

ADMINISTRATIVE PANEL DECISION

Gestion Strada Inc. v. Xiumei Yang
Case No. D2022-5040

1. The Parties

The Complainant is Gestion Strada Inc., Canada, represented by Norton Rose Fulbright Canada LLP, Canada.

The Respondent is Xiumei Yang, China.

2. The Domain Name and Registrar

The disputed domain name <garneashop.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 30, 2022. On January 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 6, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. A revised Complaint was received by the Complainant on January 11, 2023, correcting the disputed domain name.

The Center verified that the Complaint together with the revised 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 the Respondent of the Complaint, and the proceedings commenced on January 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 3, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on February 9, 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

The Complainant through its affiliate and licensee, Louis Garneau Sports Inc., owns and operates an active lifestyle brand based in Quebec who is involved in the design and sale of cycling apparel and equipment in association with the trademark LOUIS GARNEAU. The Complainant is the owner of the LOUIS GARNEAU trademark.

Louis Garneau Sports Inc. was founded by Mr. Louis Garneau, a former international cyclist that competed from 1970 to 1983 and won the title of Canadian champion in individual pursuit in 1978 and participated to 1984 Los Angeles Olympics. Mr. Garneau is the president of Gestion Strada Inc., the Complainant.

The Complainant's activities or the activities of its predecessors in title have been publicly advertised in Canada since at least as early as 1984 in association with the LOUIS GARNEAU Marks and as early as 2003 in association with the GARNEAU trademarks through the Complainant's website, launched on or around 1997, and advertising campaigns.

The Complainant owns the registered trademarks for GARNEAU and LOUIS GARNEAU and associated design marks in Canada, as described here:

- registration no. TMA507108 for LOUIS GARNEAU, registered on January 26, 1999, in Canada;
- registration no. TMA377548 for the LOUIS GARNEAU Design, registered on December 21, 1990, in Canada;
- registration no. TMA666275 for the LOUIS GARNEAU Design registered on June 19, 2006, in Canada;
- registration no. TMA697189 for GARNEAU, registered on September 25, 2007, in Canada; and
- registrations throughout the world including in China as Chinese Trademark Registration for LOUIS GARNEAU Nos. 5037719 registered on November 7, 2008, 5037717 registered on June 7, 2009, 11512163 registered on June 28, 2016, and 33488761 registered on March 7, 2020.

The Disputed Domain Name was registered on December 20, 2021 and resolves to a website purporting to be the Complainant or its authorized online distributor and dealer of LOUIS GARNEAU cycling apparel and equipment.

5. Parties' Contentions

A. Complainant

The Complainant requests that the disputed domain name be transferred to the Complainant.

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is identical or confusingly similar to the GARNEAU trademark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

Third, the Complainant submits that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical or confusingly similar to the Complainant's trademark.

The Complainant holds several valid GARNEAU trademark registrations, which precede the registration of the disputed domain name.

The disputed domain name <garneaushop.com> is confusingly similar to the Complainant's trademarks since it merely reproduces the GARNEAU trademark with the addition of the term "shop".

The disputed domain name incorporates the Complainant's GARNEAU trademark in its entirety. As numerous UDRP panels have held, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

The Panel finds the first element of the Policy has therefore been met.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence of the existence of any of those rights or legitimate interests. The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. The Complainant has prior rights in the trademarks which precede the Respondent's registration of the disputed domain name. The Respondent's evidenced use of the Complainant's trademark to create an online shop imitating the Complainant trademark cannot constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use.

The Complainant has therefore established a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and thereby shifted the burden to the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to rebut the Complainant's *prima facie* case.

Furthermore, if the Panel makes an analysis of the disputed domain name and its website from the perspective of the Respondent being potentially a reseller or distributor, the Panel notes the composition of the disputed domain name, and the website prominently displaying the LOUIS GARNEAU trademark without

any type of disclaimer about the lack of relationship with the Complainant. The Panel finds that the disputed domain name wholly incorporating the Complainant's GARNEAU trademark with a term directly related to the Complainant's business, coupled with the Respondent's use of the disputed domain name, carry a risk of implied affiliation.

Therefore, the Panel finds that the Complainant has satisfied the second requirement of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Complainant's allegations with regard to the Respondent's registration and use of the disputed domain name in bad faith have been considered by the Panel. These allegations have not been contested by the Respondent.

As indicated above, the Complainant's rights in the GARNEAU trademark predate the registration of the disputed domain name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration of the disputed domain name, as the Respondent included in the disputed domain name the Complainant's GARNEAU trademark with the term "shop" that is related to the Complaint business and provided content related to the Complainant business.

The Respondent in all likelihood registered the disputed domain name with the expectation of taking unfair advantage of the reputation of the Complainant's trademark.

The disputed domain name directs users to a website purporting to be the Complainant or its online distributor and dealer of LOUIS GARNEAU cycling apparel and equipment. The Panel finds such use indicates an intent to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark.

The failure of the Respondent to formally answer the Complainant's Complaint also supports a finding, in combination with other factors, of bad faith on the part of the Respondent (*Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#)).

Therefore, taking all the circumstances into account and for all the above reasons, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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 <garneaushop.com> be transferred to the Complainant.

/Pablo Palazzi/

Pablo Palazzi

Sole Panelist

Date: February 23, 2023