

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

Complainant: **Birkenstock Sales GmbH**
Complainant's counsel: David Lipkus, Kestenberg Siegal Lipkus LLP
Registrant: **Vytas Klimavicius/Litamber Media Corporation**
Panel: Barry C. Effler
Service Provider: British Columbia International Commercial Arbitration Centre
BCICAC File Number: 2246-CIRA

DECISION

The Parties, Domain Names and Registrar

1. The Complainant is Birkenstock Sales GmbH.
2. The Registrant is Vytas Klimavicius.
3. The Domain Name at issue is birkenstock.ca.
4. The Registrar is 1770820 Ontario Corp. o/a domainnameca.ca
5. The Domain Name was registered by the Registrant on June 3, 2020.

Procedural History

6. The procedural history of this matter was set out in a letter from the British Columbia International Commercial Arbitration Centre to the Panel herein dated July 28, 2020:

1. On June 30, 2020 the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules. Information regarding the identity of the Registrant was not available to the Complainant and; therefore, was not included in the Complaint.
2. On June 30, 2020, CIRA was notified of this proceeding. CIRA confirmed to BCICAC that the disputed domain was placed on a Registrar LOCK, and reported the identity of the Registrant.
3. In a letter dated July 2, 2020, the Centre, confirmed compliance of the Complaint and commencement of the dispute resolution process.
4. As the Complaint with the attachments was filed exclusively online, therefore, the Centre delivered the Complaint to the Registrant only by email to the address provided by CIRA (confirmation of the delivery attached).
5. 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 1.5.

6. 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.

7. The Centre hereby appoints you, Barry C. Effler, as a single-member Panel in the above- referenced matter

7. As required by 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 which would prevent me from so acting.
8. I am not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13.2 of the Rules, to a need to stay or terminate the progress of this proceeding.

Eligibility of Complainant

9. I have reviewed the material submitted by the Complainant and am satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy. It is the owner of a registered Canadian trade-mark in which the distinguishing word component of such trade-mark is within the Domain Name in dispute.

Relief Requested

10. The Complainant requests that the Domain Name be transferred from the Registrant to the Complainant.

Applicable Law

11. 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

12. Background facts alleged by the Complainant and accepted by me as probative are summarized here from the Complaint:

The Complainant is the owner of the following Canadian trademark registrations, TMA607059 registered 2004-04-06 and TMA1057692 registered 2019-10-07, both for the word “birkenstock” for numerous goods including footwear. Use was claimed as early as 1958 in trademarks.

The domain name, <birkenstock.ca>, resolves to an operational website that advertises BIRKENSTOCK goods for sale, through the third-party marketplace Amazon.ca, related products for sale on Amazon, YouTube Videos, social media links, care instructions and company history. Additionally, third-party products manufactured by companies other than the Complainant are being sold through the affiliated links on the Domain Name’s website.

The website also features various social media links, including but not limited to a link to the official, verified BIRKENSTOCK Pinterest Merchant page and therewith giving the impression to be the official store in Canada:

Discussion and Findings

13. 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.

14. 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; ...*

15. The Complainant is the owner of a registered Canadian trade-mark in which the exact word component is included within the Domain Name. The Complainant established that it has rights in a trade-mark that was a “Mark” prior to the date on which the Domain Name was registered. The Birkenstock trade-marks were all registered earlier than the June 3, 2020 date of registration of the Domain Name.
16. 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 Birkenstock branded footwear in Canada since as early as 1958. The Complainant therefore meets this requirement.
17. I am satisfied that the Domain Name is confusingly similar to the Complainant’s Mark. The relevant word “Birkenstock” in the Domain Name is the same word as in the Mark.

18. I am satisfied that the Complainant has established bad faith by the Registrant for the purposes of paragraphs 4.1 of the Policy by showing circumstances meeting paragraph 3.5 (d) of the Policy.

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.

The Complainant's evidence contained screen shots of the website birkenstock.ca. it clearly shows birkenstock branded products being sold for commercial gain by competitors of the Complainant.

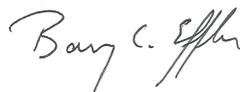
19. The use of the word "Birkenstock" on the Registrant's commercial website meets the circumstances outlined for bad faith in paragraph 3.5 (d) of the Policy. The Registrant has no business relationship with the Complainant and the Registrant's website is clearly attempting to profit from an implication that it is a website of the Complainant or an authorized dealer.
20. 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 Name.

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

Order

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

Dated: August 15, 2020

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

Barry C. Effler, LL.B., LL.M., C. Arb. (Fellow)
Sole Panellist