

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

Domain Name: LOWESDISPOSAL.CA

Complainant: LF, LLC

Registrant: Guiseppe (Joseph) Sansone
 d/b/a lowesdisposal

Registrar: Tucows.com Co.

Panelist: Teresa Scassa

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant is LF, LLC., a Delaware limited liability company. The Complainant's head office is in Wilmington, Delaware, U.S.A.
2. The Registrant did not respond to the Complaint.

B. The Domain Name and Registrar

3. The disputed domain name is lowesdisposal.ca. The Registrar for the domain name is Tucows.com Co. The disputed domain name was registered on August 21, 2007.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (CIRA) *Domain Name Dispute Resolution Policy* (Version 1.3) (the *Policy*) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.4) (the *Rules*).
5. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada, Inc. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *Rules*. No response

was received. The Provider selected a sole panelist in accordance with the process set out in the *Rules*.

6. The Complainant was represented by counsel, who provided a thorough and helpful submission.

7. The Complainant requests that the disputed domain name be transferred to it.

D. Panelist Impartiality and Independence

8. As required by paragraph 7.2 of the *Rules* I have submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

9. The Complainant, LF, LLC is the owner of the Canadian registered trademark LOWE'S (TMA 476914) since 1997, registered for use in relation to a wide range of home improvement services, including "Retail outlet services specializing in a variety of building materials, plumbing supplies, roofing materials, home furnishings and items used in home improvement." It has also registered the mark LOWE'S for use in association with other wares and services (TMA734051; TMA797099), all of which are related to its core home improvement business. It holds a Canadian registered trademark in the logo LOWE'S Design (TMA8022402) and it has applied to register its distinctive logo LOWE'S & GABLE Design, which features the word LOWE'S within a building-shaped design.

10. The Complainant meets the Canadian Presence Requirements as set out in art. 2(q) of CIRA's *Canadian Presence Requirements for Registrants, Version 1.3*, which provides that the requirements can be met where the Complainant is the owner of a Canadian registered trademark. The provision is limited to those cases where the domain name consists of or includes "the exact word component" of the registered trademark. In this case, the disputed domain name lowesdisposal.ca includes the entire trademark of the Complainant, but for the apostrophe. As the apostrophe cannot form part of a registered domain name, its absence from the disputed domain name is not material.

F. Factual Background

11. The Complainant is in the business of licensing the use of its trademarks in relation to the operation of home improvement retail stores under the LOWE'S brand. The LOWE'S chain of retail home improvement stores is very well known in Canada and the United States. It sells a very broad range of home improvement products and offers a variety of related services. The LOWE'S mark has been in use in the United States since 1946. The first Canadian stores were launched in the Greater Toronto Area (GTA) in 2007. There are currently 28 LOWE'S stores in Ontario, Alberta and Saskatchewan. The

Complainant has operated a website at lowes.com since 1995. It registered lowes.ca in 2003, and operates a website at this domain related to its Canadian operations.

12. The domain name registered by the Registrant is lowesdisposal.ca. The domain name was registered on August 21, 2007. The Complainant notes that the time of registration coincided with the period leading up to the launch of the first Canadian stores in the GTA. During this period there was substantial advertising and publicity relating to the impending opening of the new stores.

13. The Complainant has provided evidence that the Registrant registered lowesdisposal.ca as a business name on May 26, 2008. He also incorporated Lowes Disposal Ltd. under the *Canada Business Corporations Act* on October 9, 2008, although it would appear that dissolution of this corporation is pending due to non-compliance with corporate formalities. The disputed domain name resolves to a website at lowesdisposal.com. The website offers waste disposal services which chiefly involve the delivery of different types or sizes of waste disposal containers within the GTA. It is important to note that the website uses a logo that incorporates the word LOWES into the frame of a house, which, while different in detail to the building in the LOWE'S & GABLE logo used by the Complainant, is nonetheless very similar to it. The website also uses a colour scheme that is similar to that used on the Complainant's own website.

G. CIRA *Domain Name Dispute Resolution Policy* Requirements

14. Paragraph 3.1 of the *CIRA Domain Name Dispute Resolution Policy, Version 1.3* (CDRP) requires that the Complainant establish 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;
- (b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.

15. According to paragraph 4.1 of the CDRP, the Complainant must establish elements (a) and (b) above on a balance of probabilities. The Complainant must also provide "some evidence" that the Registrant has no legitimate interest in the domain name.

H. Analysis

Confusingly Similar

16. The Complainant must first establish that the disputed domain name is confusingly similar to a mark of the Complainant's; that the Complainant had rights in that mark prior to the date of registration of the domain name; and that it continues to have such rights.

17. The Complainant maintains that the disputed domain name is confusingly similar to its LOWE'S registered trademark. The test for "confusingly similar" set out in paragraph 3.3 of the Policy dictates that the panel consider only "whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark." The test is considered to be one of first impression and imperfect recollection (*Government of Canada v. Bedford*, May 27, 2003, <http://www.cira.ca/assets/Documents/Legal/Dispute/2003/00011govt-of-canada-En.pdf>).

18. The disputed domain name consists of the Complainant's trademark (minus the apostrophe) followed by a term that is descriptive of a particular type of service. The Complainant's Mark is very well known in Canada, and as such has acquired a high degree of distinctiveness. It is the dominant element in the domain name. I find that the domain name is confusingly similar to the Complainant's registered trademark. The Complainant's rights in this mark substantially predate the Registrant's registration of the disputed domain name.

Bad Faith

19. A complainant must also establish on a balance of probabilities that the disputed domain name was registered in bad faith. Under paragraph 3.5 of *Version 1.3* of the *Policy*, the categories of bad faith have been expanded, and no longer constitute a closed list of circumstances.

20. The newly added fourth category of bad faith, set out in paragraph 3.5(d) of the *Policy*, refers to circumstances where 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." It would seem that the facts of this case fit fairly squarely within this ground of bad faith.

21. The Complainant argues that the Registrant has registered the domain name in order to profit from the confusion that the domain name, in combination with the web site to which it resolves, might create in the minds of consumers. In other words, consumers may be misled into believing that the disposal services offered on the website are somehow associated with the Complaint and its LOWE'S brand.

22. The confusing similarity of the domain name, combined with the lack of any other explanation for why a name featuring "lowes" was chosen for the Registrant's business are at least suggestive of bad faith. Beyond this, the Complainant points out that at the

time of registration of the domain name, not only was LOWE'S a well known registered trademark in Canada, there had been considerable media attention in the GTA relating to the impending opening of a number of new stores in that area. As the Registrant's business is based in the GTA, the Complainant argues that he engaged in a calculated and deliberate attempt to trade on the considerable goodwill associated with the LOWE'S mark.

23. Although the waste disposal business is not one in which the Complainant currently engages, I accept the Complainant's argument that dumpster and mini bin rentals for waste disposal "are within the ambit of what a reasonable consumer might think may be offered by LOWE'S stores in Canada." Certainly there is a connection between such services and large scale home renovation projects.

24. The use of the Complainant's well known LOWE'S trademark in combination with a descriptive term that might reasonably be connected in consumers' minds with the Complainant's home improvement-related services appears on its face to be a deliberate attempt to confuse. This impression is reinforced by the use of the word LOWES on the Registrant's website, where it appears in a logo that is on first impression very similar to the LOWE'S & GABLE logo used by the Complainant. The choice of colour on the Registrant's web site also serves to enhance the likelihood of confusion. The combined effect of these elements is to create consumer confusion as to the "source, sponsorship, affiliation, or endorsement" of the Registrant's website by the Complainant. I note as well that it is clear that the Registrant is engaged in commercial activity.

25. The Complainant has also provided additional documents that suggest that the use of the lowesdisposal name may be part of a broader pattern of conduct on the part of the Registrant. The Complainant has provided a copy of a newspaper article published in the online version of the Toronto Star (thestar.com) on June 24, 2010. The article reports multiple consumer complaints relating to the Registrant's waste disposal business and suggests that the Registrant attempts to lead consumers to believe his business is affiliated with either the Complainant or Home Depot. I note, however, that a notice appears at the front of the article indicating that it is subject to a legal complaint by the Registrant Sansone. The Complainant has also supplied a copy of a Statement of Claim dated October 22, 2010, issued by Home Depot of Canada Inc. and Homer TLC against Lowes Disposal Ltd. and Giuseppe Sansone and others. The statement of claim alleges passing off and trade-mark infringement related to the operation of a waste disposal bin rental business. The allegations in the statement of claim have yet to be proven in court.

26. Overall there is much to indicate that the registration of the disputed domain name was motivated by a bad faith attempt to trade on the Complainant's goodwill in its LOWE'S registered trademark, and in so doing, to "attract, for commercial gain, Internet users to the Registrant's website . . . by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of . . . a product or service on the Registrant's website . . ." I find that the Complainant has

established, on a balance of probabilities that the Registrant has registered the domain name in bad faith.

Legitimate Interest

27. Under sub-paragraph 4.1(c) of the *Policy*, the Complainant must provide some evidence that “the Registrant has no legitimate interest in the domain name”. Paragraph 3.4 identifies six circumstances in which a legitimate interest may arise. It is worth noting that under Version 1.3 of the *Policy*, the establishment of a legitimate interest is not limited to these circumstances:

- (a) *the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had 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 or 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.*

28. It is clear that subparagraphs (b), (c), (d), (e) and (f) are not applicable in this case. If the Registrant is to be considered to have a legitimate interest in the domain name, it would have to be under sub paragraph 3.4(a): *the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark.*

29. The evidence shows that “lowesdisposal.ca” was registered as a business name by the Registrant on May 26, 2008, and that the Registrant has operated a business under that name. However, it is also clear that at the time the business name was registered, the

LOWE'S mark had been a registered trademark in Canada since 1997, and was well known in Canada as a result of its use in both Canada and the United States. Further, the registration of both the business name and the domain name took place in the same time period as a highly publicized launch of LOWE'S stores in the GTA. It is difficult to believe that the Registrant was not aware of the LOWE'S mark.

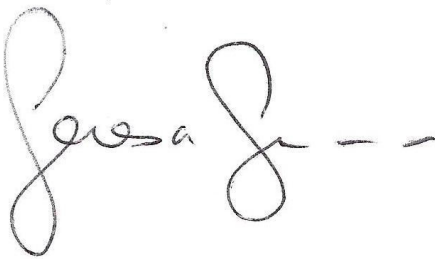
30. I have already noted that I have found that lowesdisposal.ca was registered in bad faith. A legitimate interest under paragraph 3.4(a) of the Policy turns on a use by the Registrant in good faith. I find that notwithstanding the use of the domain name in association with a business of the same name, neither the use nor the registration was in good faith. The Complainant has succeeded in providing "some evidence" that the Registrant had no legitimate interest in the domain name.

I. Conclusion and Decision

31. In conclusion, I find that the Complainant has rights in the mark LOWE'S. I find that the disputed domain name is confusingly similar to the mark, that the Registrant had no legitimate interest in the mark, and that he registered the domain name in bad faith.

32. I therefore find that the registration of the domain name LOWESDISPOSAL.CA should be transferred to the Complainant LF, LLC.

Dated: November 24, 2011

A handwritten signature in black ink, appearing to read "Teresa Scassa", with a horizontal line extending to the right from the end of the signature.

Teresa Scassa