

**IN THE MATTER OF A COMPLAINT PURSUANT TO
THE CANADIAN INTERNET REGISTRATION AUTHORITY (“CIRA”)
DOMAIN NAME DISPUTE RESOLUTION RULES (the “Rules”)**

Complainant: TCF Co. LLC and TCF Canada Inc.

Registrant: Jordan Lauzon

Domain Name: CHEESECAKEFACTORY.CA

Registrar: Go Daddy Domains Canada, Inc.

Panelists: Craig Chiasson (Chair), Murray Smith, QC, David Wotherspoon

CIIDRC case number: 14777-CDRP

(CORRECTED) FINAL AWARD

THE PARTIES

1. The Complainants are TCF Co. LLC (“**TCF USA**”), a Nevada limited liability company with a place of business at 26901 Malibu Hills, Road, Calabasas Hills, California 91301, and TCF Canada Inc. (“**TCF Canada**”), a Canadian company with a place of business at 3401 Dufferin St., Toronto, Ontario M6A 2T9.
2. The Registrant, Jordan Lauzon, is an individual with a mailing address of 10 Donker Dr., St. Thomas, Ontario N5P 4J3.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name at issue is CHEESECAKEFACTORY.CA (the “**Domain Name**”).
4. The Registrar of the Domain Name is Go Daddy Domains Canada, Inc.
5. The Domain Name was registered on November 26, 2019.

PROCEDURAL HISTORY

6. The Canadian International Internet Dispute Resolution Centre (“**CIIDRC**”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (the “**Policy**”) of CIRA.
7. This is a proceeding under the Policy, in accordance with the CIRA Dispute Resolution Rules (the “**Rules**”).
8. On February 16, 2021, the Complainants filed a complaint with respect to the Domain Name pursuant to the Policy (the “**Complaint**”).
9. In a letter dated February 17, 2021, the CIIDRC confirmed compliance of the Complaint and commencement of the dispute resolution process. The Complaint was delivered to the Registrant on the same date.
10. On March 15, 2021, the Registrant provided his Response in Accordance with the Policy and Rules.
11. On March 17, 2021, CIIDRC appointed Murray Smith, QC and David Wotherspoon as panelists, and Craig Chiasson as Chair (together, the “**Panel**”).

12. On March 20, 2021, the Complainants provided Reply Submissions and requested that the Panel exercise its discretion to consider such submissions.
13. On March 21, 2020, the Registrant provided a Response to the Complainants' Reply (the "**Sur-Reply**").
14. Despite the Policy and Rules not providing for Reply and Sur-Reply submissions, the Panel has considered all written submissions provided by the Complainants and the Registrant, although the Panel does not base any aspect of its decision on the contents of the Reply and Sur-Reply.

PANEL'S JURISDICTION

15. The Panel notes that the Complainants' submissions include claims under the Canadian *Trademarks Act* (Canada). The Panel's Jurisdiction arises solely from the Policy and Rules, which together provide a complete code for the resolution of domain name disputes. The Panel's jurisdiction is limited to the matters contained in the Policy, which do not include claims under the *Trademarks Act*. Accordingly, the Panel has no jurisdiction to adjudicate the Complainants' claim based on the *Trademarks Act* and declines to do so. The Panel has not considered *Trademarks Act*-based allegations in the Complaint in reaching its decision.

ELIGIBILITY OF COMPLAINANT

16. The Panel has reviewed all of the material submitted by the Complainants and is satisfied that the Complainants are eligible Complainants under the Policy and Rules.

CANADIAN PRESENCE REQUIREMENT

17. The Complainant, TCF USA, is the owner of the following marks which are registered in the Canadian Intellectual Property Office ("**CIPO**"):
 - a) THE CHEESECAKE FACTORY, registered on February 4, 1998 in association with bakery products, namely cakes; and
 - b) THE CHEESECAKE FACTORY, registered on December 23, 2013 in association with restaurant services

("THE CHEESECAKE FACTORY Mark").
18. TCF USA, as the owner of THE CHEESECAKE FACTORY Mark registered in Canada, meets the Canadian presence requirements.
19. As TCF Canada is incorporated in Canada, it also meets the Canadian presence requirements.

THE POSITION OF THE PARTIES

The position of the Complainant

20. THE CHEESECAKE FACTORY Mark was first registered in Canada in 1998 and has been widely used in Canada since as early as November 21, 2017 when the opening of the first The Cheesecake Factory restaurant in Canada was announced.
21. The Complainants have built up a strong reputation in Canada for decades even prior to the first use of THE CHEESECAKE FACTORY Mark.
22. The Complainants have not licensed or otherwise authorized the Registrant to register or use THE CHEESECAKE FACTORY Mark as a domain name or for any other purpose
23. The Registrant's Domain Name is confusingly similar to THE CHEESECAKE FACTORY Mark, the Registrant has no legitimate interest in the Domain Name, and the Domain Name was registered in bad faith.

The Domain Name is confusingly similar to THE CHEESECAKE FACTORY Mark

24. The Complainants say that the Domain Name is confusingly similar to the **CHEESECAKE FACTORY** Mark for the following reasons:
 - a. "CHEESECAKE FACTORY" is the distinguishing element of THE CHEESECAKE FACTORY Mark;
 - b. the Domain Name is identical in appearance and sound such that it is likely to be mistaken for THE CHEESECAKE FACTORY Mark; and
 - c. a person would likely conclude that the Domain Name originated from the same source as THE CHEESECAKE FACTORY Mark and/or is associated with the Complainants' business.

Rights in the Marks prior to the Domain Name Registration and continuing rights

25. The Complainants say that they had rights in the **CHEESECAKE FACTORY** Mark prior to the Domain Name Registration, which rights are continuing, for the following reasons:
 - a. TCF USA first registered THE CHEESECAKE FACTORY Mark with CIPO on February 4, 1998, well before the Domain Name was registered;
 - b. the Complainants have been using THE CHEESECAKE FACTORY Mark in Canada since at least November 21, 2017, when it was announced that the first The Cheesecake Factory restaurant would be opening in Canada; and
 - c. the Complainants' rights in THE CHEESECAKE FACTORY in association with bakery products, namely cakes, existed prior to the date of registration of the Domain Name on November 26, 2019 and TCF USA continues to have such rights in THE CHEESECAKE FACTORY Mark.

The Registrant has no legitimate interest in the Domain Name

26. The Complainants say that Registrant has no legitimate interest in the Domain Name for the following reasons:
- a) the Complainants have never assigned, granted, licensed, sold, transferred, or in any way authorized the Registrant to use THE CHEESECAKE FACTORY Mark;
 - b) the Registrant is simply using the Domain Name to direct Internet users to his active website THECHEESECAKEGUY.CA, which offers cheesecake products in competition with the Complainants' business;
 - c) the Domain Name was not registered in good faith in association with any goods, services, or business in Canada;
 - d) "THE CHEESECAKE FACTORY" name is not the generic name of any goods, services, or business in Canada;
 - e) the Registrant has not used "THE CHEESECAKE FACTORY" name for non-commercial activity;
 - f) "THE CHEESECAKE FACTORY" name is not a reference by which the Registrant is commonly known; and
 - g) "THE CHEESECAKE FACTORY" name is not a geographical name of the location of the Registrant's non-commercial activity or its place of business.
27. As a result of the Complainants' long-term and continuous ownership and use of THE CHEESECAKE FACTORY Mark, name, and domain name for or incorporating "THE CHEESECAKE FACTORY" in connection with its bakery products, namely cakes, and restaurant services, the Complainants say they have built a strong reputation and significant goodwill in THE CHEESECAKE FACTORY Mark and name.
28. The Complainants' submit that an objective bystander, including a person accessing the Domain Name, would mistakenly assume that "THE CHEESECAKE FACTORY" of the Domain Name was invoking, associated with, or licensed by THE CHEESECAKE FACTORY Mark, and therefore by the Complainants.
29. The Complainants have never given the Registrant permission to use THE CHEESECAKE FACTORY Mark or name in any manner.
30. Moreover, the Registrant has not used the Domain Name in any manner that would otherwise demonstrate any rights or legitimate interests in using the Domain Name.

The Domain Name was registered in bad faith

31. The Complainants say that the Registrant's registration of the Domain Name was in bad faith for the following reasons:
- a) the Registrant merely uses the Domain Name to redirect Internet users to his domain THECHEESECAKEGUY.CA, for commercial gain, creating a likelihood of confusion with THE CHEESECAKE FACTORY Mark as to the source of the Registrant's website;
 - b) both the Domain Name and THECHEESECAKEGUY.CA were registered on November 26, 2019, suggesting that the Registrant intended to use them together; and
 - c) the Registrant had, or ought to have had, actual or constructive knowledge of THE CHEESECAKE FACTORY Mark and the Complainant's presence and reputation in Canada.

The position of the Registrant

32. The Registrant submits that he has a legitimate interest in the Domain Name.
33. The Registrant says that "CHEESECAKE" and "FACTORY" are popular words that are used in a variety of situations and therefore challenges the Complainants' ownership of THE CHEESECAKE FACTORY Mark.
34. The Registrant submits that he makes cheesecakes through his small business, which he always intended to call "THE CHEESECAKE GUY". The Registrant has never advertised for "THE CHEESECAKE GUY" or built on the website located at the Domain Name, but secured the Domain Name as a back up option.
35. The Registrant acknowledges that the Domain Name is solely used to forward Internet users to THECHEESECAKEGUY.CA.
36. The Registrant denies that he registered the Domain Name in bad faith, but submits that he uses all his domains to generate income for himself.

DISCUSSION AND FINDINGS

37. Under the Policy, to succeed in the proceeding, the Complainants must prove, on a balance of probabilities, that:
- a) the Domain Name is confusingly similar to a Mark in which the Complainants had rights prior to the date of registration of the Domain Name and continue to have such rights (paragraphs 3.1 to 3.3 of the Policy); and
 - b) the Registrant has registered the Domain Name in bad faith as described in paragraph 3.5 of the Policy.
38. The Complainants must also provide some evidence that the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy.

Rights in the mark prior to the Domain Name registration and continuing rights

39. Based on the evidence submitted in this proceeding, the Panel finds the following facts:
- a. TCF USA first registered THE CHEESECAKE FACTORY Mark in Canada with CIPO on February 4, 1998 in association with bakery products, namely cakes;
 - b. TCF USA then registered THE CHEESECAKE FACTORY Mark in Canada on December 23, 2013 in association with restaurant services;
 - c. THE CHEESECAKE FACTORY Mark was used by the Complainants in Canada as early as November 21, 2017;
 - d. the Registrant registered the Domain Name on November 26, 2019; and
 - e. the Complainants' rights in THE CHEESECAKE FACTORY Mark have not lapsed and it continues to be owned and used by them.
40. Based on these facts, the Panel is satisfied that the Complainants have proven on a balance of probabilities that they had rights in THE CHEESECAKE FACTORY Mark before the registration of the Domain Name and that the Complainants' rights remain in force.

Confusingly similar

41. To succeed in satisfying paragraph 4.1(a) of the Policy, the Complainants must show that they have rights in THE CHEESECAKE FACTORY Mark and that the Domain Name is confusingly similar to the mark.
42. The definition of a "Mark" set out at paragraph 3.2 of the Policy includes, in relevant part:
- A trademark, 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 purposes 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.
43. Pursuant to paragraph 3.3 of the Policy, in determining whether a domain name is confusingly similar to a Mark, the Panel shall only consider whether the domain name resembles the Mark in appearance sound, or ideas suggested by the Mark as to be likely to be mistaken for the Mark.
44. Where the domain name incorporates the distinguishing element of the Mark, confusion will be established.
45. The Panel finds that it is more likely than not that an Internet user would mistake the Domain Name as being somehow affiliated to or owned by the Complainants, particularly because the distinguishing element of the Domain Name (being "CHEESECAKE FACTORY") and THE CHEESECAKE FACTORY Mark are identical (see *Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon*, BCICAC Case No. 00006).

46. Based on the foregoing, the Panel finds that the Complainants have established, on a balance of probabilities, that the Domain Name is confusingly similar to THE CHEESECAKE FACTORY Mark. The Registrant's submissions do not demonstrate otherwise.

Bad faith registration

47. Paragraph 3.5 of the Policy, provides a list of circumstances that will be considered evidence that a Registrant has registered a domain name in bad faith, which includes in relevant part:

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.

48. The circumstances listed in paragraph 3.5 of the Policy are not exhaustive and the Panel should consider the totality of the circumstances (see *BASF SE v. Jean-Yves Collin*, DCA-1999-CIRA).
49. A Registrant's use of a domain name that is confusingly similar to the Complainant's registered mark to intentionally attempt to attract Internet users to its website for commercial gain amounts to bad faith under paragraph 3.5(d) of the Policy. Put another way, a Registrant cannot, in good faith, use the Complainant's Mark as an engine for attracting Internet users to its website with the result of creating a likelihood of confusion (*Nalge Nunc International Corporation v. Wilson*, Dispute No. 14476 at para. 19).
50. As mentioned above, the Registrant admits that the Domain Name was registered for no other purpose than to re-direct Internet users to THECHEESECAKEGUY.CA, another domain also owned by the Registrant to facilitate his commercial gain through the sale of cheesecakes. The Panel has already found that the Domain Name is confusingly similar to THE CHEESECAKE FACTORY Mark.
51. Accordingly, the Panel finds on a balance of probabilities that the Registrant has registered the Domain Name in bad faith under paragraph 3.5(d) of the Policy. Again, The Registrant's submissions do not demonstrate otherwise.

No legitimate interest in the Domain Name

52. Pursuant to paragraph 3.4 of the Policy, any of the following circumstances will demonstrate that the Registrant has a legitimate interest in a domain name:
- a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
 - b) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;

- c) the Registrant registered the domain name in Canada 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;
- d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

53. The Complainants submitted the following with respect to the issue of the legitimate interest in the Domain Name aspect of the Complaint:

- a) the Complainants have never assigned, granted, licenced, sold, transferred or in any way authorized the Registrant to use THE CHEESECAKE FACTORY Mark;
- b) the Registrant is not using the Domain Name in connection with an active website;
- c) the Domain Name was not registered in good faith in association with any wares, services or business that is clearly descriptive;
- d) the name "THE CHEESECAKE FACTORY" is not the generic names of any goods, services, or business in Canada;
- e) the Registrant has not used "THE CHEESECAKE FACTORY" name for non-commercial activity;
- f) "THE CHEESECAKE FACTORY" name is not a reference by which the Registrant is commonly known; and
- g) "THE CHEESECAKE FACTORY" name is not a geographical name of the location of the Registrant's non-commercial activity or its place of business.

54. The Panel finds that the Complainants have provided sufficient evidence to establish that the Registrant has no legitimate interest in the Domain Name and The Registrant has failed to demonstrate that any of the circumstances set out in paragraph 3.4 of the Policy exist in this case.

ORDER

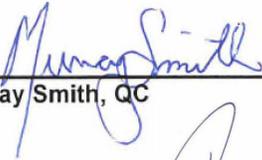
55. The Panel concludes that the Complainants have met the requirements of paragraph 4.1 of the Policy.

56. Accordingly, and pursuant to paragraph 4.3 of the Policy, the Panel orders that the Domain Name *cheesecakefactory.ca* be transferred to the Complainants.

Dated: April 1, 2021



Craig Chiasson (Chair)



Murray Smith, QC



David Wotherspoon