



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL DECISION

CIIDRC case number:	22088-UDRP	Decision date: February 6, 2024
Domain Names:	stormtechshop.com (the “ Domain Name ”)	
Panel:	James Plotkin, Q.Arb	
Complainant:	Stormtech Performance Apparel Ltd.	
Complainant's representative:	Rachel E. Schechter (Fasken Martineau DuMoulin LLP)	
Respondent:	超罗	

1. PROCEDURAL HISTORY

1. This matter is conducted pursuant to the Uniform Dispute Resolution Policy (the “**UDRP**”) and the Rules for Uniform Domain Name Dispute Resolution Policy (the “**UDRP Rules**”).
2. On January 5, 2024, the Canadian International Internet Dispute Resolution Centre (“**CIIDRC**”) wrote a letter to the Panel setting out the following procedural history in this matter:
 - a. On December 5, 2023, the Complainant filed a Complaint in respect of the Domain Name pursuant to the UDRP Policy and Rules. On the same day, the CIIDRC notified the Domain Name’s Registrar of this proceeding.
 - b. On December 7, 2023, the Registrar transmitted to the CIIDRC its verification response identifying the Respondent. The Registrar also confirmed the Domain Name was placed on a Registrar LOCK.
 - c. The same day, the CIIDRC notified the Respondent of this administrative proceeding by forwarding him a notice by email pursuant to UDRP Rule 4 and Supplemental Rule 5.
 - d. The Respondent’s deadline to file a response to the Complaint was December 28, 2023. The Respondent failed to file a response by the deadline.
 - e. The Complainant elected to proceed before a single-member panel.
 - f. On January 5, 2024, I was appointed as sole panellist after confirming my impartiality and independence in respect of the parties to this proceeding.

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3. On January 29, 2024, the Panel received the Complainant's Annex 25, which was inadvertently excluded from the documents transmitted to the CIIDRC when the complaint was filed.
4. On the same day, the Panel made the following procedural order:

On or before February 2, 2024, the Complainant shall produce:

- a. Any available evidence showing that the screenshots contained in the right column of Annex 24 were in fact from the website hosted at the <stormtechshop.com> domain name on the date alleged. The current Annex 24 contains no date/timestamp or indication as to the URL from which the impugned images were taken.
 - b. Any similar evidence with respect to Annex 25, which likewise contains no indication of the URL or a time/date stamp.
 - c. Any other evidence the Complainant wishes to file showing the content hosted at the <stormtechshop.com> domain at any given point in time.
 - d. The deadline for a decision as to whether the Respondent's registration of the <stormtechshop.com> domain name is hereby extended to February 5, 2024, to allow the Complainant to file the above-referenced evidence, should it choose to do so, and for the Panel to render its decision.
 - e. If the Complainant does not intend to file any evidence in accordance with paragraph 1, it shall advise the CIIDRC of same forthwith.
5. On February 5, 2024, the Complainant filed the following additional evidence:
 - a. Witness Statement of Darlene Leroux affirmed February 2, 2024 – Ms. Leroux is a legal assistant with the Complainant's counsel's law firm. She provided evidence that, on February 2, she navigated to the Domain Name and captured the content on various pages of the website hosted there. Those pages are timestamped and contain the URL associated with each page. Some of them indicate the Domain Name, while others (apparently from the same website) indicate <googlessales.com>.
 - b. Witness Statement of Allen Gerllays affirmed February 5, 2024 – Mr. Gerllays is the Complainant's Chief Financial Officer. Mr. Gerllay's affirmed that on November 14, 2023, he navigated to the Domain Name and took a series of screenshots between 9:00 a.m. and 9:50 a.m. PT. Those screenshots have been resubmitted as evidence (Annex 27).
 6. The Panel accepts this evidence for filing.

2. THE PARTIES' CONTENTIONS

A. Complainants

7. The Complainant is a British Columbia-based company incorporated on February 8, 1968. It designs and manufactures sporting and outdoor apparel. It sells its products directly to consumers and also wholesale to retailers.

8. The Complainant alleges its operations span Canada, the United States, the United Kingdom and the European Union. It also distributes products to other countries, including Australia, New Zealand and Mexico.
9. The Complainant operates its business, in part, through various domain names:
 - a. <<https://www.stormtech.ca/>> (registered December 5, 2000);
 - b. <<https://www.stormtechusa.com/>> (registered February 12, 2003);
 - c. <<https://www.stormtech.eu/>> (registered May 23, 2006); and
 - d. <<https://www.stormtechperformance.com/>> (August 26, 2010).
10. Each of these websites hosted at these domain names contains copyrighted texts, images, graphics and other content belonging to the Complainant. They also contain depictions of the Complainant's trademarks, including the STORM TECH and STORMTECH word marks and two design marks:



and



11. The Complainant provided evidence showing these marks are registered in various jurisdictions, including Canada, the United States, the United Kingdom, the European Union, Mexico, Australia, China and Japan. The earliest of these registrations is a Canadian registration for word mark STORM TECH registered on March 18, 1994.
12. The Complainant submits it has no business relationship with the Respondent and has not otherwise licensed or permitted the Respondent to register the Domain Name or use the Complainant's trademarks. The Respondent also lacks authority to reproduce any of the copyright-protected content found on the Complainant's various websites.
13. The Complainant shows the Domain Name's registration date as August 8, 2022. It provided screen captures that appear to depict content and apparel it sells on its own websites. It says the screen captures were taken of the website hosted at the Domain Name, and that those screen captures were taken on November 9, 2023 (**Annex 24**). The Panel notes that the evidence does not provide a timestamp and does not in fact confirm the screen captures originate from the Domain Name. However, as noted above, the Complainant submitted further evidence of screenshots from the Domain Name taken November 14, 2023 (**Annex 27**). Unlike Annex 24, Annex 27 was accompanied by a solemnly

affirmed witness statement by the Complainant's CFO indicating how and when he took the screenshots.

14. According to the Complainant, the content hosted at the Domain Name changed on or about November 19 or 20, 2023. In that regard, the Complainant submitted timestamped screenshots showing what appear to be pages offering for sale various sporting glasses, goggles, helmets and related apparel from a company other than the Complainant (**Annex 26**). Some of the screenshots indicate the Domain Name whereas others indicate <googlessales.com>. All appear to be from pages from the same website.
15. With respect to the first element of the UDRP analysis—that the Domain Name is identical or confusingly similar to the Complainant's marks—the Complainant relies on its various registered trademarks and pending trademark applications to establish its rights in the term "stormtech." It asserts the Domain Name is confusingly similar to those marks.
16. With respect to the second element of the UDRP analysis—the Respondent's lack of rights or legitimate interest in the Domain Name—the Complainant argues as follows:
 - a. There is no evidence to suggest the Respondent has any rights or legitimate interests in the Domain Name.
 - b. Using a domain name for illegal activity, such as passing off and counterfeiting, has consistently been held to demonstrate a lack of legitimate interest in a domain name.
 - c. Until recently, the Domain Name hosted an apparent fraudulent storefront impersonating the Complainant's legitimate websites without authorization.
 - d. There is no basis to find that the Respondent is commonly known by the Domain Name. In any event, the Complainant's prior trademark registrations would belie such a contention.
 - e. The Respondent does not use the Domain Name for a legitimate non-commercial or fair use, again due to the fact that it ostensibly uses the Domain Name to sell counterfeit goods.
17. With respect to the third element of the UDRP analysis—bad faith use and registration of the Domain Name—the Complainant argues that the Respondent was or ought to have been aware of the Complainant's longstanding and valuable brand when the Domain Name was registered. The fact that the Domain Name resolves to a website apparently hosting content that falsely suggests a *bona fide* commercial offering of the Complainant's goods demonstrates bad faith. The Respondent's conduct gives the false impression that the Respondent's website is affiliated with or otherwise endorsed by the Complainant. The Respondent's conduct also creates a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

B. Respondent

18. As noted, the Respondent failed to respond in accordance with the UDRP Rules and did not seek an extension of time.

C. Remedy Sought

19. The Complainant seeks an order transferring the Domain Name.

3. **DISCUSSION AND FINDINGS**

20. Although the Respondent did not respond to the Complaint, the Complainant must nonetheless meet the three-part test set out in UDRP paragraph 4(a).
21. For the reasons that follow, the Panel is satisfied that the Complaint is valid and orders the Domain Name transferred.

A. **UDRP Requirements**

22. UDRP paragraph 4(a) requires the Complainant to establish the following:
- a. The Domain Name is confusingly similar to a trademark or service mark in which the Complainant has rights;
 - b. The Respondent has no legitimate interests in respect of the Domain Name; and
 - c. The Respondent registered and is using the Domain Name in bad faith.
23. The Complainant bears the burden of proving the first and third limbs—that the Domain Name is confusingly similar with a mark in which it has rights, and that it was registered and is being used in bad faith—on a balance of probabilities [*Madonna Ciccone, p/k/a Madonna v. Dan Parisi, WIPO Case No. D2000-0847; Montage Hotels & Resorts, LLC v. Robert McDaniel, WIPO Case No. D2013-1366*].
24. Given the inherent difficulty in proving a negative, and the summary nature of these proceedings, the Complainant need only prove on a *prima facie* basis that the Respondent lacks a legitimate interest in the Domain Name [*WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, s. 2.1; Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110*]. The onus then shifts to the Respondent to prove a legitimate interest [*Ibid.*].
25. The Panel will consider each requirement in turn.

B. **Analysis**

1. The Domain Name is confusingly similar to trademark or service mark in which the Complainant has rights
26. On the first limb of the analysis, the Complainant must establish two things: 1) that it has active rights to a trademark or service mark; and 2) that the Domain Name is confusingly similar to that trademark or service mark.
27. The Complainant relies on various trademark registrations for the STORM TECH and STORMTECH word marks, as well as the two design marks depicted above. The Complainant filed ample evidence showing it has active rights in those marks. All of these precede the Domain Name's registration date.
28. The Panel is satisfied that the Complainant has established valid and subsisting rights in the Mark.

29. The Panel also considers the Domain Name confusingly similar to the Complainant's Mark. The Domain Name includes the whole STORMTECH Mark, followed by the generic term "shop." The Panel considers the Domain Name confusingly similar for the following reasons:
- a. It contains the entirety of the Complainant's Mark;
 - b. The Complainant's Mark, which is not a dictionary term, is the first and dominant part of the Domain Name;
 - c. The word "shop" does not distinguish the Domain Name from the Complainant's Mark because:
 - i. "shop" is a generic term; and
 - ii. "shop" bears an association with retail shopping, and Complainant's trademark registrations are in association with retail goods that are sold, *inter alia*, in online and brick and mortar "shops."
30. There is also authority that: "where 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 under the first element" [***Oath Inc. v. Private Registration, NameBrightPrivacy.com / Stan Karp., Case No. D2021-1614***]. The domain name at issue in that case was <aol-careers.com>. The panel considered the respondent's choice to include a hyphen in the disputed domain name "of negligible significance."
31. Although this authority might overstate the point, the Panel finds this authority persuasive in this case given the generic and descriptive nature of the additional word "shop." In the *Oath Inc.* case, after extracting the Complainant's Mark, all that remains is a descriptive term.
32. In light of the foregoing, the Complainant has established that the Domain Name is confusingly similar to the Mark.

2. The Respondent has no legitimate interest in the Domain Name

33. As noted above, the Complainant must make out a *prima facie* case that the Respondent lacks a legitimate interest in the Domain Name. As the Respondent filed no submissions, meeting this low threshold is sufficient to clear the second limb of the UDRP analysis.
34. The Complainant submits that the Respondent's use of its Mark, logos and website content indicates a lack of *bona fide* interest in the Domain Name. If born out on the evidence, this submission is supported by various authorities [see for example: ***Cube Limited v. Gueijuan Xu, WIPO Case No. D2017-2514***; ***Philipp Plein v. Gueijuan Xu, WIPO Case No. D2017-2535***; ***Fendi S.r.l. v. Ndiaye Therese, WIPO Case No. D2018-0179***].
35. Given the Respondent's website's content, and the failure to file a response explaining it, the Panel is satisfied the Complainant has shown that the Respondent lacks a legitimate interest in the Domain Name on a *prima facie* standard. In that regard, based on the additional evidence the Complainant submitted (the witness statement of Mr. Gerllays), the Panel is satisfied that the screenshots the Complainant provided in its **Annex 26** are in fact of the website content hosted at the Domain Name.
36. It bears mentioning that, in the Panel's view, the bare screenshots with no timestamp or URL information initially submitted as **annex 24** would not have been sufficient evidence. This is because they offered no means of determining the provenance of those screenshots. However, the Complainant

has bettered its evidence, which the Panel now considers sufficient given the nature of these proceedings.

3. The Respondent has registered and used the Domain Name in bad faith

37. UDRP paragraph 4(b) provides a non-exhaustive list of circumstances demonstrating bad faith registration and use. The Complainant relies upon paragraphs 4(b)(iii) and (iv):

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor;

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

38. With respect to UDRP paragraph 4(b)(iii), it appears the Respondent was using the Domain Name to compete with the Complainant. In any event it is clear from the Respondent's website's content that, at a minimum, that the Respondent intended to disrupt the Complainant's business and divert traffic away from the Complainant's websites. This demonstrates bad faith use and registration.

39. The Panel notes that the Respondent's apparent decision to change the content on the website to identify other goods is of no moment. Indeed, the fact that the Respondent flipped the content of its website, presumably as a countermeasure to the Complainant's UDRP complaint, does nothing to alleviate what the Panel finds constitutes bad faith use and registration of the Domain Name.

40. With respect to UDRP paragraph 4(b)(iv), the Panel agrees the Respondent's conduct demonstrates an intention to attract Internet users to the website hosted at the Domain Name for commercial gain. The website's content lays bare the Respondent's attempt to create a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement the Respondent's website.

41. Other panels have found similar conduct sufficient to demonstrate bad faith use and registration [see for example: *Migros-Genossenschafts-Bund v. James Okogb, Micrio*, WIPO Case No. D2017-0647; *Migros-Genossenschafts-Bund v. Patrizio De Bortoli, MediaEtCetera GmbH*, WIPO Case No. D2017-0980; *Fendi S.r.l. v. Ndiaye Therese*, WIPO Case No. D2018-0179]. The Panel has no difficulty making the same finding here.

42. In light of the foregoing, the Complainant has established that the Domain Name was registered and is being used in bad faith.

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4 **DECISION and ORDER**

43. For the above reasons, in accordance with UDRP paragraph 4(i), the Panel concludes the Complaint is well-founded and orders the Domain Names **TRANSFERRED** to the Complainant.

Made at Ottawa, Ontario on February 6, 2024

PANEL SIGNATURE

James Plotkin, Q.Arb

