

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

DECISION

Domain Name: craftsman.ca
Complainant: Stanley Black & Decker, Inc.
Registrant: Antonia Ojo
Registrar: BareMetal.com Inc.
Service Provider: Resolution Canada Inc.
Panelist: Alessandro Colonnier

A. THE PARTIES

1. The Complainant is Stanley Black & Decker, Inc., having an address at 1000 Stanley Drive, New Britain, Connecticut 6053 United States of America (the “Complainant”).
2. The Registrant is Antonia Ojo, having an address at 1201 – 11871 Horseshoe Way, Richmond, British Columbia V7A 5H5, Canada (the “Registrant”).

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is craftsman.ca (the “Domain Name”) and the Registrar is BareMetal.com 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”) and the proceeding was commenced on March 4, 2019.
6. The Registrant did not file a response.
7. On April 9, 2019, 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 its Canadian Trademark Registration No. UCA27901 (CRAFTSMAN) (the “Craftsman Mark”). Having a trademark registered in Canada is sufficient pursuant to paragraph 2(q) of the CPRR and therefore the Panel accepts this position.

E. THE POSITIONS OF THE PARTIES

The Complainant’s Position

10. The Complainant is a diversified global provider of hand tools, power tools and related accessories, electronic security solutions, healthcare solutions, engineered fastening systems, and more. The Complainant is the owner of the legendary and best-selling CRAFTSMAN tool brand covering over 80 product categories and over 6000 products.
11. The Complainant has numerous trademark registrations comprised of or containing CRAFTSMAN in jurisdictions throughout the world, including the Craftsman Mark, which has been registered in Canada since 1947 and first used in Canada in 1927. The Complainant also has numerous trademark registrations that include the word “CRAFTSMAN”.
12. The Complainant is also the owner of numerous CRAFTSMAN domain names and websites, including craftsman.com.
13. The Registrant registered the Domain Name on January 3, 2007. The Domain Name points to a pay-per-click website featuring sponsored links to competitors of the Complainant, while prominently featuring the Craftsman Mark.
14. The Complainant first issued a cease and desist letter to the Registrant on October 9, 2018. After no response was received, the Complainant sent a follow up letter on October 17, 2018. No reply was ever received.
15. According to the Complainant, the Registrant is a serial cybersquatter, having registered numerous unauthorized dot-ca domain names that are comprised of, contain, or are confusing with third party trademarks to which the Registrant does not appear entitled.
16. The Registrant has also been named as Registrant in other disputes before this Panel; namely, CIRA Dispute Nos. 00364 and 00307. In both decisions, the domain name was transferred.
17. The Craftsman Mark is confusingly similar to the Domain Name as they are identical. The Registrant has engaged in a pattern of registering domain names in accordance with Paragraph 3.5(b) of the Policy and has attempted to attract users

to the Domain Name for commercial gain in accordance with Paragraph 3.5(d) of the Policy. The Registrant has also demonstrated bad faith in view of the surrounding circumstances. The Complainant does not have any relationship with the Registrant and the Registrant does not fall within any of the categories listed in Paragraph 3.4 of the Policy such that the Registrant has no legitimate interest in the Craftsman Mark.

18. The Complainant has requested the transfer of the Domain Name to it.

The Registrant's Position

19. The Registrant did not file a response.

F. DISCUSSION & REASONS

20. 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

21. 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.
22. The Complainant has provided evidence that it is the owner of the Craftsman Mark, which has been registered in Canada since 1947. These rights easily predate the January 2007 registration date of the Domain Name.
23. 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.
24. 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).

25. In this case, the relevant part of the Domain Name is “craftsman”. This is identical to the Craftsman Mark, such that the Panel finds that the Domain Name is confusingly similar with the Craftsman Mark.

I. BAD FAITH REGISTRATION

26. 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.

27. The Complainant relies on both sub-Paragraphs 3.5(b) and 3.5(d) and also relies on bad faith not explicitly referred to in Paragraph 3.5 in view of the surrounding circumstances.

28. Sub-Paragraph 3.5(b) states that “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”.

29. As previously noted by this Panel, sub-Paragraph 3.5(b) is a two-part test:

- a. the Registrant has to have “registered the domain name... in order to prevent the Complainant... from registering the Mark as a domain name”; and,
- b. the Registrant has to have “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”.

30. As noted by the Complainant, the Craftsman Mark is famous around the world and has been in use in Canada since the 1920s. Further, the Complainant has provided evidence that it has rights in many other trademarks in Canada and abroad incorporating the word “craftsman”. It is therefore reasonable to conclude that the Registrant would have been aware of the Craftsman Mark and of the likely confusion between the Domain Name and said Craftsman Mark. The Panel therefore accepts that the Registrant would have registered the Domain Name to prevent the Complainant from doing so, satisfying the first part of the test.

31. As shown from the Complainant’s submissions and outlined above, the Registrant appears to have registered hundreds of domain names that are comprised of, contain, or are confusing with third party trademarks.

32. As noted, having as few as two domain name registrations is sufficient to establish that a registrant has engaged in a “pattern” of the abusive registrations for the purpose of the Policy.

33. From the evidence, it is quite clear to the Panel that this Registrant has engaged in a pattern of registering domain names to prevent persons who have rights in marks from doing so themselves. The Panel therefore accepts the Complainant's position satisfying the second part of the test.
34. In view of the foregoing, the Panel concludes that the Registrant has registered the Domain Name in bad faith pursuant to sub-Paragraph 3.5(b) of the Policy.
35. As a result of this conclusion, the Panel finds it unnecessary to discuss the Complainant's arguments with respect to sub-Paragraph 3.5(d) of the Policy and its submissions with respect to an additional ground of bad faith in view of the surrounding circumstances.

J. LEGITIMATE INTEREST

36. 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".
37. The Complainant has noted that the Craftsman Mark has been used and registered in Canada long before the registration of the Domain Name, and that the Domain Name is confusingly similar to the Craftsman Mark. Accordingly, the Complainant submits that it has satisfied its initial burden by demonstrating that it, and not the Registrant, has a legitimate interest in the Domain Name.
38. Contrary to the Complainant's submissions, the Panel notes that the burden is not to demonstrate whether the Complainant and not the Registrant has a legitimate interest in the Domain Name. Indeed, the burden is to provide some evidence that the Registrant has no legitimate interest in the Domain Name.
39. Notwithstanding the foregoing and based on a review of the Complainant's evidence and its other submissions, the Panel is of the view that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.
40. In particular, the Complainant has indicated that it is not and has never been in any relationship with the Registrant and that the Registrant has never been licensed or otherwise authorized to register or use the Craftsman Mark in any manner whatsoever.
41. The Complainant has further provided some evidence that the Domain Name was not a mark that the Registrant used in good faith and that the Registrant had rights in the mark. The Complainant has also met its burden in showing that the Domain Name is not a clearly descriptive or generic name associated with the wares or services offered on the website, and that the Registrant did not use the Domain Name in good faith in association with a non-commercial activity. Finally, the Complainant has shown that the Domain Name is not the legal name of the Registrant or some other name by which it was commonly identified, nor is the

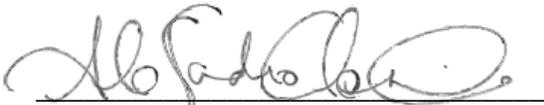
Domain Name the geographic name or the location of the Registrant's non-commercial activity or business.

42. 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

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

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



Alessandro Colonnier for the Panel

April 23, 2019