

**IN THE MATTER OF A COMPLAINT PURSUANT TO
THE CANADIAN INTERNET REGISTRATION AUTHORITY (“CIRA”)
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DISPUTE NUMBER:	BCICAC FILE: 2251-CIRA
COMPLAINANT:	BROOKS SPORTS, INC.
REGISTRANT:	CARY HOGAN
DISPUTED DOMAIN NAME(S)	BrooksCanada.ca (“Disputed Domain Name”)
REGISTRAR:	GO GET CANADA DOMAIN REGISTRAR LTD.
SERVICE PROVIDER:	BRITISH COLUMBIA INTERNATIONAL COMMERCIAL ARBITRATION CENTRE (“Provider”)
PANEL:	LESLIE E. MAEROV, FCI Arb., Q. Arb.

Decision Date: August 13, 2020

THE PARTIES:

1. The Complainant is Brooks Sports, Inc., a company with its global headquarters in Seattle, Washington, United States of America, and is represented by Clark Wilson LLP, of Vancouver, Canada. The Registrant is Cary Hogan, of Toronto, ON, who has not responded to the Complaint and is not represented.

THE DISPUTED DOMAIN NAME AND REGISTRAR:

2. The Disputed Domain Name in issue is “BrooksCanada.ca” which was registered on April 16, 2020, and expires April 16, 2021. The Registrar is Go Get Canada Domain Registrar Ltd.

PROCEDURAL HISTORY:

3. This complaint (“Complaint”) was filed with the Provider as recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“Policy”), in accordance with the CIRA Dispute Resolution Rules (“Resolution Rules”) on June 30, 2020. The Complaint was determined to be in administrative compliance with the Resolution Rules and this proceeding was deemed commenced on July 8, 2020.

4. The Registrant's identity is not published in the public WHOIS database, and within the time limited by Rule 4.3 of the Resolution Rules, on June 30, 2020, the Provider sent a request for registrar verification to the Registrar to determine the identity, including the mailing address and contact email of the Registrant, together with a request that the domain name be put on a Registrar lock. On July 1, 2020, the Registrar confirmed the identity of the Registrant and his mailing address and contact email, and confirmed that the disputed domain name was placed on a Registrar lock.

5. Pursuant to Rule 4.4 of the Resolution Rules, on July 8, 2020, the Provider notified the Registrant at the email address for the administrative contact of record in the Registrant Information at cary.hogan@hotmail.com and also at postmaster@brookscanada.ca of the commencement of this proceeding, and advised the Parties of the name and contact details of the Administrator. On July 8, 2020, the Provider gave notice to the Registrant that he was required to respond to the Complaint not later than July 28, 2020, in accordance with the Policy and Resolution Rules.

6. The Registrant has not responded to the Complaint within the time limited, and the Complainant elected under Rule 6.5 to convert to a single member panel. Prior to my appointment I submitted a Statement of Independence and Impartiality to the Provider, declaring that there are no circumstances that would give rise to justifiable doubts as to my independence and impartiality, as required by the Resolution Rules. On July 31, 2020, after clearing for any potential conflicts, the Provider appointed me as a single member Panel.

7. When the Registrant does not respond to the Complaint, the Panel is required to decide the proceeding for the resolution of this dispute on the basis of the Complaint.

JURISDICTION:

8. By obtaining registration of a domain name in the dot-ca country code top level domain name registry operated by CIRA, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and Resolution Rules. This is an administrative proceeding pursuant to the Policy and Resolution Rules.

9. In order to bring a proceeding under the Policy, a complainant must satisfy the Canadian Presence Requirements for Registrants contained in CIRA Policies, Rules and Procedures, which require that the applicant must meet at least one of the listed requirements.

10. The Complainant satisfies one of those requirements by being the owner of a trademark which is the subject of a registration at the Canadian Intellectual Property Office (“CIPO”) under the *Trademarks Act* (Canada), R.S.C. 1985, c. T-13. Satisfaction of this requirement limits permission to register a dot-ca domain name consisting of or including the exact word component of that registered trademark. The Complainant is the owner of the following trademarks (“Brooks Marks”):

Trademark	Registration No.	Registration Date	Expiry Date	Goods
BROOKS	TMA303228	May 31, 1985	May 31, 2030	Athletic footwear, namely, boots, shoes, laces and insoles.
	TMA290452	May 4, 1984	May 4, 2029	Athletic shoes.
	TMA839329	January 7, 2013	January 7, 2028	Athletic bags, gym bags, fanny packs, backpacks, water holsters, athletic footwear.
	TMA966636	March 24, 2017	March 24, 2032	Footwear, namely, athletic footwear; athletic clothing, namely, shirts; athletic headgear, namely, hats, and caps. Athletic clothing, namely, shirts, pants, jackets, hats, caps, shorts, tights and hosiery, and athletic footwear

11. By being the owner of registered Canadian trademarks and satisfying the Canadian Presence Requirements for Registrants, the Complainant is therefore an eligible complainant.

FACTUAL BACKGROUND:

Background facts as submitted by the Claimant, and accepted by me as probative are summarized as follows:

12. The Complainant has been engaged in the sale of goods in association with one or more of the Brooks Marks since as early as 1973 in Canada. The Complainant was originally founded in 1914, with its headquarters in Seattle, WA, and throughout its history has produced and sold a variety of athletic shoes and apparel. It sells a variety of performance running shoes, trail shoes, casual shoes, vintage shoes and athletic apparel in Canada.

13. Sale of Brooks branded footwear products in association with the Brooks Marks from 2011 to 2018 were in excess of 1 million units having a value of tens of millions of dollars. Sales of Brooks branded apparel during the same period were roughly the same number of units having a value in excess of \$10 million. As a result the Complainant enjoys a substantial reputation through the Brooks Marks in association with footwear and apparel goods, and significant goodwill is attached to the Brooks Marks.

14. The Disputed Domain Name "BrooksCanada.ca" was first registered on April 16, 2020, and expires on April 16, 2021. It resolves to an active website that advertises what appear to be Brooks branded goods. It is unclear whether these are legitimate Brooks goods obtained from Brooks or an authorized reseller of Brooks goods, or counterfeit goods.

15. As set out below, the Complainant alleges that the Registrant is a competitor to the Complainant and has registered the Disputed Domain Name for the purpose of disrupting the business of the Complainant, and that it is posing as the Complainant in an attempt to secure payment and sales which ought to have been directed to the Complainant. The Complainant does not allege that counterfeit goods are being sold on the website operated by the Registrant, but whether or not that is the case is not germane to the resolution of the Complaint.

16. The Registrar redirects users to a website selling goods bearing the Brooks Marks. The Complainant has submitted evidence that the website to which the Disputed Domain Name resolves sells goods using the Brooks Marks without authorization.

RELIEF REQUESTED:

17. The Complainant requests that the ownership of the Disputed Domain Name be transferred to the Complainant immediately.

APPLICABLE LAW:

18. As directed by Rule 12.1, my decision is made on the basis of the evidence and argument submitted, in accordance with the Policy, the Resolution Rules and any rules and principles of the laws of Ontario, Canada. The Complainant has indicated a preference that the laws of British Columbia be applied to this Complaint, but Rule 12.1 provides that unless both parties indicate the same preference, that the decision must be rendered on the basis of the laws of Ontario. The Respondent, not having responded to this Complaint, has not indicated a preference of the applicable law.

DISCUSSION & ANALYSIS:

19. In order to succeed in this proceeding, the Complainant is required to prove two things on a balance of probabilities, which are that:

- (a) The Disputed Domain Name is Confusingly Similar to the Complainant's Mark in which the Complainant had rights prior to the date of registration of the Disputed Domain Name, and continues to have such rights, as set out in par. 3.1(a) of the Policy; and
- (b) The Registrant has registered the Disputed Domain Name in bad faith, as described in par. 3.5 of the Policy.

(a) Is the Disputed Domain Name Confusingly Similar to the Complainant's Marks?

20. To be confusingly similar, the Disputed Domain Name must so nearly resemble the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark. A Mark is defined in s.3.2 of the Policy as, in part: a trademark, including the word elements of a design mark, that has been used in Canada by a person, for the purpose of distinguishing the wares, services or business of that person from the wares, services or business of another person. The Complainant has established that, as the owner of the Brooks Marks, and by providing evidence that it markets its wares on its web site visible in Canada using the Brooks Marks, it is the owner of a trademark that has been used in Canada for the purpose of distinguishing its wares from the wares of another person.

21. The Complainant must have had rights in the Mark prior to the date of registration of the Disputed Domain Name and continue to have such rights. The Complainant satisfies this requirement by way of its ownership rights to the Brooks Marks and having used those Marks in Canada for the purpose of distinguishing its wares from the wares of another person. The Complainant's rights to the trademark significantly preceded the registration of the Disputed Domain Name, as the Brooks Marks have been used in Canada as early as 1973, and the first of its Marks was registered as a trademark in 1984, and the others were registered between 1984 and 2017, while the Disputed Domain Name was not registered until April 16, 2020. Those Marks continue to be valid and in effect at least until their present expiry dates.

22. Pursuant to par. 1.2 of the Policy, the Disputed Domain Name means the domain name excluding the dot-ca suffix.

23. Where a domain name wholly incorporates a Complainant's registered Mark, this is sufficient to establish identity or confusing similarity for the purposes of the Policy: *Nikon Inc. v. Technilab, Inc.* Case D2000-1774 (WIPO) March 7, 2001. Identity or near identity to the Complainant's mark will always be sufficient to find that a domain name is confusingly similar to a complainant's mark: *Sleep Country Canada Inc. v. Pilfold Ventures Inc.* Case 00027 (CIRA) March 14, 2005. Since the Disputed Domain Name contains the exact wording of the Brooks Marks, namely the use of the word "brooks", there could be no doubt that it is confusingly similar to the Brooks Marks. An Internet user who has knowledge or recollection of the Mark might easily mistake the Disputed Domain Name as being somehow affiliated with or owned by the Complainant.

24. Including the word "canada" in the Disputed Domain Name does not differentiate it from the Brooks Marks. Incorporation of a trademark in its entirety together with other descriptive or non-distinctive words is not sufficient to differentiate the domain name from a Mark, nor will it prevent a domain name from being held to be confusingly similar to a complainant's Mark: *Quixstar Investments, Inc. v. Hoffman* Case No. D2000-0253 (WIPO) May 29, 2000. Further, the addition of the word "canada" enhances the likelihood of confusion because the Registrant sells goods in which the Complainant has acquired a substantial reputation as the result of its extensive use of the Brooks Marks in Canada.

25. Further, the footer of the Registrant's website contains a copyright notice indicating that "Brooks Canada" is the copyright holder. It further states that it is "Powered by Brooks

Canada”. This is a clear indication of the Registrant’s intention that users of the site be misled into thinking that the site is legitimately associated with the owner of the Brooks Marks.

26. In conclusion, by incorporating the whole of the Complainant’s well known, widely used and publicized Mark, the Disputed Domain Name is likely to lead persons visiting the website to conclude that it is associated with the Complainant, and it is therefore confusingly similar to the Complainant’s Marks.

(b) Has the Registrant registered the Disputed Domain Name in bad faith?

27. Evidence of any of the non-exhaustive circumstances described in par. 3.5 of the Policy is evidence that a Registrant has registered a domain name in bad faith. The Complainant may satisfy this requirement by establishing that the Registrant has registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant as set out in par. 3.5(c) of the Policy. The Complainant submits that this ground is satisfied where a registrant’s intention to damage a complainant’s business can be inferred by it directing potential clients away from the complainant’s website to itself - thereby, in practice, setting itself up as a competitor of the complainant: *GNLV, Corp. v Cyber Media Inc.*, Case 00296 (CIRA) August 30, 2015, at para. 26.

28. The content of the Registrant’s Website clearly shows that it is posing as the Complainant in an attempt to divert payments and sales which would have been sent to the Complainant by a person seeking the Complainant’s goods. By diverting sales away from the Complainant through the unauthorized use of the Brooks Marks, the Registrant has set itself up as a competitor of the Complainant and has disrupted the Complainant’s business.

29. The Complainant may also satisfy this requirement by providing evidence that 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.

30. A cursory review of the Registrant’s website to which the Disputed Domain Name resolves that was introduced into evidence by the Complainant clearly shows that the

Registrant has passed itself off as Brooks, in an attempt to attract consumers to its website for commercial gain. The Complainant's Marks are prominently displayed on the Registrant's website and on products offered for sale on the website. The text and graphics included in the Registrant's website is clearly intended to give rise to a consumer's mistaken impression that the website, and the goods sold offered for sale on this website, are sold by or affiliated with the Complainant when that is not the case. There is no indication that the goods being sold are affiliated with any other party except Brooks.

31. The only reasonable inference to be drawn from the registration of a domain name that incorporates the whole of the Complainant's well known, widely used and publicized Mark, in the absence of an explanation from the Registrant, is that it was done to disrupt the business of the Complainant by directing Internet users seeking the goods of the Complainant to its competitor. These facts are sufficient to demonstrate the Registrant's bad faith: *Capital One Financial Corp. v Burns*, Case 0329 (CIRA) December 14, 2016.

32. Numerous other decisions have held that bad faith exists under this paragraph where the Registrant passes itself off as the owner of the trademarks associated with its website: See for example, *GNLV, Corp. v Cyber Media Inc. supra*.

33. Finally, the Registrant is deemed to have known of the Brooks Marks by virtue of their public registration at the CIPO, and as the Disputed Domain Name was registered many years after the Complainant acquired rights to the Brooks Marks in Canada, the registration of the Disputed Domain Name must be considered to have been made in bad faith.

34. The evidence before me indicates that the Complainant has no relationship or association with the Registrant, and that the Registrant is not an authorized retailer of Brooks branded products that derive from the Complainant. The Registrant did not register the Disputed Domain Name with the consent or approval of the Complainant and the Registrant has not been licensed or otherwise permitted to use any of the Brooks Marks within the Disputed Domain Name or the website to which it resolves. The Registrant has no business relationship with the Complainant and the Registrant's website is clearly attempting to divert unsuspecting customers looking for authentic Brooks branded goods to the unauthorized website offering goods featuring trademarks identical to or confusingly similar to the Claimant's, and to profit from an implication that it is a website of the Complainant or an authorized dealer. There is no evidence that the

Disputed Domain Name was used for any legitimate non-commercial or fair use.

35. I find that the use of the Mark “BROOKS” in the Registrant’s domain name and on the Registrant’s commercial website meets the circumstances outlined for bad faith.

36. In addition, to be successful in this proceeding, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

37. Par. 3.4 of the Policy identifies 6 non-exhaustive circumstances that, if proved, demonstrate that the Registrant has a legitimate interest in a domain name. There is no evidence before me that indicates that the Registrant satisfies any of those circumstances, nor is there any other evidence that would indicate that the Registrant has any legitimate interest in the Disputed Domain Name. To the contrary, the Complainant has provided evidence that it is the sole owner of the Brooks Marks, and submits that it has not authorized the use of those Marks to the Registrant, nor has it authorized the use of the word “Brooks” to the Registrant for use in the Disputed Domain Name. The activity that supports a finding of registration in bad faith cannot at the same time reflect a legitimate interest on the part of the Registrant.

38. The evidence is that the use in Canada of the Disputed Domain Name by the Registrant is in association with the advertising and sale of goods in competition with the legitimate owner of the Brooks Marks without proper authority.

39. Accordingly I find that the Complainant has satisfied the requirement that the Registrant has no legitimate interest in the Disputed Domain Name.

DECISION AND ORDER:

40. For the reasons set out in this decision, I have found that the Complainant has satisfied all the requirements under the Policy in order to be successful in this proceeding. As previously indicated, the Complainant is in compliance with the Canadian Presence Requirements for Registrants contained in CIRA Policies, Rules and Procedures which would allow it to be the registrant of a dot-ca domain name containing the exact words of the Brooks Marks.

41. I order that the Disputed Domain Name “BrooksCanada.ca” be transferred to the Complainant immediately.

A handwritten signature in blue ink, appearing to read "Leslie Maerov".

LESLIE E. MAEROV
Single member panel
August 13, 2020