

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

Domain Name: bareminerals.ca

Complainant: Bare Escentuals Beauty, Inc.

Registrant: Peter Munch

Registrar: MyID.ca Inc.

Panel: Sharon Groom (Chair), David Allsebrook, James Minns

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. Bare Escentuals Beauty, Inc. (the “Complainant”), is a wholly owned subsidiary of Shiseido Americas Corporation and is located in the United States.
2. The registrant for the domain name is Peter Munch (the “Registrant”) who is located in Ontario, Canada.

B. The Domain Name and Registrar

3. The disputed domain name is bareminerals.ca (the “Domain Name”). The registrar for this domain name is MyID.ca Inc. (the “Registrar”). The disputed Domain Name was registered on July 4, 2018 by Hiba Alnatour and transferred to Peter Munch on or about January 21, 2019.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution service provider, Resolution Canada, Inc. (“Resolution Canada”), is that the Complainant filed a complaint against

the Registrant with Resolution Canada requesting that the current registration of the Domain Name be transferred to the Complainant.

6. The complaint was originally dated January 29, 2019 and named Hiba Alnatour, located in Lebanon, Beirut as the registrant, but was amended on March 14, 2019 to add the registrant Peter Munch.

7. In its complaint the Complainant indicates that it sent a cease and desist letter on November 20, 2018 through CIRA's Messenger Service to the owner of the Domain Name as the ownership information was concealed at the registry level. The Complainant received confirmation that it was delivered, however no response was received.

8. The Complainant then petitioned CIRA to disclose the ownership information associated with the Domain Name and on December 17, 2018 CIRA sent an email indicating that the registered owner of the Domain Name was Hiba Alnatour, with an address in Lebanon, Beirut.

9. It appears that the complaint was sent to Resolution Canada on or about January 29, 2019 and on January 30, 2019 Resolution Canada emailed CIRA to request the registrant information for the Domain Name and was provided with the name of Peter Munch with an incomplete street address in Toronto, Ontario.

10. Although the panel does not have this evidence in front of it, it appears that the complaint was forwarded to, or brought to the attention of, the Registrar and/or Peter Munch prior to the date that the complaint was amended and officially submitted on March 14, 2019. In this regard the Registrant has submitted evidence in his response, which was filed April 15, 2019, consisting of various emails dated prior to March 14, 2019 including one dated February 8, 2019 from the Registrar to Resolution Canada stating that "Hiba [sic] Alnatour is not the registrant" of the Domain Name and an email dated February 19, 2019 from Peter Munch to Resolution Canada in which he asserts his ownership of the Domain Name.

11. It appears that the name of the registrant of the Domain Name was changed from Hiba Alnatour to Peter Munch at some point between December 17, 2018 and January 30, 2019. Peter Munch claims that he acquired the Domain Name on January 21, 2019 but the only evidence supplied in support of this statement is an email from CIRA Registration Services dated January 21, 2019 to Peter Munch stating that the Domain Name has been "successfully transferred to a new Registrar". The new registrar is stated as MyID.ca, which is the same as the former registrar, so it is not clear what actual change took place.

12. The Complainant was made aware of the change of name of the registrant of the Domain Name so amended the complaint to add Peter Munch's name on March 14, 2019 and filed it with Resolution Canada. Otherwise the complaint remained the same, and included the name of Hiba Alnatour as a registrant.

13. Resolution Canada served notice of the complaint on the Registrant Peter Munch as required by paragraph 4.3 of the Rules. Service of the complaint was made by email on March 15, 2019.

14. The Registrant was given 20 days to file a response and filed a response on April 15, 2019. The panel was appointed on August 19, 2019.

15. On May 2, 2019 the Complainant requested from Resolution Canada the right to file additional submissions and on May 7, 2019 the Registrant requested from Resolution Canada the right to file an addendum of its own. These requests were remitted to the panel for consideration and on August 21, 2019 the panel informed Resolution Canada that it had determined that it would not be accepting any further submissions from either side. Section 11.1 of the Policy provides that neither party shall have the right to submit additional evidence or argument unless the panel specifically requests it, and in this case the panel decided to render its decision on the pleadings before it.

D. Panellist Impartiality and Independence

16. As required by paragraph 7 of the Rules, the panellists have submitted to Resolution Canada declarations of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

17. The Complainant is a company located in the United States. However it is the registered owner of various registrations for trademarks incorporating the word BAREMINERALS in Canada, including registration no. TMA698113 for the mark BAREMINERALS which was registered in 2007. The Domain Name consists of this mark, therefore, the Complainant satisfies the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

18. The Complainant is the owner of seven registrations for marks incorporating the words BAREMINERALS in Canada, all of which were registered before the registration date of the Domain Name and the mark BAREMINERALS as been used in Canada since 2005. The marks are used in association with the advertising and sale of cosmetics and the Complainant operates a website at bareminerals.com where the cosmetics may be viewed and purchased in Canada.

19. The Complainant asserts that as a result of extensive and continuous use, the BAREMINERALS trademarks have achieved an exceptional reputation around the world and in Canada.

20. The Domain Name is not active.

G. CIRA Domain Name Dispute Resolution Policy

21. Paragraph 4.1 of the Policy requires that the Complainant establish 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 registered the domain name in bad faith as described in section 3.5; and

(c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

22. The Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. 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 section 3.4 of the Policy.

H. Analysis

Rights to a Mark

23. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights (and continues to have these rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name.

24. The Domain Name was registered on July 4, 2018, therefore this is the earliest possible relevant date for this analysis.

25. A “Mark” is defined in paragraph 3.2(c) of the Policy as:

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

26. The Complainant has submitted evidence of its registration of the trademark BAREMINERALS in seven trademark registrations, each of which was registered prior to the registration date of the Domain Name. It also has submitted evidence of use of the marks in on its website bareminerals.com. Therefore the panel finds that the Complainant has established that it had rights in a mark prior to the date of registration of the Domain Name, and continues to have these rights.

27. The Domain Name consists of the word BAREMINERALS, which is the same as the only word in two of the registered marks. Therefore, pursuant to paragraph 3.3 of the Policy, the panel finds that the Domain Name is confusingly similar to the mark BAREMINERALS as it so nearly resembles the mark in appearance, sound and in the idea suggested by the mark as to be likely to be mistaken for the mark.

Bad Faith

28. The Complainant also has to show, on the balance of probabilities, that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds which constitute

bad faith and it must be noted that these are not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.

29. The Complainant argues first that the Registrant's conduct constitutes bad faith pursuant to paragraph 3.5(b) of the Policy which states:

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.

30. In order to succeed on this ground the Complainant has to show, on the balance of probabilities, 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 Complainant has presented a copy of one of the Registrants' dot-ca domain name portfolios, which consists of 3591 domain name registrations including some which are comprised of, or confusingly similar to, registered trademarks of others. However there is no date provided for the time when this information was received by the Complainant, and the submission relating to this evidence in the complaint is not underlined, as are the other amendments to the complaint, so it appears to the panel that this information was part of the original complaint submitted on January 29, 2019 and was thus obtained using the original registrant's name, Hiba Alnatour, not the name of Peter Munch. Peter Munch in his response denies that he owns any of these domain names and asserts that the only domain name registered to Peter Munch is bareminerals.ca.

31. This evidence certainly demonstrates bad faith against the original registrant - Hiba Alnatour - as she has registered numerous domain names which contain, or consist of, registered marks belonging to third parties, thus establishing a pattern. In addition, the registration of these domain names in many cases prevents the owners of the trademarks from registering them as .ca domain names without the addition of other words., and certainly prevents the Complainant from registering its mark BAREMINERALS as a .ca domain name.

32. The fact that this Domain Name was transferred to Peter Munch shortly after the cease and desist letter was sent in November 2018 suggests, in the absence of any other explanation, that the transfer took place to thwart the attempt of the Complainant to obtain the Domain Name and thus implies that the parties were not dealing at arm's length and were in fact acting in concert in the transfer of this Domain Name. Peter Munch did not file any evidence to provide an alternate explanation for this transfer, nor did he provide any legitimate interest in the Domain Name. He adopted a very aggressive tone in his Response and submitted various submissions and emails as evidence, yet notably did not include anything which actually explained how and why he came to acquire the Domain Name.

33. The panel therefore finds that, on the balance of probabilities, the current registrant Peter Munch acted in concert with the original registrant Hiba Alnatour, to register the Domain Name

and then transfer it from one party to the other in order to prevent the Complainant from registering the mark BAREMINERALS as a domain name. The fact that the parties do not seem to be acting at arm's length leads the panel to find that the Registrant also acted in concert with the original registrant Hiba Alnatour in engaging in a pattern of registering domain names in order to prevent persons who have rights in marks from registering the marks as domain names. Therefore the panel finds that there was bad faith pursuant to paragraph 3.5(b) of the Policy.

34. As an additional surrounding circumstance leading to a finding of bad faith, the panel finds that the timing of the transfer of the Domain Name to the Registrant, coming approximately two months after the original cease and desist letter was sent, and one month after CIRA provided the registrant information to the Complainant, suggests that it occurred to try and thwart the dispute resolution proceedings. The Registrant must have been in contact with the original registrant to have obtained a transfer of the Domain Name as alleged, yet the Registrant did not make any effort to explain the circumstances of the transfer nor did he deny knowing about the cease and desist letter. In addition he did not provide a legitimate reason for the Registrant's interest in the Domain Name, especially occurring as it did at a critical time. The Registrant's language in his response demonstrated a clear understanding of domain name dispute resolution proceedings, so the choice to remain silent on these pertinent issues is an additional ground which suggests that the Domain Name was registered in bad faith.

35. Therefore, this panel determines that on the balance of probabilities, that the Domain Name was registered in bad faith pursuant to paragraphs 3.5(b) and 3.5(d) of the Policy, and based on additional surrounding circumstances.

Legitimate Interest

36. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the domain name. Paragraph 3.4 lists six possible ways in which a Registrant may have a legitimate interest in a domain name which are as follows:

(a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

(b) 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;

(c) 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;

(d) 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;

(e) 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

(f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

This list is not exhaustive as it is said to be "without limitation". Therefore neither party is bound by only those criteria.

37. In addressing the subject of legitimate interest we note that the Complainant has established that it has rights in the mark BAREMINERALS, which is reproduced in the Domain Name, and the Registrant has not been licensed to use this Mark. Therefore there can be no legitimate interest under subsection (a). The term BAREMINERALS has not been used by the Registrant in association with any wares, services or business and the term is not clearly descriptive as referred to in subsection (b), nor is it a generic term. There is no evidence that the Registrant has used it for a non-commercial activity including, criticism, review or news reporting, so subsections (c) and (d) are not applicable. Finally, the Domain Name is not the name of the Registrant nor is it the name of a geographic place, therefore neither subsections (e) or (f) apply either.

38. The burden of proof of lack of legitimate interest falls upon the Complainant. It is however a light burden, as knowledge of the use and rights in the domain name is better available to the registrant, such that demonstration by a complainant that there are reasonable grounds to question whether a registrant has any legitimate interest is sufficient to discharge the burden and cast upon the registrant the onus of proving its legitimate interest. The Complainant discharges this onus by the suspicious timing and lack of explanation of the transfer of the domain name, aided by the snide and dismissive tone and the studied lack of information in the response, thus shifting the onus of proof to Mr. Munch. Mr. Munch has explicitly elected not to supply evidence of any legitimate interest. We therefore find that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the Domain Name.

39. The Registrant has not rebutted the Complainant's evidence with any evidence of its own, therefore he has not shown, on the balance of probabilities, that he has a legitimate interest in the Domain Name.

I. Conclusion and Decision

40. In conclusion, the panel finds that the Complainant has rights in the mark BAREMINERALS which predate the registration of the Domain Name. The panel also finds that the Domain Name is confusingly similar to the Complainant's mark, that the Domain Name was registered in bad faith and that the Registrant has no legitimate interest in the Domain Name.

41. The panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name bareminerals.ca be transferred to the Complainant.

Dated: September 6, 2019

A handwritten signature in black ink, appearing to read "Sharon Groom", written over a horizontal line.

By: Sharon Groom (Chair)

A handwritten signature in blue ink, appearing to read "David Allsebrook", written over a horizontal line.

By: David Allsebrook

A handwritten signature in blue ink, appearing to read "James Minns", written over a horizontal line.

By: James Minns