

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

**DECISION**

Domain Name: vibram.ca

Complainant: Vibram S.p.A.

Registrant: Interex Corporate Registration Services Inc.

Registrar: dot-ca-registry.ca

Service Provider: Resolution Canada

Panelist: Eric Macramalla (Chair), David Allsebrook and Bruce Richardson

**A. THE PARTIES**

1. The Complainant is Vibram S.p.A. (the “Complainant”), which is a company organized under the laws of Italy and located in Albizzate, Italy.
2. The Registrant is Interex Corporate Registration Services Inc. (the “Registrant”) located in Charlottetown, P.E.I.

**B. DISPUTED DOMAIN NAME & REGISTRAR**

3. The disputed domain name is vibram.ca (the “Domain Name”).

**C. PROCEDURAL HISTORY**

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on October 27, 2016. The Date of Commencement of the proceeding was November 8, 2016.
6. The Registrant response was deemed deficient by the Provider for failing to provide the preferred method of communication as well as certain exhibits appearing incomplete. An Amended Response was filed on December 9, 2017.
7. On January 4, 2017, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

**D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT**

8. The Complainant is the owner of multiple Canadian trademark registrations comprised of, or containing, the element VIBRAM. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

**E. THE POSITIONS OF THE PARTIES**

The Complainant's Position

9. The Complainant's submissions include the following.
10. The Complainant's company is based in Albizzate, Italy. In part, it manufactures and sells VIBRAM branded rubber outsoles for footwear. The Complainant's VIBRAM trademark is a coined term.
11. The Complainant is the owner of the following Canadian trademark registrations, which shall be collectively referred to as the VIBRAM Trademarks:

<b>Trademark</b>	<b>Reg. No.</b>	<b>Reg. Date</b>
VIBRAM & Design	TMA745687	2009-08-19
VIBRAM & Design	TMA873801	2014-03-19
VIBRAM Design	TMA745686	2009-08-19
VIBRAM Design	TMA285603	1983-12-09
VIBRAM	TMA220414	1977-05-06
VIBRAM & DESIGN	TMA233870	1979-06-22
VIBRAM FIVEFINGERS	TMA871264	2014-02-13
VIBRAM Design	TMA735128	2009-02-24

12. The Complainant has used the VIBRAM trademark in Canada since at least as early as 1977.
13. The Complainant is the owner of the domain name vibram.com, which was registered in 1995.
14. The Domain Name is confusingly similar with the VIBRAM Trademarks. Further, the Registrant does not have a legitimate interest in the Domain Name. Finally, the Registrant registered the Domain Name in bad faith as the Registrant engaged in a pattern of unauthorized domain name registrations containing third party trademarks.
15. The Complainant is seeking the transfer of the Domain Name.

## The Registrant's Position

16. The Registrant has argued as follows:
17. The Registrant “requests of the Panel, for the purposes of the Complaint, that reference to, and reliance upon, CIPO Application Number 1795321 be struck from the Complaint. An application for a trade-mark is not a trade-mark, regardless of the magical thinking of the Complainant.”
18. The Registrant “requests of the Panel, for the purposes of the Complaint, that reference to, and reliance upon, CIPO TMA871264 'Vibram Fivefingers' be struck from the Complaint. The domain name in question is not identical to the trade-mark being referenced, and importantly, the registration domain name on 31 August 2009 was prior to the registration of the trade-mark.”
19. The Registrant “calls into question the validity of the design trade-mark TMA735128 and design trade-mark TMA233870 as the Complainant ceased use of the polygram design more than five years ago.”
20. The Registrant “calls into question the validity of trade-mark TMA220414 for *Semelles, talons, talonnettes, protège-talons, souspeids, plaques, intersemelles, en caoutchouc naturel, synthétique et plastique.*” as these terms are unknown, and Complainant has not presented any evidence it is selling “*Semelles, talons, talonnettes, protège-talons, souspeids, plaques, intersemelles, en caoutchouc naturel, synthétique et plastique* in Canada, as Respondent finds no trace of such sales in Canada.”
21. The Registrant argues that the Complaint should fail on the basis of the doctrine of laches or delay given that the Complaint was filed seven (7) years after the registration of the domain name.

## **F. DISCUSSION & REASONS**

22. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:
  - (a) the Registrant's 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 3.5 of the Policy;  
  
and the Complainant must provide some evidence that:
  - (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy.

### CONFUSINGLY SIMILAR - PARAGRAPH 3.3

23. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

#### Rights in the Marks & Rights that Predate the Domain Name Registration Dates

24. Where the Complainant relies upon a trademark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use. In cases where a trademark registration matured to registration after the domain name registration date, or the Complainant is relying on common law rights, it must establish rights that predate the domain name registration.
25. The Domain Name was registered on August 31, 2009.
26. A number of the Complainant's VIBRAM Trademarks issued to registration prior to the August 31, 2009 registration date of the Domain Name. Therefore, the Panel concludes that the Complainant has established rights that precede the registration of the Domain Name.
27. This is not the appropriate forum to call into question the validity of the trademark registrations being relied upon by the Complainant. Those registrations are *prima facie* valid, and should the Registrant wish to challenge the validity of the trademark registrations, it may do so in the Federal Court.

#### Confusingly Similar

28. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
29. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
30. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant's corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant's marks based upon the appearance, sound or the ideas suggested by the mark.
31. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-marks Act*, when assessing the likelihood of confusion between

marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.

32. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy's summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.
33. The Panel concludes that the Domain Name is confusingly similar with the Complainant's VIBRAM Trademarks, given that the Domain Name so nearly resembles the VIBRAM Trademarks in appearance, sound and in the ideas suggested so as to be likely to be mistaken for these marks. The Domain Name is comprised exclusively of the VIBRAM Trademark, and as a result, the Registrant cannot escape a finding of confusing similarity.

#### Conclusion - Confusion

34. The Panel finds that the Domain Name is confusingly similar with the VIBRAM Trademarks in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

#### BAD FAITH REGISTRATION

35. The Complainant has alleged that the Registrant has engaged in a pattern of unauthorized domain name registrations containing third party trademarks to which it is not entitled. Specifically, the Complainant has relied upon previous CDRP decisions involving the Registrant, as well as Daniel Mullen, the administrative contact associated with the Domain Name.
36. Paragraph 3.5(b) provides, in part, that the Complainant must establish that the Registrant "*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.*" [emphasis is that of the Panel]
37. The Policy does not, therefore, impose a temporal limitation on which unauthorized domain name registrations the Complainant may rely upon when establishing a "pattern" of registrations. The Complainant may rely upon domain names previously owned by the Registrant to establish a "pattern".
38. On this basis, the Panel concludes that these registrations constitute evidence of bad faith registration as per Paragraph 3.5(b).

### **LEGITIMATE INTEREST**

39. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
40. As per paragraph 4.1 of the Policy, the Complainant must provide “some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6”.
41. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
43. The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Domain Name. The Complainant did not authorize the registration and the domain name is likely to mislead the public into believing that the Registrant is affiliated with, or endorsed by, the Complainant.
44. The Registrant has sought to legitimize the Domain Name by arguing that it constitutes a surname. The Panel has concluded, however, that “Vibram” is not a commonly known surname in Canada. Further, the domain name is not the legal name of the Registrant or a name, surname or other reference by which the Registrant is commonly identified. For these reasons, the Registrant has not legitimized the domain name registration.
45. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

### **The Defense of Laches**

46. The Registrant has argued that the Complaint should fail on the basis of laches given that the Complaint was filed seven (7) years after the registration of the domain name. The Panel is unconvinced by the argument and believes it should fail.
47. The doctrine laches does not generally apply under the CDRP and a delay in bringing a Complaint does not by itself prevent a Complainant from filing or succeeding under the CDRP. Even if the equitable doctrine of laches did apply, the Registrant cannot establish that it has been prejudiced in any manner by the delay. The Domain Name is not actively being used. Furthermore, the length of time the Registrant has owned the disputed domain name does not excuse this clearly improper Domain Name registration.

### **DECISION & ORDER**

48. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.

49. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name vibram.ca.

Dated at Ottawa, Ontario, Canada, this 25<sup>th</sup> day of January, 2017.



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Eric Macramalla (Chair)  
David Allsebrook  
Bruce Richardson