

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

Complainant: Chicago Bar Company LLC.
Registrant: CK Kamateros
Panel: Barry C. Effler (Chair), Claude Freeman, Melvyn J. Simburg
Service Provider: British Columbia International Commercial Arbitration Centre
BCICAC File Number: DCA-1997-CIRA

DECISION

The Parties, Domain Names and Registrar

1. The Complainant is Chicago Bar Company LLC.
2. The Registrant is CK Kamateros.
3. The Domain Name at issue in this dispute is rxbar.ca.
4. The Registrar is (10 dollar.ca) 10 Dollar Domain Names Inc.
5. The Registrant registered the Domain Name on June 1, 2017.

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 August 8, 2018:

The British Columbia International Commercial Arbitration Centre (BCICAC) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (CDRP) of the Canadian Internet Registration Authority (CIRA).

1. The above named Complainant has filed a Complaint with respect to the above-referenced domain name(s) in accordance with the CDRP on July 10, 2018.
2. The Complaint was reviewed and found to be compliant. By letter and email dated July 10, 2018, BCICAC so advised the parties and forwarded a copy of the Complaint to the Registrant.
3. As the Complaint with the attachments was filed exclusively online; therefore, BCICAC delivered the Complaint to the Registrant only by email.
4. 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.

5. The Registrant submitted its Response to the Centre on July 27th, 2018. The Response was not in compliance with the required format. The Registrant resubmitted its Response on July 31, 2018.

6. The Registrant's Response was delivered to the Complainant on August 1, 2018.

7. The Complaint and the Responses were filed in English, which shall be the language of the proceeding.

8. In accordance with Paragraph 6 of the Rules, the Provider shall appoint a three-member Panel, with consideration to the nominees of the parties, and select a Chair. BCICAC names Claude Freeman, LL.M. (ADR), C. Med., C. Arb. and Melvyn J. Simburg as panelists. Barry C. Effler, LL.B., LL.M., C.Arb. Fellow is named as Chair of the Panel.

7. Following review of the Complaint and the Response, the Panel requested that the Complainant respond to the Response. The Complainant was given until September 7, 2018 to file such reply. The date for issuing a decision in this matter was extended by the Panel to the earlier of September 28, 2018 or 21 days following receipt of the Reply.
8. A Reply was filed by the Complainant on September 7, 2018. The Respondent filed a further short Reply to the Reply which the Panel elected to receive as evidence in this matter.
9. As required by paragraph 7.1 of the Rules, each Panellist has declared to BCICAC that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.
10. The Panel is 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

11. The Panel has reviewed the material submitted by the Complainant and is satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy, because it meets the Canadian Presence Requirements as the owner of registered Canadian trademark Reg. No. TMA928625, further details of which will be set out below.

Relief Requested

12. The Complainant requests that the Domain Name rxbar.ca be transferred from the Registrant to the Complainant.

Applicable Law

13. As directed by paragraph 12.1 of the Rules, the Panel will render its decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

Facts

14. Background facts alleged by the Complainant and accepted by the Panel as probative are quoted here from the Complaint:

Complainant Chicago Bar Company LLC (“Chicago Bar”) owns numerous trademark registrations across the world, including Canada, the United States, Australia and the European Union. Complainant’s RXBAR trademark is world-famous, and Complainant has spent a considerable amount of time and money protecting its intellectual property rights, including the RXBAR trademark. Complainant is the sole owner of the trademark relevant to this case, RXBAR, at the Canadian Intellectual Property Office (CIPO), the U.S. Patent and Trademark Office (USPTO), Australian Intellectual Property Office (AUIPO) and the European Union’s Intellectual Property Office (EUIPO). Attached hereto as **Annex 1** are trademark registrations and records of the RXBAR trademark at these trademark offices (copied below, in part, for convenience):

RXBAR for GOODS: (class 29) Fruit- and nut-based food bars; high protein food bars (CA Reg. No. TMA928625, Filing Date: December 2, 2014, Registration Date: February 10, 2016);

RXBAR for GOODS: (class 29) Processed fruit- and nut-based food bars (US Reg. No. 4478942, Filing Date: December 5, 2012, Registration Date: February 4, 2014);

RXBAR for GOODS: (class 5) Nutritional and dietary supplements formed and packaged as bars; nutritional supplements; dietary supplements; fruit-based meal replacement bars for boosting energy; (class 29) Processed fruit- and nut-based food bars; dried fruit products, fruit-based snack foods; food products made from nuts (AU Reg. No. 1598060, Filing Date: December 20, 2013, Registration Date: September 15, 2014); and

RXBAR for GOODS: (class 29) Fruit- and nut-based food bars; fruit- and nut-based high-protein food bars; (class 30) High-protein cereal bars (EM Reg. No. 013489372, Filing Date: November 24, 2014, Registration Date: May 5, 2015)

Complainant, Chicago Bar Company LLC (“Chicago Bar”), doing business as RXBAR, was founded in 2013 by Peter Rahal and Jared Smith. It is based in Chicago Illinois, and produces and sells nutritious bars. Its most popular product, the RXBAR, is made with all-natural ingredients and does not include any added sugar, gluten, soy or dairy products. In 2016, Chicago Bar was reported to have generated \$7 million of earnings before interest, tax, depreciation and amortization. . . .

On October 6, 2017, Kellogg Company (NYSE: K) announced that it entered to an agreement to acquire Chicago Bar for \$600 million, or approximately \$400 million net of tax benefits. Since October 27, 2017, Chicago Bar operates as a subsidiary of Kellogg Company. . . . As the fastest growing nutrition bar brand, RXBAR contributed to Kellogg's increase in net sales in the first quarter of 2018. It contributed about 13 percentage points to Kellogg North America Other's currency-neutral net sales growth in this quarter as it continues to expand its distribution and share.

Complainant maintains a primary website at <rxbar.com>. In this site, Complainant serves its customers and sells its nutritious bars in various flavors. Complainant's RXBAR brand continues to be well-known as one of the most popular nutritious bar brand online, and it has generated significant interest and attention internationally among fans, the media, and competitors. According to Similarweb.com, the Complainant's website received a total visit of 185.41K in the past six months. . . .

Aside from the tremendous organic following that Complainant and its RXBAR brand have managed to achieve, its popularity has also been boosted by its appearance in the news and media. Complainant has been featured in and highlighted by numerous publications and media outlets including ABC News and New York magazine. . . . The media has marveled at the popularity of the RXBAR brand, especially considering its humble beginnings to its present standing as a member of the Kellogg family.

In summary, Complainant's extensive and continuous use of the RXBAR trademark, and the fact that Complainant has made significant investments over the years to promote and protect this trademark and the RXBAR business across the internet and world, demonstrate that Complainant enjoys a substantial degree of public recognition in RXBAR and has seen this mark become uniquely and distinctly associated with Complainant.

15. Discussion and Findings

16. Policy paragraph 4.1 sets forth the onus on a complainant. It provides, in relevant part, 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.*

17. 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; ...(emphasis added)*

18. The relevant definition of “Mark” requires that a trade-mark be “used”. The term “use” is no longer defined in the Policy.

19. The Complainant is the owner of a registered Canadian trade-mark in which the exact word component exactly matches the Domain Name excluding the dot ca portion of the domain name. The Complainant established that it has rights in the trade-mark (registered February 10, 2016) that was a “Mark” prior to the June 1, 2017 date on which the Domain Name was registered.

20. 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 advertising and selling its products in Canada using the registered trade-mark since at least June 13, 2013, according to the Canadian Trade-mark. The Complainant therefore meets this requirement.

21. The Panel is satisfied that the Domain Name is confusingly similar to the Complainant’s Mark. The relevant key word “rxbar” in the Domain Name is the same word as in the Mark, with the exclusion of the dot ca in the Domain Name.

22. The Panel finds that the Complainant has established bad faith by the Registrant for the purposes of paragraphs 4.1 of the Policy by showing circumstances meeting paragraphs 3.5 (a) 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:*

(a) 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;

23. The Complainant's evidence is that the Registrant wrote to the Complainant offering to sell the Domain name for the sum of \$50,000 USD. The Registrant does not deny making an offer to sell the Domain name and in fact issued an Invoice to the Complainant dated April 4, 2018 for the sum of \$50,000 USD to transfer the Domain name - copy of invoice attached to Complaint.

24. The Response by the Registrant discusses the offer to sell the Domain Name:

I have not made any attempts to sell the Domain Name in the market place. I only offered to sell it to the Complainant, and gave the Complainant my "I don't want to sell price." Unfortunately, they took it the wrong way, and as a result, are making the motion to take it away from me.

25. The Panel finds that offering an "I don't want to sell price" is still offering to sell the Domain name for an amount far in excess of the Registrant's costs. This evidence meets the requirements of paragraph 3.5 (a).

26. The Complainant has established evidence to meet the tests set out in paragraph 4.1 (a) Confusing similar domain name to a trademark of the Complainant and (b) evidence of bad faith by the Registrant.

27. The test in paragraph 4.1 of the Policy is

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.

28. The Complainant has met the onus to establish its case for the purposes of meeting the confusingly similar and bad faith requirements of paragraph 4.1 (a) and (b). The onus is on the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the Domain Name.

29. The Response by the Registrant discusses why the Registrant selected the Domain Name:

I purchased RXBAR.CA to create a social on-line gathering where people can buy food & drinks. The bar is called RelaxBar, and I purchased RXBAR.CA to create the website for RelaxBar.

The business I'm looking to create is a social bar business, not a protein bar business. The two businesses at the core have nothing in common.

In a nutshell, you go to rxbar.ca (RelaxBar), purchase drinks and food that can be retrieved at a local bar or restaurant, then email the items you purchased to a person you are interested in getting to know better. If the person accepts the drinks and food, the party must meet at the chosen location. Kind of like Tinder, with drinks and food. . . .

The word "rxbar" is a refined word from "RelaxBar;" and on a marketing standpoint sounds and looks more appealing than "RelaxBar:" The word "rxbar" is catchy, and easy to remember. I got the idea from another domain name: rx soleil. . . .

I have made no use of this Domain Name beyond having it resolve to a parked site that provides no links to any other sites and has no advertising other than the registrar's.

There is no evidence that this Domain Name presented by the Registrant is a competitor of the Complainant.

30. The Panel notes that the offer to sell the Domain Name established bad faith. The onus is on the Registrant to establish a legitimate interest.
31. The Panel reviewed each of the circumstances outlined in paragraph 3.4 of the Policy that would deem the Registrant to have a legitimate interest in the Domain Name. Nothing in the evidence before the Panel established any of those circumstances.
32. The Panel considered the Registrant's assertion that he would use the Domain Name regarding a business selling food and drink to support dating, and not sell protein bars. The Registrant provided no evidence of any action taken to establish such a business.
33. Use of a domain name that conflicts with a trade-marked word is not in itself improper if the use is not in conflict with the protected use established in the trade-mark. A trade-mark holder has no right to all possible uses of its protected word mark.
34. In this case, however, we have bad faith. Further, there is no legitimate use within the meaning of paragraph 3.4 of the Policy. Merely asserting a possible use with nothing further, does not meet the burden of paragraph 3.4 of the Policy.

Conclusion

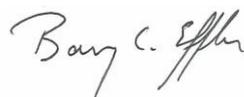
35. The Panel finds that the Complainant has met the burden assigned to it under paragraph 4.1 of the Policy and the Registrant has not met his burden to establish a legitimate interest in the Domain Name under paragraph 3.4 of the Policy.

Order

36. For the reasons set forth above, the Panel orders the Domain Name rxbar.ca be transferred to the Complainant.

Dated: September 26, 2018

Barry C. Effler (Chair), Claude Freeman, Melvyn J.
Simburg



Barry C. Effler (Chair) for the Panel