

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

**Dispute Number:** DCA-987-CIRA  
**Complainant:** The Hartz Mountain Corporation  
**Registrant:** Mr. Robert Harwin  
**Disputed Domain Name:** hartz.ca  
**Registrar:** tu cows.com

**Panellist / Arbitrator:** Mr. Claude Freeman  
**Service Provider:** British Columbia International Commercial Arbitration  
Centre (the “BCICAC”)

**BCICAC FILE NUMBER:** DCA-987-CIRA

On March 28, 2007, the Complainant filed a complaint against the Registrant with the BCICAC, seeking that the Registrant’s registration of <hartz.ca> be transferred to Complainant.

The complaint filed by the Complainant was reviewed by the BCICAC and found to be in administrative compliance with the Policy and Rules in accordance with the provisions of Rule 4.2. By letter and by mail dated March 28, 2007, the BCICAC, as dispute resolution service provider, so advised the parties and forwarded by express post and email a copy of the complaint to the Registrant for his response.

The Registrant responded to the complaint on April 16, 2007, by email to the BCICAC (and a copy to the Complainant’s counsel).

By way of a response by the BCICAC on April 16, 2007, the BCICAC provided a response to the Registrant, indicating that the response received April 16, 2007 from the Registrant was not in administrative compliance in the following areas:

- 1) failure to nominate candidates from the providers list of panellists – per paragraph 5.2(c) of CDRP rules;
- 2) failure to provide a summary of and references to the relevant Canadian Law – per paragraph 5.2(f) of CDRP rules;
- 3) failure to provide a summary of and references to prior CIRA decisions that would be persuasive, and which apply to domain names registered under any other top-level domain – per paragraph 5.2(g) of CDRP rules; and
- 4) failure to conclude with the certification of the Registrant in form set out in Appendix “B”, followed by the signature of the Registrant or its authorized representative – per paragraph 5.2 (j) of CDRP rules.

As provided for by paragraph 5.6 of CDRP rules, the Registrant was given 10 days notice in order to remedy all instances of non-compliance.

By way of letter dated May 7, 2007, the BCICAC advised the parties that the Registrant had not submitted a response as required under Rule 5.1, and that settlement discussions were in progress, and that the proceeding could be terminated by written consent of the parties served upon the BCICAC. Alternatively, as per CDRP rule 6.5, the Complainant could advise the BCICAC by May 14, 2007 (within 5 days of receipt of the May 7, 2007 notice) of its decision to convert from a three-person tribunal to a sole arbitrator.

As permitted, the Complainant elected a sole arbitrator to render a decision in this matter. On May 15, 2007, the BCICAC provided the appointment of the herein arbitrator, and same was accepted by this arbitrator on May 17, 2007.

### **Facts**

The business roots or origins of Hartz (Complainant) as a brand name in the supply of pets, pet foods and pet supplies date back to 1926 when Max Stern started importing singing canaries from Germany to America.

Stern began selling his canaries in New York City and quickly found success with the sale of his canaries. Returning to Germany, again and again, Stern returned with more canaries and by 1932 was the largest importer of canaries, selling to the likes of Macy, Sears Roebuck, Woolworth, Grant, Kresge and others, at which time he decided to expand by adding packaged bird foods.

In 1969, Stern's son joined the company and further expanded the product lines by adding tropical fish and aquatic supplies. By the early 1980's, Hartz products were sold in more than 40,000 U.S. and Canadian retail outlets. In the 1990's, the company's expansion now included manufacturing facilities in America and Brazil, and then, also included over-the-counter, flea control products.

Today, Hartz Mountain has a product line of more than 1,500 pet care products for a wide array of pets.

For 2006, the company reports aggregate world-wide sales in excess of hundreds of millions of dollars at the wholesale level – of which approximately 95% are USA sales and 5% other countries. The company reports advertising and promotional expenditures in the millions of dollars in approximately 21 countries, including Canada, and its Hartz trademark is registered in 66 countries.

The Complainant submits that it has secured some 12 product trademark registrations in Canada – many of which supersede the Registrant's registration of its domain name, and further provides by way of example, some 8 domain names and many others which include "hartz.com." In fact, the submissions by the Complainant, in support of the Canadian product trademarks, demonstrate a range of registrations in Canada from 1953 through 2004.

Complainant also provided information on a recently successful recovery of its domain name in the WIPO Arbitration and Mediation Centre, Case #D2006-1319 (Dec. 12, 2006), in cause style: The Hartz Mountain Corporation v. WHOIS ID Theft Protection, which parallels similar allegations as set out in this complaint.

The Complainant further submits that the Registrant is unable to demonstrate any bone fide offering of goods and services, nor any intent of doing so, history of same, or any material attesting to any historical goods or services rendered in connection to ‘Hartz’.

The Complainant also submits that the use by computer users of “hartz.ca” can, and will be confusing and distracting – with the results of users, customers, and potential customers being diverted away from its business site. Overall, the Complainant submits that the disputed domain name is:

- 1) Confusingly similar
- 2) Registrant has no right or legitimate interest in the domain name, and
- 3) The domain name was registered and used in bad faith.

### **Reasons**

As noted earlier, the Registrant was not only found administratively non-compliant, but has not put forth submissions to be reviewed in detail. Paragraph 4.1 of the CDRP policy, puts the onus on the Complainant to prove on a balance of probabilities that the disputed domain name is confusingly similar to that of the Registrant (hartz.ca), and that it has been registered in bad faith. In addition, the Complainant is required under this paragraph to provide “some evidence” that the Registrant has no legitimate interest in the disputed domain name.

#### **1. Confusingly Similar**

The first test is whether the Disputed Domain Names are confusingly similar to Complainant’s domain name.

The evidence before us shows that in Canada, the Complainant has been using the Hartz marks both corporately from at least the 1960’s, and by way of CIPO registration since 1953.

In order to address the issue of confusion with the standard legal test prevailing in Canada, one can find that in determining whether or not there exists a reasonable likelihood of confusion between the trademarks at issue, the Registrar must have a regard to all the surrounding circumstances, including non-exhaustively, those specifically enumerated in Subsection 6 (5) of the Canadian Trademarks Act.

- a) inherent distinctiveness of the trademarks, and the extent to which they have become known;
- b) length of time the trademarks have been in use;
- c) nature of wares, services or business;

- d) nature of the trade; and
- e) degree of resemblance between the trademarks in appearance or sound in the ideas suggested by them.

A generally accepted principle when applying the test of confusion is looking at the trademarks from the point of the unwary consumer – comparing similarities as opposed to differences. Can the consumer be easily misled by error or otherwise – and perhaps not even know? Could this also impact not only on the consumer, but also on other potential commercial relationships being sought with the Complainant ?

This Panellist concludes on this issue that the Complainant has met the onus of demonstrating that the disputed domain name is “confusingly similar” - as also supported in part by the “tests” applied by Subsection 6 (5) of the Canadian Trademarks Act (“a” to “e” above).

## **2. Legitimate Interest**

A sufficient and initial proof brought on by the Complainant and pertaining to the Registrant’s lack of legitimate interest forces the Registrant to rebut, explain or otherwise plead this issue. Failing to do so permits the Panellist to make a negative inference.

As described above, the Complainant must provide “some evidence” that the Registrant has no legitimate interest in the domain name, as described in Policy paragraph 3.6. If the Complainant satisfies this evidentiary burden, the onus shifts to the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the challenged domain name.

Policy paragraph 3.6 sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It provides as follows:

*The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a complaint was submitted.*

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant has Rights in the Mark;*
- (b) the Registrant used 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;*
- (c) the Registrant used 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;*
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review of news reporting;*

- (e) 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
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

*In paragraphs 3.6 (b), (c), and (d) "use" by the Registrant includes, but is not limited to, use to identify a web site.*

The legitimate interest criteria set forth in Policy paragraphs 3.6 (a), (b), (c), and (d) are satisfied only if the Registrant's use was in "good faith", a term which is not defined by the Policy. This Panellist notes that "good faith" as used in Policy paragraph 3.6 is not necessarily the opposite of "Bad Faith" as defined in Policy paragraph 3.7.

This Panellist has reviewed submissions by the Complainant and absent any submissions by the Registrant to not only debate Complainant's positions, but to provide any historical proof of commercial activities, and fully eliminate confusion between the Registrant and the Complainant, leaves for invalidated support for the Registrant. To go further, the history covered by the Complainant's submissions (registrations, et al) themselves, speaks volumes about the Complainant's right to a legitimate interest.

The Registrant has failed to justify its claim to a legitimate interest in the disputed website.

### **3. Registration in Bad Faith**

The following facts lead this Panellist to conclude that the disputed domain name was registered in bad faith:

- 1) The Registrant himself, has after despite considerable history of past name and product branding by the Complainant, registered a confusingly similar name.
- 2) The Registrant has added links to various other competitors' websites of the Complainant, and this despite mentioning that he purchased the website for a photo album of family and holiday shots.
- 3) The registrant has by way of a written communication to the Complainant said: "I, in the interest of being fair and honourable, will be more than happy to place a link on page one of my website to a website of your choosing (hartz.com)".

All of the foregoing is irreconcilable and sustains the conclusion that if the website was purchased for a family web / blog site, surely a less confusing name would or should have been sought by the Registrant. The statement (by the Registrant) quoted in item #3 above, points further to an admission, or at the very least, to an allusion of a confusing name situation.

### **Balance of Probabilities**

Even if a complainant has met the burdens of proof contained in Paragraph 4.1, a complaint will be dismissed if the registrant is able to prove on a balance of probabilities that the registrant has a

legitimate interest in the disputed domain name. Again, such "legitimate interest" must meet one or more of the six tests set out in Paragraph 3.6 and referred to above.

This balance of probabilities test in Paragraph 4.1 of the Policy deals with the situation where even though a complainant has satisfied all of the burdens of proof contained in Paragraph 4.1, a Panellist believes that justice requires the Registrant to succeed. In finding against a Registrant, the Panellist is depriving that Registrant of a property interest. Such a decision should not be taken lightly. Therefore, even if a Panellist finds that a complainant has satisfied the rather heavy burdens of proof placed on it by Paragraph 4.1, if the Panellist is satisfied that on a balance of probabilities the registrant has a legitimate interest in the disputed domain name, the Panellist must find for the registrant and dismiss the complaint. The Registrant has manifestly provided no argument, solid, or otherwise, to refute the allegations made by the Complainant.

In the case at hand, this Panellist is satisfied that on a balance of probabilities, based upon the evidence before it that the Registrant has no legitimate interest in the Disputed Domain name.

### **Decision and Order**

I find that the Complainant has succeeded in this proceeding initiated under the Policy.

I therefore direct that the registration of <hartz.ca> be transferred to the Complainant: The Hartz Mountain Corporation.

Dated this 4<sup>th</sup> day of June 2007.



Claude Freeman, LLM (ADR), C.Med.