

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.3) AND ACCOMPANYING RULES**

Complainant: Brooks Sports, Inc.
3400 Stone Way N, 5th Floor
Seattle, WA
98103
USA
(the “Complainant”)

Complainant’s Authorized Representative: Clark Wilson LLP
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Canada

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Registrant: Terry Hunter
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Canada
Telephone: 450.746.8150
Email: terry.hunter97@hotmail.com
postmaster@brooksshoescanada.ca
(the “Registrant”)

Disputed Domain Name: brooksshoescanada.ca
(the “Domain Name”)

Registrar: Go Get Canada Domain Registrar Ltd.

Single Member Panel: R. John Rogers

Service Provider: Canadian International Internet Dispute
Resolution Centre (“CIIDRC”)

CIIDRC Case Number: 2280-CDRP

PROCEDURAL HISTORY

CIIDRC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3) (the “Policy”) and Rules (the “Rules”) of the Canadian Internet Registration Authority.

On August 25, 2020, the Complainant filed a complaint (the “Complaint”) with CIIDRC, a division of VanIAC (formerly the British Columbia International Commercial Arbitration Centre). In the Complaint, the Complainant seeks an order in accordance with the Policy and the Rules directing that the registration of the Domain Name be transferred from the Registrant to the Complainant.

CIIDRC determined the Complaint to be in administrative compliance with the requirements of Rule 3.2 and, by way of an emailed letter dated August 25, 2020 (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be August 25, 2020. The Transmittal Letter advised the Registrant that in accordance with the provisions of Rule 5, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or September 14, 2020. Delivery of this email to the Registrant was confirmed by CIIDRC on August 25, 2020.

By an email dated September 21, 2020, CIIDRC advised the parties that as CIIDRC had not received a Response to the Transmittal Letter by September 14, 2020 as required by Rule 5.1, that pursuant to Rule 6.5, the Complainant had the right to elect that the panel in this matter be converted from a three member panel to a single member panel. In a responding email dated September 24, 2020, the Complainant advised CIIDRC that it wished to exercise this right and to have a single member panel appointed.

Following the Complainant’s election to proceed with a single member panel, the undersigned was appointed by CIIDRC as the Single Member Panel by letter dated September 24, 2020, copies of which letter were sent by email to both the Complainant and the Registrant. The undersigned has confirmed to CIIDRC that he can act impartially and independently as the Single Member Panel in this matter.

The undersigned determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

CANADIAN PRESENCE REQUIREMENTS

Section 1.4 of the Policy requires that in order to initiate the Complaint, the Complainant at the time of the initiation of the Complaint must satisfy the Canadian Presence Requirements for Registrants v 1.3 (“Canadian Presence Requirements”) unless the Complaint relates to a trademark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of that trademark.

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and
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The evidence before the Panel is that the Complainant is the owner of four trademarks registered in the CIPO at the date of the Complaint and that the Complaint relates to these trademarks. The Panel therefore determines that the Complainant has satisfied the provisions of section 1.4 of the Policy.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by CIIDRC and the Complainant in the Complaint, the Panel finds that all technical requirements for the prosecution of this proceeding have been met.

FACTS OFFERED BY THE COMPLAINANT

The facts in the Complaint might be summarized as follows:

1. The Complainant currently offers in Canada a broad product line which includes a variety of performance running shoes, trail shoes, casual shoes, vintage shoes, and athletic apparel.
2. The Canadian sales of the Complainant's footwear products from 2011 to 2019 consisted of 1.2 million units with a value of over \$62 million; and the Canadian sales of the Complainant's apparel during the same period consisted of over 858,000 units having a value of over \$13.6 million.
3. Since at least July 1, 1973, these sales have been made in Canada under the "BROOKS" name, which name in various style formats has been incorporated into four trademarks owned by the Claimant and registered with the CIPO (the "BROOKS trademarks").
4. The Complainant enjoys a substantial reputation and goodwill associated in Canada with the BROOKS trademarks with respect to footwear and apparel goods.
5. The Registrant registered the Domain Name on May 23, 2020.
6. The Domain Name resolves to a website which prominently displays one of the Complainant's trademarks and which offers for sale products similar to those products offered in Canada by the Complainant.
7. On May 17, 2020 the domain name <brooks-canada.ca> was registered and on June 2, 2020 the domain name <brooksrunningshoes.ca> was registered (collectively the "Related Domain Names").
8. The Related Domain Names:
 - a. were registered with the same registrar as the Domain Name; and
 - b. resolve to websites very similar to that website to which the Domain Name resolves in that they contain the same:
 - i. header, footer, and graphics, and
 - ii. "FAQ" and "Privacy Notice" pages.
9. The Complainant has never authorized any party connected with either the Domain Name or the Related Domain Names to in any manner use the BROOKS trademarks, and submits that the Registrant and the registrants for the Related Domain Names consist of one or more parties acting to infringe on the BROOKS trademarks.

FACTS OFFERED BY THE REGISTRANT

As was noted above, the Registrant has not filed a Response.

REMEDIES SOUGHT

The Complainant seeks an order from the Panel in accordance with paragraph 4.3 of the Policy instructing the Registrar of the Domain Name to transfer the Domain Name to the Complainant.

THE POLICY

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

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. One or more of the trademark registrations comprising the BROOKS trademarks qualify as a “Mark” as defined in paragraph 3.2 of the Policy;
2. the Complainant had “Rights” in the BROOKS trademarks prior to the date of registration of the Domain Name and continues to have “Rights” in the BROOKS trademarks;
3. the Domain Name is “Confusingly Similar” to one or more of the registrations comprising the BROOKS trademarks as the concept of “Confusingly Similar” is defined in paragraph 3.3 of the Policy;
4. the Registrant has no “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in paragraph 3.4 of the Policy; and
5. the Registrant has registered the Domain Name in “bad faith” in accordance with the definition of “bad faith” contained in paragraph 3.5 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

MARK

In the matter at hand, the relevant portions of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (a) a trademark, 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;

Since July 1, 1973 the Complainant has used at least one of the BROOKS trademarks in Canada to distinguish its provision of wares, services or business from another provider of similar wares, services or business.

This use by the Complainant of the Brooks trademarks commenced well before the registration of the Domain Name on May 23, 2020.

The Complainant continues to so use the BROOKS trademarks in Canada.

The Panel finds that the Complainant has established that one or more of the BROOKS trademarks qualifies as a “Mark” for the purposes of paragraph 3.2(a) of the Policy.

RIGHTS

Paragraph 3.1 of the Policy requires that the Complainant have “Rights” in the BROOKS trademarks. Unfortunately, the term “Rights” is not defined in the Policy.

However, given the evidence before the Panel of the Complainant’s ownership and use of the BROOKS trademarks in Canada, the Panel finds that the Complainant has “Rights” in the BROOKS trademarks for the purpose of paragraph 3.1 of the Policy.

CONFUSINGLY SIMILAR

The Policy in paragraph 3.3 provides that the Domain Name will be found to be “Confusingly Similar” to the BROOKS trademarks only if the Domain Name so nearly resembles one or more of the BROOKS trademarks in appearance, sound or the ideas suggested by the BROOKS trademarks as likely to be mistaken for one or more of the registrations included in the BROOKS trademarks.

As paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “brooksshoescanada” is the portion relevant for consideration.

The Domain Name consists of the word “brooks” together with the words “shoes” and “canada”. The word “brooks” alone is contained in the BROOKS trademarks owned by the Complainant.

To satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that the “brooksshoescanada” portion of the Domain Name so nearly resembles the BROOKS trademarks in appearance, sound or the ideas suggested by the BROOKS trademarks as likely to be mistaken for the BROOKS trademark.

In *Telus Corporation v. Unknown* CDRP Case No. DCA-1903-CIRA (BCICAC) the domain name in dispute was <koodotel.ca>. This disputed domain name resolved to a website whereby the registrant offered phone plans in the black market similar to those offered by the telephone company, Telus Corporation, under its KOODO trademark which was registered with the CIPO.

In this matter in finding for the complainant the panel noted that the word fragment TEL “in common parlance may be referenced for telephone and telecommunications, both of which areas are services under the KOODO Mark.” In addition, the panel noted that the addition of TEL to the KOODO trademark did not give the disputed domain name any distinctiveness.

Similarly, in *L’Oreal SA & L’Oreal Canada Inc. v. Interex Corporate Registration Services Inc.* DCA-1478-CIRA, the panel considered whether or not the domain name <myloreal.ca> was confusingly similar to the trademark L’OREAL. The panel noted that “it is a well established principle that a domain name that wholly incorporates a Mark, in particular one as famous as the one in this case, will be found to be confusingly similar to the Mark despite the fact that the domain name may also contain a descriptive or generic term”.

The test to be applied when considering confusing similarity is one of first impression and imperfect recollection. Will a person as a matter of first impression, knowing only the complainant’s corresponding trademark, and having imperfect recollection of this trademark, likely mistake the disputed domain name for the complainant’s trademark based upon the appearance, sound or the idea suggested by the trademark?

In addition, it is one thing for a disputed domain name to include without an ulterior motive a portion of the complainant’s trademark and another where it is clear that the party owning and using the disputed domain name is doing so in what appears to be a deliberate attempt to encourage a party coming across the disputed domain name to mistakenly assume that it is within the purview of and authorized by the complainant.

In the matter at hand, the Panel finds in the situation similar to that in the referenced *Telus* decision that the addition of the words “shoes” and “canada” to the BROOKS trademark does not give the Domain Name any distinctiveness.

As well, and similar to the situation in the *L’Oreal* decision, the Panel finds that the BROOKS trademarks are sufficiently famous in Canada that for the Domain Name to wholly incorporate the word “Brooks” satisfies the confusingly similar requirement of paragraph 3.3 despite the fact that the Domain Name contains the additional words “shoes” and “canada”.

However, more compelling is what appears to be the deliberate attempt by the Registrant to create a first impression for a visitor to the website to which the Domain Name resolves, that the Complainant has somehow authorized the use of one or more of the BROOKS trademarks by the Registrant. The free use in this website of one or more of the BROOKS trademarks confirms this appearance and clearly constitutes an attempt by the Registrant to confuse visitors to this website into believing that the Registrant’s service offering is somehow authorized or approved by the Complainant.

The Panel therefore finds that the Complainant has satisfied the onus placed upon it by paragraph 3.3 of the Policy and has demonstrated that the Domain Name so nearly resembles one or more of the Complainant’s BROOKS trademarks in appearance, sound or the ideas suggested by the BROOKS trademarks as to be likely to be mistaken for the BROOKS trademarks.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in paragraph 3.4 of the Policy.

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- 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 used 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 used 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.

In paragraph 3.4(d) “use” by the Registrant includes, but is not limited to, use to identify a web site.

It is to be noted that in paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrant use the Domain Name “in good faith”. The evidence before the Panel, as referenced above, is not that the Registrant used the Domain Name in good faith, but rather, to the contrary, that the Registrant used the Domain Name and the Related Domain Names to disrupt and trade upon the goodwill of the Complainant without a license to do so. Therefore, the provisions of these paragraphs do not apply.

The Registrant’s name is not included in the Domain Name, so the provisions of paragraph 3.4(e) do not apply.

With respect to the provisions of paragraph 3.4(f), although the Domain Name does include a geographical reference, there is no indication that the Domain Name is the “geographical name of the location of the Registrant’s place of business”. Therefore, the Panel finds that the provisions of paragraph 3.4(f) do not apply.

The Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

BAD FAITH

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the four general intentions set out in paragraph 3.5.

Of these intentions, the form of intention contained in paragraph 3.5(d) is the one most applicable to the matter at hand.

Paragraph 3.5(d) provides as follows:

- (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.

Based upon the evidence before the Panel and its finding of the deliberate attempt by the Respondent to create a first impression for a visitor to the website to which the Domain Name resolves that the Complainant has somehow authorized the use of one or more of the BROOKS trademarks by the Registrant, the Panel finds that the Complainant has satisfied the provisions of paragraph 3.5 (d) of the Policy by establishing that that the Registrant has intentionally attempted to attract for commercial gain traffic to the website to which the Domain Name resolves, by creating a likelihood of confusion with one or more of the BROOKS trademarks as to the source, sponsorship, affiliation, or endorsement of the website to which the Domain Name resolves.

Moreover, the similarity among the websites to which the Domain Name and the Related Domain Names resolve appears to confirm the Complainant's contention that the Registrant and, possibly, related parties have attempted to trade on the Complainant's goodwill and to mislead prospective customers of the Complainant into mistakenly believing that these websites are operated by the Complainant. Such mistaken belief in turn leads to these consumers purchasing the footwear and apparel from the registrant of the website when these consumers are under the mistaken impression that they are purchasing such footwear and apparel goods from the Complainant.

DECISION

As was above set out, paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainant has the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Name.

The Panel finds that the Complainant has satisfied this onus with respect to all three of these items by demonstrating that one or more of the BROOKS trademarks qualifies as a Mark in accordance with paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to one or more of the Complainant's BROOKS trademarks; and that the Registrant has registered the Domain Name in bad faith in accordance with the provisions of paragraph 3.5 of the Policy.

The Panel also finds that the Complainant has shown some evidence that the Registrant does not have a legitimate interest in the Domain Name in accordance with the provisions of paragraph 3.4 of the Policy.

The Panel therefore finds that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

ORDER

The Complainant in the Complaint seeks an order in accordance with the Policy and the Rules directing that the registration of the Domain Name be transferred from the Registrant to the Complainant.

Section 2 of the Canadian Presence Requirements lists the types of individuals and entities who are permitted to apply for the registration of and to hold and maintain the registration of a .ca domain name. As the Complaint provides that the Complainant has its headquarters in Seattle, Washington, USA , it would appear that the only provision of Section 2 of the Canadian Presence Requirements which qualifies the Complainant as being a party permitted to hold and maintain the registration of the Domain Name is section 2 (q) which states:

2 (q) 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; or

In the matter at hand, the Complainant has provided evidence of its ownership of four trademarks registered in the CIPO for the mark BROOKS. It is obvious that the Domain Name includes the exact word component of the mark BROOKS and that the Complainant, at the date of the Complaint, therefore satisfies the Canadian Presence Requirements.

Provided that on the date of the transfer the Complainant continues to own one or more of the BROOKS trademarks to thereby satisfy the Canadian Presence Requirements, the Panel orders that the domain name <brooksshoescanada.ca> be transferred to the Complainant.

Dated: October 8, 2020.

“R. John Rogers”

R. John Rogers
Single Member Panel

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