

**CANADIAN INTERNET REGISTRATION AUTHORITY  
DOMAIN NAME DISPUTE RESOLUTION POLICY**

**COMPLAINT**

Dispute Number: DCA-1073-CIRA  
Domain Name: www.jumo.ca  
Complainant: JUMO GmbH & Co KG  
Registrant: Enercorp Instruments Ltd.  
Registrar: Can Reg (Infinet Communications Group)  
Panel: Hon. Roger P. Kerans, Michael D. Manson, and Eric Macramalla  
Service Provider: British Columbia International Commercial Arbitration Centre

**DECISION**

**A. THE PARTIES**

1. The Complainant is JUMO GmbH & Co KG, Moltkestrasse 13-31, D – 36039, Fulda, Germany.
2. The Registrant is Enercorp Instruments Ltd., 25 Shorncliffe Road, Toronto, ON, M9B 3S4.

**B. THE DOMAIN NAME AND REGISTRAR**

3. The domain name at issue is www.jumo.ca. The domain name is registered with of Can Reg (Infinet Communications Group), Suite 207 – 4611 Viking Way, Richmond, B.C., V6V 2K9.

**C. PROCEDURAL HISTORY**

4. The Complainant submitted this complaint to the British Columbia International Commercial Arbitration Centre as service provider in respect of the *CIRA Domain Name Dispute Resolution Policy* of the Canadian Internet Registration Authority (CIRA). The Service Provider served notice of the complaint to the Registrant as required by *CIRA Rules*, paragraph 4.3. A response to the complaint was received from the Registrant on May 1, 2008 and was reviewed by the BCICAC and sent to the Complainant on May 1, 2008. The Complainant elected to have the complaint heard by a panel of three. The service provider selected Hon. Roger P. Kerans, Michael D. Manson, and Eric Macramalla as panellists, with the Hon. Roger P. Kerans as chair of the Panel, and gave the parties and Panel notice of those appointments and forwarded the file for the proceeding to the Panel.
5. In accordance with the *CIRA Rules*, paragraphs 7.1 and 7.2, prior to accepting appointment, each panellist provided the BCICAC with his declaration of his independence and impartiality.

**D. CIRA CANADIAN PRESENCE REQUIREMENTS**

6. The Panel finds that the Complainant has met the CIRA Canadian Presence requirements in that the Complainant is the registered owner of Canadian trade-mark registration number TMA694475 for the trade-mark JUMO and thereby complies with paragraph 1.9(b) of the CDRP.

**E. RELIEF SOUGHT**

7. The Complainant requests that the Panel order the transfer of the contested domain name from the Registrant to the Complainant.
8. The Registrant requests the domain name jumo.ca remain registered to the Registrant and that the Registrant be compensated for costs incurred in preparing for and filing materials in the proceeding.

**F. PARTIES CONTENTIONS**

**a. Complainant**

The Complainant is the registered owner of the trade-mark JUMO, which was registered on August 21, 2007, under trade-mark registration number TMA694475 for use in association with a variety of wares and services relating to electrical systems, electrical mechanical systems, industrial manufacturing equipment and automated machinery, alleging use in Canada since as early as 1984.

It is the Complainant's position that as owner of the registered trade-mark for JUMO in Canada, the registering of the domain name jumo.ca by the registrant, without the authorisation of the Complainant, constitutes trade-mark infringement under relevant provisions of the *Trade-marks Act*.

The Complainant also alleges that there has been bad faith by the Registrant in adopting the Registrant's trade-mark JUMO, in that the Registrant has intended to take advantage of the reputation of the Complainant and the goodwill associated with the Complainant's trade-mark, which shows a clear indication that the primary purpose in doing so was to disrupt the Complainant's business. It is alleged that the Registrant was a distributor of the Complainant's products in Canada, but that distribution agreement was terminated by the Complainant on November 12, 2001. All co-operation between the parties ceased as of December 31, 2001 and the reason for the termination of the alleged distribution agreement was that the Registrant began competing with the Complainant by selling its own products to customers who had been interested in the Complainant's products.

The Complainant further alleges that under paragraph 3.7(a) of the CDRP Policy, a Registrant is considered to have registered of a domain name in bad faith if the domain name was registered primarily for the purpose of selling or otherwise transferring the registration to the Complainant for valuable consideration. It is alleged that the Registrant offered to sell the domain name to the Complainant for \$100,000.

The Complainant also alleges that the Registrant has no legitimate interest in the jumo.ca domain name and that the Registrant has not used the registered trade-mark JUMO of the Complainant in good faith, nor does the Registrant have any rights in and to the registered trade-mark JUMO. The Complainant deals with each of the subparagraphs of paragraph 4.1 of the CDRP Policy and states that the Registrant has not demonstrated a legitimate interest in the domain name jumo.ca.

**b. Registrant**

The Registrant disputes the allegations of the Complainant in the Response and alleges the following facts:

- (i) The Registrant denies that it was ever licensed by the Complainant to use the trade-mark JUMO in Canada. It is alleged that the parties entered into a “representation agreement”, giving the Registrant exclusive representation of Juchheim Products in Canada and to sell their products in the United States. An English translation and a last page of a German agreement showing signatures to the agreement are attached to the Response.
- (ii) The Registrant also alleges that it is the Registrant who had the sole right to represent Jumo products in Canada from 1979 to 2001, pursuant to the agreement entered into between the parties. It is important to note that there is no evidence from either party as to who controlled the character and quality of the products and services provided in Canada in association with the trade-mark JUMO during the relevant period of time, from 1979 to termination of the agreement between the parties, which allegedly took place as of November, 2001.
- (iii) The Registrant also submits that they incorporated the company Jumocorp Inc., which was federally incorporated in Canada on September 3, 1986 (Schedule “C” to Response), which has been treated as a division of the Registrant. As such, it is alleged that in accordance with paragraph 3.1(e) of the CDRP, the domain name jumo.ca comprises part of the legal corporate name of a division of the Registrant.

- (iv) The Registrant also states that they were the sole distributor of M. K. Juchheim until December 31, 2001, some seven months after jumo.ca was registered by the Registrant.
- (v) Moreover, it is alleged by the Registrant that it is the Registrant who established the reputation for Jumo products in North America, through their own self financed advertisements and the service and repairs performed on customer's products by the Registrant. Warranty claims were allegedly serviced at the Registrant's expense. The Registrant further alleges that if there is any bad faith or an attempt to disrupt business, it is the fact that the complainant tried to replace the Registrant as the distributor of Jumo products in Canada by the Complainant's United States subsidiary, Jumo Process Control.
- (vi) The Registrant also alleges that no formal offer was ever made to sell the domain name to the Complainant.
- (vii) Finally, the Registrant states that the website jumo.ca has been used in good faith, not only to sell but also to repair and service Juchheim products in Canada.

## **G. ANALYSIS OF CIRA POLICY PROVISIONS**

9. Paragraph 4.1 of the CDRP provides:

**“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 3.7;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

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 3.6.”

10. Paragraph 3.7 of the *CIRA Policies, Rules and Procedures* provides that a Registrant will be considered to have registered a domain name in bad faith, **if, and only if** (emphasis mine):
- (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;
  - (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names; or
  - (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant.
11. Accordingly, if and only if the evidence demonstrates at least one of the criteria set out in paragraph 3.7, there can be no showing of bad faith, which is essential to the Complainant to be able to be successful in this proceeding.

(See *Canadian Broadcasting Corporation v. Quon* (April 8, 2003); Dispute No. DCA 681 – CIRA), (*Coca-Cola Ltd. v. Amos Hennan* (October 28, 2003); Dispute No. DCA 711 - CIRA)

12. **Confusingly similar 4.1 (a) test**

The domain name jumo.ca is virtually identical to the Complainant's registered trade-mark JUMO. The presence of the ".ca" suffix does not alleviate the potential confusion as the policy in paragraph 1.2 specifically deals with this point:

"...for the purposes of this Policy, "**domain name**" means the domain name excluding the "dot-ca" suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA."

A discussion of what is "confusingly similar" is found in *Glaxo Group Limited v Defining Presence Marketing Group Inc.*, CIRA decision number 00020. In this

case, there is no question that the domain name is confusingly similar to the Complainant's registered trade-mark. However, and most importantly, the domain name in dispute was registered on May 30, 2001, more than six years before the trade-mark JUMO was registered by the Complainant on August 21, 2007. Further, while the Complainant's registration alleges use since as early as 1984, the evidence of the Registrant is that since as early as 1979 the Registrant had been using the trade-mark JUMO in association with products distributed by the Registrant in Canada. Further, the Registrant registered the federally incorporated company Jumocorp on September 3, 1986, 21 years prior to the registration of the Complainant's JUMO trade-mark.

13. Under Canadian Law, a mere distributor or retailer of a manufacturer's products, bearing the manufacturer's trade-mark, acquires no rights to use such trade-mark, unless authorised to do so by the manufacturer. However, where a distributor can show by virtue of a distributor's use of the mark in Canada, without the necessary control over character or quality of such use by the manufacturer, and to the extent that the Canadian public regards the mark as that of the distributor and not the manufacturer, then the distributor **may** well have acquired rights to the trade-mark in this country. The evidence on this issue in this dispute is inconsistent and the Panel finds that on a balance of probabilities, does not favour either party to the extent that this Panel can make a decision in favour of the Complainant.

*Lifegear, Inc. et al. v. Urus Industrial Corporation* (2002), 23 C.P.R. (4th) 58 at 61 (F.C.T.D.).

*Glaxo v. Trivill* (2005), 45 C.P.R. (4th) 75, at 79 (C.I. R.A.)

*White Consolidated Industries, Inc. v. Beam of Canada Inc.* (1991), 39 C.P.R. (3d) 94 at 119 (F.C.T.D.)

14. It is therefore the Panel's decision that the Complainant has not established, on a balance of probabilities, that the Registrant has registered the domain name in bad faith.
15. Accordingly, notwithstanding the representations made by the Complainant concerning the previous relationship between the parties and the fact that the parties are now competitors, the Panel is unable to find the necessary evidence of bad faith required for the Complainant to be successful and finds that the Registrant did not, on a balance of probabilities, register the domain name in bad faith.
16. Further, notwithstanding the Panel's finding on bad faith is determinative of the dispute in favour of the Registrant, the Panel also considered the evidence on the issue of legitimate interest, and applying the factors enumerated in paragraph 3.6 of the CDRP Policy, the Panel is unable to find that the Registrant has no legitimate interest, given the dispute over the right to the trade-mark in Canada and the lack of any evidence as to adequate control over the character and quality of use of the mark in this country by the Complainant, through relevant license terms, nor any

terms in the alleged agreement between the parties that would suggest that the relationship was purely a distributorship agreement in respect of which the Registrant could not have acquired any rights in the trade-mark in this country.

17. For all the above reasons, the complaint concerning the domain name www.jumo.ca is not successful and is dismissed.
18. Each party shall bear their own costs.

Dated and signed at Victoria, British Columbia, Canada, this 29<sup>th</sup> day of May, 2008.

**Roger Kerans**

Digitally signed by Roger Kerans  
DN: cn=Roger Kerans, o=ADRC, ou,  
email=rpk2@kerans.ca, c=CA  
Date: 2008.05.29 16:17:25 -07'00'

.....  
Hon. R.P. Kerans, Chair, with the authority to sign for himself and all panellists.