

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

Dispute Number: DCA-1921-CIRA
Domain Name: <lurpak.ca>
Complainant: Mejeriforeningen Danish Dairy Board.
Registrant: Annette Samuelsson
Registrar: HEXONET Services Inc.
Panel: The Honourable Neil Anthony Brown QC
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

OVERVIEW

1. This matter concerns a dispute between the Complainant and the Registrant regarding the registration of the domain name <lurpak.ca> (“the disputed domain name”).
2. The British Columbia International Commercial Arbitration Centre (“BCICAC”) 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. The Registrant has not filed a Response in this proceeding.

THE PARTIES

1. The Complainant in this proceeding is Mejeriforeningen Danish Dairy Board of c/o BrandIT GmbH, Bellerivestrasse 49, 8008 Zurich, Switzerland and disputes@brandit.com (“the Complainant”).
2. The Registrant in this proceeding is Annette Samuelsson, 99 University Avenue, Kingston, ON K7L3N6 Canada and keepwalking07@gmail.com (“the Registrant”).

REGISTRATION OF THE DISPUTED DOMAIN NAME

1. The disputed domain name was registered by the Registrant on August 9, 2016.
2. The Registrar of the disputed domain name is HEXONET Services Inc.

PROCEDURAL HISTORY

According to the information provided by the BCICAC:

- (a) The Complainant filed a Complaint with respect to the disputed domain name in accordance with the Policy on October 30, 2017.
- (b) The Complaint was reviewed and found to be administratively compliant. By email dated November 2, 2017, the BCICAC as service provider confirmed administrative compliance of the Complaint and, as Notice in accordance with Rules 2.1 and 4.3, forwarded a copy of the Complaint to the Registrant by email on that date, together with its Schedules. By the same communication the BCICAC informed the parties that in accordance with Rule 4.4 the date of commencement of the Proceeding was November 2, 2017 and that any Response had to be filed by November 22, 2017.

- (c) The Registrant did not file a Response in this proceeding with the BCICAC by November 22, 2017 or at all.
- (d) On November 23, 2017 the BCICAC by email to the Complainant and the Registrant noted that the time to submit a Response had expired and that accordingly under Rule 6.5, the Complainant might elect to convert from a three-person tribunal to a single arbitrator, which the Complainant did on or about November 27, 2017.
- (e) On November 27, 2017, BCICAC appointed The Honourable Neil Anthony Brown QC as sole arbitrator in this proceeding. The sole arbitrator has signed and forwarded to the BCICAC an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.
- (f) The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and the Rules by virtue of its ownership of the trademark for LURPAK with the registration number TMA425127 registered with the Canadian Intellectual Property Office on March 11, 1994 and used by or on behalf of the Complainant in Canada since 1957.

FACTS

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

The Complainant is a Danish entity which is the central organisation of the Danish dairy companies consisting of 28 companies that sells dairy products around the world. It also hosts the secretariat of IDF Denmark, and performs the administration of the tasks of the Danish National Committee of the International Dairy Federation.

The Complainant operates under the brand LURPAK, which has an international reputation and accordingly the use of the brand is strictly controlled.

The Complainant operates internationally and in Canada under the brand LURPAK.

The Complainant maintains that the Registrant, without permission or authority, registered the domain name <lurpak.ca> on August 9, 2016 and has used it for a pay-per-click site featuring links to brands of dairy products that are in competition with LURPAK, such as "Kerrygold Irish Butter", "Ancor Butter" and "Tesco." The Complainant maintains that this has been done to obtain the illegal advantage of an association with the Complainant's business and its LURPAK brand.

For that reason, the Complainant has requested that the disputed domain name be transferred from the Registrant to the Complainant.

The Registrant has not replied to the submissions of the Complainant.

The Complainant is the owner of the following trademark registered with the Canadian Intellectual Property Office ("CIPO"), namely: trademark for LURPAK with the registration number TMA425127 registered on March 11, 1994 ("the LURPAK mark").

As the disputed domain name was registered on August 9, 2016, the Complainant was the registered owner of a Canadian trademark prior to the date on which the domain name was registered.

CONTENTIONS OF THE PARTIES

A. THE COMPLAINANT

The Complainant submits as follows:

1. CANADIAN PRESENCE REQUIREMENTS

The Complainant submits that it satisfies the Canadian presence requirement of paragraph 1.4 the Policy in view of the Complainant's registration of the LURPAK mark with CIPO referred to above and established by the evidence.

2. THE REGISTRAR

The Registrar of record in respect of the disputed domain name registration is HEXONET Services Inc. The Complainant has adduced evidence to that effect (see **Annex 2** to the Complaint for a copy of the CIRA WHOIS database search result for the disputed domain name).

3. THE COMPLAINANT'S RELEVANT TRADEMARK RIGHTS AND ITS USE BY THE COMPLAINANT IN ITS BUSINESS

The mark on which the Complaint is based is LURPAK, registered with the Canadian Intellectual Property Office ("CIPO") with the registration number TMA425127 registered on March 11, 1994. A copy of the trademark certificate is contained in Annex 3 to the Complaint.

The Complainant has a long-standing and well developed international reputation based on its LURPAK brand and has engaged in extensive quality control so that only the best dairies may use the LURPAK brand. The brand is recognised as signifying premium quality.

The Complaint has been operating in Canada using the LURPAK brand and mark since at least 1957.

The LURPAK mark is distinctive and famous internationally and has enjoyed such distinctiveness and fame since long prior to August 9, 2016 when the disputed domain name was created.

4. THE GROUNDS ON WHICH THE COMPLAINT IS MADE

Confusingly Similar

The Complainant submits that the <lurpak.ca> domain name directly and entirely incorporates the Complainant's well-known registered trademark LURPAK which has been in use in Canada since at least 1957. It is now well established that in determining confusing similarity, the "dot-ca" suffix should be disregarded. Indeed, the LURPAK mark has been recognised in several prior domain name decisions as being a well-known trademark that has now been incorporated into the disputed domain name. Those principles should be applied in the present case, leading to a finding by the Panel that the domain name is confusingly similar to the LURPAK mark.

Registrant has No Legitimate Interests in the Disputed Domain Name.

None of the circumstances set out in paragraph 3.4 apply in the present case. The term LURPAK has no meaning in the English or French languages other than in association with the Complainant's trademark.

The website associated with the domain name is being used as a pay-per-click site, featuring links using brands that compete with that of the Complainant, such as "Kerrygold Irish Butter," "Ancor" and "Tesco". This is evidenced by **Annex 4** to the Complaint.

The Registrant is not commonly known by the disputed domain name and the WHOIS information identifies the Registrant in this proceeding as the Registrant the domain name.

Nor has the Registrant used the domain name in connection with a *bona fide* offering of goods or services. The intention of the Registrant has been to take advantage of an association with the business of the Complainant.

Importantly, the trademark relied on by the Complainant predates the registration of the disputed domain name. The Registrant therefore had knowledge of the trademark at the time of registering the domain name and it must be assumed that the Registrant was aware that the registration of the domain name would be illegal.

The Registrant has Registered the Domain Name in Bad Faith

Sub-paragraph 3.5 (a).

The present case comes squarely within the provisions of Sub-paragraph 3.5 (a).

There is no doubt that the Registrant offered the domain name for sale to the Complainant for \$5999 USD, showing that the registration of the domain name was an abusive registration. Correspondence between the parties and supporting that proposition is contained in **Annex 5** to the Complaint.

The Complainant also relies in that regard on prior domain name decisions.

Sub-paragraph 3.5 (b).

The present case also comes squarely within the provisions of Sub-paragraph 3.5 (b).

That is so because a search shows that the Registrant has around 220 domain names including those incorporating well-known trademarks. This shows a pattern of abusive domain name registrations by the Registrant.

Sub-paragraph 3.5 (d).

The case also comes within Sub-paragraph 3.5 (d) as the domain name is being used for pay-per-clicks which would generate a financial benefit from users who visit the page thinking they are going to an official LURPAK site.

Conclusion.

Accordingly, the Complainant submits that the Panel should order that the disputed domain name 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

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 Requirements provides that:

"A Person which does not meet any of the foregoing conditions [conditions (a) to (p)], 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".

The Complainant is the owner of the LURPAK mark more particularly set out above and which is registered with CIPO.

The Complainant has therefore satisfied CIRA's Canadian Presence Requirement for Registrants in respect of the disputed domain name.

2. REGISTRATION OF THE DISPUTED DOMAIN NAME

- (a) The Registrant registered the disputed domain name on August 9, 2016 and the registrar of the domain name is HEXONET Services Inc.
- (b) The Complainant submits that the Registrant of the domain name is Annette Samuelsson. The WHOIS search establishes that this is so.
- (c) 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;

and the Complainant must provide some evidence that:

(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 marks on which it relies to establish that proposition. The Complainant submits that it can meet those requirements.

The Mark

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 has adduced evidence which the Panel accepts, to show that it is the owner of a series of trademarks including the Canadian trademark for LURPAK, details of which have already been set out and supported by evidence which the Panel accepts.

The next question that arises is whether the LURPAK mark relied on is a "mark(s)" in which the Complainant had Rights prior to the date of registration of the Domain Name and continues to have such Rights. Bearing in mind that the date of registration of the domain name was August 9, 2016, ("the due date") the Panel finds that the Complainant had rights in trademark registered number TMA425127 for LURPAK with the Canadian Intellectual Property Office ("CIPO") on and from March 11, 1994 which was of course prior to the due date.

The Panel also finds that the Complainant continues to have such rights.

The Panel finds that the LURPAK mark 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 registered with CIPO.

The panel therefore finds that the LURPAK mark is a mark in which the Complainant had rights before the disputed domain name was registered and in which it still has rights.

Confusingly similar

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 so 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 (see *Coca-Cola Ltd. v. Amos B. Hennan*, BCICAC Case No. 00014).

Having regard to those principles, the panel finds that the disputed domain name is confusingly similar to the LURPAK mark. That is so because an objective bystander asked to make a comparison between the domain name and each the trademark would clearly see that they are identical and would assume that the domain name

was related to the trademark and that it may well be an official domain name of the Complainant. An internet user would also probably conclude that the idea suggested by the domain name was that it was the name of a well-known brand and that it would lead to a website dealing with the Complainant's business conducted under that brand.

Accordingly, the disputed domain name is confusingly similar to the LURPAK mark as it so nearly resembles the mark in appearance, sound and in the ideas suggested as to be likely to be mistaken for the LURPAK mark within the meaning of Paragraph 3.3 of the Policy.

The Panel therefore concludes that the disputed domain name is confusingly similar to the LURPAK mark in which the Complainant had Rights prior to the registration date of the disputed domain name and in which it continues to have such Rights.

The Complainant has thus made out the first of the three elements that it must prove.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

Under the Policy, the question whether the Registrant has a legitimate interest in the disputed domain name is to be decided in the following framework. First, there must be an assertion that the Registrant has no legitimate interest in the domain name. That criterion has been satisfied because the Complainant has made such an assertion in the Complaint. Secondly, the Complainant must provide some evidence that "...(c) the Registrant has no legitimate interest in the domain name *as described in paragraph 3.4 (emphasis added)*." Each of the sub-paragraphs of paragraph 3.4 describes a situation which, if made out, would give the Registrant a legitimate interest in the domain name. The obligation on the Complainant is therefore to show that the Registrant cannot make out any of the successive tests in the sub-paragraphs of 3.4. Thirdly, the Panel has to decide whether the evidence as a whole shows on the balance of probabilities that the Registrant has a legitimate interest in the domain name. Fourthly, the Registrant is not confined to the criteria set out in that paragraph, for those criteria are "without limitation". In other words, a registrant may try to bring itself within any of the specified criteria, but it may also rely on any other fact or argument it wishes to rely on to show that it has a legitimate interest. If it does do this, the role of the Panel is to decide if the registrant has made out its case and to make that decision on the balance of probabilities.

The first task of the Panel is therefore to see if the Complainant has provided "some evidence" that the Registrant has not brought himself within any of the specific criteria in paragraph 3.4.

Applying that test, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the disputed domain name. In particular, the Complainant has shown by the evidence that:

- (a) The term LURPAK has no meaning in the English or French language other than in association with the Complainant's LURPAK trademark; accordingly the evidence shows that the Registrant could not argue that the domain name was a generic or common dictionary word giving rise to a legitimate interest in the domain name;
- (b) The evidence revealed by **Annex 4** shows that the Registrant has caused the domain name to resolve to a website featuring products that are in competition with those of the Complainant; clearly such conduct gives no legitimacy to the Registrant's registration and use of the domain name;
- (c) The WHOIS evidence shows that the Registrant is not commonly known by the domain name;
- (d) There is no evidence, as the Complainant has shown, tending to suggest that the Registrant had used or would use or prepare to use the domain name in connection with a *bona fide* offering of goods or services; rather, the evidence shows the Registrant was minded to take advantage of an alleged association with the business of the Complainant;
- (e) It is clear from the evidence of the chronology of events and the fame of the LURPAK trademark that the Registrant must have been aware of the trademark when it registered the domain name and that the Registrant therefore registered the domain name for an improper purpose.

All of this evidence shows that on the available evidence and inferences that can be drawn from it, that the Registrant has no legitimate interest in the domain name.

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. Accordingly, the Complainant has provided evidence that the Registrant cannot bring itself within any of the specified criteria in paragraph 3.4 that would show a legitimate interest in the domain name and the Panel so finds.

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.

The Complainant has thus established the second of the three elements that it must prove.

REGISTRATION IN BAD FAITH

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-Canada 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.

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.”

Section 3.5 provides that “ (f)or the purposes of paragraphs 3.1(c) ... any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:... “ and then goes on to provide four such circumstances, three of which are relied on by the Complainant, namely:

“(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) ...

(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 to be noted again that the criteria for bad faith are not exclusive, but that complainants may rely on circumstances other than those enumerated to show bad faith registration.

The Panel will now examine the three criteria relied on by the Complainant

Intention to sell, rent, licence or transfer the domain name-Paragraph 3.5(a)

The Complainant submits that the record shows that the Registrant’s conduct brings it within this sub-paragraph and that it justifies the conclusion that the Registrant registered the domain name for the primary purpose of selling it to the Complainant. To support this contention, the Complainant points to the correspondence between the parties in **Annex 5** and says that it shows that this was the Registrant’s primary purpose.

The Panel agrees with this submission as it is the only conclusion that can be reached on the evidence.

As the Complainant submitted there is no doubt on the evidence that the Registrant offered the domain name for sale to the Complainant for \$5999 USD, showing that the registration of the domain name was an abusive registration.

The first ground has therefore been made out.

A Pattern of conduct in registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names- Paragraph 3.5 (b)

The Complainant submitted that a search shows that the Registrant has around 220 domain names including those incorporating well-known trademarks such as CITIZEN WATCH, CRAIGS LIST and GIORGIO ARMANI. The search result is contained in ANNEX 6 to the Complaint and shows a pattern of abusive domain name registrations by the Registrant.

The Panel agrees with the Complainant on the evidence and finds that the case falls squarely within the subparagraph, showing bad faith registration of the domain name.

Intentionally Attract Traffic For Commercial Gain –Paragraph 3(5)(d)

The Complainant also relies on paragraph 3.5(d) of the Policy and submits that the Registrant intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the LURPAK mark as to the source, sponsorship, affiliation or endorsement of the contents of Registrant's website.

The Panel agrees with that submission. As the Complainant submits, the disputed domain name was being used as a pay-per-click page which must have been devised for the Registrant to make money from hits to the page and that was probably the result.

That ground is therefore also made out.

Bad Faith in general

Bad faith registration may also be shown by conduct other than the conduct specified. This is made clear by Section 3.5 providing as it does, that "(f)or the purposes of paragraphs 3.1(c) ... any of the following circumstances, *in particular but without limitation*, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:..." (emphasis added). This provision is included, as bad faith conduct may take many forms and it is frequently used to find bad faith registration and (under the Uniform Domain Name Dispute Resolution Policy) bad faith use.

The Panel has examined all of the evidence carefully and has conclude that it shows on the balance of probabilities that the Registrant registered the domain name in circumstances that can fairly be described as bad faith within the generally accepted meaning of that expression. Indeed there is no other interpretation that can be made of the evidence.

The Panel also notes that the domain name was registered at a time by which the Complainant and its LURPAK brand and mark had become entrenched internationally and had established an active and physical presence in Canada. This is shown by the evidence and submissions of the Complainant, and it is clear from that evidence that the LURPAK brand had acquired great prominence by the time the domain name was registered.

The Panel finds that the intention of the Registrant was to register the domain name because it reflected the Complainant's famous trademark and eventually to use it for a purpose consistent with its own interests and not with the Complainant's interests and probably for a purpose that would benefit the Registrant financially. That constitutes bad faith registration.

The Complainant has thus made out the third of the three elements that it must establish.

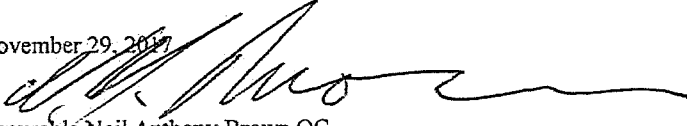
CONCLUSION AND DECISION

The Panel finds that the constituent elements of the Policy have 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 Domain Name <lurpak.ca> be transferred from the Registrant to the Complainant Mejeriforeningen Danish Dairy Board.

Date: November 29, 2017

A handwritten signature in black ink, appearing to read 'Neil Anthony Brown', written over the date.

The Honourable Neil Anthony Brown QC