPADE trademarks.
  - f. The Disputed Domain Name is not comprised of the legal name of the Registrant nor was it a surname or other reference by which the Registrant was commonly identified, nor is it the geographical name of the location of the Registrant's non-commercial activity or place of business (section 3.4 (e) & (f) of the Policy).
65. In the Panel's view, the Complainant has provided ample evidence that the Registrant has no legitimate interest in the Disputed Domain Names to meet the onus at paragraph 4.1 of the Policy.

## **VII. Decision**

66. For the reasons stated above, the Panel decides in favour of the Complainant and, in accordance with paragraph 4.3 of the Policy and Rule 9.1, orders that the Disputed Domain Name: <katespade> be transferred to the Complainant, Kate Spade LLC.

Dated this 13<sup>th</sup> day of July 2020

/signed/

Tina M Cicchetti, Panellist