

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

Domain Name: victorinox.ca
Complainant: Victorinox AG
Registrant: Trina Bolden
Registrar: MyID.ca Inc.
Panellist: Sharon Groom
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, Victorinox AG, is a company located in Switzerland.
2. The Registrant for the domain name is Trina Bolden located in Ontario, Canada.

B. The Domain Name and Registrar

3. The disputed domain name is victorinox.ca. The Registrar for this domain name is MyID.ca Inc. The disputed domain name was registered on February 19, 2014.

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 1.5) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution provider, Resolution Canada, Inc., is that the Complainant filed a complaint against the Registrant with Resolution Canada, Inc. requesting that the current registration of the domain name victorinox.ca be transferred to Victorinox AG. The complaint was dated March 26, 2019.
6. Resolution Canada, Inc. served notice of the complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the complaint was made by email on April 9, 2019.

7. The Registrant was given 20 days to file a response and no response was filed. As the complaint received no response, the case was remitted to one panellist.

D. Panellist Impartiality and Independence

8. As required by paragraph 7 of the Rules, the panellist has submitted to Resolution Canada, Inc. a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

9. The Complainant, Victorinox AG is a company located in Switzerland. However it is the registered owner of various registrations for the mark VICTORINOX in Canada, including registration no. TMA106099 which was registered in 1954, and the domain name consists of this mark. Therefore, the Complainant satisfies the Canadian Presence Requirements under paragraph 2(q) of the *CIRA Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

10. The Complainant is best known for the sale of the pocket knife commonly known as the “swiss army knife”. The company was renamed VICTORINOX in 1921 based on a combination of the name “Victoria” and “Inox” which is an abbreviation of the French word for stainless steel (acier inoxydable). Therefore the mark VICTORINOX is a coined word.

11. The Complainant owns six registrations for the trademark VICTORINOX in Canada, five of which issued prior to the registration of the domain name victorinox.ca. These registrations are TMA106009, TMA461716, TMA594015, TMA694779 and TMA733261.

12. The Complainant states that it sells swiss army knives, household and professional knives, watches, travel gear and fragrances in Canada under the trademark VICTORINOX through online channels and bricks and mortar locations.

G. CIRA Domain Name Dispute Resolution Policy

13. Paragraph 4.1 of the Policy 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 registered the domain name in bad faith as described in section 3.5; and

(c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

14. The Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in

the domain name. 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 section 3.4 of the Policy.

H. Analysis

Rights to a Mark

15. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights (and continues to have these rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name.

16. The domain name was registered on February 19, 2014, therefore this is the relevant date for this analysis.

17. A “Mark” is defined in paragraph 3.2(c) of the Policy as:

(a) a trade-mark, including the word elements of a design mark, that is registered in CIPO;

18. The Complainant has submitted evidence of its registration of the trademark VICTORINOX in five active trademark registrations, each of which was registered prior to the registration date of the domain name. Therefore I find that the Complainant has established that it had rights in a mark prior to the date of registration of the domain name, and continues to have these rights.

19. The domain name consists of the word VICTORINOX, which is the same as the only word in each of the registered marks. Therefore, pursuant to paragraph 3.3 of the Policy, I find that the domain name is confusingly similar to the mark VICTORINOX as it so nearly resembles the mark in appearance, sound and in the idea suggested by the mark as to be likely to be mistaken for the mark.

Bad Faith

20. The Complainant also has to show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds which constitute bad faith and it must be noted that these are not exhaustive; it is open to the panellist to find other grounds which lead to a conclusion of bad faith conduct.

21. The Complainant argues first that the Registrant’s conduct constitutes bad faith pursuant to paragraph 3.5(a) of the Policy which states:

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.

22. The Complainant presents evidence that the domain name linked to a webpage offering the domain name victorinox.ca for sale in Canadian dollars through a link to myID.ca Domain Marketplace or in US dollars through Escrow.com. The link at myID.ca opened a new webpage where the domain name was offered for sale for \$695. On January 29, 2019 the Complainant sent an email to the Registrant using CIRA's Interested Party Contact and received an email in response from a person identified as "Charlie Gaurang" who offered the domain name for sale for \$2500 USD using Escrow.com.

23. The Complainant requested the registrant details for the domain name from CIRA using the Disclosure of Registrant Information procedure and was told that the name of the registrant was Trina Bolden, with an email address of alfonsmorale@gmail.com. The Complainant sent a letter dated March 14, 2019 to the Registrant and copied the email address provided in the registrant details, as well as the email address of the initial contact, Charlie Gaurang, requesting that the domain name be transferred to the Complainant. No response was received.

24. The fact that the domain name, which is confusingly similar to the Complainant's registered trademarks, was registered and the sole use seems to have been to advertise the domain name as being for sale for a price well exceeding the Registrant's actual cost to register the domain name, in my view meets the criteria for bad faith set out in paragraph 3.5(a) of the Policy.

25. The Complainant also submits that the Registrant has demonstrated bad faith under paragraph 3.5(b) of the Policy which states:

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.

26. The Complainant alleges that the registration of the domain name prevents it from registering its mark VICTORINOX as a domain name. The Complainant also requested that CIRA provide a list of domain names registered by the Registrant and was given a list of three others which included "googel.ca" and "presidentchoice.ca". The Complainant provided evidence showing that GOOGLE and PRESIDENT'S CHOICE are trademarks registered to other parties. It also presented evidence that the webpage associated with googel.ca showed the domain name listed for sale and when one clicked on the link with myID.ca the asking price shown for the domain name was \$3500.

27. The registration of the domain name victorinox.ca has prevented the Complainant from registering it, and the fact that the Registrant has registered two other domain names consisting of typos of two registered trademarks does show a pattern, as it demonstrates that the registration

of victorinox.ca, which consists of a registered trademark, was not an isolated incident. I therefore find that the Complainant has also demonstrated, on the balance of probabilities, that the Registrant registered the domain name in bad faith, as set out in paragraph 3.5(b) of the Policy.

Legitimate Interest

28. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the domain name. Paragraph 3.4 lists six possible ways in which a Registrant may have a legitimate interest in a domain name which are as follows:

- (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 registered 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 registered 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.

This list is not exhaustive as it is said to be "without limitation". Therefore neither party is bound by only those criteria.

29. In addressing the subject of legitimate interest I note that the Complainant has established that it has rights in the mark VICTORINOX, which is reproduced in the domain name, and the Registrant has not been licensed to use this Mark. Therefore there can be no legitimate interest under subsection (a). The word VICTORINOX is a coined word, created from the word VICTORIA and an abbreviation for the French word for stainless steel (acier inoxydable). Since it is a coined word it cannot be clearly descriptive as referred to in subsection (b), nor can it be a generic term. There is no evidence that the Registrant has used it for a non-commercial activity including, criticism, review or news reporting, so subsections (c) and (d) are not applicable. Finally, the domain name is not the name of the Registrant nor is it the name of a geographic

place, therefore neither subsections (e) or (f) apply either. I therefore find that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the domain name.

30. The Registrant has not rebutted this evidence with any evidence of its own, therefore it has not shown, on the balance of probabilities, that it has a legitimate interest in the domain name.

I. Conclusion and Decision

31. In conclusion, I find that the Complainant has rights in the mark VICTORINOX which predate the registration of the domain name. I also find that the domain name is confusingly similar to the Complainant's mark, that the Registrant registered the domain name in bad faith and that the Registrant has no legitimate interest in the domain name.

32. I therefore order, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name victorinox.ca be transferred to the Complainant Victorinox AG.

Dated: June 13, 2019

A handwritten signature in black ink, appearing to read "Sharon Groom", written over a horizontal line.

By: Sharon Groom (Sole panellist)