



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

CIIDRC case number: 14555-CDRP

Decision date: March 8, 2021

Panelist: Douglas M. Isenberg, Esq.

Complainants: Skechers USA Inc. II; Skechers USA Canada Inc.¹

Registrant: Robert J. Hammer

Domain name in dispute: <gowalkboots.ca> (« Disputed Domain Name »)

CIIDRC case number: 14555-CDRP

1. PROCEDURAL HISTORY

The history of this proceeding, according to the information provided by the Centre, is as follows:

1. On January 22, 2021, Mr. Daniel Anthony of Smart & Biggar filed a Complaint on behalf of the aforementioned Complainant pursuant to the CDRP and the Resolution Rules. The identity of the Registrant is not published in the public WHOIS database; therefore, the Registrant's name was not included in the Complaint.
2. CIRA was notified of this proceeding on January 22, 2021. On January 23, 2021, CIRA transmitted by email to CIIDRC its verification response informing who is the Registrant of

¹ Skechers USA Inc. II and Skechers USA Canada Inc. are interchangeably referred to herein as "Complainant," as the context may allow or require.

the disputed domain name. CIRA also confirmed that the disputed domain name was placed on a Registrar LOCK.

3. On January 25, 2021, CIIDRC confirmed compliance of the Complaint and commencement of the dispute resolution process.
4. The Complainant did not file any further submissions with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the disputed domain name, as permitted by section 11.1 of the CIRA Domain Name Dispute Resolution Rules Version 1.5.
5. As the Complaint with the attachments was filed exclusively online, therefore, the Centre delivered the Complaint to the Registrant only by email to the address provided by CIRA.
6. Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded the Complaint to the Registrant on January 25, 2021.
7. The Registrant failed to file its response by the due date of February 15, 2021.
8. The Complainant in this administrative proceeding has elected for a Panel consisting of a single member.
9. On February 17, 2021, CIIDRC appointed Douglas M. Isenberg, Esq., as a single-member Panel in the above- referenced matter.

2. ELIGIBLE COMPLAINANT

Paragraph 1.4 of the CDRP states: "The person initiating a Proceeding (the 'Complainant') must, at the time of submitting a complaint (the 'Complaint'), satisfy the Canadian Presence Requirements for Registrants (the 'CPR') in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office ('CIPO') and the Complainant is the owner of the trade-mark." Section 2(d) of the CPR provides that "[a] corporation under the laws of Canada or any province or territory of Canada" satisfies the CPR.

Complainant states that it satisfies the CPR because "Co-Complainant Skechers USA Canada, Inc. is a Canadian Corporation."

As a result, the Panel finds that, based on the Complaint, Complainant is an eligible complainant under paragraph 1.4 of the CDRP.

3. FACTS ALLEGED BY THE PARTIES

Complainant states that it has “sold millions of dollars of footwear in Canada in association with the marks GOWALK and SKECHERS GO WALK”; that Skechers USA Inc. II is the owner of common law rights in the trademarks GOWALK and SKECHERS GO WALK in association with footwear and clothing, which have been in extensive use in Canada for nearly a decade in association with footwear; that Skechers USA Canada Inc. “is a licensee of the marks authorized to use and enforce the rights in Canada”; and that Skechers USA Canada Inc. is the owner of a trademark registration for the trademark SKECHERS GO WALK in Canada, namely, TMA1017917 (registered on March 22, 2019).

Complainant states that its “primary website is skechers.com, which has been owned and used since 1993”; that “Canadian retail services for the Skechers brand are offered through a Canada-specific section within the dot-com website rather than through a Canadian domain name”; and that “Canadian retail services are offered at skechers.com/en-ca.”

Complainant states that the Disputed Domain Name was created on November 7, 2019; that it “currently leads to a website falsely claiming to be a Skechers Canada Outlet Store”; that it “uses the flagship SKECHERS trademark and logo, as well as other trademarks (including GOWALK) without permission and shows many unauthorized copyrighted images of Skechers brand footwear”; and that “[t]he website is an infringing counterfeit website designed to defraud customers.”

As noted above, the Registrant did not submit a Response.

4. CONTENTIONS OF THE PARTIES

- **Complainant**

Complainant contends that the Disputed Domain Name is Confusingly Similar to a trademark or service mark in which the Complainant has rights because the Disputed Domain Name contains the entirety of Complainant’s GOWALK common law trademark and “the inclusion of additional words will not prevent a domain name from being confusingly similar to a trademark,” adding that “[t]his is particularly true with respect to domain names involving a Complainants’ well-known mark (in this case: GOWALK) and non-distinctive terms (in this case: ‘boots’).”

Complainant contends that Registrant has no legitimate interest in the Disputed Domain Name as described in the Policy because, *inter alia*, "Complainants did not license or otherwise authorize the anyone to register or use the mark GOWALK as part of the domain name gowalkboots.ca"; "there are no trademark registrations or applications that include GO WALK on the Canadian Trademark (CIPO) Database records, apart from those owned by the Complainant itself"; "CDRP panelists have stated that use of a Domain Name for impersonating a brand for commercial gain is the very definition of bad faith and there can therefore be no good faith use in this case"; "[t]he mark GOWALK is not being used in good faith"; "while the added word 'boots' may be descriptive and generic, the distinctive part of the domain name, GOWALK, is neither descriptive or generic, but is a trademark of the Complainants"; the Disputed Domain Name "appears to be used for commercial activity, namely, selling counterfeit Skechers brand footwear online or pretending to sell such shoes and defrauding the customers of their money"; "[t]here is no reason to believe the Domain Name corresponds to the legal name of the Registrant, and given the Complainants' trademark rights in the mark GOWALK and SKECHERS GO WALK, it would be an infringement to adopt a name comprising 'go walk' to sell footwear"; and "[t] here is no indication that the Domain Name is a geographical name."

Complainant contends that the Registrant has registered the domain name in bad faith as described in the Policy because, *inter alia*, the website associated with the Disputed Domain name "currently leads to a fraudulent website claiming to be a Skechers Canada Outlet Store, which sells Skechers brand footwear, including GOWALK brand footwear"; "[t]he website has a similar layout to the authentic skechers.com website and uses the Skechers logo and unauthorized images of Skechers footwear"; "Customers of the Complainants who mistakenly arrive at the website at the Domain Name are misled into thinking that it is operated by the Complainants, and as a result, may be deterred or prevented from arriving and shopping at the Complainants' legitimate website"; and "the Registrant is selling counterfeit Skechers brand footwear and/or in some cases don't ship the footwear and simply steal the money."

- **Respondent**

As noted above, the Registrant did not submit a Response.

5. DISCUSSION AND FINDINGS

In accordance with Paragraph 3.1 of CDRP, the onus is on the Complainant to prove:

- 1) 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;
- 2) the Registrant has no legitimate interest in the domain name as described in the Policy; and
- 3) the Registrant has registered the domain name in bad faith as described in the Policy.

To consider each of these requirements in turn.

1) Confusingly Similar

With respect to paragraph 3.1(a) of the CDRP, the Panel concludes that Complainants have rights in the mark SKECHERS GO WALK prior to the date of registration of the Disputed Domain Name, as a result of TMA1017917 (registered on March 22, 2019); and that Complainants also had common law rights in the marks GOWALK and SKECHERS GO WALK prior to the date of registration of the Disputed Domain Name, as a result of the uncontroverted facts and supporting documentation provided by Complainants.

Paragraph 3.3 of the CDRP states: "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." It is apparent that the Disputed Domain Name contains the GOWALK trademark in its entirety. "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark" WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.7.² Further, "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity." WIPO Overview 3.0, section 1.8

² Although WIPO Overview 3.0 addresses the Uniform Domain Name Dispute Resolution Policy ("UDRP"), Paragraph 3.2(l) of the CIRA Domain Name Dispute Resolution Rules expressly allows references to "dispute resolution proceedings which apply to domain names registered under any other top level domain which the Complainant considers persuasive."

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(a) of the CDRP.

2) No Legitimate Interest

With respect to paragraph 3.1(b) of the CDRP, regarding a lack of legitimate interests, the Panel is satisfied that the Complainant has established, on a balance of probabilities, that the Registrant does not have a legitimate interest in the Disputed Domain Name. By failing to submit a Response, the Registrant has not made any attempt to rebut Complainant's allegations or argue that it has a legitimate interest in the Disputed Domain Name under any of the six elements described in paragraph 3.4 of the CDRP, nor is there any evidence that demonstrates Registrant has a legitimate interest in the Disputed Domain Name. See, e.g., *Cointreau v. Netnic Corporation*, CIRA Case No. 00180 ("[t]here is no evidence from the 'customer' about its 'interest' in the Domain Name"); and *General Motors LLC v. Tony Wilson*, CIRA Case No. 00182 ("the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name and this evidence has not been rebutted by the Registrant").

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(b) of the CDRP.

3) Bad Faith

The Panel evaluates whether the Complainant has established that Registrant has registered the Disputed Domain Name in bad faith, as defined by the CDRP. Pursuant to paragraph 3.5 of the CDRP, the following "shall be evidence that a Registrant has registered a domain name in bad faith":

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;
- (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;

(c) the Registrant registered the domain name or acquired the Registration 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; or

(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.

The Panel is persuaded that bad faith exists pursuant to paragraph 3.5(d), given that Complainant has stated, and Registrant has not denied, that the Disputed Domain Name "currently leads to a fraudulent website claiming to be a Skechers Canada Outlet Store, which sells Skechers brand footwear, including GOWALK brand footwear"; "[t]he website has a similar layout to the authentic skechers.com website and uses the Skechers logo and unauthorized images of Skechers footwear"; "Customers of the Complainants who mistakenly arrive at the website at the Domain Name are misled into thinking that it is operated by the Complainants, and as a result, may be deterred or prevented from arriving and shopping at the Complainants' legitimate website"; and "the Registrant is selling counterfeit Skechers brand footwear and/or in some cases don't ship the footwear and simply steal the money." The Panel agrees with and finds applicable the decisions cited by Complainant, *Emerson Vulcan Holding LLC v. Dan Thompson*, BCICAC Case No. DCA-2060-CIRA ("the very definition of bad faith" exists where "Registrant is using a domain name comprising a third-party brand to attract web traffic for that brand... for his own commercial gain by creating a likelihood of confusion in the mind of the public as to source, sponsorship, affiliation or endorsement of the Registrant's website"); and *Kijiji International Limited v. [privacy protected]*, Resolution Canada CIRA Case No. 00118 (finding bad faith where "[t]he Complainant's evidence is that the Registrant used the Domain Name to imitate the Complainant" and "[t]his evidence was not countered by the Registrant" and "the website [using the disputed domain name] features the logo of the Complainant as part of its fraudulent attempt to attract Internet users to the website").

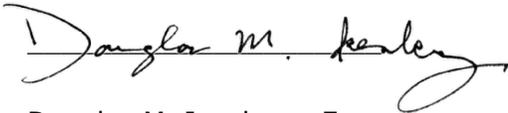
In light of the above, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(c) of the CDRP.

6. DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of CDRP, Paragraph 12 of the Resolution Rules, the Panel orders that the Disputed Domain Name <gowalkboots.ca> be transferred to Complainant Skechers USA Canada Inc.³

Made as of March 8, 2021.

SIGNATURE OF PANEL

A handwritten signature in black ink that reads "Douglas M. Isenberg". The signature is written in a cursive style with a large, sweeping initial 'D'.

Douglas M. Isenberg, Esq.

³ The Complaint requests the following remedy: "Complainants respectfully requests [sic] the domain name gowalkboots.ca be transferred to the Complainant Skechers Canada (i.e. Skechers USA Canada, Inc.), since it will meet the Canadian Presence Requirements to hold the domain name."