

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

Domain Name: <papajohns.ca>

Complainant: Papa John's International, Inc.

Registrant: Don McGrath

Registrar: Go Daddy Domains Canada, Inc.

Panel: Hugues G. Richard

Service Provider: Resolution Canada Inc.

**DECISION**

**THE PARTIES**

1. The Complainant in this proceeding is Papa John's International, Inc., located at Salmätargatan 7, 113 59 Stockholm, Sweden ("the Complainant").
2. The Registrant is Don McGroth, located at C.P. 3272 Scc. Bureau Chef, Tracadie-Sheila, New-Brunswick, Canada, E1X 1G5 ("the Registrant").

**THE DOMAIN NAME AND REGISTRAR**

3. The disputed domain name in this proceeding is <papajohns.ca> ("Disputed Domain Name").
4. The Registrar is: Go Daddy Domain Names Inc.
5. The Disputed Domain Name was registered by the Registrant on May 12, 2010.

**PROCEDURAL HISTORY**

6. 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").
7. The history of the proceeding is that the Complainant filed a complaint against the Registrant with Resolution Canada, Inc. (the Center) requesting that the current registration of the Disputed Domain Name <papajohns.ca> be transferred to Papa John's International, Inc.
8. The Center served notice of the Complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the Complaint was made on August 6, 2015.
9. The Registrant filed no Response to the Complaint.
10. On September 4, 2015, the Center named Hugues G. Richard as the sole panelist (the Panel).
11. The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and the Rules. The Complainant is a United States Corporation headquartered in Jefferstown, Kentucky that owns several Canadian trade-mark registrations, including for the word mark "PAPA JOHN'S", registration no. TMA 531,864 which is identical to the disputed Domain Name. As such, the Complainant meets the Canadian Presence Requirements under paragraph 1.4 of the Policy and paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.
12. According to the information provided by the Center, the Panel is required to deliver its decision on September 25, 2015.

## **FACTUAL BACKGROUND**

13. The following information derives from the Complaint.

14. The Complainant is the owner of Canadian trademark "PAPA JOHN'S", TMA 531,864, registered on August 28, 2000 and used in association with pizza and related services since at least as early as July 13, 2000.
15. The Complainant is the owner of Canadian design trademark "PIZZA PAPA JOHN'S", TMA 531,901, registered on August 29, 2000 and used in association with pizza and related services since at least as early as July 13, 2000.
16. The Complainant is the owner of Canadian trademark "PAPA JOHN'S PIZZA", TMA 284, 178, registered on October 14, 1983 and used in association with restaurant services since as early as October 31, 1981.
17. All trademark registrations are in good standing.
18. The Disputed Domain Name is identical or similar to the Complainant's trade-marks and was registered on May 12, 2010, without the permission of the Complainant.
19. As stated above, no representations were filed by the Registrant.
20. The Disputed Domain Name resolves to a website comprised of a single page, a copy of which is attached at Annex 7 of the Complaint. The top left corner of the page still displays the logo of the Registrar "Go DADDY". The rest of the page is filled with pay-per-click links and various links related to pizza restaurants or delivery, or food in general.

## **THE COMPLAINANT'S CONTENTIONS**

### **21. The Complainant alleges that:**

- a) The Complainant has been using the "PAPA JOHN'S" trade-marks in Canada in association with operation of restaurant, fast food restaurant and take-out restaurant since as early as October 31, 1981 and is the registered owner of multiple "PAPA JOHN'S" trade-marks in Canada (TMA 531,901; TMA 284,178; TMA 531,864), all of them predating the date of the registration of the Disputed Domain Name by the Registrant.

- b) The Disputed Domain Name is confusingly similar to Complainant's trade-marks: the Disputed Domain Name is identical to Complainant's "PAPA JOHN'S" trade-mark and consumers are bound to mistake it for the said trade-mark.
- c) The Registrant has no legitimate interest in the Disputed Domain Name because:
  - (i) The Disputed Domain Name is identical to the Complainant's trade-mark and the Complainant has not authorized the Registrant's use of the Disputed Domain Name.
  - (ii) The Registrant does not have any rights in the "PAPA JOHN'S" trade-mark.
  - (iii) The Registrant is not using the Disputed Domain Name in connection with a bona fide offering of goods or services, but is instead using the Disputed Domain Name to redirect internet users to a website featuring links to third-party websites, some of which compete directly with the Complainant's business.
  - (iv) The Registrant was aware of the Complainant's rights in the trade-mark and registered the Disputed Domain Name because of the fame of this trade-mark.
- d) The Registrant has registered and is using the Disputed Domain Name in bad faith because:
  - (i) The Registrant registered the Disputed Domain Name with the registrar GoDaddy.com, LLC and kept the default settings designated as "Parked Pages", which constitute of "online domain monetization system designed to generate revenue from domain names that are not actively being used as websites". Therefore, the presence of a "Parked Page" on the Disputed Domain Name page shows that the Registrant has been inactive and has not used the page; or the Registrant voluntarily, proactively elected to participate in GoDaddy's "CashParking" service to allow him to monetize

its parked domain name. As such, the pay-per-click links found at the Disputed Domain Name would be the result of, at minimum, the Registrant's inactive, non-use of the domain name, or at worst, a concerted effort to participate in and facilitate the monetization of the Disputed Domain Name by parking it and featuring third-party links.

- (ii) The Registrant ignored the Complainant's attempts to resolve this dispute outside of any administrative proceeding and failed to respond to the Complainant's cease-and-desist letter.
- (iii) The Registrant was well aware of the Complainant's rights in the trade-marks, as well as the value of these trade-marks.

## **RELIEF SOUGHT**

22. The Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant.

## **CIRA DOMAIN NAME DISPUTE RESOLUTION POLICY**

23. According to paragraph 4.1 of the Policy, in order to be successful, the Complainant must 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 of the Policy; and
- (c) the Registrant has no legitimate interest in the domain name as described in section 3.4 of the Policy.

24. The Complainant must prove 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 Disputed Domain Name.

25. Even if a Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the proceeding if he proves, on a balance of probabilities, that he has a legitimate interest in the Disputed Domain Name as described in paragraph 3.4 of the Policy.

26. The three elements in paragraph 4.1 are cumulative. They are considered below.

#### **A. Confusing Similarity**

27. The Complainant must first show that the Disputed Domain Name is confusingly similar to a mark in which the complainant has rights prior to the date of registration of the Disputed Domain Name and in which it continues to have such rights.

28. The Complainant registered the "PAPA JOHN'S" word trade-mark in Canada in 2000 (TMA 531,864) in association with pizza based on use of the mark in Canada on July 13, 2000. It also registered a "PAPA JOHN'S PIZZA" word trade-mark in 1983 (TMA 284,178) in association with operation of a restaurant, fast food restaurant and take-out restaurant based on use of the mark in Canada since October 31, 1981. The Complainant is also the current owner of a "PIZZA PAPA JOHN'S" design trade-mark that was registered in Canada in 2000 (TMA 531,901) for pizza and restaurant services; delivery services for delivering restaurant food, since as early as July 13, 2000. Since the Registrant registered the Domain Name <papajohns.ca> on May 12, 2010, the Complainant's rights in the "PAPA JOHN'S" trade-mark precede the Disputed Domain Name registration date. The Complainant's "PAPA JOHN'S" trade-mark by itself satisfies the requirement of prior rights, as per paragraphs 3.1(a) and 3.2(c) of the Policy.

29. The Complainant has submitted at Annex 2 selected pages from the Complainant's 2014 Annual Report. The Complainant also submitted as Annex 3 excerpts of press releases and awards received by the Complainant in 2014 and 2015. In addition, the

Complainant filed, as Annex 14, the affidavit of Julia R. McGuffey, an employee of Papa John's who attests that the Complainant has continuously used the "PAPA JOHN'S" trade-mark.

30. Among these annexes, none demonstrates use of the trade-mark in Canada, but only in the United States. Thus, it cannot constitute evidence showing that the use of the mark is continuing in Canada.

31. However, at page 6 of its submissions, the Complainant states:

Specifically in the area of Canada, Papa Johns opened its first restaurant in 1981 and has since grown to 90 restaurants, at the present time. Papa Johns has also been a member of the Canadian Franchise Association (CFA) since 2006.

32. In view of the presence of the Complainant in Canada, the Panel is satisfied that the Complainant continues to have its rights in the mark "PAPA JOHN'S" in Canada as required by subparagraph 3.1(a) of the Policy.

33. The Complainant has thus established its rights in the mark "PAPA JOHN'S" since prior to 2010, and has demonstrated that it continues to have these rights.

34. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a trade-mark if it 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.

35. The test to be applied when considering confusing similarity is one of first impression and imperfect recollection<sup>1</sup> and the "dot-ca" suffix should be excluded from consideration, as per paragraph 1.2 of the Policy. When those principles are applied, the Disputed Domain Name incorporates the entire trademark "PAPA JOHN'S" (TMA 531,864) and is confusingly similar to the Complainant's "PAPA JOHN'S PIZZA" word and design trade-marks (TMA 284,178 and TMA 231,901).

36. Accordingly, the Domain Name <papajohns.ca> is confusingly similar with a mark in which the Complainant had rights prior to the date of the registration of the Disputed

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<sup>1</sup> *McKee Homes Ltd. v. Gerlinde Honsek, Resolution Canada*, Dispute No.: 00079, par. 41.

Domain Name and in which it continues to have such rights, namely the "PAPA JOHN'S" trade-mark.

## **B. Bad Faith**

37. The Complainant also needs to establish, on a balance of probabilities, that the Disputed Domain Name was registered in bad faith. Paragraph 3.5 of the Policy lists non-exhaustive grounds that can constitute proof of bad faith.
38. Under subparagraph 3.5(a), bad faith can be found if the Registrant registered the Disputed Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant or its competitors for valuable consideration in excess of the registration and transfer costs.
39. There is no evidence that the Registrant's activities support bad faith under subparagraph 3.5(a). There is no proof that the Registrant offered to sell the domain name to the Complainant or its competitors.
40. Subparagraph 3.5(b) allows a finding of bad faith if the Registrant registered the domain name in order to prevent the Complainant from registering the mark as a domain name, provided that the Registrant engages in a pattern of such behavior.
41. No evidence was adduced with regards to the ownership of the Registrant of multiple domain names that would indicate that the Registrant engages in a pattern of registering domain names to prevent rightful owners of trade-marks from registering them as domain names.
42. Subparagraph 3.5(c) provides that registering a domain name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant, is evidence of bad faith.
43. In this case, no evidence was adduced with regards to the fact that the Registrant and the Complainant are competitors.



44. Lastly, as per subsection 3.5(d) of the Policy, bad faith can be found whenever the Registrant has intentionally attempted 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 the Registrant's website.
45. In this case, the Registrant makes currently no actual use of the website resulting from the Disputed Domain Name except for having pay-per-click advertisements and links to other websites related to pizza, including other pizza delivery services.
46. In order to have acted in bad faith, the Registrant must have registered the Disputed Domain Name primarily for the purpose of disrupting the Complainant's business. In this case, it is likely that by adopting a domain name that incorporates in its entirety the Complainant's "PAPA JOHN'S" mark, the Registrant disrupted the Complainant's business and misdirected internet traffic that could have been otherwise captured by the Complainant.
47. In compliance with this requirement, the registration of the Disputed Domain Name has prevented the Complainant from registering its "PAPA JOHN'S" mark as a .ca domain name. Given the use and registration of the "PAPA JOHN'S" trade-mark in Canada by the Complainant, the Registrant must have had knowledge of the Complainant's mark at the time he chose to register a domain name that is identical with the said mark.
48. Indeed, the combination of the words "Papa" and "John's" associated with pizza by the Registrant in the Disputed Domain Name, as provided by the screenshot of the Disputed Domain Name's website submitted as Annex 7 of the Complainant's Complaint, cannot be an insignificant and innocuous amalgam made with no thoughts of the Complainant's trade-mark. These words associated with pizza represent a distinguishing combination proper to the Complainant's branding. These elements are not related with each other in a way that the Registrant could have associated them by sheer logic or coincidence without knowledge of the Complainant's business in Canada or elsewhere.

49. Potential commercial gain for the Registrant could be based on two possibilities. First, as underscored by the Complainant, the Registrant had a potential of financial gain based on its effort to participate in and facilitate the monetization of the Disputed Domain Name by parking the Domain Name and featuring third-party links in the same industry on the website as provided by GoDaddy's "CashParking" service. The other potential of gain for the Registrant could be in view of selling the registration to the Complainant for a valuable consideration in excess of the Registrant's actual costs.
50. In light of the above, the Complainant has proven, on the balance of probabilities, that the Registrant registered the Disputed Domain Name primarily for the purpose of attracting, for commercial gain, Internet users to its website and to other on-line location by creating a likelihood of confusion with the Complainant's Mark as to the affiliation of its website and the other websites referred on it for the purpose of subparagraph 3.5(d) of the Policy, and that a finding of bad faith is justified under this ground.
51. If the Panel is wrong on the potential of commercial gain for the Registrant as stated by subparagraph 3.5(d) of the Policy, the other elements of the present case are cumulatively sufficient to constitute evidence of bad faith under subparagraph 3.1(c). For this purpose, the Panel reminds the parties that the grounds of bad faith stated by subparagraph 3.5 of the Policy are not limitative and that a finding of bad faith can be justified on other grounds and circumstances.
52. Given that the Disputed Domain Name is identical to the Complainant's "PAPA JOHN'S" mark, that the Disputed Domain Name was registered many years after the Complainant's registration, that the association of the words "Papa", "John's" with pizza delivery and restaurants cannot be a sheer coincidence, and that the Registrant did not file any submissions that would justify its registration, the Panel can infer that such actions were done in bad faith against the interests of the Complainant.

53. The Complainant's "PAPA JOHN'S" word mark has been registered in Canada since 2000 while the "PAPA JOHN'S PIZZA" word mark that the Complainant currently owns was registered in 1983 based on use in Canada since as early as 1981. The Complainant currently owns 90 restaurants in Canada. The Registrant must have been aware of the Complainant's mark at the time he registered the Disputed Domain Name in 2010. The Registrant had no authorization from the Complainant to use a domain name identical to the Complainant's registered trade-mark in order to capture Internet traffic.

54. It is therefore likely that the Registrant intentionally chose the Disputed Domain Name as the likelihood of confusion with the "PAPA JOHN'S" mark was sure to drive internet traffic to the Registrant's website for web users looking for the Complainant's website or for websites related to pizza restaurants or delivery.

55. The Panel thus finds that the Complainant has met its second burden of proof and concludes that the Registrant's registration was made in bad faith pursuant to paragraph 3.5 of the Policy.

### **C. Legitimate Interest**

56. Paragraph 3.4 lists six circumstances that demonstrate a Registrant's legitimate interest in a domain name.

57. In this case, the Disputed Domain Name is identical or confusingly similar with the Complainant's trade-marks and the Registrant has no rights in the "PAPA JOHN'S" registered trade-marks. Paragraph 3.4(a) is therefore not satisfied.

58. Secondly, the Registrant does not appear to have used the Disputed Domain Name in good faith in association with any wares, services or business. At the time of these proceedings, as illustrated by a screenshot of the Registrant's webpage at annex 7 of the Complaint, the website is inactive and offers no information on how to purchase any product but only refers to third-party websites related to pizza restaurants or delivery. The use of the Disputed Domain Name by the Registrant

thus fails to meet the requirement of use under subparagraphs 3.4(b) or (c) on the balance of probabilities.

59. The Registrant was not using the Disputed Domain Name in good faith in association with criticism, review or news reporting as provided by paragraph 3.4(d) of the Policy. Finally, the Disputed Domain Name is not the legal name or other identifier of the Registrant (3.4(e)), nor is it the geographical name of the location of the Registrant's place of business (3.4(f)).

60. It results that none of the criteria in paragraph 3.4 have been satisfied. In view of the above and of the absence of submissions from the Registrant, an evaluation of all evidence presented demonstrates that the Registrant has no legitimate interest in the Disputed Domain Name.

#### CONCLUSION AND DECISION

61. The Panel concludes that the Complainant has rights in the "PAPA JOHN'S" trademarks that predate the registration of the <papajohns.ca> domain name by the Registrant. It also concludes that the Disputed Domain Name is identical or confusingly similar to the Complainant's trade-marks and that the Registrant has no legitimate interest in the Disputed Domain Name. Finally, it finds that the Complainant has shown that the Registrant registered the domain name in bad faith.

62. The Panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name <papajohns.ca> be **transferred** to the Complainant, Papa John's International, Inc.



Hugues G. Richard, sole panelist

Dated: September 9, 2015