

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

**DECISION**

<b>Complainant:</b>	Behr Process Corporation
<b>Registrant:</b>	Privacy Protected / Priatharshan Gnanendran
<b>Domain Name</b>	<i>behr.ca</i>
<b>Registrar:</b>	CA Registry
<b>Sole Panel Member:</b>	Thomas Manson, Q.C.
<b>Service Provider:</b>	British Columbia International Commercial Arbitration Centre
<b>BCICAC File:</b>	DCA-1721- CIRA

**A. OVERVIEW**

This matter concerns a dispute between the Complainant and the Registrant regarding the registration of *behr.ca*, (the "Domain Name"); the CA Registry is the relevant registrar.

This is a proceeding under the Canadian Internet Registration Authority ("CIRA") Domain Name Dispute Resolution Policy (the "Policy"), in accordance with the CIRA Dispute Resolution Rules (the "Rules").

**B. PROCEDURAL HISTORY**

The British Columbia International Commercial Arbitration Centre ("BCICAC") is a recognized service provider pursuant to the Policy and Rules of CIRA.

The Complainant filed a complaint dated October 6, 2015 (the "Complaint") with the BCICAC seeking an order in accordance with the Policy and Rules directing the transfer of the registration of the Domain Name to the Complainant.

In a letter dated October 6, 2015, the BCICAC as Service Provider, confirmed compliance of the complaint and commencement of the dispute resolution process.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 of the Rules and, by letter of transmittal dated October 6, 2015 (the "Transmittal Letter"), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rule 2.1 and Rule 4.3 of the Rules. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 of the Rules to be October 6, 2015 and advised the Registrant that in accordance with the provisions of Rule 5 of the Rules, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or October 26, 2015.

By email dated October 12, 2015 the Complainant filed an amended complaint and annexes via electronic transmission; a copy of this was sent to the Registrant

By letter dated October 13, 2015 the BCICAC acknowledged receipt of the Amended Complaint and Annexes (together, the "Complaint") and drew the Registrant's attention to the 20-day time period (ie by November 2, 2015) within which the Response was required under Rule 5.

The Registrant did not provide a Response by November 2, 2015 (or at all) pursuant to CIRA Rule 5.1.

Accordingly, under Rule 6.5, the Complainant was at liberty to elect to convert from a three member panel to a single member panel.

As permitted given the absence of a Response, the Complainant elected under Rule 6.5 to convert from a panel of three to a single member panel.

By letter dated November 10, 2015 the BCICAC appointed Thomas Manson, Q.C. as sole member of the Panel in this matter.

In accordance with Rule 7, Thomas Manson, Q.C. provided the BCICAC with the required Declaration of Independence and Impartiality.

The Panel has been properly appointed and constituted as a single member panel to determine the Complaint in accordance with the Rules.

In accordance with Rule 5.8, as no Response has been submitted by the Respondent, the Panel decides the Proceeding on the basis of the Complaint.

## C. CANADIAN PRESENCE REQUIREMENTS / JURISDICTION

### Canadian Presence Requirements

The Canadian Presence Requirements for Registrants (the "Presence Requirements") require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(q) of the Presence Requirements stipulates that:

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

In this case, the Complainant is the owner of the Canadian trade-mark registration "BEHR", Registration No. TMA369136 (used in Canada since May 3, 1962) and Canadian trade-mark registration "BEHR", Registration No. TMA912580 (used in Canada since March 26, 2003)<sup>1</sup>. The Panel finds that the Complainant is eligible to initiate these proceedings.

### Technical Requirements

Based upon the information provided with the Complaint, the Panel finds that all technical requirements for the commencement of this proceeding have been met and that the Panel has jurisdiction to consider this matter.

## D. EVIDENCE

In accordance with Rule 5.8 the Panel finds as follows:

### The Complainant and its Marks in Canada<sup>2</sup>

The Complainant is a paint, stain, and varnish manufacturer [see Annex 2, page 1].

Founded in 1947 by Otho Behr, the company supplies architectural paint and exterior wood care products throughout the United States and Canada.

In 1986 the Complainant introduced premium paints under the name and mark BEHR® [see Annex 2, page 2].

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<sup>1</sup>See the summary in Appendix A

<sup>2</sup>*Loc. cit.*

In May 1989 the Complainant applied to register the trademark (Word) "BEHR" in Canada; the CIPO registration record indicates that the trademark was used in Canada for goods since at least as early as May 3, 1962. Registration was granted under No. TMA369136 on June 1, 1990.

In April 1995 the Complainant applied to register the trademark (Design) "BEHR &(Design)" in Canada; the CIPO registration record indicates that the trademark was used in Canada for goods since at least as early as Jan 10, 1980. Registration was granted under No. TMA472658 on March 13, 1997.

In April 2004 the Complainant applied to register the trademark (Design) "BEHR &(Design)" in Canada; the CIPO registration record indicates that the trademark was used in the United States. Registration was granted under No. TMA639280 on May 6, 2005.

The registration of the trademark "BEHR" under No. TMA369136 was renewed in Canada on June 1, 2005 and the Complainant remains the registrant in CIPO in respect of Registration No. TMA369136.

In December 2012 the Complainant applied to register the trademark (Word) "BEHR" in Canada; the registration record indicates that the trademark was used in Canada for goods since March 26, 2003. A registration was later granted in 2015 under Registration No. TMA912580.

#### **Domain Creation and "Privacy Protected" Identity of Registrant**

The WHOIS Search [see Annex 3, at page 3] shows that the Domain was created "2008/01/09" and indicates that the identity of the registrant is "Privacy Protected". Nevertheless, the identity of the Registrant is set out in the Complaint as "Priatharshan Gnanendran".

The Complainant has in no way authorized, permitted or allowed the Registrant to register or use the Domain Name.

#### **Current Status**

The Complainant is headquartered in California and Behr Process Corp (Canada) is located in Calgary, Alberta [see Annex 2, page 8].

The Complainant's products have been highly successful; with its BEHR MARQUEE® Interior Paint & Primer winning top honors in the 2014 Innovation Award selected by The Home Depot® [see Annex 2, page 4]. BEHR has been ranked "Highest in Customer Satisfaction with Interior Paints" by the J.D. Power 2015 Paint Satisfaction Study [see Annex 2, page 5]. Complainant has been a partner of The Home Depot since 1978 when BEHR made the decision to sell its products to the broader market; The Home Depot has stores throughout the US and Canada [see Annex 2, pages 6-7].

To promote its BEHR® products, the Complainant has maintained an active Internet presence and operates from its primary website at "<behr.com>"<sup>3</sup> [see Annex 2]. Complainant also has a substantial presence on social media with a Facebook page for "BehrPaint" that has over 121,900 likes, over 22,000 followers on their Twitter page and over 3,000 followers on their LinkedIn company page [see Annex 2, pages 9-11].

#### **Current Status of Domain**

The WHOIS record [see Annex 3, page 3] for the Domain does not show the identity of the Registrant. However, the Complainant identifies the Registrant in the Complaint and the Panel decides this matter on the basis of the Complaint, as it is required to do.

The Domain Name currently resolves a Pay-Per-Click (PPC) website [see Annex 3, pages 1-3].

#### **E. REMEDY SOUGHT**

The Complainant seeks an order that the Domain Name be transferred to the Complainant

#### **F. POLICY AND ANALYSIS**

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 a balance of probabilities, that:

- (a) the Registrant's dot-ca domain name is "Confusingly Similar"<sup>4</sup> to a Mark<sup>5</sup> 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;

and the Complainant must provide some evidence that:

<sup>3</sup>The Complaint describes this as <behr.ca> and refers to Annex 2; this is a palpable error as Annex 2 refers to the website <behr.com> - if it were otherwise there would be no reason to commence this proceeding.

<sup>4</sup> The expression "Confusingly Similar" is described in paragraph 3.3 of the Policy.

<sup>5</sup>The word "Mark" is described in paragraph 3.2 of the Policy.

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

**Policy Para 4.1(a) - Trade Name as a Mark**

The relevant portion of paragraph 3.2 of the Policy states that for the purpose of the Policy, a "Mark" 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;

...

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

The Complainant has used "BEHR" in Canada since at least 1962 and has been the registered owner of the trademark "BEHR" since June 1990. Subsequent renewal and registrations of the trademarks "BEHR" and "BEHR &(design)" occurred prior to the date of registration of the Domain Name in 2008. And, the Complainant continues to have such Rights.

The Complainant has established that the Trade Name qualifies as a "Mark" within the provisions of paragraph 3.2 (c) of the Policy.

**Policy Para 4.1(a) - Confusingly Similar**

A Domain Name is "Confusingly Similar" if the Panel concludes that 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 should be noted that paragraph 1.2 of the Policy also provides that a domain name is defined so as to exclude the "dot-ca" suffix.

The Panel agrees with the approach taken in *Tuscows.com v Interex Corporate Registration Services Inc*, April 11, 2014, Case No. 00257<tuscowsreseller.ca>, namely that:

"The test to be applied when considering "confusing similarity" is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant's corresponding marks only, and having an imperfect recollection of the marks, would likely mistake the Domain Names for the Complainant's marks based upon the appearance, sound or the idea suggested by the mark" -

As the Complainant submits, the Domain Name contains the "BEHR" mark in its entirety (*Dixie*

*Consumer Products LLC v Xavier Alexander*, August 14, 2014, Case No. 00266<dixie.ca>). The Panel finds that the Complainant has satisfied the onus placed upon it and has demonstrated that the Domain Name is "confusingly similar" to the Mark.

In addition, to satisfy this branch of the test under paragraph 4.1(a), the Complainant must demonstrate that it has rights in the Mark that predate the registration of the Domain Name.

The resolution of this issue is straightforward; (with the exception of the most recent registration granted in 2015, Registration No. TMA912580) the Complainant's "BEHR" mark has been registered in Canada for over 25 years and continues in existence to this day.

Further, the Panel finds that the Complainant had rights in the Mark prior to the date of registration of the Domain Name and continues to have such rights.

#### **Policy Para 4.1(b) - Bad Faith**

The Complainant says that the Registrant registered the Domain Name in bad faith.

The Complainant has alleged that the Domain Name was registered in bad faith pursuant to paragraph 3.5(c) the Registrant has registered the Domain Name primarily for the purpose of disrupting the business of the Complainant.

The Complainant has also alleged that the Domain Name was registered in bad faith pursuant to paragraph 3.5(d) of the Policy, namely that the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement

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.

It is a well-established principle that pointing a domain name containing a third party trademark to a pay-per-click website may give rise to a finding of bad faith. These websites put a registrant in a position to reap a financial benefit by way of referral fees.

*S. Tous, S.L. v GnanavannanRatnasabapathi* September 24, 2015, Case No. 00302 at para. 48



<tous.ca>

*Meguiar's, Inc v Interex Corporate Registration Services Inc*, March 9, 2015, Case No. 00279 at para. 38 <meguiars.ca>

In this case, the Domain Name resolves to a PPC website which is a form of web advertising that allows companies to place advertisements and from which revenue is gained. The links on the Domain Name include "Behr Paint Colors", "Interior Paint Colors", "Behr Paint", "Behr Paint Colors Interior" and other paint related links [see Annex 3, pages 1-2]. However, the Complainant has in no way authorized, permitted or allowed the Registrant to register or use the Domain Name. The Panel finds that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to an online 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 which is evidence of bad faith per paragraph 3.5(d) of the Policy

The Panel concludes that bad faith does indeed exist as per paragraph 3.5(d):

*Sleep Country Canada Inc. v. Pilfold Ventures Inc.*, March 14, 2005, Resolution Canada Case No. 00027, <sleepcountrycanada.ca>;

*Lee Valleys Tools Limited v. Pilfold Ventures Inc.*, September 2, 2005, Resolution Canada Case No. 00040 <leevalleytools.ca>

The Panel also notes that, despite receiving notice of the Complaint, the Registrant has not bothered to make any submissions to the Panel, including those suggesting that the Domain Names were not registered in bad faith.

*General Motors LLC v. DS1 Design*, May 29, 2013, Resolution Canada Case No. 00231 at para. 37 <buickcertifiedservice.ca, chevroletcertifiedservice.ca and cadillaccertifiedservice.ca >

In light of the foregoing, the Panel finds that the Registrant registered the Domain Name in bad faith as described in paragraph 3.5(d).

#### **Policy Para 4.1(c) - No Legitimate Interest**

The final element of paragraph 4.1 for the Panel to determine is whether the Complainant has established "some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4". The Policy lists, in paragraph 3.4, six "circumstances" which, "in particular but without limitation", demonstrate that the Registrant has a legitimate interest in a domain name.

Paragraph 3.4 of the Policy essentially provides that:

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The Registrant has a legitimate interest in a domain name if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

- (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 paragraphs 3.4 (d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

The Complainant contends that the Registrant has no legitimate interests in relation to the subject Domain Name per paragraph 3.4 of the Policy.

The Complainant says that the Domain Name is not a mark that satisfies the conditions under paragraph 3.4(a). A search of the Canadian Intellectual Property Office trade-mark database reveals no trade-mark registrations for *behr.ca* [see Annex 5].

The Complainant has shown the long-standing use by the Complainant of the trade-mark BEHR. Accordingly, the Complainant has provided some evidence that the Domain Name cannot be "clearly descriptive" pursuant to paragraph 3.4(b) of the Policy.

As for paragraph 3.4(c) of the Policy, the Panel concluded that the Registrant registered the Domain Name in bad faith and thus the Registrant cannot have a legitimate interest pursuant to this provision.

The Complainant says that the Domain Name was not used for a legitimate, non-commercial purpose such as criticism, review, news reporting, or any other activity, so the Registrant cannot have a "legitimate interest" under paragraph 3.4(d) of the Policy.

According to the Complainant, the Registrant is Priatharshan Gnanendran and thus the Domain Name is clearly not a legal name of the Registrant. This is some evidence that the Registrant has no legitimate interest under paragraph 3.4(e) of the Policy

There is no evidence to suggest that the Domain Name is the geographical name of the location of the Registrant's non-commercial activity or place of business per paragraph 3.4(f) of the Policy

There does not appear to be evidence of the existence of any of the criteria for legitimate interest listed in paragraph 3.4 of the Policy. The additional evidence submitted by the Complainant is sufficient to satisfy the onus on the Complainant to provide "some evidence" that the Registrant has no legitimate interest in the Domain Name.

The Panel finds that the Complainant has provided "some evidence" that the Registrant does not have a legitimate interest in the Domain Name. Again, the Panel notes that the Registrant has not filed any submissions disputing the Complainant's submissions or justifying its registration or use of the Domain Name.

#### **G. DECISION & ORDER**

The Panel finds that the Complainant has satisfied the applicable requirements of the Policy in accordance with the Rules.

As requested, the Panel orders the transfer of the Domain Name *behr.ca* to the Complainant, pursuant to paragraph 4.3 of the Policy.



Dated at Beijing, PRC, this 1<sup>st</sup> day of December, 2015



Thomas Manson, Q.C., Sole Panel Member

**APPENDIX "A"**  
**Registration History of Complainant's Marks**

The Complainant is the owner of trade-marks which are the subject of a registration under the Trade-marks Act (Canada) R.S.C 1985. The details of these trade-marks are listed in the following table and the certificates are available in Annex 1:

<b>TRADE-MARK</b>	<b>OWNER</b>	<b>DATE OF REGISTRATION</b>	<b>REGISTR. NUMBER</b>	<b>Classes of Goods</b>
BEHR (Word)	BEHR PROCESS CORPORATION	1990-06-01	TMA369136	2, 3
 (BEHR & Design)	BEHR PROCESS CORPORATION	1997-03-13	TMA472658	-
 (BEHR & Design)	BEHR PROCESS CORPORATION	2005-05-06	TMA639280	-
BEHR (Word)	BEHR PROCESS CORPORATION	2015-08-27	TMA912580	9, 20, 42