

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

DECISION

Complainant:	Knorr-Bremse AG
Registrant:	zhao bin
Domain Name	<i>knorrbremse.ca</i>
Registrar:	Go Daddy Domains Canada, Inc
Sole Panel Member:	Thomas Manson, Q.C.
Service Provider:	British Columbia International Commercial Arbitration Centre
BCICAC File:	DCA-2019-CIRA

A. OVERVIEW

This matter concerns a dispute between the Complainant and the Registrant regarding the registration of *knorrbremse.ca* (the "Disputed Domain Name"); Go Daddy Domains Canada, Inc is the current 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 submitted a complaint dated Sept. 17, 2018 (the "Complaint") to the BCICAC seeking an order in accordance with the Policy and Rules directing the transfer of the registration of the Disputed Domain Name to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with CIRA's requirements under Rule 3.2. By letter of transmittal dated Sept. 17, 2017 (the "Transmittal

Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be Sept. 17, 2018 and advised the Registrant that in accordance with the provisions of Rule 5, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or Oct. 9, 2018.

The Registrant did not provide a Response by Oct. 9, 2018 (or at all). Accordingly, under Rule 6.5, the Complainant was at liberty to elect to convert from a three-person panel to a single member panel. As permitted, the Complainant elected to convert from a panel of three members to a single member panel.

By letter dated Oct. 15, 2018 the BCICAC appointed Thomas Manson, Q.C. as sole arbitrator for a single member panel in this matter.

On Oct. 17, 2018 Thomas Manson, Q.C. accepted the appointment and provided the BCICAC with the required Declaration of Independence and Impartiality.

The Panel has been properly appointed as of Oct. 17, 2018 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. In addition, the Panel has by emails dated Oct. 29 and 31 and Nov. 5, 2018 requested additional evidence and clarification from the Complainant. Additional evidence and submissions from the Complainant (received Oct. 31, 2018 and Nov. 5, 2018) also form part of the record.

Given the submission of additional evidence and argument, on its own motion the Panel extended the time for delivery from Nov. 5, 2018 to Nov. 9, 2018. At that time, the Panel requested additional submissions from the Complainant. Further Submissions from the Complainant (received Nov. 5, 2018) also form part of the record.

C. CANADIAN PRESENCE REQUIREMENTS / JURISDICTION

Eligibility of Complainant

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. The Complainant is the registered owner of a Canadian trademark “KNORR-

BREMSE" (Application number 1037886, Registration number TMA560900)¹. Thus, the Complainant satisfies the Presence Requirements and is an eligible complainant under Paragraph 1.4 of the Policy.

Requirements for Commencement

All requirements for the commencement of this proceeding have been met and that the Panel has jurisdiction to consider this matter.

D. EVIDENCE

The Panel finds as follows:

The Complainant and its Marks in Canada

The Complainant's evidence is that it is a well-known developer and manufacturer of braking systems for rail and commercial vehicles. It was founded in Berlin in 1905 by Georg Knorr, one of the world's pioneers in the development of braking systems. The company name emphasizes the Complainant's activity, as the German word "bremse" means brake. Knorr-Bremse's commercial success for more than 100 years was based on an agreement with the Prussian State Railways to supply single-chamber express braking systems. These systems offered considerably enhanced safety performance and it was no more necessary to have train guards operating the brakes by hand. As a second main field of activity since the 1920s, the Complainant developed and manufactured braking systems for commercial vehicles, for trucks and semi-trailer tractor units over six tons, buses, trailers or special vehicles.

The evidence is that the Complainant is one of the world's leading developers and manufacturers of braking systems, with over 19,000 employees and worldwide sales of more than EUR 4 billion. The Complainant has established over 90 locations in 27 countries throughout the world.

In addition to the Canadian trademark registration of KNORR-BREMSE referred to above, the Complainant is owner of several international, regional (i.e. Community trademarks, EUTM), and national (Germany (DE), USA, and others) trademark registrations. These trademarks are protected for the goods and services in the industry field, in particular brakes, where Complainant is doing business².

These trademark registrations predate the date of registration of the Disputed Domain Name. Further the Complainant has a significant Internet presence and is the owner of more than 80

¹ Annex 1b Filed Nov. 30, 1999, Registered April 26, 2002

² Annex 3 consists of excerpts from the respective databases on these trademark registrations.

domain names incorporating the designation “KNORR-BREMSE”³, *inter alia*:

knorr-bremse.com	knorr-bremse.eu
knorr-bremse.de	knorr-bremse.fr
knorr-bremse.ag	knorr-bremse.info
knorr-bremse.asia	knorr-bremse.it
knorr-bremse.at	knorr-bremse.jp
knorr-bremse.biz	knorr-bremse.kr
knorr-bremse.career	knorr-bremse.net
knorr-bremse.ch	knorr-bremse.org
knorr-bremse.cn	knorr-bremse.press
knorr-bremse.co	knorr-bremse.ru
knorr-bremse.co.uk	knorr-bremse.us
knorr-bremse.com.br	knorr-bremse.xxx
knorr-bremse.com.cn	knorr-bremse.中国
knorr-bremse.com.ru	

Creation of Domain

A WHOIS search results report [Further Evidence submitted by the Complainant on Oct. 31, 2018] shows that the Domain was created “2016/01/22”.

Registrar

The Registrar of Record was incorrectly identified in the Complaint as “Tucows Inc.” This error became apparent to the Panel on or about Nov. 5, 2018. At that point, the Registrar, “at the time the proceeding (was) submitted” was identified by the Complainant as “Go Daddy Domains Canada, Inc” (as shown on page 1 of this Decision). The identification is supported by a “knorrbremse.ca whois history” document submitted by the Complainant to the Panel on Nov. 5, 2018.

³ See, for instance, Annex 4 materials.

By email sent on or about Nov. 5, 2018, the Complainant sought to amend the Complaint to correct the identity of the relevant Registrar. Leave is hereby granted *nunc pro tunc* to do so as of commencement of this Proceeding.

On Nov. 6, 2018 the BCICAC, as Provider, notified the Registrar that a CDRP dispute was filed on September 17, 2018 with respect to the domain name "*knorrbremse.ca*".

Current Status of Domain

In the Complaint, the Registrant is identified as "zhao bin" of Beijing, China. This was confirmed by the Further Evidence submitted by the Complainant on Oct. 31, 2018 in the form of an August 16, 2018 email from Disclosure Requests, Canadian Internet Registration Authority. "Bin" (presumably the second element in the name "zhao bin") also appears on an email address "bin@chinaknorr.com"⁴.

No Rights, Licence, or Authorization

The Complaint makes clear and this Panel accepts that:

- the "Registrant does not have any rights or legitimate interest in the disputed domain name"; and
- the Complainant has given "no licence or authorization of any other kind" to the Registrant to use the designation "*knorrbremse.ca*".

Indeed, the Disputed Domain Name resolves to a website of "KNORR-BREMSE LIMITED 克诺尔制动系统有限公司", a "brake parts factory" in China. Annex 6a is a screenshot of the website:

⁴ See Annex 6a, a screenshot of a webpage to which the Disputed Domain Name resolves.

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 dot-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* (emphasis added) must prove, on a balance of probabilities, that:

(a) the Registrant's dot-ca domain name is "Confusingly Similar"⁶ to a Mark⁷ 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.

Paragraph 4.1 of the Policy goes on to state that even if the Complainant proves (a) and (b) and provides some evidence of (c), *the Registrant* (emphasis added) 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.

Policy Para 4.1(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 ... that is registered in CIPO;

According to Annex 1b, "KNORR-BREMSE" has been used in Canada since at least 1975 and the word mark "KNORR-BREMSE" was registered in CIPO in April 2002. The Complainant is shown as

⁶ The expression "Confusingly Similar" is described in paragraph 3.3 of the Policy.

⁷ The word "Mark" is described in paragraph 3.2 of the Policy.

the owner.

The Complainant has established that "KNORR-BREMSE" 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 Complainant submits that the Disputed Domain Name is "confusingly similar" to the Complainant's mark or marks. It refers to the practice of combining hyphenated elements in a Mark (eg. Coca-Cola) to a domain name (eg "cocacola.com") and suggests that the Registrant has done here is "clearly not sufficient to distinguish the marks". The Coca-Cola example is apt. The "confusingly similar" issue faced in the present case was addressed in *Coca-Cola Ltd. v. Amos B. Hennan* October 28, 2003, Case No. 00014 <cocacola.ca>. The "dot-ca" domain there was a Mark without a hyphen. The <cocacola.ca> decision was referred to by the learned Panel in a recent CDRP decision *WD-40 Manufacturing Company v. Interex Corporate Registration Services Inc.*, Oct. 15, 2018, Case No. 00374 <wd40.ca> and <wd-40.ca>. In <cocacola.ca> (2003), the Panel found (at para. 33-34):

"The cocacola.ca Domain Name, without the dot-ca suffix, is Complainant's Marks, except for the omission of the hyphen in between the terms "coca" and "cola". However, the absence of punctuation marks is irrelevant to the evaluation of the similarity between a domain name and a trademark. (*Canadian Broadcasting Corporation / Société Radio Canada v. William Quon*, April 8, 2003; Dispute No. DCA 681-CIRA).

Accordingly, the Panel finds that the cocacola.ca Domain Name is Confusingly Similar, within the meaning of Paragraph 3.4(b) of the Policy, to the Complainant's Marks."

This reasoning is applicable here; the Panel finds the Disputed Domain Name is "confusingly similar" to the Complainant's Mark.

Further, the Complainant's rights in the Mark precede the 2016 registration date of the Disputed Domain Name. As required under para. 4.1(a) of the Policy, the Panel finds that the Complainant's rights in the Mark predate the registration of the Disputed Domain Name and the Complainant continues to have such rights.

Policy Para 4.1(b) - Bad Faith Registration

The Complainant says that the Registrant has registered *and is using* the Disputed Domain Name in bad faith. It should be noted that paragraph 4.1(b) of Policy focuses on *bad faith registration* as described in paragraph 3.5. Four non-exclusive circumstances considered evidence of bad faith in registering a domain name are set out in paragraph 3.5. In <wd40.ca> and <wd-40.ca> (2018), the learned Panel emphasized (at page 12):

“the criteria for bad faith are not exclusive, ... complainants may rely on circumstances other than those enumerated to show bad faith registration”

and:

“Bad faith registration may also be shown by conduct other than the conduct specified (in paragraph 3.5)”

Indeed, here the Complaint makes no express reference to the provisions of paragraph 3.5.

The Complainant says the Registrant “intentionally attempts to attract, for commercial gain, internet users to Registrant’s website by creating a likelihood of confusion with the Complainant’s marks as to the source, sponsorship, affiliation or endorsement of the Registrant’s website”. This is comparable to paragraph 3.5(d) of the Policy, which provides:

(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.

In this regard, it is reasonable to infer that the Registrant was aware of the Complainant’s rights in the mark “KNORR-BREMSE” at the time of the registration of the Disputed Domain Name. Further, the Complainant says and this Panel accepts that the Registrant is misleading Internet users, for commercial gain, in order to attract them to its own products and services. This Panel sees no explanation for Registrant’s conduct other than to simply draw upon the reputation and prestige of the famous mark “Knorr-Bremse” for commercial gain. The Registrant is using the Disputed Domain Name not only to sell KNORR-BREMSE parts (exhausts) which allegedly are the Complainant’s original products under the “KNORR-BREMSE” trademark and its own products, the Complainant says, but also for goods of Complainant’s competitors. Thus, the Complainant says and the Panel accepts that the Registrant using the Complainant’s Mark to bait users and switch them to competing products.

The Complainant refers to *Toyota Motor Sales, U.S.A., Inc. v. Pick Pro Parts* WIPO Domain Name

Decision D2005-0562 on "bad faith"⁸. The Panel there stated:

"the Respondent confusingly employs the Complainant's marks in the domain names to attract internet users to the Respondent's commercial site, where the Respondent attempts to sell Complainant's parts, as well as those of its competitors, evidently for commercial gain. This constitutes bad faith under para. 4 (b) (iv) of the Policy."⁹

The conduct of the Respondent in the *Toyota* case is similar to the conduct of the Registrant who confusingly employs the Complainant's Mark in the Disputed Domain Name to attract Internet users to a purported "KNORR-BREMSE" commercial site, where the Registrant attempts to sell Complainant's parts, as well as those of its competitors, for commercial gain.

However, given that the Complainant makes no explicit reference to paragraph 3.5(a)-(d), this Panel prefers to follow the approach taken by the learned Panel in <wd40.ca> and <wd-40.ca> (2018). At the time of registration of the Disputed Domain Name in 2016, the Registrant knew, or should have known, of the existence of the Complainant's trademark. In effect, the Registrant has registered a "dot-ca" domain name in Canada containing a well-known trademark (without a hyphen) for the purpose of selling its own products and services in China. The Complainant submits and the Panel accepts that the Registrant is misleading internet users, for commercial gain. This Panel finds that the evidence as a whole shows that the Registrant registered the Disputed Domain Name "in circumstances that can fairly be described as bad faith within the generally accepted meaning of that expression".

The Panel also notes that the Registrant has not made any submissions to the Panel, including those suggesting that the Disputed Domain Name was 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 Disputed Domain Name in bad faith as described in paragraph 3.5.

Policy Para 4.1(c) - No Legitimate Interest in Domain Name

Finally, the Panel must determine under sub-paragraph 4.1(c), whether the Complainant has provided "some evidence that the Registrant has no legitimate interest in the domain name as

⁸ With respect to the use of WIPO decisions, the Panel notes that paragraph 3.2(l) of the 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." – see, for instance, *The Toronto-Dominion Bank v. Undisclosed*, Nov. 8, 2017, Case No. 00349 <tdeasyweb.ca>, at pages 4 and 6.

⁹ This is presumably to para. 4(b)(iv) of the UDRP.

described in paragraph 3.4”.

Paragraph 3.4 provides:

For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

- (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.

Returning to sub-paragraph 4.1(c), the balance of probabilities standard applies only to the first two sub-paragraphs of paragraph 4.1. It does not apply to the “no legitimate interest” question under sub-paragraph 4.1(c). This approach is consistent with the decision in *Home Depot of Canada Inc. v Terry Davies*, January 23, 2017, Case No. 00330. There, the learned Panel stated:

Although “some evidence” is not defined, it imposes, in the Panel’s view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide “some evidence” of a

negative.

Further, this Panel considers that sub-paragraph 4.1(c) does not require a complainant to negate each of the sub-paragraphs of paragraph 3.4. It is sufficient for a complainant to provide "some evidence" that a registrant has "no legitimate interest in (a) domain name as described in paragraph 3.4". Whether "some evidence" of "no legitimate interest" is sufficient is for the Panel to determine "based on its evaluation of all evidence presented" (from the language of the preamble of paragraph 3.4).

Here, the Complainant says that the Registrant has no rights or legitimate interest in the Disputed Domain Name. In particular:

(a) To the best of Complainant's knowledge, the Registrant has neither a local presence nor any trademarks registered in Canada, nor any trade names or personal names corresponding to the designation "KNORR-BREMSE" or the disputed domain name "knorrbremse.ca".

(b) Resellers or distributors of spare parts or exhausts who do not have a direct contractual relationship to a manufacturer of original product may use a trademark in a domain name only if they meet certain requirements. However, any legitimate use by the Registrant is precluded here since the Complainant says:

- (i) There are no (and never have been) direct contractual relationships between the Complainant and the Registrant;
- (ii) The "KNORR-BREMSE LIMITED" website in China does not contain any information on the relationship between the company offering goods under the Disputed Domain Name and the Complainant. Hence, the Registrant does not accurately disclose its relationship with the trademark owner;
- (iii) The Registrant is not exclusively selling the trademarked goods on the website under the Disputed Domain Name; and
- (iv) The Registrant is using the Disputed Domain Name not only for trademarked goods, but also for those of the Complainant's direct competitors, so that Registrant will bait and switch users to goods directly competing with the Complainant. Therefore, Registrant cannot claim on rights or legitimate interests nor a *bona fide* offering of goods.

On the Panel's evaluation of all of the evidence presented, including the evidence above, the Complainant has demonstrated that the Registrant has no legitimate interest in the Disputed

Domain Name.

Alternatively, there is “some evidence” of the following:

The Registrant is not using “knorrbremse” in good faith and there is no evidence that the Registrant has rights to the “KNORR-BREMSE” Mark in Canada so the Registrant cannot rely on subparagraph 3.4(a) of the Policy;

The Registrant registered the Disputed Domain Name in bad faith so the Registrant cannot rely on subparagraph 3.4(b) of the Policy;

The Disputed Domain Name is not the generic name of any wares, services or business and “knorrbremse” is not understood in Canada to be “the generic name thereof in any language” and so the Registrant cannot rely the provisions of subparagraph 3.4(c) of the Policy;

The evidence is that the Registrant uses the Disputed Domain Name in association with a commercial activity, and so he or she cannot rely the provisions of subparagraph 3.4(d) of the Policy;

It is inconceivable that “knorrbremse” is the legal name, surname or other reference by which the Registrant “zhao bin” is commonly identified and so he or she cannot invoke subparagraph 3.4(e) of the Policy; and

The Registrant has an address in Beijing and the Disputed Domain Name resolves to a website for a “brake parts factory” in Beijing. He or she cannot have used the Disputed Domain Name under subparagraph 3.4(f) as “knorrbremse” is not the geographical location of the Registrant’s place of business.

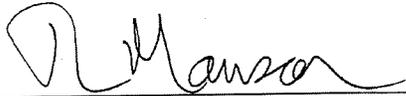
This Panel finds that the Complainant has provided “some evidence” that the Registrant does not have a legitimate interest in the Disputed Domain Name. Again, the Panel notes that the Registrant has not responded to this proceeding or presented any evidence to establish a legitimate interest in the Disputed Domain Name.

G. DECISION & ORDER

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

Accordingly, the Panel orders the registration of the Disputed Domain Name, *knorrbremse.ca*, be transferred to the Complainant, pursuant to paragraph 4.3 of the Policy.

Dated this 8th day of November, 2018

A handwritten signature in black ink, appearing to read "T. Manson", written over a horizontal line.

Thomas Manson, Q.C., Sole Panel Member