

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN INTERNET REGISTRATION
AUTHORITY DOMAIN NAME DISPUTE RESOLUTION POLICY**

Complainant:	Skechers USA INC. II
Complainant's counsel:	Daniel Anthony of Smart & Biggar
Registrant:	Diane Theberge
Panel:	Barry C. Effler
Service Provider:	British Columbia International Commercial Arbitration Centre
BCICAC File Number:	DCA-2263-CIRA

DECISION

Decision: Domain name skecherscanadashoes.ca ordered transferred
to Complainant Skechers USA INC. II.

The Parties, Domain Names and Registrar

- A. The Complainant is Skechers USA INC. II, a Virginia corporation.
- B. The Registrant is Dianne Theberge with an address in Ontario.
- C. The Domain Name at issue is **skecherscanadashoes.ca**.
- D. The Registrar is Go Get Canada Domain Registrar Ltd.
- E. The Domain Name was registered by the Registrant on April 3, 2019.

Procedural History

1. The procedural history of this matter was set out in a letter from the British Columbia International Commercial Arbitration Centre to the Panel herein dated August 26, 2020:
 1. On July 24, 2020, the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.
 2. On July 24, 2020, the CIRA dispute resolution department was notified of this proceeding. CIRA confirmed to BCICAC that the disputed domain was placed on a Registrar LOCK, and confirmed the identity of the Registrant.
 3. In a letter dated July 27, 2020, the Centre as Service Provider, confirmed compliance of the complaint and commencement of the dispute resolution process.

4. As the Complaint with the attachments was filed exclusively online, therefore, the Centre delivered the Complaint to the Registrant only by email to the address provided by CIRA.
5. The Complaint was successfully delivered to the Registrant.
6. The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
7. The Centre hereby appoints you, Barry C. Effler, as a single-member Panel in the above referenced matter.

2. As required by the Rules, I have declared to BCICAC that I can act impartially and independently in this matter as there are no circumstances known to me which would prevent me from so acting.
3. I am not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13 of the Rules, to a need to stay or terminate the progress of this proceeding.

Eligibility of Complainant

4. I have reviewed the material submitted by the Complainant and am satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy. It is the owner of a registered Canadian trademark in which the distinguishing word component of such trademark is within the Domain Name in dispute.

Relief Requested

5. The Complainant requests that the Domain Name be transferred from the Registrant to the Complainant.

Applicable Law

6. As directed by paragraph 12 of the Rules, I will render my decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

Background Facts

7. Background facts alleged by the Complainant and accepted by me as probative are summarized here from the Complaint:

The Complainant is the owner of the following Canadian trademark registrations, among others:

Trademark Registration No. TMA451434 for the trademark SKECHERS, registered on 1995-12-08;

Trademark Registration No. TMA772016 for the trademark SKECHERS, registered on 2010-07-15;

(collectively, the "SKECHERS Trademarks")

The Complainant (directly and through its predecessors in interest) has sold SKECHERS brand shoes since at least 1992. With respect to Canada specifically, the Complainant has sold SKECHERS brand shoes since at least as early as 1995, and has offered footwear retail services under the same mark since at least as early as 2002. The Complainant sells a very large range of footwear and other apparel. The Complainant's primary website is www.skechers.com and has owned that domain name since 1993.

As a result of the Complainant's extensive use and marketing SKECHERS brand in Canada for decades, combined with Complainant's longstanding commitment to quality, the Complainant's mark SKECHERS has become recognized in the industry as being associated with good quality and fashionable footwear. Substantial time, effort, and resources have been invested in developing and marketing the products associated with the SKECHERS mark. As a result, the Complainant enjoys strong protection of its SKECHERS mark, and the mark represents valuable goodwill to the Complainant.

The Complainant has a series of predecessors in interest for the SKECHERS brand. The Complainant states that none of its predecessors in interest or the Complainant have authorized the Registrant to make use of the Skechers Canadian trademarks to conduct commercial business in Canada under the Domain Name skecherscanadashoes.ca.

There is not, and has never been, any authorized relationship between the Complainant and the Registrant, nor between the Complainant's Canadian subsidiary, Skechers USA Canada, Inc., and the Registrant. The Registrant is not licensed or otherwise authorized to register or use the mark SKECHERS in any manner whatsoever, including as part of the domain name skecherscanadashoes.ca and selling of the Complainant's SKECHERS branded shoes.

The disputed Domain Name leads to a sophisticated commercial website using the

Complainant's trademark SKECHERS to falsely impersonate the Complainant. The disputed Domain Name's website only offers for sale SKECHERS branded footwear, which are likely counterfeit. The home page features "hot sales," nine pages feature "mens" footwear, 15 pages feature "new arrivals," and 22 pages feature "women" footwear. All the shoes displayed on this website are labeled with the Complainant's SKECHERS mark, and most of these shoes also visibly bear the Complainant's S designmark.

Discussion and Findings

8. Policy paragraph 4.1 sets forth the onus on a complainant. It provides as follows:

4.1 **Onus.** *To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:*

(a) *the Registrant's dot-ca 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;*

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.*

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

9. The Policy provides a definition of the term "Mark" (but as amended no longer defines Rights):

3.2 **Mark.** *A "Mark" is:*

(a) *a trade-mark, 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 purpose 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; ...

10. The Complainant is the owner of a registered Canadian trade-mark in which the exact word component is included within the Domain Name. The Complainant established that it has rights in a trade-mark that was a “Mark” prior to the date on which the Domain Name was registered. The Skechers trade-marks were all registered decades earlier than the April 3, 2019 date of registration of the Domain Name.
11. The relevant definition of “Mark” requires that a trade-mark be “used”. The term “use” is no longer defined in the Policy. As indicated in the Background Facts set out above, the Complainant has been selling Skechers brand shoes in Canada since as early as 1995. The Complainant therefore meets this requirement.
12. I am satisfied that the Domain Name is confusingly similar to the Complainant’s Mark. The relevant key word “Skechers” in the Domain Name is the same word as in the Mark, with additional words added. Adding the words “Canada” and “shoes” actually adds to the potential for internet customers to confuse the Respondent’s website with the Complainant’s website. Neither “Canada” or “shoes” are distinctive in this context.
13. I am satisfied that the Complainant has established bad faith by the Registrant for the purposes of paragraphs 4.1 of the Policy by showing circumstances meeting paragraphs 3.5 (d) of the Policy.

Paragraph 3.5 of the Policy:

3.5 Registration in Bad Faith. *For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:*

...

(d) 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.

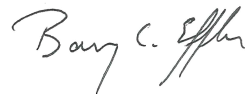
The Complainant's evidence contained screen shots of the website skecherscanadashoes.ca. The evidence showed numerous examples of products for sale with the Skecher trademark on them.

14. The Complainant states it has no business relationship with the registrant, see Background Facts, above.
15. The use of the word "Skechers" on the Registrant's commercial website meets the circumstances outlined for bad faith in paragraph 3.5 (d) of the Policy. The Registrant has no business relationship with the Complainant and the Registrant's website is clearly attempting to profit from an implication that it is a website of the Complainant or an authorized dealer.
16. There is no evidence that any of the circumstances outlined in paragraph 3.4 of the Policy regarding legitimate interest apply and I am satisfied that the Registrant has no legitimate interest in the Domain Name.
17. I am satisfied that the Complainant has met the onus on it to succeed, as required by paragraph 4.1 of the Policy.

Order

18. For the reasons set forth above, I order the Domain Name in issue to be transferred to the Complainant.

Dated: August 28, 2020



Barry C. Effler, LL.B., LL.M., C. Arb. (Fellow)
Sole Panellist