

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

**DECISION**

Domain Name: metalor.ca

Complainant: Metalor Technologies International SA

Registrant: KMG Environmental Inc. c/o/b Michael Gupton

Registrar: Go Daddy Domains Canada, Inc.

Service Provider: ResolutionCanada Inc.

Sole Panelist: Eric Macramalla

**A. THE PARTIES**

1. The Complainant is Metalor Technologies International SA (the “Complainant”).
2. The Registrant is KMG Environmental Inc. c/o/b Michael Gupton (the “Registrant”).

**B. DISPUTED DOMAIN NAME & REGISTRAR**

3. The disputed domain name is metalor.ca (the “Domain Name”) and the Registrar is Go Daddy Domains Canada, Inc.

**C. PROCEDURAL HISTORY**

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (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 its complaint (the “Complaint”) on October 29, 2014. The Date of Commencement of the proceeding was November 5, 2014.
6. The Registrant’s did not file a formal response. However, the Registrant issued various emails to the Provider. Upon learning the identity of the Registrant, the Complainant filed an Amended Complaint identifying the Registrant as the owner of the Domain Name.
7. On December 11, 2014, 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 which would prevent it from so acting.

**D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT**

8. The Complainant is the owner of a Canadian trade-mark registration METALOR, Registration No. TMA433022. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

**E. THE POSITIONS OF THE PARTIES**

The Complainant's Position

9. The Complainant is the owner of the Canadian trade-mark registration METALOR (the "METALOR Trade-mark"). The METALOR Trade-mark achieved registration on September 9, 1994 and claims use in Canada since at least as early as 1982.
10. The Complainant became aware of the Domain Name on August 14, 2014. On that same date, a letter was sent to the Respondent through the CIRA message delivery form, advising the Respondent of the Complainant's rights; seeking that Respondent cease and desist from using the Domain Name and seeking a transfer of the Domain Name. No response was received.
11. The Complainant can trace its origins back to 1852 as a leader in the business of chemistry, metallurgy and management of precious metals.
12. The Complainant has offered goods and services, namely the purchase and sale of precious metals and precious metals related services such as refining, under the METALOR Trade-mark in Canada since at least 1992 and continues to offer such goods and services in Canada.
13. The Complainant owns the Metalor.com domain name through which goods and services are offered.
14. The Complainant has prominently and extensively used, promoted and advertised the METALOR Trade-mark for at least 78 years and the Metalor.com domain name for over 16 years. By virtue of these efforts the METALOR Trade-mark and metalor.com domain name have become well recognized by consumers as designating the Complainant as a leader in the precious metals industry. Accordingly, the trademark and domain name are extremely valuable to the Complainant.
15. The Registrant resolved the domain name to a pay-per-click website populated with sponsored links.
16. The Domain Name is confusingly similar with the METALOR Trade-mark. The Registrant does not have a legitimate interest in the Domain Name as it is not licensed, or otherwise authorized, to use the METALOR Trade-mark. The Registrant registered the Domain Name in bad faith, namely to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a

likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement.

17. The Complainant is seeking the transfer of the Domain Name.

The Registrant's Position

18. The Registrant did not file a formal response. However, the Registrant did issue the following email correspondence to the Provider on November 5, 2014:

Hello,

A simple email to me before you drew all this up could have settled matters. But, so be it. My contact information is publicly available on any whois service. The registered owner of metalor.ca is 6421556 Manitoba Ltd. For your records. The domain name in question may be available for sale. I will review the documents attached herein and reply in a timely and reasonable manner.

Sincerely,  
6421556 Manitoba Ltd  
Michael Gupton

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Hello,

I can find no record of emails sent to me on or abouts August 14, 2014 from CIRA or Metalor, nor any other source regarding metalor.ca. Your EXHIBIT F clearly shows that the domain in question was not registered nor used in bad faith, for commercial gain, as the domain has never been used for commercial gain. The domain has been "parked" since it was purchased on the open and free market. There has never been a hosting account for this domain, nor has the domain name been used in any solicitations, claims, or commercial dealings whatsoever. And furthermore, the domain name owner is making legitimate noncommercial or fair use of the domain name, without intent of (i) commercial gain, (ii) misleadingly diverting consumers, or (iii) tarnishing the trademark at issue. The domain name was purchased on the free and open market and has been parked ever since. It was not forwarded, nor used to confuse nor divert consumers in any way, shape, or form.

Sincerely,  
Michael Gupton

19. On December 11, 2014, the Registrant dispatched the following email correspondence:

Ms Leung,

The process for domain dispute is absolutely warranted and required. However, in this case, it is utterly ridiculous and frivolous. Metalor should have contacted me

prior to this if they wanted the dot ca domain name in question. The formal response procedure and documentation is unbelievably excessive in this situation. The only reasonable solution for this particular dispute would have been a simple email or phone call, and this matter would have been settled. The domain in question may be relinquished to CIRA immediately upon recompense of reasonable out-of-pocket expenses to the registrant.

Sincerely,  
Michael Gupton

**F. DISCUSSION & REASONS**

20. 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.

**CONFUSINGLY SIMILAR - PARAGRAPH 3.3**

21. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

**Rights in the Marks & Rights that Predate the Domain Name Registration Dates**

22. The Complainant's METALOR Trade-mark establishes requisite trade-mark rights in this case.
23. Where the Complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use. In cases where a trade-mark registration matured to registration after the domain name registration date, or the Complainant is relying on common law rights, it must establish rights that predate the domain name registration.
24. The Complainant's trade-mark registration for METALOR issued to registration in 1994, which precedes the March 1, 2013 domain name registration date.

Therefore, the Panel concludes that the Complainant has established rights that precede the registration of the Domain Name.

### Confusingly Similar

25. 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.
26. 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).
27. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant’s corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant’s marks based upon the appearance, sound or the ideas suggested by the mark.
28. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-mark Act*, when assessing the likelihood of confusion between marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.
29. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy’s summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.
30. The Domain Name is identical to the METALOR Trade-mark. Under the circumstances, the Panel concludes that the Domain Name is confusingly similar with the Complainant’s METALOR Trade-mark given that the Domain Name so nearly resembles the METALOR Trade-mark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for the mark.

### Conclusion - Confusion

31. The Panel finds that the Domain Name is confusingly similar with the METALOR Trade-mark in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

### **BAD FAITH REGISTRATION**

32. The Complainant has alleged that the Domain Name was registered in bad faith pursuant to paragraph 3.5(d) of the Policy, namely that the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement.
33. Given that it is comprised exclusively of the METALOR Trade-mark, the Domain Name suggests a connection to the Complainant. Under the circumstances, the Panel is of the view that the Domain Name is likely to confuse potential consumers into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainant. Further, it is a well-established principle that resolving a disputed domain name to a pay-per-click website featuring sponsored links to competitors of a complainant maybe considered evidence of bad faith. These websites put a registrant in a position to reap a financial benefit by way of referral fees. In this case, the Panel concludes that bad faith does indeed exist.
34. In light of the foregoing, the Panel finds that the Complainant has established bad faith as per paragraph 3.5(d).

### **LEGITIMATE INTEREST**

35. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
36. As per paragraph 4.1 of the Policy, the Complainant must provide "some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6".
37. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
39. The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Domain Name. The Complainant did not authorize the registration and the website is likely to mislead the public into believing that the Registrant is affiliated with, or endorsed by, the Complainant.
40. In cases where a domain name is an exact match for a brand owner's trade-mark, the initial assumption will be that a registrant does not have a legitimate interest in said domain absent an agreement to the contrary between the parties. Nothing in the record displaces this assumption.
41. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

**DECISION & ORDER**

42. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.
43. Pursuant to paragraph 4.3 of the Policy, the Panel orders the domain name metalor.ca transferred to the Complainant.

Dated at Ottawa, Ontario, Canada, this 14<sup>th</sup> day of January, 2014.



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Eric Macramalla