



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL DECISION

CIIDRC case number:	20100- CDRP	Decision date: May 24, 2023
Domain Name:	Shakeshack.ca (the “ Domain Name ”)	
Panel:	Melvyn J. Simburg (Chair); James Plotkin, Q.Arb; Stefanie G. Efstathiou	
Complainant:	SSE IP, LLC	
Complainant’ representative:	Daniel Anthony (Smart & Biggar)	
Registrant:	Tony Kasioulis	

1. PROCEDURAL HISTORY

1. This matter is conducted pursuant to the Canadian Dispute Resolution Policy (the “**CDRP**”) and the Canadian Dispute Resolution Rules (the “**CDRP Rules**”) of the Canadian Internet Registry Authority (“**CIRA**”).
2. The procedural history was set out in a letter from the Canadian International Internet Dispute Resolution Centre (“**CIIDRC**”) to the Panel:
 - a. On March 17, 2023, Daniel Anthony of Smart & Biggar LLP filed a Complaint on behalf of the Complainant pursuant to the CDRP and CDRP Rules. The Complaint with the attachments was filed via email.
 - b. On March 17, 2023, the CIIDRC notified CIRA of this proceeding. On the same day, CIRA transmitted its verification response confirming the Registrant’s identity. CIRA also confirmed that it placed the Domain Name on a Registrar LOCK.
 - c. On March 20, 2023, the CIIDRC confirmed Complaint’s compliance with CDRP Rule 3.2 and commenced this administrative proceeding.
 - d. On March 20, 2023, the CIIDRC notified the Registrant of this administrative proceeding.

- e. On April 6, 2023, the Registrant requested an extension from April 10, 2023 to April 14, 2023 to file a response. This request was granted.
 - f. The Registrant filed his Response on April 14, 2023. The CIIDRC found the response was compliant with the CDRP Rules.
 - g. On April 19, 2023, the CIIDRC received additional submissions from the Complainant's counsel with a request that the Panel consider them. The Registrant requested until May 2, 2023 to respond to the Complainant's additional submissions, and provided those submissions to the CIIDRC.
 - h. The CIIDRC informed the parties that the Panel would decide whether to accept the additional submissions.
 - i. The Complaint and the Response were filed in English, which shall be the language of the proceeding.
 - j. In accordance with Paragraph 6 of the CRDP Rules, the CIIDRC shall appoint a three-member Panel, with consideration to the nominees of the parties, and select a Chair.
 - k. The CIIDRC named Melvyn J. Simburg as Chair of the Panel, and James Plotkin, Q.Arb and Stefanie G. Efstathiou as panelists.
 - l. All Panel Members have conducted a diligent search of their records to confirm their impartiality and independence vis-à-vis the parties and counsel. Each Panelist completed and submitted to the CIIDRC a duly completed Statement of Impartiality and Independence pursuant to CDRP Rule 7.
3. Upon due consideration, the Panel has decided to accept both the Complainant's and Registrant's additional submissions.

2. THE PARTIES' CONTENTIONS

A. Complainant Initial Submissions and Evidence

- 4. Together with the Complaint, the Complainant filed the affidavit of Ronald Palmese Jr. sworn March 17, 2023. Mr. Palmese is general counsel to Shake Shack Enterprises, LLC, a corporation related to the Complainant.
- 5. In summary, the Complainant's submissions and evidence are:
 - a. The Complainant is eligible to file this complaint under the CDRP since it meets the Canadian Presence Requirements ("**CPR**"). The Complainant relies on CIPO trademark registrations for SHAKE SHACK (TMA963105), registered on February 16, 2017, and SHAKE SHACK & Design (TMA1094131), registered on February 22, 2021 (the "**Marks**").
 - b. The Complainant owns the Marks. It also owns U.S. and other international registrations for the Marks and related trademarks.

- c. The Complainant is a “famous American fast-casual” restaurant chain with over 400 locations worldwide. Many of the Complainant’s stores are located in major cities in US states that border Canada, including for example, Buffalo, Detroit, Seattle, and Syracuse.
- d. The Complainant has owned the <shakeshack.com> domain name since April 29, 2000, which it uses to host a commercial website associated with its offerings.
- e. The Complainant has been using the Marks in the United States, consistently and continuously, in association with restaurant services since at least 2001.
- f. The Complainant states its revenues grew from USD 2,160,000 in 2005 to USD 112,042,000 in 2014 (the year the Domain Name was registered).
- g. As part of its marketing, the Complainant spends a considerable sum advertising and promoting its services, including through the Internet, on social media, print advertising, and product placement.
- h. The Complainant and the Mark are well-known:
 - i. The Complainant has been referenced in various Canadian publications, such as the National Post, Globe and Mail and Ottawa Citizen. Some of these publications predate the Domain Name’s registration. The Complainant has also been featured in various internationally known US publications, such as the New York Times, the Wall Street Journal and Forbes.
 - ii. The Complainant’s Mark has also been referenced and featured in various popular television shows (e.g., The Daily Show, the Newsroom, How I met Your Mother and Anderson Cooper Live).
 - iii. The Complainant produced web analytics showing search rates for SHAKE SHACK in 2010.
- i. “Rights” under the CDRP include common law rights, and the Complainant has demonstrated sufficient recognition and goodwill within Canada predating the Domain Name’s registration in the Marks.
- j. Apart from the “.ca” suffix, the Domain Name is identical to the Marks. CDRP Paragraph 3.3 states that when conducting a confusion analysis, the Panel should disregard the “.ca” suffix.
- k. The Registrant has no legitimate interests in the Domain Name. Specifically, he appears to fall within none of the non-exhaustive legitimate interest categories listed in CDRP Paragraph 3.4.
 - i. The Registrant does not own a trademark for the words SHAKE SHACK. The Complainant searched the Domain Name’s historical use using the Wayback Machine, which revealed no historical activity at the Domain Name.

- ii. The Domain Name is not registered in association with any wares, services or business in respect of which the Domain Name is clearly descriptive in English or French of: 1) the character or quality of the wares, services or business; 2) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; 3) the place of origin of the wares, services or business.
 - iii. The Domain Name was not registered 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.
 - iv. There is no evidence the Domain Name is registered in good faith in association with any non-commercial activity.
 - v. There is no evidence that the Domain Name represents the Registrant's legal name or surname, or other reference by which the Registrant is commonly identified.
 - vi. The Domain Name is not the Registrant's geographical location or the location of any good faith non-commercial activity by the Registrant.
- l. The Registrant registered the Domain Name in bad faith pursuant to CDRP Paragraphs 3.5(a) and 3.5(b).
 - m. With respect to CDRP Paragraph 3.5(a)—the Domain Name is registered primarily for the purpose of selling, renting, licensing or otherwise transferring registration to the Complainant for valuable consideration in excess of the registrant's actual cost—the Complainant relies on its extensive reputation and popularity and the fact that the Domain Name does not resolve to an active website of any kind. The Registrant appears to have registered the Domain Name at what the Complainant says was the “height” of its “international expansion”.
 - n. With respect to CDRP Paragraph 3.5(b)— the Registrant registered the Domain Name or acquired the Registration to prevent the Complainant from registering the Mark as a Domain Name, provided the Registrant, alone or in concert with others, has engaged in a pattern of registering domain names to prevent persons with Right in Marks from registering them as domain names—the Complainant obtained from CIRA a list of the “.ca” domain names the Registrant has registered. That list reveals the Registrant has registered 28 domain names. Many of them are identical to or confusingly similar with registered trademarks and “.com” domain names predating the Domain Name's registration. The Complainant says this proves the Registrant has engaged in a pattern of abusive domain name registrations aimed at depriving the trademarks' rightful owners from registering their corresponding “.ca” domain names.

B. Registrant's Responding Submissions and Evidence

- 6. The Registrant states that he purchased the Domain Name in preparation to open a dance club. He intended to name the club “shake shack”, and explains he arrived at that name since the club is the “shack” where people would come to “shake” their bodies (dance). In support,

he includes a brief affidavit from his friend essentially stating that he told her about this idea at the time.

7. The Registrant states he never sold a domain name despite his various registrations. He explained that “[a]s business possibilities pop up in my mind... this first thing I do, is purchase a domain name”.
8. The Registrant asserts that, contrary to the Complainant’s submissions, SHAKE SHACK was not well known (if known at all) in Canada in 2014 when he registered the Domain Name. He points out the Complainant’s Canadian trademarks post-date the Domain Name’s registration.
9. The Registrant asserts he was offered money in the past to sell the Domain Name, but that he refused.

C. Complainant’s Reply Submissions

10. Regarding the Registrant’s submissions on bad faith, the Complainant submits that when registering a domain name that corresponds to a well-known brand, the test is not whether one can assert an alternative purpose for registering the Domain Name; the test is whether the Registrant can evidence actual concrete steps towards the realization of that purpose. The Registrant has provided no evidence of any concrete steps towards realizing his alleged dance club plan in the 10 years he has owned the Domain Name, or even that he is in the dance club industry. A vague intention that was never pursued is no defence to a finding of bad faith registration.
11. The Complainant re-iterates its arguments on confusing similarity. Since this is not proper reply, the Panel will not set those submissions out again here.
12. The Complainant also re-iterates its arguments on bad faith registration. Again, since this is not proper reply, the Panel will not set those submissions out again here.

D. Registrant’s Sur-reply Submissions

13. The Registrant submits that the Complainant’s Mark having been “mentioned” in Canada does not make it well-known.
14. The Registrant submits he was unaware of any Shake Shack restaurants when he registered the Domain Name.
15. The Registrant asserts (but does not explain) that the Complainant is wrong that he registered some 28 other domain names.
16. In response to the submission that he has never done anything to develop his domains, the Complainant points to a link (<https://swingersgolf-2023.myshopify.com/password>), which appears to be an e-commerce shop corresponding with a different domain name he has registered. The landing page says “COMING SOON” and includes an email subscription field with the text “FIND OUT WHEN WE OPEN” above it.

E. Remedy Sought

17. The Complainant seeks an order to have the Domain Name transferred.

3. DISCUSSION AND FINDINGS

18. The Complainant must establish eligibility under the CPR and meet the three-part test set out in CDRP paragraph 3.1 in respect of each Domain Name.

19. For the reasons that follow, the Panel is satisfied the Complainant meets the CPR and has established all elements in the CDRP paragraph 3.1 analysis. The Panel will address the CPR and each of the paragraph 3.1 requirements in turn.

A. Eligibility

20. The Complainant relies on Canadian trademark registrations for SHAKE SHACK (TMA963105) and SHAKE SHACK & Design (TMA1094131) as grounds for meeting the CPR.

21. CPR paragraph 2(q) speaks to meeting the CPR based on a Canadian trademark registration:

Trade-mark registered in Canada. A Person which does not meet any of the foregoing conditions, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark.

22. In this case, and as noted below, the Domain Name is identical to the Mark. Accordingly, the Complainant's Canadian trademark registrations are sufficient to render this Complaint eligible under the CPR.

B. CDRP Requirements

23. In accordance with Paragraph 3.1 of the CDRP, the Complainant must show:

- a. The Domain Name is Confusingly Similar to a trademark or service mark in which the Complainant has rights predating the Domain Name' registration, and that it continues to have such rights;
- b. The Registrant has no legitimate interest in the Domain Name; and
- c. The Domain Name has been registered in bad faith.

24. The onus is on the Complainant to prove the Domain Name is confusingly similar and was registered in bad faith. Complainant must also provide "some evidence" that the Registrant lacks a legitimate interest in the Domain Name [**CDRP paragraph 4.1**]. The onus then shifts to the Registrant to prove a legitimate interest [**ibid.**].

25. The Panel will consider each requirement in turn.

C. Analysis

1. The Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

26. On the first limb of the analysis, the Complainant must establish two things: 1) that it has active rights to a “Mark” that precede the Domain Name’s registration; and 2) that the Domain Name is confusingly similar to that Mark.

27. CDRP paragraph 3.2 defines “Mark”, inter alia as follows:

(a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person.

...

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

28. CDRP paragraph 3.3 states that in determining whether a domain name is “Confusingly Similar” to a Mark, the Panel shall only consider 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”.

29. CDRP paragraph 1.2 clarifies that the “.ca” suffix is excluded from the confusion analysis. That the Complainant does not possess trademark registrations including “.ca” is therefore irrelevant to the analysis.

30. Based on the evidence, the Panel is satisfied that the Complainant’s rights in the Mark predate the Domain Name’s registration. The registered trademarks the Complainant relies upon to establish eligibility under the CPR post-date the Domain Name. They thus cannot form the basis for the confusion analysis.

31. However, upon review of the Complainant’s evidence, the Panel is satisfied that the Complainant established sufficient goodwill and reputation in Canada in the years preceding the Domain Name’s registration to give rise to rights in the Mark. This evidence includes proof of media coverage within Canada, as well as web traffic from within Canada. Although somewhat less persuasive, the Panel also notes the references to the Mark in widely distributed American media sources, such as the New York Times and various television programs that are available in Canada.

32. With respect to the second prong, the Panel concludes the Domain Name is identical to the Mark. Accordingly, it meets the confusingly similar threshold.

33. In light of the foregoing, the Panel is satisfied the Complainant has met the threshold under CDRP paragraph 3.1(a) on a balance of probabilities in respect of the Domain Name.

2. That the Registrant has No Legitimate Interest in the Domain Name

34. The CDRP places the initial onus on the Complainant to establish that the Registrant has no legitimate interest in the Domain Name. Given the difficulty inherent in proving a negative, the CDRP only requires the Complainant to plead “some evidence” sufficient to establish a lack of legitimate interest. The Registrant may then attempt to rebut that evidence by establishing a legitimate interest on a balance of probabilities [CDRP paragraph 4.1; [14541-CDRP \(calvinkleincanadaoutlet.ca\)](#), para. 53].
35. In this regard, the Complainant lists the six non-exhaustive legitimate interest examples in CDRP paragraph 3.4 and argues why they do not apply to the present case.
- i. According to CDRP subparagraph 3.4(a), the Registrant does not own a trademark for the words SHAKE SHACK and has never used a Mark in this respect or the Domain Name as a Mark. The Complainant searched the Domain Name’s historical use using the Wayback Machine, which revealed no historical activity at the Domain Name. The Registrant did not reply with concrete evidence to the argument, other than submitting an attestation from a friend (Schedule A) that on a night in 2014 the Registrant mentioned that the Domain Name would be “a great name for a Dance club”. This cannot be seen as any good faith use or use at all and there cannot be drawn any legitimate rights from such conversation. The fact remains that the Registrant has never had a trademark for the Domain Name and hasn’t had any activity on the Domain Name.
 - ii. According to CDRP subparagraphs 3.4(b) and (c), the Domain Name is not registered in association with any wares, services or business in respect of which the Domain Name is clearly descriptive in English or French of: 1) the character or quality of the wares, services or business; 2) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; 3) the place of origin of the wares, services or business. Furthermore, the Domain Name was not registered in good faith in association with any wares, services or business for which the Domain Name was understood in Canada to be the generic name thereof in any language. The Panel agrees that as a coined term “shake shack” cannot be descriptive or generic, and the Complainant has sufficiently proven that. The Registrant has not sufficiently proven that the term is descriptive or generic and has not provided any evidence to support such argument. As the onus lies on the Registrant to prove legitimate interest on the balance of probabilities in this respect, a mere mention of a “great name for a dance club” cannot be seen sufficient in this respect.
 - iii. There is no evidence the Domain Name is registered in good faith in association with any non-commercial activity according to CDRP subparagraph 3.4(d). The Registrant mentions only that “All the websites I own have they own specific reason for ownership”. This is not sufficient evidence to prove that the registration was in good faith and in connection with a non-commercial activity.
 - iv. According to CDRP subparagraph 3.4(e), there is no evidence that the Domain Name represents the Registrant’s legal name or surname, or other reference by which the

Registrant is commonly identified. The Registrant did not provide any evidence in this regard.

- v. According to CDRP subparagraph 3.4(f), the Domain Name is not the Registrant's geographical location or the location of any good faith non-commercial activity by the Registrant. The Registrant did not provide any evidence in this regard.

36. In light of the foregoing, the Panel is satisfied the Complainant provided "some evidence" that the Registrant lacks a legitimate interest in the Domain Name. The Registrant has failed to rebut that evidence on a balance of probabilities.

3. That the Registrant has Registered the Domain Name in Bad Faith

37. CDRP paragraph 3.5 provides a non-exhaustive list of circumstances demonstrating bad faith registration. The Complainant relies on paragraph 3.5(a) and (b).

38. Complainant alleges that the Registrant has registered the Domain Name for the purpose of selling, renting, licensing, or otherwise transferring registration to the Complainant for valuable consideration. Doing so would be a violation of CDRP paragraph 3.5(a).

39. In support of its position, Complainant points out that: (i) SHAKE SHACK was a popular brand earlier than the Domain Name's registration date; (ii) although there were no Shake Shack restaurants operating in Canada (and there still are not) that the brand was likely well-known in Canada; (iii) the Domain Name does not resolve to any online business presence; (iv) Registrant has registered 28 domain names including several that are identical or confusingly similar to well-known brands; (v) the Domain Name resolves to a web page that states "shakeshack.ca is parked free, courtesy of GoDaddy.com," and the page has links to search "Recipes," "The Shake Shack", and "Menu Shake Shack"; and (vi) at the time of registration, Complainant was engaged in active international expansion.

40. None of Complainant's evidence points directly to an intent to transfer the Domain Name for a profit. The Registrant denies that intent and points out that he has never sold a domain name despite offers received. The Complainant has not refuted that evidence. For these reasons, the Panel finds that Complainant has not established, on a balance of probabilities, bad faith registration under paragraph 3.5 (a).

41. Paragraph 3.5(b) of the Policy provides that for the purposes of paragraph 3.1(c) and 4.1(b), the Panel will find evidence that a Registrant has registered a domain in bad faith if:

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 Right in Marks from registering the Marks as domain names

42. In support of its position, Complainant references the evidence listed above, and in particular points out that at least 12 of Registrant's domain names are identical or confusingly similar to well-known trademarks recorded in Canada or the U.S.
43. The Registrant asserts that: (i) SHAKE SHACK in 2014 was not a mark or business well-known in Canada; (ii) Registrant did not personally know of the brand; and (iii) Registrant wanted to register the Domain Name in connection with starting a dance club business.
44. Both parties have cited cases in support of their positions.
45. The Panel has reviewed the cases and applied them to the facts of this dispute. The Panel finds that the Registrant has engaged in a pattern of registering domain names, and that despite the Registrant's denials and stated intent to start a dance club at some point after registration of this Domain Name, the Panel finds from the evidence, and from reasonable inferences to be drawn from the evidence, that the Registrant's registration of the Domain Name and of several other domain names, was undertaken at least in part to prevent the Complainant from registering its mark as a domain name, and to prevent others with rights in their marks from registering the marks as domain names.
46. In particular, the Registrant's assertion that he intended to open a dance club in 2014 called "Shake Shack" is inadequately supported. He has provided no evidence whatsoever of any steps taken to open a dance club, where he planned to open it, or what came of his plans in the intervening nine years. Merely claiming an idea to start a business is insufficient to support Registrant's contention that the Domain Name was registered in connection with alleged dance club services and not to prevent use of the Domain Name by a well-known business operating in the U.S. and expanding internationally. Given this paucity of evidence, the Panel is unable to find any basis to challenge the Complainant's evidence and argument that the elements of CDRP paragraph 3.5(b) have been established in this case.
47. In light of the foregoing, the Panel finds the Complainant has established, on a balance of probabilities, that the Domain Name was registered in bad faith.


4 DECISION and ORDER

48. For the above reasons, in accordance with paragraph 4 of the CDRP and paragraph 12 of the CDRP Rules, the Panel finds in the Complainant's favour and orders that the Complainant is entitled to transfer of the domain name "shakeshack.ca" from the Registrant to the Complainant. Once Complainant provides CIRA with the contact information necessary for the transfer and at least 30 days have elapsed thereafter, CIRA is to transfer the domain name in accordance with Complainant's instructions, this Decision, and CIRA policies.

Made at Seattle, Washington on May 24, 2023

(Signatures on following page)

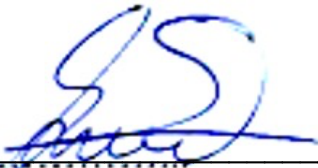
PANEL SIGNATURE



Melvyn J. Simburg (Chair)



James Plotkin, Q.Arb



Stefanie G. Efstathiou

