

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

**Complainant:** Golden Krust Patties, Inc.

**Registrant:** Christine Chin

**Domain Name:** goldenkrust.ca

**Registrar:** Go Daddy Domains Canada, Inc.

**Arbitrator:** David Wotherspoon

**Service Provider:** British Columbia International Commercial Arbitration Centre

**BCICAC File:** DCA-2040-CIRA

**DECISION**

**THE PARTIES**

1. The Complainant is Golden Krust Patties, Inc. ("Golden Krust") of 3958 Park Avenue, Bronx, New York, 10457, USA.
2. The Registrant is Christine Chin, an individual with a mailing address of 314 – 1460 Bishop Gate, Oakville, Ontario, L6M 4N5.

**THE DOMAIN NAME AND REGISTRAR**

3. The Domain Name at issue is goldenkrust.ca (the "Domain Name").
4. The Registrar of the Domain Name is Go Daddy Domains Canada, Inc.
5. The Domain Name was registered on November 16, 2016.

**PROCEDURAL HISTORY**

6. The British Columbia International Commercial Arbitration Centre ("BCICAC") is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (the "Policy") of the Canadian Internet Registration Authority ("CIRA").
7. This is a proceeding under the Policy, in accordance with the CIRA Dispute Resolution Rules (the "Rules").
8. The Complainant filed a complaint with respect to the Domain Name pursuant to the Policy on November 28, 2018 (the "Complaint").
9. In a letter dated November 29, 2018, the BCICAC confirmed compliance of the Complaint and commencement of the dispute resolution process.
10. The Complaint was delivered to the Registrant on November 29, 2018.
11. The Registrant did not provide a response within the timeframe required by the Rules. As a result, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

Subsequently, the BCICAC appointed David Wotherspoon as sole arbitrator in the Complaint on December 21, 2018.

12. The Arbitrator is obliged to issue a decision on or prior to January 10, 2019.

#### **ELIGIBILITY OF COMPLAINANT**

13. The Arbitrator has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and Rules.

#### **CANADIAN PRESENCE REQUIREMENT**

14. The Complainant is the owner of the Canadian trademark registration for GOLDEN KRUST CARIBBEAN BAKERY & GRILL and Design registered in the Canadian Intellectual Property Office ("CIPO") on January 22, 2009 with Registration Number TMA732990 (the "Golden Krust Mark").
15. The Complainant, as the owner of a trademark registered in Canada, meets the Canadian presence requirements.

#### **FACTS**

16. The Complainant's submissions set out the following facts.
17. The Complainant is a successful Caribbean food chain started by Jamaican immigrants to the USA. The Complainant is one of the most successful minority-owned franchisors in the world.
18. The Complainant currently has over 100 Golden Krust restaurants. The Complainant is the largest Caribbean restaurant franchise in North America, and it continues to grow, with new locations opening regularly.
19. The Complainant is the registered owner of the Golden Krust Mark for numerous goods and services, including:
  - Take-out food (namely pies, pastries, breads, beef, chicken, seafood, vegetables, vegetable pies, vegetable patties, shrimp, calaloo, soy pies, soy patties, meatloaf pies, and meatloaf patties);
  - Clothing (namely, t-shirts, sweat shirts, hats, and aprons);
  - Restaurant services, bakery and grill services, take-out restaurants, and delivery of food by restaurants; and
  - Restaurant franchising (namely, offering technical assistance in the establishment and operation of restaurants) and business assistance relating to the establishment of franchises.
20. The Complainant registered the Golden Krust Mark with the CIPO on January 22, 2009.

21. The Complainant also owns several registrations for or incorporating "GOLDEN KRUST" for similar goods and services in the USA. It has been using these marks since at least as early as the 1990s.
22. The Complainant owns the only marks registered on the USA and Canadian trademark registers that incorporate "GOLDEN KRUST."
23. The Complainant and its franchises have generated over a hundred million dollars in revenue.
24. The Complainant has spent hundreds of thousands of dollars on registration and enforcement activities to protect its marks for or incorporating "GOLDEN KRUST" and even greater amounts on marketing activities to promote its wares and services used in association with its marks.
25. The Complainant has built up a strong reputation and significant goodwill in the widely recognized "GOLDEN KRUST" marks in connection with the Complainant's goods and services due to the Complainant's extensive use of its marks and name, its substantial promotional activities, its registration of the Golden Krust Mark in Canada and its international enforcement activities.
26. The Complainant owns various domain names that incorporate "GOLDEN KRUST", including:
  - goldenkrust.com*
  - goldenkrustbakery.com*
  - goldenkrustbakery.net*
  - goldenkrustfoundation.com*
  - goldenkrustfoundation.net*
  - goldenkrustfoundation.org.*
27. The Complainant's main website is available at <http://www.goldenkrust.com>. The Complainant's website has thousands of unique visitors per year.
28. The Complainant promotes its website as part of its marketing and advertising to the public and to prospective franchisees.
29. On October 31, 2016, the Complainant held a franchise opportunity seminar in Toronto, Ontario to give prospective new franchisees an overview of the Complainant's operations and opportunities, as well as to provide other information related to how the Complainant assists in the establishing of franchised locations.
30. This seminar was open to the public and members of the public attended. The success of the Complainant's business was part of the content of the seminar. Opportunities for business in Canada were also discussed.
31. The Complainant has not licensed or otherwise authorized the Registrant to register or use "GOLDEN KRUST" as a domain name or for any other purpose.

32. The webpage associated with the Domain Name has a link to Go Daddy's Domain Buy Service. Through this service, Go Daddy's personal domain brokers contact the current owner of a domain name to determine whether the owner is willing to sell the domain name to the prospective or interested buyer. The Complainant attempted to contact the Registrant and purchase the Domain Name through Go Daddy's Buy Service, but was not successful in purchasing the Domain Name.

### **The Position of the Parties**

#### **The Position of the Complainant**

33. The Complainant submits that the Domain Name is confusingly similar to the Golden Krust Mark in which the Complainant had rights prior to the registration of the Domain Name and continues to have such rights, and further that the Registrant has no legitimate interest in the Domain Name and that the Domain Name was registered in bad faith.

#### **The Domain Names are Confusingly Similar to a Mark in which the Complainant Has Rights**

34. "GOLDEN KRUST" is the predominant element in the Golden Krust Mark.
35. The Complainant and its customers refer to the Complainant as "Golden Krust."
36. The Domain Name is confusingly similar to the Complainant's Golden Krust Mark because the Domain Name is identical to the predominant element of the Golden Krust Mark in appearance and sound such that it is likely to be mistaken for the mark.
37. A person, as a matter of first impression, knowing the Complainant's Golden Krust Mark, and having an imperfect recollection, would likely mistake the Domain Name for the Golden Krust Mark.
38. The Domain Name consists only of "GOLDENKRUST" and merely adds ".ca" to the end. The addition of ".ca" in the Domain Name does not prevent it from being confusingly similar.

#### **Rights in the Mark Prior to the Domain Name Registration and Continuing Rights**

39. The Complainant registered the Golden Krust Mark with CIPO on January 22, 2009 and established its rights in the Golden Krust Mark by virtue of the Canadian registration. The Complainant had rights in the Golden Krust Mark prior to the date of registration of the Domain Name on November 16, 2016 and continues to have such rights.

#### **The Registrant Has No Legitimate Interest in the Domain Name**

40. The Registrant has no legitimate interest in the Domain Name for the following reasons:
- The Registrant does not have any rights in "GOLDEN KRUST" as a name or mark;
  - The Domain Name is not used in connection with the bona fide offerings of goods or services, and even if it were, the Domain Name is not descriptive of or the generic name for any goods or services;

- There is no reason to believe that the Registrant is commonly known as or goes by the name "Golden Krust" and there is no evidence to suggest that consumers or others associate the Registrant with the name "Golden Krust";
  - The Registrant's registration of the Domain Name was an attempt by the Registrant to capitalize on the goodwill attached to the Complainant's well-known Golden Krust Mark and names;
  - The Registrant is not making any legitimate non-commercial use of the Domain Name; and
  - The Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.
41. The Complainant owns the only mark registered on the Canadian trademark register that incorporates "GOLDEN KRUST". In contrast, the Registrant does not own any trademark registrations for "GOLDEN KRUST" for any goods or services.
42. As a result of the Complainant's long-term and continuous ownership and use of its marks, tradenames and domain names for or incorporating "GOLDEN KRUST" in connection with its business, the Complainant has built a strong reputation and significant good will in its marks and names. An objective bystander, including a person accessing the Domain Name, would naturally assume that the "GOLDEN KRUST" of the Domain Name was invoking, associated with, or licensed by the "GOLDEN KRUST" of the Golden Krust Mark, and therefore, by the Complainant.
43. The Complainant has never given the Registrant permission to use the Golden Krust Mark or names in any manner.
44. The Registrant has not used the Domain Name in any manner that would otherwise demonstrate any rights or legitimate interests in using the Domain Name.

#### **The Domain Name Was Registered in Bad Faith**

45. The Registrant's registration of the Domain Name was in bad faith for the following reasons:
- The Registrant's use of the Domain Name for a website with "Sponsored Listings" hyperlinks that direct to websites that offer goods and services that are directly competitive with Complainant;
  - The Registrant's use of the Domain Name to redirect Internet users to websites unrelated to the Complainant;
  - The Registrant's actual or constructive knowledge of the Golden Krust Mark, the Complainant's reputation and the Complainant's success in North America;
  - The Registrant's use of a confusingly similar Domain Name to draw on the Complainant's goodwill in the Golden Krust Mark for commercial gain; and

- The fact that the Registrant registered the Domain Name a few weeks after the presentation in Toronto, Canada by the Complainant to educate and inform prospective franchisees about opportunities available to them when licensed to use the Golden Krust Mark in Canada.

#### **The Position of the Registrant**

46. The Registrant did not file a Response.

#### **DISCUSSION AND FINDINGS**

47. To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

- 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
- The Registrant has registered the domain name in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

- The Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

#### **Confusingly Similar**

48. To succeed in meeting its onus under ¶14.1(a), the Complainant must show that it has rights in a mark and that the Domain Name is "Confusingly Similar" to that mark.

49. A "Mark" includes:

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.

50. Pursuant to ¶13.3 of the Policy, in determining whether the Domain Name is "Confusingly Similar" to a Mark, the Arbitrator shall only consider whether the Domain Name so nearly resembles the Mark in appearance, sound or ideas suggested by the Mark as to be likely to be mistaken for the Mark.

51. In *American Express Marketing and Development Corp v Nameshield Inc*, DCA-249-CIRA, the Panel held that the domain name was confusingly similar as it incorporated a well-known mark held by the complainant.

52. In *WhatsApp Inc v Hiba Alnatour*, DCA-1904-CIRA, the Panel held that the domain name, which consisted entirely of the complainant's mark excluding the dot-ca suffix was confusingly similar.

53. The Complainant is the registered owner of the "Golden Krust Mark" in Canada.

54. The Domain Name incorporates the distinctive portion of the Complainant's Golden Krust Mark.
55. An Internet user who has knowledge or recollection of the Golden Krust Mark might easily mistake the Domain Name as being somehow affiliated to or owned by the Complainant (see *Canadian Broadcasting Corporation/Société Radio-Canada v William Quon*, BCICAC Case No 00006).
56. Accordingly, the Complainant has established on a balance of probabilities that the Domain Name is "Confusingly Similar" to the Complainant's Golden Krust Mark.
57. The Registrant has failed to provide any evidence to rebut this conclusion.

#### **Rights in the Mark Prior to the Domain Name Registration and Continuing Rights**

58. The Complainant registered the Golden Krust Mark in Canada with CIPO on January 22, 2009. In addition, the evidence demonstrates that the Complainant has rights to the Golden Krust Mark, based on use and registration outside of Canada, which date back to the 1990s, years prior to the registration of the Domain Name. The Complainant continues to have such rights.
59. The Domain Name was registered on November 16, 2016.
60. I am satisfied that the Golden Krust Mark was registered before the registration of the Domain Name and accordingly the Complainant had rights in the Golden Krust Mark before the registration of the Domain Name. As the evidence demonstrates that the Complainant's rights remain in force, the Complainant continues to have such rights.

#### **Bad Faith Registration**

61. Pursuant to ¶3.5 of the Policy, any of the following circumstances will be evidence that a Registrant has registered a domain name in bad faith:
  - 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;
  - 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;
  - The Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or
  - 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.

62. The phrase "disrupting the business of the Complainant" is satisfied where the use of the domain name creates a likelihood of confusion among end users to affiliation or sponsorship, and includes trademark infringement and passing off (*Great Pacific Foods Industries Inc v Ghalib v Dhalla*, Case No 0009 at 20-21).
63. The evidence demonstrates that the Complainant's mark is well known in North America, and as such, at the time of the Registration of the Disputed Domain Name, the Registrant knew, or should have known, of the existence of the Golden Krust Mark.
64. The Registrant's use of the Domain Name with a website featuring links to websites offering products in competition with the Complainant constitutes "disrupting" the Complainant's business in the form of classic trademark or trade name confusion (*Standard Life Assurance Company of Canada*, Case No 00046).
65. There is no evidence to suggest that the Registrant is itself a direct business competitor of the Complainant – i.e., the Registrant is not in the business of selling the products and providing the services that the Complainant provides.
66. I find that the Complainant has established, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith.
67. The Registrant has failed to provide any evidence to rebut this conclusion.

#### **No Legitimate Interest in Domain Name**

68. Pursuant to ¶3.4 of the Policy, any of the following circumstances will demonstrate that the Registrant has a legitimate interest in a domain name:
  - The domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
  - The Registrant registered 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;
  - The Registrant registered 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;
  - 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;



- 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
- The domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In (d), "use" by the Registrants includes, but is not limited to, use to identify a website.

69. The Complainant has provided some evidence to show that the Registrant has no legitimate interest in the Domain Name:

- There has never been any business relationship between the Complainant and the Registrant;
- The Complainant does not sponsor the Registrant's website, nor has it authorized the use of its mark on the Registrant's website;
- The Registrant's use of the "GOLDEN KRUST" mark has not been for the purpose of distinguishing the Registrant's business or products;
- The "GOLDEN KRUST" name is not generic;
- The Registrant has not used the "GOLDEN KRUST" name for non-commercial activity;
- The "GOLDEN KRUST" name is not a reference by which the Registrant is commonly known; and
- The "GOLDEN KRUST" name is not a geographical name of the location of the Registrant's non-commercial activity or its place of business.

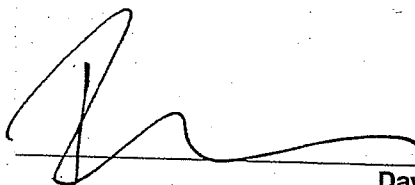
70. I am satisfied that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

71. The Registrant has failed to provide any evidence to rebut this conclusion or submit a response that it has a legitimate interest in the Domain Name.

**ORDER**

72. I have concluded that the Complainant has met the requirements of ¶4.1 of the Policy.
73. Accordingly, and pursuant to ¶4.3 of the Policy, I order that the registration of the domain name *goldenkrust.ca* be transferred to the Complainant by the Registrar, Go Daddy Domains Canada, Inc.

Dated: January 8, 2019



**David Wotherspoon**  
Sole Arbitrator