

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

Complainant:	Kohler Co.
Complainant's counsel:	Daniel Anthony of Smart and Biggar
Registrant:	Dwayne Fudge
Panel:	Barry C. Effler
Service Provider:	British Columbia International Commercial Arbitration Centre
BCICAC File Number:	DCA-1940-CIRA

DECISION

DECISION SUMMARY:

The Parties, Domain Names and Registrar

1. The Complainant is Kohler Co. of Kohler, Wisconsin, United States of America.
2. The Registrant is Dwayne Fudge.
3. The Domain Names at issue in this dispute are

KOHLERCANADA.CA KOHLERGENERATORSCANADA.CA.
4. The Registrar is Go Daddy Domains Canada, Inc.
5. Both Domain Names at issue were registered by the Registrant on June 2, 2016.

Procedural History

6. The procedural history of this matter was set out in a letter dated January 8, 2018 from the British Columbia International Commercial Arbitration Centre to me as the sole Panelist herein:

On December 12, 2017 the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.

In a letter dated December 13, 2017, the Centre as Service Provider, confirmed compliance of the complaint and commencement of the dispute resolution process.

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 1.4 (August 22, 2011).

As the Complaint with the attachments was filed exclusively online, therefore, the Centre delivered the Complaint to the Registrant only by email.

Attempts to deliver the Complaint to the Registrant have been successful.

The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

The Centre hereby appoints you, **Barry C. Effler, LL.B., LL.M., C. Arb. Fellow**, as sole arbitrator in the above-referenced matter.

7. As required by paragraph 7.1 of the *Rules*, I have declared to BCICAC that I can act impartially and independently in this matter as there are no circumstances known to me that would prevent me from so acting.
8. I am not aware of any other legal proceeding or other arbitration in relation to the Domain Names that would give rise, under paragraph 13.2 of the *Rules*, to a need to stay or terminate the progress of this proceeding.
9. Reference to *Policy* herein means the *CIRA Domain Name Dispute Resolution Policy, version 1.3 (August 22, 2011)*. Reference to *Rules* herein means the *CIRA Domain Name Dispute Resolution Rules Version 1.5 (July 28, 2014)*.

Eligibility of Complainant

10. I have reviewed the material submitted by the Complainants and am satisfied that Complainant is an eligible complainant under paragraph 1.4 of the *Policy*. Kohler Co. is the owner of a registered Canadian trade-mark which it is alleging the Domain Name in

dispute is the exact word component of such trade-mark. Paragraph 1.4 of the *Policy* requires that a complainant meet the Canadian Presence Requirement of the *Canadian Presence Requirements For Registrants version 1.3* “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.

11. The trade-mark in question is KOHLER and the Domain Names in dispute include this mark which is identical as to the word portion.

Relief Requested

12. The Complainant requests that the Domain Names in dispute be transferred from the Registrant to the Complainant.

Applicable Law

13. As directed by paragraph 12.1 of the Rules, I will render my decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

Background Facts

14. Background facts alleged by the Complainant and accepted by me as probative are quoted here from the Complaint: [edited to remove reference to exhibits provided with the Complaint for improved readability]:

The Complainant is an American manufacturing company that is globally renowned for its high quality plumbing products. Kohler Co. was founded by John Michael Kohler in 1873 with the creation of the company's first bathtub. Since that time, Kohler Co. has expanded into offering a wide range of household and commercial products including furniture, cabinetry, tiles, engines and generators.

...

The KOHLER Trademark represents to the worldwide consuming public the goods and services offered by the Complainant.

...

The Complainant has used the KOHLER Trademark in Canada dating back almost as early as the company's inception in 1873 and continuing to today. Over that time, Kohler Co. has gained substantial and valuable goodwill in Canada in the KOHLER Trademark. Products bearing the KOHLER Trademark are available in Canada through an expansive network of authorized dealers, including major retailers such as The Home Depot, Lowe's and Rona.

...

The Complainant Kohler Co. is the owner of nineteen (19) Canadian trademark registrations consisting of, or prominently featuring, the word KOHLER, all registered for use in association with various goods in the nature of plumbing fittings and fixtures, household goods and appliances, industrial and household power generators, landscaping vehicles and appliances, interior design products, and related goods and services:

Registration No.	Trademark	Registration Date
TMDA20212	KOHLER	1914-10-10
TMDA35576	KOHLER OF KOHLER	1924-05-08
TMDA48802	"KOHLER"	1930-02-27
UCA50862	KOHLER	1954-05-27
TMA432465	THE BOLD LOOK OF KOHLER	1994-08-26
TMA557368	KOHLER AEGIS	2002-02-04
TMA603384	KOHLER	2004-02-26
TMA591951	THE BOLD LOOK OF KOHLER	2003-10-09
TMA659876	KOHLER	2006-03-01
TMA711028	KOHLER COMMAND	2008-04-04
TMA681721	KOHLER	2007-02-15

TMA764147	KOHLER	2010-04-14
TMA739629	KOHLER	2009-05-07
TMA783427	KOHLER	2010-11-25
TMA803796	KOHLER	2011-08-05
TMA803794	KOHLER	2011-08-05
TMA783428	KOHLER	2010-11-25
TMA832842	KOHLER	2012-09-26
TMA774142	KOHLER	2010-08-10

...

The Complainant has also developed a[...] presence on the internet and is the owner of several domain names which contain the word "KOHLER", for example: <kohler.com>, <kohler.ca>, <kohlergenerators.com>, <kohlerfirst.com>.

...

The Disputed Domain Names redirect to the website www.firstpowergenerators.com. This website features information about a company identifying itself as "First Power Generators", located in Newmarket, Ontario, and offering services related to the sale and installation of generators and power backup systems in the Greater Toronto Area. The website states that the company is an authorized dealer of Generac, Eaton and Honeywell, though only Generac brand generators are displayed on the website. The products offered are competitive with KOHLER brand generators.

...

As the Disputed Domain Names were not registered until June 2, 2016, and Kohler Co.'s oldest active Canadian trademark registration for KOHLER was registered on October 10, 1914, the Complainant has enjoyed rights in the KOHLER Trademark in Canada more than a century prior to the registration of the Disputed Domain Names, and continues to have such rights.

Discussion and Findings

15. *Policy* paragraph 4.1 sets forth the onus on a complainant. It provides as follows:

4.1 **Onus.** *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 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.*

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

16. The *Policy* provides a definition of the term "Mark" (but as amended no longer defines Rights):

3.2 **Mark.** *A "Mark" is:*

(a) *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; ...*

17. The Complainant has established that it has rights in a trade-mark that was a "Mark" prior to the date on which the Domain Names were registered. The trade-marks were all registered significantly earlier than the June 2, 2016 date of registration of the Domain Names. (see paragraph 14, above for details.)

18. The relevant definition of “Mark” requires that a trade-mark be “used”. The term “use” is no longer defined in the *Policy*. As indicated in the Background Facts set out above, the Complainant has been selling products under its trade-marks since at least 1914. The Complainant therefore meet this requirement.
19. The issue of the Confusingly Similar test for *Policy* paragraph 4.1 (a) is the most difficult test for the Complainants to meet. The word portion of the trade-mark does not exactly match the word portion of the Domain Names.
20. The Complainants’ submission from the Complaint is concise set out and is quoted here:

Paragraph 3.3 of the Policy provides that a domain name will be considered “confusingly similar” to a trademark if the domain name so nearly resembles the trademark in appearance, sound or the ideas suggested by the trademark as to be likely to be mistaken for the trademark. For the purposes of the Policy, “domain name” means the domain name excluding the “dot-ca” suffix (Paragraph 1.2, Policy). Therefore, in this case, the question is whether the Disputed Domain Names so nearly resemble as to be likely to be mistaken for the KOHLER Trademark.

A number of panels have determined that the test for “confusingly similar” is not one of the trademark being exactly the same as the domain name. Rather, the test is one of resemblance based on the first impression and imperfect recollection. Accordingly, the inclusion of additional words will not prevent a domain name from being confusingly similar to a trademark.

Ford Motor Co of Canada Ltd v Lefebvre, CIRA Decision No. 1782 at para 31 (downtownford.ca).

Vanguard Trademark Holdings USA, LLC v Nikulainen, CIRA Decision No. 1687 at para 15 (nationalcarhire.ca).

In particular, panels have found that the addition of a geographically descriptive term does not add to the distinctiveness of a domain name, but rather can serve to enhance the confusing similarity with a trademark because it suggests that the domain relates to a website operated by, or associated with, the trademark owner for goods or services offered in that geographic location.

Ford Motor Co of Canada Ltd v Lefebvre, CIRA Decision No. 1782 at para 33 (downtownford.ca).

Carey International, Inc v Saleh, CIRA Decision No. 1735 at para 18 (montrealcareylimo.ca).

HMV (IP) Ltd v Mateescu, CIRA Decision No. 1364 at para 20 (hmvcanada.ca).

Consequently, it is very likely that a person knowing the Complainant's mark KOHLER, would mistake the Disputed Domain Names (KOHLECANADA and KOHLERGENERATORSCANADA) as being associated with the Complainant's mark. In this regard, Kohler Co. is a well-known provider of a number of products under the KOHLER Trademark, including generators. Internet users would naturally assume that the Disputed Domain Names relate to the products of Kohler Co. specifically sold in Canada.

Furthermore, panels have found that the addition of a descriptive word to a well-known and widely used mark is likely to lead persons visiting the website to believe that it is associated with the complainant. For example, in *Oakley Inc v Yayang* (CIRA Case No. 1377 at para 18), the panel, in considering the domain name <discount-oakleysunglasses-sale.ca>, found that the additional phrases "discount", "sunglasses" and "sale" did not distinguish the disputed domain name from the OAKLEY mark and that the inclusion of the word "sunglasses" added to the likelihood of confusion since the manufacture and sale of sunglasses was a major part of the complainant, Oakley's, business.

Similarly, in this case, the inclusion of the term "generators" in the domain name KOHLERGENERATORSCANADA only serves to add to a likelihood of confusion with the Complainant's KOHLER trademark because KOHLER is a well-known manufacturer of industrial and household generators.

21. I agree with the analysis provided by the Complainant set out above and accordingly I am satisfied that the Domain Names are confusingly similar to the Complainant's Mark.
22. I am satisfied that the Complainant has established bad faith by the Registrant for the purposes of paragraphs 4.1 of the *Policy*. Paragraphs 3.5 of the *Policy* outlines circumstances which if found shall be evidence that the Registrant has registered a domain name in bad faith. The paragraph expressly states that this list is without limitation.

Paragraph 3.5 of the *Policy*:

3.5 Registration in Bad Faith. *For the purposes of paragraphs 3.1(c) and 4.1(b), 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: . . .*

(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.

23. The Complainant's evidence regarding the Domain Names is
- (a) At the time of filing this Complaint, there were no active trademarks on the Canadian Trademarks Register for any mark consisting of or containing the word KOHLER, other than those owned by the Complainant.
 - (b) . . . there has never been, any relationship between the Complainant and the Registrant regarding the use of the KOHLER Trademark. The Registrant has never been licensed by the Complainant or otherwise authorized to register or use the KOHLER Trademark in any manner whatsoever, including as part of a domain name.
 - (c) On its face, the Registrant's trademark is FIRST POWER GENERATORS, and the products it purportedly sells are GENERAC, EATON, and HONEYWELL brand generators. As such, there is no evidence that the Registrant has any rights in the mark KOHLER, and the evidence actually points to the contrary.
 - (d) The Disputed Domain Names redirect to the website www.firstpowergenerators.com. This website features information about a company identifying itself as "First Power Generators", located in Newmarket, Ontario, and offering services related to the sale and installation of generators and power backup systems in the Greater Toronto Area. The website states that the company is an authorized dealer of Generac, Eaton and Honeywell, though only Generac brand generators are displayed on the website. The products offered are competitive with KOHLER brand generators.
- [quoted from Complaint.]
24. Both Domain names are referring traffic to a site that is marketing products competitive to the Complainant.
25. This evidence meets the bad faith requirements of Paragraph 3.5 (d) as there is uncontroverted evidence of internet traffic being referred to a competitor's website that offers competing products.
26. The Complainant has established evidence to meet the tests set out in Paragraph 4.1 (a) Confusing Similar domain name to a trademark of the Complainant and (b) evidence of bad faith by the Registrant.

27. The test in paragraph 4.1 of the Policy is

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

28. The Complainant has met the onus to establish its case for the purposes of meeting the confusingly similar and bad faith requirements of paragraph 4.1 (a) and (b). The onus is on the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the Domain Names.

29. The Registrant has chosen to not participate in these proceedings and accordingly has not provided any evidence to me in support of his position.

30. There is no evidence before me that the Registrant has any business or personal project that would indicate a legitimate interest in the Domain Names.

31. There is no evidence that any of the circumstances outlined in paragraph 3.4 of the *Policy* regarding legitimate interest apply and I am satisfied that the Registrant has no legitimate interest in the Domain Names.

32. I am satisfied that the Complainant has met the onus on it to succeed, as required by paragraph 4.1 of the *Policy*.

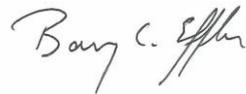
33. Paragraph 4.3 of the *Policy* requires the Panel to decide if the Domain Names should be cancelled or transferred to the Complainant if the Panel decides in favour of the Complainant.

34. Transfer is the remedy which will protect the Complainants' business interests and rights in the trade-mark KOHLER.

Order

35. For the reasons set forth above, I order the Domain Names in issue to be transferred to the Complainant.

Dated: January 27, 2018

A handwritten signature in cursive script that reads "Barry C. Efler".

Barry C. Efler, LL.B., LL.M.
Sole Panellist