Decision for dispute CAC-UDRP-106156

Case number	CAC-UDRP-106156
Time of filing	2024-01-23 08:05:45
Domain names	baffincanada.com, baffinsalecanada.com, baffinbootscanada.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Baffin Ltd.

Complainant representative

Organization	Coöperatie SNB-REACT U.A.

Respondent

Organization	Web Commerce Communications Limited

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following:

Canadian registered trademark BAFFIN registered on November 10, 1989 for goods in class 25;

Canadian registered trademark BAFFIN & Design registered on September 30, 2004 for goods in classes 9, 25, and 26.

FACTUAL BACKGROUND

In addition to its rights in its Canadian registered trademarks described above, the Complainant has an established Internet presence and maintains its website at www.baffin.com.

Each of the disputed domain names was registered on June 6, 2022, and each of the registrations was updated on May 25, 2023.

The disputed domain names <baffincanada.com> and <baffinsalecanada.com> each resolve to identical websites that purport to offer Complainants BAFFIN-branded goods for sale to the public; and the disputed domain name <baffinbootscanada.com> is inactive and passively held.

There is no information available about the Respondent except for that provided in the Complaint, the Registrar's WhoIs and the information provided by the Registrar verifying that the Respondent is the registrant of the disputed domain names.

PARTIES CONTENTIONS

The Complainant

The Complainant claims rights in the BAFFIN trademark established by its ownership of the Canadian trademark registrations described above and use of the mark in its business as a manufacturer and merchant of footwear and apparel.

The Complainant alleges that the disputed domain names are confusingly similar to the BAFFIN mark in which it has rights because each of them incorporates the Complainant's trademark in its entirety.

The Complainant adds that the additional geographical term "Canada" and the descriptive terms "sale" and "boots", do not affect the confusing similarity, arguing that it is established that where the relevant trademark is recognizable within the domain name at issue, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

It is further contended that since Complainant is based in Canada, and its primary product line consists of boots, the particular additional terms added in this case only increase the confusing similarity.

The Complainant adds that the generic Top-Level Domain ("gTLD") extension <.com>, which is a technical requirement, should generally be disregarded for the purpose of the analysis of confusing similarity.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain names, arguing that there is no evidence or WhoIs information on record showing that the Respondent might be commonly known by the respective disputed domain names.

The Complainant avers that a trademark search at the Canadian Trademarks Database, has shown that the Respondent has not acquired any prior trademark or service mark rights.

Furthermore, the Complaint asserts that it has no relationship whatsoever with the Respondent, and in particular has never licensed or otherwise authorized the Respondent to use the BAFFIN trademarks on websites or in the disputed domain names.

It is further contended that the Complainant has exclusive trademark rights which predate the registration of the disputed domain names by several decades.

In this regard the Complainant submits that the disputed domain names were registered in July 2022, and the earlier of the Complainant's BAFFIN trademark registrations, dates back to 1989.

It is argued that in the absence of a license or permission from the Complainant concerning the use of its trademarks, no actual or contemplated bona fide or legitimate use of the disputed domain names can reasonably be claimed.

Referring to screen captures of elements of the websites to which two of the disputed domain names resolve, namely <baffincanada.com> and <baffinsalecanada.com>, which are exhibited in an annex to the Complaint, the Complainant alleges that rather than using the two resolving domain names for any bona fide offering of goods, the Respondent has sought use them to impersonate the Complainant for commercial gain.

The exhibited screen captures show that two of the disputed domain names, namely <baffincanada.com> and <baffinsalecanada.com> resolve to websites which essentially copy the look and feel, as well as elements of the content of the Complainant's official website at www.baffin.com.

Specifically, the Respondent has placed the exact same 'favicon' (favicon.ico image) on its infringing websites as on the Complainant's official website; both the infringing websites and the Complainant's official website the header contain a black bar where free T for orders over a certain amount of Canadian dollars is advertised, followed by a white bar displaying Complainant's BAFFIN & Design mark with maple leaf logo on the left; below the header, a large graphic is displayed, followed directly by images of the Complainant's line of snow boots and other cold-climate shoes.

Also, in the footer of the Respondent's websites, the newsletter section of Complainant's website is blatantly copied, and a false and misleading copyright notice is placed, which again includes a reference to Complainant or its trademarks,

Additionally, the Complainant complains that the Respondent's websites confusingly state that they are 'powered by' themselves i.e. contain statements: "Copyright © 2024 baffincanada Powered By baffincanada.com" and "Copyright © 2024 baffinsalecanada Powered By baffinsalecanada.com".

The Complainant submits that therefore Respondent is falsely stating it owns the copyright in either the design of the website and/or the products offered thereon; and argues that according to the WIPO Overview 3.0 at 2.13.1 panels established under the Policy have categorically held that the use of a domain name for illegal activity (e.g., (...) impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. See Tommy Hilfiger Licensing B.V. v. Client Care (Web

Commerce Communications Limited) CAC 105810 (<tommyhilflgercanadaca.com> and 83 other domain names): "Impersonation is not fair and as such does not create any rights or legitimate interests."

The Complainant adds that these websites can be described as 'counterfeit websites' which does not qualify as a bona fide offering of goods, and means that the Respondent has no rights or legitimate interests in respect of the disputed domain names. See Karhu Holding B.V. v. Web Commerce Communications Limited CAC Case 105713) "such use cannot be qualified as a bona fide offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such use is likely to mislead Internet users.". See also Karhu Holding B.V. v. Web Commerce Communications Limited CAC Case 105517, taking into account the misleading copyright disclaimer, concluded that "the Panel cannot imagine any possible legitimate justification for this use".

The Complainant further complains that every single product advertised on the Respondent's websites is advertised with a discount, often around 50%.

The Complainant next alleges that each of the disputed domain names has been registered and is being used in bad faith arguing that the content of the active websites to which two of the disputed domain names direct, clearly demonstrates that the Respondent has sought to impersonate and pass itself off as Complainant or one of its local outlets.

It is contended that that the Respondent must have been fully aware of the Complainant, its trademarks, and business activities, arguing that in addition to the incorporation of Complainant's trademarks into the disputed domain names, two of the websites associated with the disputed domain names are essentially copies of the Complainant's own website and include its visual mark in the header and 'favicon'; furthermore the use of the term "canada" reinforces the impression that the disputed domain names are connected to the Complainant's website, as Complainant was founded and is established in Canada.

The Complainant adds that it follows that the Respondent registered the disputed domain names to attract Internet users by deliberately causing confusion in their minds by creating a false impression of affiliation or connection with the Complainant, and so obtain a commercial gain. Such an activity cannot be understood as being in good faith.

The Complainant also argues that registration of a domain name for impersonation purposes constitutes registration and use in bad faith. See Liu.Jo S.p.A v. Web Commerce Communications Limited CAC Case 105699 where the Panel considered that "the Respondents' conduct of using the disputed domain names to publish a page that reproduces the "look and feel" of the Complaint's official website and reproducing its logos and trademarks are clear evidence of both registration and use in bad faith."

Complainant concludes arguing that by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site or of a product or service on its web site.

The Respondent

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Complainant has provided uncontested evidence that it has rights in the BAFFIN mark, established by its ownership of its Canadian registered trademarks upon which it relies as described above and the goodwill and reputation that it has established in the mark through long and extensive use, including on its website at www.baffin.com in its business as a manufacturer and merchant of apparel and footwear.

The Complainant's mark BAFFIN mark is contained in its entirety, and is the dominant and only distinctive element in each of the disputed domain names. The addition of the placename to Canada contributes no distinguishing character to any of the disputed domain names and nor does it prevent a finding of confusing similarity in respect of any of them, particularly because the Complainant is established in Canada.

Similarly, the words "sale" and "boots", in <baffinsalecanada.com> and <baffinbootscanada.com> respectively, add no distinguishing character.

Furthermore, the gTLD extension <.com> would be considered by Internet users as a necessary technical requirement for an Internet domain name and therefore does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's BAFFIN mark.

This Panel finds therefore that in each case the disputed domain names are confusingly similar to the BAFFIN mark in which the Complainant has rights and the Complainant has therefore succeeded in the first element of the test in Policy paragraph4(a)(i).

In its Complaint, the Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain names as set out in the Complainant's detailed submissions above.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph4(a)(ii).

The Complainant has adduced uncontested evidence of its registered trademark rights in the BAFFIN trademark, dating back to the earlier of the registrations it relies upon on November 10, 1989 and it has further made out a prima facie case that it has established a reputation for its BAFFIN mark and the goods to which it applies the mark by reason of extensive marketing including through its established Internet presence on its website at www.baffin.com.

The disputed domain names were each registered on June 6, 2022 and each of the registrations was updated on May 25, 2023, which further confirms that they are each in the control of the same entity, namely the Respondent.

Two of the disputed domain names <baffincanada.com> and <baffinsalecanada.com> each resolve to identical websites that purport to offer the Complainants BAFFIN-branded goods for sale to the public; and the other disputed domain name <baffinbootscanada.com> is inactive and passively held.

BAFFIN is a distinctive mark. The Complainant is based in Canada and is a manufacturer and merchant of apparel including footwear. So, it follows that the combination of the geographical place name Canada, and the generic words "sale" and "boots" with the Complainant's mark in the disputed domain names are an intentional reference to the Complainant, its marks and its products.

This Panel finds therefore that on the balance of probabilities the disputed domain names were each registered by the same person.

Furthermore, this Panel finds that the evidence proves on the balance of probabilities that each of the disputed domain names was registered in bad faith with the Complainant's mark in mind, with the intention of taking predatory advantage of the goodwill in the Complainant's mark to attract Internet traffic.

The uncontested evidence is that two of the disputed domain names each resolve to an almost identical website which presents itself as being that of Complainant. The Complainant has exhibited elements of the content of its own website at www.baffin.com and the content of the Respondents websites at www.baffincanada.com and www.baffinsalecanada.com. The exhibited content shows that Respondent's websites are using the Complainant's trademark and images of the Complainant's footwear to impersonate the look and feel of the Complainant's website and to impersonate the Complainant.

Given that all of the disputed domain names were registered on the same date, that two of the disputed domain names are being used to impersonate the Complainant, and each of the three disputed domain names are held by the same registrant, on the balance of probabilities, the disputed domain names are being used in bad faith. The registration and passive holding of the disputed domain name <baffinbootscanada.com> constitutes registration and bad use for the purposes of the Policy.

As this Panel has found that the each of the disputed domain names was registered and is being used in bad faith, the Complainant has therefore succeeded in the third element of the test in Policy paragraph 4(a)(iii) in respect of each registration in issue.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **baffincanada.com**: Transferred
2. **baffinsalecanada.com**: Transferred
3. **baffinbootscanada.com**: Transferred

PANELLISTS

Name	**James Bridgeman**

DATE OF PANEL DECISION 2024-02-21

Publish the Decision