



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE
DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL
DECISION

CIIDRC case number:	20099-CDRP	Decision date: April 11, 2023
Domain Name:	guess-canada.ca	
Panel:	Hon. Neil Brown, KC	
Complainant:	Guess? IP Holder L.P.	
Complainant's representative:	Karl Racine	
Registrant:	Everett Aguilar	

OVERVIEW

1. This matter concerns a dispute between the Complainant and the Registrant regarding the registration and use of the domain name <guess-canada.ca> ("the disputed domain name").
2. The Canadian International Internet Dispute Resolution Centre ("CIIDRC") is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy ("the Policy") of the Canadian Internet Registration Authority ("CIRA").
3. This is a proceeding under the CIRA Domain Name Dispute Resolution Policy ("the Policy"), in accordance with the CIRA Dispute Resolution Rules ("the Rules").
4. The Complainant claims that the Registrant registered the disputed domain name in breach of the Policy and that it should be transferred from the Registrant to the Complainant. The Registrant has not filed a Response in this proceeding.

THE PARTIES

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1. The Complainant in this proceeding is: Guess ? IP Holder L.P., 1444 South Alameda Street, Los Angeles, California, 90021-0932, United States, ("the Complainant") and its Authorized Representative in this proceeding is Karl Racine, Gowling WLG (Canada) LLP, Suite 2600, 160 Elgin Street, Ottawa, Ontario K1P 1C3, Canada.
2. The Registrant of the disputed domain name in this proceeding is Everett Aguilar, 2884 Spruce Drive, New Bedford, 16143, Pennsylvania, United States. ("the Registrant").

REGISTRATION OF THE DISPUTED DOMAIN NAME

1. The Registrant registered the domain name <guess-canada.ca> ("the disputed domain name") on April 25, 2022.
2. The Registrar of the disputed domain name is CentralNic Canada Inc. of abuse@hexonet.net.

PROCEDURAL HISTORY

According to the information provided by CIIDRC:

- a) The Complainant filed a Complaint with respect to the disputed domain name in accordance with the Policy and the Rules on March 9, 2023. The Complaint was reviewed and found to be administratively compliant.
- b) By email dated March 9, 2023, the CIIDRC as service provider confirmed administrative compliance of the Complaint and commencement of the dispute resolution process, as Notice in accordance with Rules 2.1 and 4.3, and forwarded a copy of the Complaint to the Registrant together with its Schedules, by email on that date, together with CIIDRC's commencement letter. No response was received from the Registrant by the deadline of March 29, 2023 or at all. The Registrant's address and telephone number provided by CIRA are invalid.
- c) As permitted, given the absence of a Response, the Complainant elected to convert from a three-person tribunal to a single arbitrator.
- d) On April 6, 2023, CIIDRC appointed as a single-member Panel in this proceeding The Honorable Neil Anthony Brown KC who has completed and returned to CIIDRC a statement of acceptance and a declaration of impartiality and independence. The Panellist's decision is due to be provided to CIIDRC by April 27, 2023.
- e) The Panel has reviewed all of the material submitted by the Complainant and is satisfied on that material that the Complainant is an eligible Complainant under the Policy and the Rules by virtue of its ownership of the trademark registrations referred to hereafter.

FACTS

The facts set out below are taken from the Complaint, together with related exhibits.

- a) The Complainant is a United States company engaged internationally in the industry of designing, distributing and licensing world-class collections of contemporary apparel and accessories for men, women and children. It is very well known and its GUESS brand is famous. It was established in 1981.

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- b) The Complainant's GUESS brand is protected worldwide by an extensive portfolio of trademark registrations. Its Canadian portfolio comprises various Canadian trademark registrations ("the GUESS Trademarks") that includes the trademark GUESS (TMA374149) for fashion and related retail services on which this Complaint is based. Details of its trademarks have been tendered and will be referred to in this decision.
- c) The Complainant operates an extensive range of websites comprising the GUESS trademarks in 55 countries including at www.guess.com and www.guessfactory.com.
- d) Its Canadian trademark registrations are granted by the Canadian Intellectual Property Office ("CIPO"), within the meaning of s.2 (q) of the Canadian Presence Requirements and for which public notice has been given by CIPO, within the meaning of s.2 (r) of the Requirements.
- e) The trademark registrations are set out in the Complaint and particulars of those registrations are set out in Annex 2 to the Complaint.
- f) It has come to the notice of the Complainant that on April 25, 2022, the Registrant registered the disputed domain name which has been used for a website at www.guess-canada.ca. This is a matter of great concern to the Complainant, as the website is masquerading as that of the Complainant, misappropriating entire images from official Guess websites and presenting them as its own, as is made very apparent from a side-by-side comparison of the Registrant's website with the official GUESS website of the Complainant.
- g) The Complainant has tried to stop the Registrant's conduct and to have the disputed domain name transferred to the Complainant but to no avail.
- h) Accordingly, the Complainant has filed this Complaint to have the disputed domain name transferred from the Registrant to the Complainant to rectify the damage already done to its good name and business reputation and to prevent any more damage being done thereto.
- i) The Registrant has not filed a Response in this proceeding.
- j) To establish that the Complainant meets CIRA's Canadian presence requirements, it relies on the fact that it is the owner of trademarks which are the subject of registration in Canada under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, notable Canadian Trademark Registration No. TMA374149 registered on October 12, 1990.
- k) The Complainant has been selling its products in Canada since prior to the registration of the disputed domain name.

CONTENTIONS OF THE PARTIES

A. THE COMPLAINANT

The Complainant submits as follows:

1. CANADIAN PRESENCE REQUIREMENTS

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- a) The Complainant submits that it satisfies the Canadian Presence Requirements of paragraph 1.4 the Policy in view of the fact that it owns several Canadian trademark registrations granted by the Canadian Intellectual Property Office ("CIPO"), within the meaning of s.2 (q) of the Requirements referred to above as the GUESS trademarks and in particular its mark for GUESS, referred to above as the GUESS trademark, all of which are more particularly set out in Annex 2 of the Complaint. Alternatively, the Complaint relates to a trademark registered in CIPO and the Complainant is the owner of the trademark.
- b) Accordingly, the Complainant submits that it satisfies the Canadian Presence
- c) Requirements for this Complaint.

2. THE REGISTRATION OF THE DISPUTED DOMAIN NAME

- a) The disputed domain name was registered by the Registrant on April 25, 2022.
- b) The Registrar of the disputed domain name is CentralNic Canada Inc. of abuse@hexonet.net .

3. THE GROUNDS ON WHICH THE COMPLAINT IS MADE

Confusingly Similar

- a) The Complainant submits that the disputed domain name is confusingly similar to a mark in which it had rights prior to the date of the registration of the domain name and continues to have such rights.
- b) In that regard the Complainant is the owner of numerous trademarks for GUESS and GUESS with extensions, that are the subject of registration in Canada and in the Canadian Intellectual Property Office ("CIPO") under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13.
- c) In particular, the Complainant relies on the registered trademark for GUESS, being Registered No. TMA374149, registered in the name of the Complainant as owner on October 12, 1990, renewed on October 12, 2020 and continuously and currently owned by the Complainant ("the GUESS trademark"). The Complainant has remained the owner of the GUESS trademark since its inception and hence prior to the date of the registration of the disputed domain name. It continues to have such rights and the next date for renewal of the trademark is October 12, 2030.
- d) The GUESS trademark is registered for a broad range of goods and services including men's, women's and children's clothing of an equally broad range and variety and for the operation of a business specializing in the sale of apparel and accessories. All of that range of goods and services is offered by the Complainant in its business.
- e) The disputed domain name is confusingly similar to the disputed domain name as it includes the GUESS trademark in its entirety and adds only the geographic identifier "canada", which indicates to the internet user that it relates to the activities of the Complainant in Canada; a hyphen which does not negate the confusing similarity and the "dot-ca" suffix which is disregarded for the purposes of making the comparison between the domain name and the trademark. Moreover, the GUESS mark is famous and its presence in the domain name indicates an intention by the Registrant to confuse internet users into believing that the

domain name is a domain name of the Complainant or that the Complainant has authorised or approved of its creation and use.

Legitimate Interest

- a) The Complainant submits that the Registrant has no legitimate interest in the disputed domain name as it does not come within any of the criteria set out in paragraph 3.4 of the Policy because none of those criteria could possibly be established on the facts of this proceeding. Indeed, all of the facts militate against a finding of legitimate interests in the domain name on the part of the Registrant.
- b) The Complainant elaborates on each of the criteria set out in paragraph 3.4 to show that none of them apply in the present case.

Bad Faith

- a) The Complainant submits that the Registrant has registered the disputed domain name in bad faith as described in paragraph 4.1 of the Policy. The facts bring the case within paragraph 3.5 of the Policy as the Registrant clearly intended to create a likelihood of confusion with the Complainant's GUESS trademark within the meaning of paragraph 3.5(d) of the Policy.
- b) The registration of the domain name, being confusingly similar to the GUESS trademark, shows opportunistic bad faith. The Registrant must have had the Complainant in mind in selecting the domain name. The Registrant also must have been aware of the mark as it reflected one of the most significant markets for fashion products. The registration therefore must have been in bad faith.
- c) Registering the domain name and setting up an associated retail website using the GUESS mark and images, all without permission, is clear evidence of bad faith registration and use.
- d) The Complainant's submissions are supported by references to the relevant Canadian law and prior domain name decisions in CIRA and related proceedings.

Conclusion.

The Complainant therefore submits that the disputed domain name should be transferred from the Registrant to the Complainant.

B. THE REGISTRANT

The Registrant did not file a Response to this proceeding.

DISCUSSION OF THE ISSUES AND FINDINGS

1. CANADIAN PRESENCE REQUIREMENTS

Paragraph 1.4 of the Policy provides that a complainant initiating a complaint must satisfy the Canadian Presence Requirements for Registrants in respect of the domain name that is the subject of the proceeding.

Paragraph 2 (q) of the Canadian Presence Requirements for Registrants establishes that requirement in the following circumstance:

“Trade-mark registered in Canada. A Person which does not meet any of the foregoing conditions, but which is the owner of a trade-mark which is the subject of a registration under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark;...”. Alternatively, the Complaint relates to a trademark registered in CIPO and the Complainant is the owner of the trademark.

- a) The evidence, which the Panel accepts, is that the Complainant is the owner of a trademark which is the subject of registration under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registered No.TMA374149, for GUESS, registered in the name of the Complainant as owner on October 12, 1990 renewed on October 12, 2020 and still current.
- b) The Complainant has therefore satisfied CIRA's Canadian Presence Requirement for Registrants in respect of the disputed domain name and is entitled to initiate the Complaint.

2. REGISTRATION OF THE DISPUTED DOMAIN NAME

- a) The disputed domain name <guess-canada.ca> was registered by the Registrant on April 25, 2022.
- b) The Registrar of the disputed domain name is CentralNic Canada Inc. of abuse@hexonet.net .
- c) The foregoing matters were established by evidence that the Panel accepts.
- d) The Panel will therefore proceed with this matter on the basis that the Complainant has made out its standing to file the Complaint and that the Registrant is the proper party against whom the proceeding should be brought.

3. GENERAL

The purpose of the Policy, as stated in paragraph 1.1, is to provide a forum in which cases of bad faith registration of .CA domain names can be dealt with relatively inexpensively and quickly.

In accordance with paragraph 4.1 of the Policy, to succeed in the Proceeding, the Complainant must prove, on the balance of probabilities, 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; and
- b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5 or generally; and the Complainant must provide some evidence that:

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

The Panel will now deal with each of the three elements.

CONFUSINGLY SIMILAR

As the Complainant correctly submits, it is required to prove that the disputed domain name is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the disputed domain name and continues to have such Rights. The Complainant must therefore show that it has rights to a mark, that it had those rights before the domain name was registered, that it still has them and that the disputed domain name is confusingly similar to the mark on which it relies to establish that proposition. The Complainant submits that it can meet those requirements.

The Mark

- a) The first question that arises is whether the Complainant has a trademark on which it can rely for the purpose of this proceeding. The Complainant relies on the series of GUESS trademarks and in particular the GUESS trademark which is a Canadian trademark which is Canadian Trademark Registered No. TMA374149, registered in the name of the Complainant in CIPO as owner on October 12, 1990, renewed on October 12, 2020 and due for renewal on October 12, 2030.
- b) The GUESS trademark is registered for a broad range of goods and services including men's, women's and children's clothing of an equally broad range and variety and for the operation of a business specializing in the sale of apparel and accessories. All of that range of goods and services is offered by the Complainant in its business.
- c) The Complainant has established its trademark rights by evidence which the Panel accepts, namely documentary evidence from CIPO set out in Annex 2 of the Complaint. Copies of the relevant trademark registrations adduced by the Complainant in evidence are annexed to the Complaint as Annex 2.
- d) The Panel finds that the GUESS trademark is a mark as defined by Paragraph 3.2 of the Policy and that it comes within the meaning of "mark" in Paragraph 3.2 (a), as the unchallenged evidence shows that it is "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;...".
- e) The Panel also finds that the Complainant adopted the GUESS trademark as its trademark in the trade and industry in question from at least October 12, 1990 when the trademark was registered which was of course well prior to the disputed domain name being registered.
- f) The Panel also finds that the GUESS trademark is a mark in which the Complainant continues to have such rights.

Confusingly similar

- a) Pursuant to paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles the same in appearance, sound or in the ideas suggested as to be likely to be mistaken for the mark. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection and the "dot-ca" suffix should be excluded from consideration.
- b) Having regard to those principles, the Panel finds that the disputed domain name is confusingly similar to the GUESS trademark. That is because the entirety of the trademark is contained in the domain name. The hyphen in the domain name could not possibly negate the confusing similarity between the domain name and the trademark and prior Panels have consistently taken that view.
- c) Likewise, panels have consistently ignored the "dot-ca" suffix in this comparison as it could not negate a finding of confusing similarity and as all Canadian domain names require that suffix.
- d) The internet user would therefore naturally conclude that the domain name is virtually identical to the trademark and would see it as confusingly similar to the trademark for that reason.
- e) Moreover, an internet user would also conclude that the idea suggested by the domain name was that it was an official domain name of the Complainant that would lead to a website dealing with the Complainant's business conducted under the GUESS trademark.
- f) The Panel agrees with the submission of the Complainant that the disputed domain name is confusingly similar to the disputed domain name as it includes the GUESS trademark in its entirety and adds only the geographic identifier "canada", which indicates to the internet user that it relates to the activities of the Complainant in Canada.
- g) The Panel also agrees with the submission of the Complainant that the GUESS trademark is famous and its presence in the domain name indicates an intention by the Registrant to confuse internet users into believing that the domain name is a domain name of the Complainant or that the Complainant has authorized or approved of its creation and use.
- h) Accordingly, the Panel finds that the disputed domain name is, for the purposes of the Policy, confusingly similar to the GUESS trademark as it so nearly resembles the marks in appearance, sound and in the ideas suggested as to be likely to be mistaken for the GUESS trademark within the meaning of Paragraph 3.3 of the Policy.
- i) The Complainant has thus made out the first of the three elements that it must prove.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

- a) The Complainant submits that the Registrant does not have a legitimate interest in the disputed domain name within the meaning of Section 3.4 of the Policy.
- b) The Registrant has not been using the GUESS mark in any way that would provide legitimate rights in the name. It has no registered trademark corresponding to the domain name and was not authorized by the Complainant to register it.

- c) The Registrant is not using the name GUESS as a company name as authorized by the Complainant and has no other legal rights in the name. Rather, it is clearly the fame of the Complainant's trademark and business that has motivated the Registrant to register the disputed domain name.
- d) Moreover, is inconceivable that the Registrant would use the GUESS trademark without being aware of the Complainants' rights to it, as it is very prominent as a trademark and has been so for many years, including in Canada.
- e) The Registrant is also wrongly using the domain name to redirect internet users to its own website. The Panel has examined the evidence submitted to that effect and finds that it clearly makes out the Complainant's submissions. As such, on the evidence, the Registrant is neither using the disputed domain name to provide a bona fide offering of goods or services, nor a legitimate non-commercial or fair use as allowed under the Policy.
- f) Redirecting an internet user to a registrant's website shows an intention to profit from the goodwill of the Complainant and the confusion created by the confusingly similar nature of the disputed domain name with the Complainant's marks and this conduct does not show a legitimate interest, but the opposite.
- g) For the reasons set out above, the Panel finds that the Registrant has no rights or legitimate interest in the disputed domain name. The Panel agrees with the Complainant's submissions in every respect and finds accordingly that the Registrant has and had no right to register the disputed domain name and has no legitimate interest in it.
- h) To look at the matter in more detail, the Panel agrees with the Complainant that the task of the Panel is to see if the Complainant has provided "some evidence" that the Registrant has not brought itself within any of the specific criteria in paragraph 3.4. Applying that test, the Panel finds that the Complainant has provided evidence that the Registrant has no legitimate interest in the disputed domain name. In particular, the Complainant has shown by the evidence that, as the Complainant submitted and as the Panel agrees, that:

The Registrant has not used the domain name in good faith under paragraph 3.4(a).

The Registrant has not used the domain name in good faith under section 3.4(b).

The Registrant has not used the domain name in good faith under section 3.4(c).

The Registrant has not used the domain name in good faith under section 3.4(d).

- i) The Registrant also cannot have used the domain name under section 3.4(e) as it is not the legal name of the Registrant or a name by which the Registrant is commonly known.
- j) The Registrant also cannot have used the domain name under section 3.4(f) as it is not the geographical location of the Registrant as defined.
- k) Moreover, in each of the criteria mentioned above, the Panel finds that the facts as they are known from the evidence simply cannot be accommodated in any of those provisions. The Complainant has therefore shown very persuasively that on the available evidence and inferences that can be drawn from it, that the Registrant has no legitimate interest in the disputed domain name.

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- l) The Panel has also examined each of the circumstances set out in the various sub-paragraphs of paragraph 3.4 of the Policy. It is apparent to the Panel that the Registrant could not conceivably bring itself within any of the circumstances in those sub-paragraphs. In this regard it must be remembered that the Registrant has in effect taken the Complainant's trademark without permission, set itself up as having an interest in the trademark, caused the domain name to resolve to its website and caused it to be used in the Registrant's own interest and thereby damaged the Complainant's good name and business.
- m) These facts have two effects. First, they show that the Complainant has shown persuasive evidence that the Registrant has no legitimate interest in the domain name, so that the Complainant has met its obligations under this section of the Policy. Accordingly, the Complainant has provided evidence that the Registrant cannot bring itself within any of the specified criteria in paragraph that would show a legitimate interest in the domain name and the Panel so finds.
- n) More importantly, the facts also show that the Registrant has in fact no such legitimate interest, for such conduct of the Registrant described above could never give rise to a legitimate interest in a domain name. The Registrant has embarked on a systematic process, as the Complainant submits, of using the domain name for a website that is masquerading as the Complainant, blatantly misappropriating entire images from official GUESS websites and presenting them as its own, as is seen graphically from the side-by-side comparison between the Registrant's website and the official GUESS webpages that is set out in the Complaint. It is also apparent that the Registrant has brazenly set up a purported payment system which is grossly improper. All of this is illegal and unprincipled in every respect and cannot possibly justify the registration or use of the domain name.
- o) Finally, and underlying all of these considerations, is the fact that the Registrant had an unlimited opportunity of presenting its case, but has forfeited that opportunity by not filing a Response and has not tried in any way to show it has a legitimate interest in the domain name.
- p) The Complainant has thus established the second of the three elements that it must prove.

REGISTRATION IN BAD FAITH

- a) The Panel now turns to consider whether the disputed domain name was registered in bad faith. In that regard, the Panel notes that, consistent with the decision in *Canadian Broadcasting Corporation? Societes Radio-Vanada v. William Quon*, CIRA Dispute Number 00006(April 8, 2003), pp.13-14, surrounding circumstances may be considered in assessing whether the disputed domain name has been registered in bad faith.
- b) By clause 3.1 of the Policy, the Complainant is obliged to prove that: "(c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5."
- c) The Complainant relies on the whole of that provision and in particular Paragraph 3.5(d). The matter clearly comes within that provision which provides that:

"(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."

- d) Clearly, the Registrant wanted to cause confusion and set about it by causing the domain name to resolve to its own dishonest website in an attempt to give the impression that it was offering the Complainant's goods and services for sale and providing a means of paying for them. That is clearly dishonest.
- e) Moreover, if the domain name remains with Registrant, further disruption is probable. That is because the Registrant has taken the Complainant's trademark, used it in its domain name and sought by that means to divert some of the Complainant's business to itself and its own illegal business. The confusion created is as to whether the internet user has arrived at the Complainant's site or not and whether the goods and services being offered are those of the Complainant or not.
- f) Merely registering the domain name was in bad faith. The Complainant is famous and the Registrant knew of it as is seen by registering the domain name with the trademark embodied in it. The Registrant was also clearly targeting it by in effect stealing the Complainant's name and intellectual property, no doubt for the profit it thought it could make.
- g) The Panel therefore finds that the Registrant has registered the domain name in bad faith by committing a serious breach of Section 3.5(d).

Bad Faith in General

- a) The Panel has examined all of the evidence carefully and has concluded that it shows that the Registrant registered the domain name in circumstances that can only be described as bad faith within the generally accepted meaning of that expression. Indeed, there is no other interpretation that can be placed on the evidence.
- b) The Complainant has thus made out the third of the three elements that it must establish.

CONCLUSION AND DECISION

The Panel finds that the constituent elements of the Policy have all been made out and that the Complainant is entitled to the relief it seeks. The Panel will therefore order that the disputed domain name be transferred to the Complainant.

ORDER

The Panel directs that the registration of the disputed domain name <guess-canada.ca> be transferred from the Registrant to the Complainant Guess ? IP Holder L.P.

Date: April 11, 2023



The Honorable Neil Anthony Brown KC.

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