

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

**DECISION**

Domain Name: redwingshoes.ca  
Complainant: Red Wing Shoe Company, Inc.  
Registrant: Computer King  
Registrar: Webnames.ca Inc.  
Service Provider: Resolution Canada Inc.  
Panelist: Alessandro Colonnier

**A. THE PARTIES**

1. The Complainant is Red Wing Shoe Company, Inc., having an address at 314 Main Street, Riverfront Centre, Red Wing, Minnesota 55066 United States of America (the “Complainant”).
2. The Registrant is Computer King, having an address at #104 3016 – 19<sup>th</sup> Street North East, Calgary, Alberta T2E 6Y9 Canada (the “Registrant”).

**B. DISPUTED DOMAIN NAME & REGISTRAR**

3. The disputed domain name is redwingshoes.ca (the “Domain Name”) and the Registrar is Webnames.ca Inc.

**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 March 2, 2018.
6. The Registrant did not file a response.
7. On May 2, 2018, 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 that would prevent it from so acting.

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

8. The Panel must be satisfied that the Complainant is eligible to bring a Complaint with CIRA and fulfills one of the criteria set out in paragraph 2 of the *CIRA Canadian Presence Requirements for Registrants*, Version 1.3 (the “CPRR”).

9. The Complainant submits that it is eligible to submit its Complaint by virtue of Canadian Trademark Registration Nos. TMA413025 (RED WING), TMA199695 (RED WING SHOES & DESIGN), TMA226614 (RED WING SHOE STORE), TMA291041 (RED WING & WING DESIGN), TMA942159 (RED WING SHOES & WINGS DESIGN) and TMA841943 (RED WING & WING DESIGN) (the “Red Wing Marks”) in accordance with paragraph 2(q) of the CPRR. The Panel accepts this position.

**E. THE POSITIONS OF THE PARTIES**

The Complainant’s Position

10. The Complainant is a footwear company that was founded in 1905, and for over 110 years, the Complainant has manufactured high grade footwear. At the turn of the 20<sup>th</sup> century, the Complainant saw a necessity for shoes specifically designed for industries such as mining, logging and farming, and developed a boot that was tough but comfortable.
11. Footwear under the Complainant’s “Red Wing” brand is now sold in over 100 countries across the world, including Canada. Indeed, the Complainant operates its business in Canada under the corporate entity Red Wing Canada, Inc.
12. The Complainant’s Red Wing Marks are distinctive, widely recognized trademarks, and the “Red Wing” branded boots have become the paragon in the mining, logging and farming industries.
13. The Complainant has a strong reputation among consumers for offering quality, well-respected name brand footwear. The Complainant has invested substantial sums of money in developing and marketing its product and services under the Red Wing Marks and has developed substantial goodwill and customer loyalty.
14. The Registrant Computer King acquired the Domain Name on or about July 9, 2017. However, the Domain was originally registered on April 5, 2005 by 1126065 Alberta inc., having its administrator as Ralph Hill. Prior to acquiring the Domain Name, Registrant was the computer service company for Reddhart, a group of individuals including Mr. Hill.
15. For a period of time before the Registrant’s acquisition of the Domain Name, Reddhart used such Domain Name to forward to a website that referred customers to Reddhart’s stores. The Domain Name included reference to Complainant’s competitors and also directed consumers to third party sites.
16. After the Complainant informed Reddhart that it could not use its Red Wing Marks, Reddhart agreed to stop. Reddhart and the Complainant entered into an agreement that stipulated Reddhart would stop using the Red Wing Marks and any names confusingly similar to “Red Wing”. Despite the agreement, Reddhart transferred the Domain Name to the Registrant.

17. Registrant knew of Complainant's rights in the Red Wing Marks based on its involvement with Reddhart's website. The Registrant has acquired and used the Domain Name that is confusingly similar to the Complainant's Red Wing Marks in bad faith. Indeed, the website associated with the Domain Name refers to "RED WING SHOE STORES" and directs consumers to a third part website at Reddhart.ca, which sells brands that compete with the Complainant.
18. Finally, Registrant profits from the registration and use of the Domain Name. Search engines are likely to index Registrant's website based on those terms, and indeed a Google search provides results for the website reddhart.ca.
19. The Complainant has requested the transfer of the Domain Name to it.

The Registrant's Position

20. The Registrant did not file a response.

**F. DISCUSSION & REASONS**

21. 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.

**H. CONFUSINGLY SIMILAR – PARAGRAPH 3.3**

22. To satisfy this branch of the test, the Complainant must demonstrate that: i. it has rights in a mark; ii. the rights in its mark predate the registration date of the Domain Name; and iii. the Domain Name is confusingly similar with the mark.
23. The Complainant has provided evidence that it is the owner of the Red Shoe Marks, which were registered as early as 1974. These rights predate both the acquisition date of the Domain Name by the Registrant (July 2017) and the original registration of the Domain Name (May 2005).
24. 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.

25. 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).
26. In this case, the relevant part of the Domain Name is “redwingshoes”. The Panel notes that the Red Wing Marks include trademark registrations for the words “RED WING” and “RED WING SHOE STORE” and for the design “RED WING SHOES & DESIGN”. These marks are nearly identical to the relevant part of the Domain Name. Accordingly, the Panel finds that the Domain Name is confusingly similar with the Red Wing Marks in which the Complainant had rights prior to the registration and acquisition date of the Domain Name, and continues to have such rights.

**I. BAD FAITH REGISTRATION**

27. To succeed, the Complainant must prove on a balance of probabilities that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy sets out a non-exhaustive list of criteria that may establish bad faith registration.
28. The Complainant relies on sub-Paragraph 3.5(c), which applies when “the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant’s licensor or licensee of the Mark, who is a competitor of the Registrant”.
29. The Complainant also relies on sub-Paragraph 3.5(d), which applies when “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.
30. As shown from the Complainant’s submission, the Domain Name resolves to a parked webpage promoting a competitor of the Complainant, Reddhart.ca. The webpage also displays the logo of the Registrant, which is a hyperlink that appears to resolve to the Registrant’s corporate website.
31. The Domain Name says in part that “If you are interested in finding a quality, full service, supplier of Red Wing branded footwear, plus other fine safety footwear brands such as Canada West, Wolverine, CAT, Blundstone, and Mellowwalk, please go to Reddhart.ca”.
32. The Registrant is quite clearly attracting users to the Registrant’s website by creating a likelihood of confusion with the Complainant’s Red Shoe Marks. When a user arrives at the Domain Name, said user is directed to either visit the Complainant’s competitor, or the Registrant’s corporate website.
33. The Panel therefore accepts the Complainant’s position and concludes that the Registrant has registered the Domain Name in bad faith pursuant to sub-Paragraph 3.5(d) of the Policy.

34. As a result of the foregoing conclusion, the Panel finds it unnecessary to discuss the Complainant's arguments with respect to sub-Paragraph 3.5(c) of the Policy.

**J. LEGITIMATE INTEREST**

35. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name. Paragraph 4.1 of the Policy requires the Complainant to provide "some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6".

36. The Panel finds that the Registrant has no legitimate interest in the Domain Name. According to the Complainant, the Registrant is a computer service company of the original registrant of the Domain Name. Although the original registrant transferred the Domain Name to the current Registrant, the website still redirects to a competitor's website; namely, Reddhart.ca. The Registrant also has its own logo on the front page of the Domain Name, which hyperlinks to its corporate website for computer services.

37. The Complainant has shown that the Registrant does not fall into any one of the categories to demonstrate that the Registrant has a legitimate interest in the Domain Name. Namely, the Panel does not believe that the Registrant's use shows that the Domain Name was a mark, used in good faith by the Registrant and that the Registrant had rights in the mark. Therefore, sub-Paragraph 3.4(a) is not satisfied. The Panel also does not believe that the Domain Name was registered in good faith in association with any wares, services or business, so the Registrant's use cannot fall under sub-Paragraphs 3.4(b) or (c). The Registrant was not using the Domain Name in good faith in association with criticism, review or news reporting (paragraph 3.4(d)). Finally, the Domain Name is not the legal name or a name, surname or other reference by which the Registrant was commonly identified (3.4(e)), nor is it the geographical name of the location of the Registrant's place of business (3.4(f)).

38. Therefore, none of the criteria in Paragraph 3.4 have been satisfied and the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

**K. CONCLUSION AND ORDER**

39. For the reasons set out above, the Panel decides this dispute in favour of the Complainant.

40. Pursuant to Paragraph 4.3 of the Policy, the Panel orders the transfer of the Domain Name redwingshoes.ca to the Complainant.

  
Alessandro Colonnier for the Panel

May 17, 2018