

ADMINISTRATIVE PANEL DECISION

Canadian Tire Corporation, Limited, Padinox Inc. v. jinfeng zhu
Case No. D2022-4677

1. The Parties

Complainants are Canadian Tire Corporation, Limited, Canada (“Complainant No. 1”), and Padinox Inc., Canada (“Complainant No. 2”) (together “Complainants”), represented by Torys LLP, Canada.

Respondent is jinfeng zhu, China.

2. The Domain Name and Registrar

The disputed domain name <padernostore.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2022. On December 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 14, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on December 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 4, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 5, 2023.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on January 10, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainants are companies organized under the laws of Canada which are active in the retail business, including cookware and other kitchenware.

Complainants have provided evidence that Complainant No. 2 is the registered owner of various trademarks relating to the well-known kitchenware brand PADERNO, *inter alia*, but not limited to the following:

- Word mark PADERNO, Canadian Intellectual Property Office (CIPO), registration number: TMA 253147, registration date: November 28, 1980, status: active.

It is undisputed between the Parties that Complainant No. 1 is being the parent company of Complainant No. 2 who has granted Complainant No. 1 an exclusive license to use the PADERNO brand in Canada.

Moreover, Complainants have demonstrated to own the domain name <paderno.com> which resolves to Complainants' official website at "www.paderno.com", offering cookware and other kitchenware under the PADERNO brand.

Respondent, according to the Whois information for the disputed domain name, is a resident of China who registered the disputed domain name on June 23, 2022. The latter resolves to a website at "www.padernostore.com", offering cookware and kitchenware under the PADERNO brand at discounted prices, thereby prominently displaying Complainants' official PADERNO logo and using product pictures taken from Complainants' official website at "www.paderno.com" without any authorization to do so.

Complainants request that the disputed domain name be transferred to Complainant No. 1.

5. Parties' Contentions

A. Complainants

Complainants contend that their PADERNO trademark is a well-known kitchenware brand with annual Canadian sales in excess of CAD 65 million in association with this brand.

Complainants submit that the disputed domain name is confusingly similar to their PADERNO trademark, as it consists of the latter in its entirety, followed by the term "store" which does not negate the similarity between the disputed domain name and the PADERNO trademark. Moreover, Complainants assert that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) the website to which the disputed domain name resolves is being used as a counterfeit operation, (2) Respondent has misappropriated copyrighted images from Complainants' website, including images of the PADERNO products, and (3) the prices of the products offered on the website under the disputed domain name are significantly less than the prices of Complainants' original PADERNO products. Finally, Complainants argue that Respondent has registered and is using the disputed domain name in bad faith since (1) Complainants' PADERNO trademark is well-known, (2) the nature of the disputed domain name suggests affiliation with Complainants, (3) the use of the term "store" reinforces the impression that the disputed domain name belongs to Complainants as it refers to their field of business, (4) Respondent must have had Complainants' well-known PADERNO trademark in mind when registering the disputed domain name, and (5) the exploitation of consumer confusion for the purpose of selling counterfeit goods is one of the strongest examples of registration and use of a domain name in bad faith.

B. Respondent

Respondent did not reply to Complainants' contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainants carry the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainants have rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainants, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a response as it considers appropriate.

A. Consolidation of Complainants

Given that Complainant No. 1 is the parent company of Complainant No. 2 which owns the PADERNO trademarks used by Complainant No.1 by means of an exclusive license, both Complainants obviously have a specific common grievance against Respondent why it is appropriate in the case at hand and in line with the UDRP panels' majority view to accept this Complaint filed by multiple complainants (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.11.1).

B. Identical or Confusingly Similar

The Panel concludes that the disputed domain name is confusingly similar to the PADERNO trademark in which Complainants have rights.

The disputed domain name incorporates Complainants' PADERNO trademark in its entirety, added by the term "store". Numerous UDRP panels have recognized that where a domain name incorporates a trademark in its entirety, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that trademark (see WIPO Overview 3.0, section 1.7). Moreover, it has been held in many UDRP decisions and has become a consensus view among UDRP panels, that the addition of other terms (whether e.g. descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent the finding of confusing similarity under the first element of the UDRP (see WIPO Overview 3.0, section 1.8). Accordingly, the addition of the term "store" is not in contrast to find confusing similarity arising from the incorporation of Complainants' entire PADERNO trademark in the disputed domain name.

Therefore, Complainants have established the first element under the Policy as set forth by paragraph 4(a)(i).

C. Rights or Legitimate Interests

The Panel is further convinced on the basis of Complainants' undisputed contentions that Respondent has not made use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor has Respondent been commonly known by the disputed domain name, nor can it be found that Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain.

Respondent has not been authorized to use Complainants' PADERNO trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent's name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the term "paderno" on its own. To the contrary, the disputed domain name resolves to a website at

“www.padernostore.com”, offering cookware and kitchenware under the PADERNO brand at discounted prices (which according to Complainants would correspond to counterfeit products), thereby prominently displaying Complainants’ official PADERNO logo and using product pictures taken from Complainants’ official website at “www.paderno.com” without any authorization to do so. Such use of the disputed domain name obviously neither qualifies as a *bona fide* offering of goods or services nor as using the disputed domain name for a legitimate, noncommercial or fair purpose. The Panel finally notes that the nature of the disputed domain name creates a risk of implied affiliation with Complainants’ PADERNO trademark suggesting sponsorship or endorsement by Complainants which is not the case (see WIPO Overview 3.0, section 2.5.1).

Accordingly, Complainants have established a *prima facie* case that Respondent has no rights or legitimate interests in respect of the disputed domain name. Having done so, the burden of production shifts to Respondent to come forward with appropriate evidence demonstrating rights or legitimate interests (see WIPO Overview 3.0, section 2.1). Given that Respondent has defaulted, it has not met that burden.

Therefore, the Panel finds that Complainants have also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

D. Registered and Used in Bad Faith

The Panel finally holds that the disputed domain name was registered and is being used by Respondent in bad faith.

Resolving the disputed domain name, which includes Complainants’ PADERNO trademark in its entirety together with the term “store” directly pointing at Complainants’ retail business to a website at “www.padernostore.com”, offering cookware and kitchenware under the PADERNO brand at discounted prices (that Complainants claim corresponds to counterfeit products), thereby prominently displaying Complainants’ official PADERNO logo and using product pictures taken from Complainants’ official website at “www.paderno.com” without any authorization to do so, is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusing with Complainants’ PADERNO trademark as to the source, sponsorship, affiliation or endorsement of Respondent’s website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

In connection with this finding, it also carries weight in the eyes of the Panel that Respondent obviously provided false or incomplete contact information in the WhoIs register for the disputed domain name since, according to the Courier Delivery Records, the Written Notice on the Notification of Complaint dated December 15, 2022 could not be delivered. This fact at least throws a light on Respondent’s behavior which supports the Panel’s bad faith finding.

Therefore, the Panel concludes that Complainants have also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <padernostore.com> be transferred to Complainant No. 1.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: January 18, 2023