

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

DECISION

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| Domain name in issue: | menswarehouse.ca |
| Complainant: | The Men's Wearhouse Inc. |
| Registrant: | Wade Traversy |
| Registrar: | Dotcanuck Web Services (Transnational Media Inc.) |
| Panellist: | David Allsebrook |
| Dispute Resolution Service Provider: | Resolution Canada, Inc. |

Summary

The Complainant, The Men's Wearhouse Inc. is a large U.S. clothing retailer, which seeks the transfer to it of the Canadian domain name menswarehouse.ca. The Complainant owns the registered Canadian trade marks The Men's Wearhouse and menswearhouse.com. The Respondent, Wade Traversy, is an individual resident in British Columbia, Canada. He has filed no response to these proceedings.

Threshold issues

Jurisdiction of the panel

The Canadian Internet Registration Authority (CIRA) operates the .ca Internet domain. All registrants of domain names ending ".ca" have agreed, through contracts entered into with CIRA at the time of registration (the Registration Agreement), to abide by CIRA's Domain Name Dispute Resolution Policy (the "Policy") and the procedural Rules pertaining thereto (The Rules).

CIRA has named Resolution Canada as one of the service providers (the "Provider") to manage the conduct of complaints under the Policy. Resolution Canada has appointed the undersigned as the sole panelist to decide the complaint.

By submitting a complaint under the Policy, and expressly in its submissions, the Complainant has agreed to be bound by the terms of the Policy (Policy, clause 1.9(a)). It has provided the Certification prescribed in Appendix A to the Rules. The Complainant's Canadian trade mark registrations satisfy the Canadian presence requirement.

The undersigned has delivered a statement of impartiality and independence to Resolution Canada as required by Rule 7.1.

All of the requirements for the appointment of a panel and consideration by it of a complaint have been met.

Service of the Complaint

The complaint was delivered by commercial courier, on December 16, to the address given by the Registrant for the administrative contact. Accordingly I find that the respondent was served with the complaint in accordance with Rule 2.1(a)(i).

The 20 days provided for a response have passed without communication from the Registrant.

Pursuant to Rule 5.8 the Panel is obliged to proceed to a decision based upon the unanswered record filed by the complainant.

Analysis of the Complaint

The Policy presently in effect is Version 1.1. It stipulates that to succeed in obtaining the transfer to it of the domain name, the Complainant must show 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 3.6; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7.

Confusing Similarity

The Complainant submitted certificates of two Canadian trade marks registered in its name. Both predate the registration of the domain name in issue.

The trade mark THE MEN'S WAREHOUSE is registered for use in association with clothing, namely, "men's, women's and boys' suits, sportcoats, slacks, raincoats, all weather coats, umbrellas, rainboots, jackets, coats, scarves, ties and belts", and for "retail clothing store services". The trade mark has been used in Canada since July 2001.

The trade mark MENSWEARHOUSE.COM is registered for use in association with the sale of clothing on line, namely, “computer on-line retail services in the field of men's clothing, sportswear and related accessories; providing access to an on-line database in the nature of an interactive directory featuring information about men's clothing and accessories; providing information about Applicant's corporate and business principles, and newsletters of general interest; providing and on-line searchable database guide for locating, organizing and presenting men's clothing and retail stores; association services, namely providing opportunities for exchange of information regarding a wide variety of topics by means of a global computer network; computerized on-line services featuring gift certificates for electronic or paper delivery.” This trade mark has been used in Canada since July 1996.

The Men's Wearhouse is a substantial business, having 500 clothing stores in the United States and \$1.4 billion dollars in sales. The complaint states that The Men's Wearhouse has “a loyal following of Canadian Customers” and lists its U.S. retail locations near Canada, which it actively promotes to Canadian customers. No sales figures to Canadians are given.

In addition, the marketing and sale of clothing at a web site located at menswearhouse.com is said to be a cornerstone of The Men's Wearhouse's marketing strategy. Pages from the menswearhouse.com web site, demonstrating its presentation of men's clothing for sale, are included in the complaint.

A print out of some of the web site located at the disputed domain name is included in the complaint. It consists almost entirely of descriptions of articles of men's clothing. Most of the descriptions are cryptic, such as “BLAIR Menswear: Men's Diamond Cut Carpenter Jeans (Jeans)”. A few articles of clothing are shown in small photographs. The clothing descriptions are all hyperlinks. There are no other pages on the site. There is no means of ordering the clothing on the site, no means of contacting the host of the site, nor is there any identification or description of the site operator.

The complaint states that the respondent appears to generate sales revenue through referral marketing or pay per click advertising. The links on the menswarehouse.ca site take the user to third party web sites which sell clothing, after passing briefly through a Commission Junction web site. Commission Junction is an intermediary which measures the referral traffic from one web site to another so as to determine compensation payable. The third party sites expressly offer to pay referral fees to anyone whose web site generates sales for them through click through traffic. In other words, the menswarehouse.ca web site does not sell clothing, but promotes the sale of

clothing by others. It has no other function but to serve as an elementary on-line catalogue for third parties.

There is no doubt that menswarehouse.ca is confusingly similar to menswearhouse.com and The Men's Wearhouse. The play on words included in the registered trade marks lends them a degree of inherent distinctiveness. Their use predates the use of menswarehouse.ca, in one case by seven years. The goods sold by the complainant in connection with its trade marks are of the same kind as those promoted by the registrant. Both seek to profit from the trade in men's clothing on line. Both are aimed at Canadian consumers. The domain name menswarehouse.ca embodies one of the meanings of the Complainant's trade marks. The similarity in appearance, meaning and pronunciation is strong.

Legitimate Interest

The onus of proof is on the Complainant to show "some evidence" that the Registrant has no legitimate interest in the domain name. Applying the criteria listed in paragraph 3.6 of the Policy, the evidence suggests that the Registrant has no legitimate interest in the domain name. Despite the implication in the domain name, no warehouse is involved in the menswarehouse.ca operation. The entire enterprise is a web site. Thus the domain name is both misdescriptive and confusing with registered trade marks. In the absence of any explanation by the Registrant, I must conclude that the Complainant has met its onus of proof.

Bad faith

When contacted by the Complainant's solicitors, the Registrant is said to have offered to sell the domain name for \$12,000, which he said reflected twelve months of revenue generated using the domain name. An offer to sell a domain name at a high price in response to a complaint is not in itself evidence of bad faith, as it may be a reasonable response from a legitimate holder of a domain name. However, the fact that the Registrant claimed to place value on the domain name, and did not answer the complaint (despite his obligation under the Policy to do so) suggests a tacit acknowledgement that his registration of menswarehouse.ca was in bad faith.

Under the Policy, a registration is considered to have been in bad faith if "the Registrant registered the domain name ... 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." (Clause 3.7(c)). The evidence presented strongly suggests that the Registrant's enterprise is predicated entirely upon the confusing similarity of the menswarehouse.ca domain name and the Complainant's name and trade marks. Given the crude nature of the site at

menswarehouse.ca, it is hard to imagine how it could generate \$1,000 a month in click through revenues unless it was by confusing customers seeking the Complainant. Accordingly I find the registration to have been made in bad faith.

DECISION AND ORDER

Having considered all evidence and submissions filed in the proceeding, and in accordance with the reasons given above, I hereby order and direct that the domain name menswarehouse.ca be transferred to the Complainant.



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David Allsebrook, B.B.A., M.B.A., LL.B., B.C.L.

Sole Panellist

January 28, 2005

Toronto, Ontario, Canada.