

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

DECISION

Domain Name: purellhandsanitizer.ca

Complainants: GOJO Industries, Inc.

Registrant: Water by Wave Inc.

Registrar: Domain Robot Enterprises Inc.

Service Provider: Resolution Canada Inc.

Panelist: Alessandro Colonnier

A. THE PARTIES

1. The complainant is GOJO Industries, Inc., having an address at One GOJO Plaza #500, Akron, Ohio, 44311, United States (the “Complainant”).
2. The registrant is Water by Wave Inc., having an address at 1 Yonge Street, Suite 1801, Toronto, Ontario, M5E 1W7, Canada (the “Registrant”).

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is purellhandsanitizer.ca (the “Domain Name”) and the Registrar is Domain Robot Enterprises Inc.

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy*, Version 1.3 (August 22, 2011) (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules*, Version 1.5 (July 28, 2014) (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 their complaint (the “Complaint”) on June 22, 2020. However, the Provider issued a Notice of Deficient Complaint on June 24, 2020 and the Complainant filed an Addendum to the Complaint on June 24, 2020. The Date of Commencement of the Proceeding was June 25, 2020.
6. The Registrant did not file a response.
7. On July 24, 2020, 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 submitted that it is eligible to submit its Complaint by virtue of Canadian Trademark Registration Nos. TMA499624 (PURELL), TMA770777 (PURELL & DESIGN), TMA995090 (PURELL), TMA1065033 (PURELL CRT HEALTHY SOAP), TMA1071338 (PURELL HEALTHY SOAP), and TMA1074766 (PURELL SINGLES) (the “Purell Marks”).
10. The Panel accepts that the Complainant is the owner of the Purell Marks, and that they are eligible to initiate a proceeding in accordance with paragraph 2(q) of the CPRR.

E. THE POSITIONS OF THE PARTIES

The Complainants’ Position

11. The Complainant is a long-recognized manufacturer of hand-hygiene and skin-care products. The Complainant introduced its best-known product, PURELL® Instant Hand Sanitizer, in 1991. Over the past 30 years, the Complainant’s Purell brand has become world-famous, recognized, and trusted by millions for its safe, effective, high-quality, and environmentally friendly products.
12. The Complainant has marketed products bearing its Purell family of marks across the globe and has registered many of those marks around the world, including with the Canadian Intellectual Property Office (CIPO).
13. On May 23, 2020, the Registrant registered the Domain Name, which wholly incorporates the Complainant’s Purell word mark. The Domain Name combines the Purell word mark with language identifying the type of goods the Complainant markets with its Purell Marks.
14. The Complainant has not licensed or authorized the Registrant to register the Domain Name or to use any of the Complainant’s Purell Marks in conjunction with the Registrant’s business or for any other purpose. The Registrant is not associated with, sponsored by, or endorsed by the Complainant in any way and the Registrant is a direct competitor of the Complainant in the hand-sanitizer market.
15. The Complainant submitted that the Domain Name is confusingly similar to its Purell Marks, that it was registered in bad faith, and that the Registrant has no legitimate interest in the Domain Name.
16. The Complainant has requested that the Domain Name be transferred to it.

The Registrant's Position

17. The Registrant did not file a response.

F. DISCUSSION & REASONS

18. 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.

G. CONFUSINGLY SIMILAR – PARAGRAPH 3.3

19. 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.
20. Based on the Complainant's submissions, the Panel is satisfied that the Complainant is the owner of the Purell Marks, that all of the Purell Marks were registered prior to the May 2020 Domain Name registration date, and that the Complainant continues to have rights in the Purell Marks.
21. 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.
22. 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).
23. In this case, the relevant part of the Domain Name is “purellhandsanitizer”. The difference between the Domain Name and Purell word marks is the Domain Name’s “handsanitizer” suffix. As pointed out by the Complainant, the first element of the Domain Name is identical to the distinctive and famous Purell word marks, and the inclusion of non-distinctive generic terms, particularly those that relate to the goods associated with the Complainant's Purell Marks, does not distinguish the Domain Name.

24. As also submitted by the Complainant and posited by this Panel in *KPMG International Cooperative and KPMG LLP v. Dominique Brassard* ([CIRA Decision No. 00425](#)), the addition of such generic terms so closely related to the goods of the Complainant can even add to the likelihood of confusing similarity.
25. The Panel therefore finds that the Domain Name so nearly resembles the Purell Marks in appearance as to be mistaken as such. The Domain Name is therefore confusingly similar to the Purell Marks.

H. 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. Based on the Complainant's submissions, the Panel accepts that the Registrant intentionally attempted to attract, for commercial gain, Internet users to its competitor website by creating a likelihood of confusion with the Complainant's Purell Marks.
28. In particular, the Complainant has provided evidence in the form of timestamped screenshots dated June 9, 2020 showing the <https://zapagerm.shop/> website, which sells competing hand sanitizer products. An email reply from Zapagerm Orders dated June 10, 2020 explicitly acknowledged the redirection of the Domain Name to its competing site and parked the website instead.
29. The Registrant passively held the Domain Name at least as of June 22, 2020 after receiving the Complainant's June 9, 2020 letter. The Panel acknowledges the decisions cited in the Complaint, including *The Toronto-Dominion Bank v. David Crowe* ([CIRA Decision no. 00404](#)) that suggest that a registrant's passive holding of a domain is evidence of bad faith registration.
30. In addition, the Complainant also provided evidence that the Registrant was likely aware of the Complainant's Purell branded hand sanitizers at the time of registration, and that the Registrant was also likely aware of the increased demand for said hand sanitizers at the time of registration.
31. In view of the foregoing, the Panel accepts that the Registrant used the Domain Name to either redirect a user to its own competing website, or to passively hold it by directing a user to a parked webpage. Irrespective of such change the circumstance, the Panel concludes that the Registrant registered the Domain Name in bad faith pursuant to Paragraph 3.5(d) of the Policy.

I. LEGITIMATE INTEREST

32. 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".

33. The Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.
34. Based on the Complainant's submissions, the Panel finds that the Registrant did not register or use the Domain Name in good faith, that the Domain Name does not comprise the legal name of the Registrant, and that the Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or business.
35. None of the criteria in Paragraph 3.4 of the Policy 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.

J. CONCLUSION AND ORDER

36. For the reasons set out above, the Panel decides this dispute in favour of the Complainant.
37. Pursuant to Paragraph 4.3 of the Policy, the Panel orders the transfer of the Domain Name purellhandsanitizer.ca to GOJO Industries, Inc.



Alessandro Colonnier for the Panel

August 14, 2020