

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

Domain Name: business.ca  
Complainant: 2193165 Ontario Ltd.  
Registrant: Business.ca Incorporated  
Registrar: DomainsAtCost Corp.  
Service Provider: Resolution Canada Inc.  
Panel: Peter C. Cooke

DECISION

THE PARTIES

The Complainant is 2193165 Ontario Ltd with an address of 870 Taplin Drive, Pickering, ON L1V 1H3, Canada.

The Registrant is Business.ca Incorporated with an address of 11 Allstate Parkway, Suite 448, Markham, ON L3R 9T8, Canada.

THE DOMAIN NAME AND REGISTRAR

The subject of this proceeding is the Domain Name business.ca, registered on September 23, 2000.

The Registrar of the domain name is DomainsAtCost Corp.

PROCEDURAL HISTORY

This is an administrative dispute resolution proceeding pursuant to the Canadian Internet Registration Authority ("CIRA") *Domain Name Dispute Resolution Policy* Version 1.3 (August 22, 2011) (the "Policy") and the CIRA *Domain Name Dispute Resolution Rules* Version 1.5 (July 28, 2014) (the "Rules").

According to the information provided by Resolution Canada Inc. the dispute resolution service provider, the history of the proceeding is as follows:

The Complainant filed a complaint dated April 16, 2015 with Resolution Canada Inc., requesting that the Domain Name registration be transferred from the Registrant to the Complainant.

After having determined that the complaint was in administrative compliance with the requirements of the Policy and the Rules, Resolution Canada Inc. commenced the dispute resolution process and served notice of the complaint on the Registrant (as required by paragraph 4.3 of the Rules) by email on April 28, 2015. No response was received from the Registrant.

The Complainant has elected to proceed before a panel consisting of one panellist. As required by paragraph 7.1 of the Rules, the panel has declared to Resolution Canada Inc. that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

#### ELIGIBILITY OF COMPLAINANT

The Complainant satisfies Paragraph 2(q) of the CIRA *Canadian Presence Requirement for Registrants*, as the Complainant is the owner of a registered Canadian trade-mark corresponding to the Domain Name.

#### OVERVIEW OF THE POLICY

Paragraph 4.1 of the Policy sets forth the Complainant's burden of proof in order to succeed in the proceeding. The onus is on the Complainant to 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.

#### COMPLAINANT'S CONTENTIONS

The Complainant is the owner in Canada of the trade-mark BUSINESS.CA DESIGN TMA605,959 registered on March 23, 2004, having acquired it from the Registrant by way of an Agreement dated June 30, 2009. Although the Domain Name was registered by the Registrant on September 23, 2000, evidence is provided showing that the Registrant sold it to the Complainant by way of the same Agreement on June 30, 2009.

The Complainant alleges that the Registrant “knowingly registered the domain in bad faith after selling the domain and trademark to Complainant”.

The Complainant alleges that the Registrant does not have a legitimate interest in the Domain Name because the Registrant transferred title of the domain to the Complainant in June of 2009. The Registrant “...refuses to turn over the username and password to access the domain”.

## DISCUSSIONS AND FINDINGS

### Confusing Similarity Between Domain Name And Complainant’s Mark

As set out above, the Complainant must prove that the 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. A domain name is “confusingly similar” to a Mark if the Domain Name so nearly resembles the Mark in appearance sound or ideas suggested by the Mark so as to be likely to be mistaken for the Mark, as per paragraph 3.3 of the Policy.

The Complainant has established that it acquired the BUSINESS.CA DESIGN trade-mark in June 2009 at the time that it acquired the Domain Name and that it continues to have rights therein. The registration of the trade-mark must be considered to be valid for the purposes of this proceeding. In this case the Domain Name is not merely similar to the Complainant’s registered trade-mark but is identical to it.

Although the Complainant did not technically have rights in a Mark “prior to the date of registration of the Domain Name”, it clearly acquired both from the Registrant by the way of the same Agreement. Following the approach taken in *Canadadrugs.com v. NC Britton Holdings Ltd.* (CIRA-00028), the Panel considers that, under the circumstances, the relevant date by which time the Complainant needed to have Rights in a Mark, is not the date of registration but the date the Registrant purchased the Domain Name.

As the Complainant acquired Rights in the BUSINESS.CA DESIGN Trade-mark at the same time that it acquired the Domain Name, and continues to have such rights, the Panel is therefore of the view that the Complainant has succeeded in meeting the test under 4.1(a) of the Policy.

### Bad Faith Registration

The Complainant submits that the Registrant knowingly registered the Domain Name in bad faith after selling the Domain Name and trade-mark to the Complainant. The Complainant later states in the complaint that the Registrant refuses to turn over the username and password to access the domain.

It is noted that the enumerated list of bad faith examples in paragraph 3.5 is not exhaustive, as the Policy specifically states that examples are “in particular but without limitation”. Accordingly, the Panel may find bad faith even in the absence of any of the examples set forth in paragraph 3.5 (a) – (d). This Panel has kept in mind the purpose of these proceedings set out under paragraph 1.1 of the Policy, which is to provide a forum in which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly.

The Complainant filed evidence of the sale of the Trade-mark and Domain Name to the Complainant. The evidence shows that the transfer of the trade-mark ownership has been recorded at the Canadian Intellectual Property Office, but the WHOIS records, also filed as evidence, show no similar transfer has been recorded in respect of the Domain Name. Whether there is bad faith can be determined from common sense inferences from the Registrant’s conduct and other surrounding circumstances (see *Coca Cola v. Amos B. Henna* CIRA-00014). The Complainant’s allegations that no username or password were provided by the Registrant to facilitate the transfer of the Domain Name is an indication that the Registrant was not dealing in good faith with the Complainant when it sold the Domain Name to the Complainant. No explanation was provided by the Registrant in response.

Accordingly, the Panel concludes that the Registrant transferred the Domain Name in bad faith, pursuant to paragraph 3.5 (b) of the Policy.

#### No Legitimate Interest In The Domain Name

The Complainant has submitted that the Registrant does not have a legitimate interest in the Domain Name because the Registrant transferred title of the Domain Name to the Complainant in June 2009.

Paragraph 4.1 of the Policy requires that the Complainant provide *some* evidence that the Registrant has no legitimate interest in the Domain Name.

The Complainant has provided evidence that the legal title to the Domain Name is no longer held by the Registrant, and has therefore satisfied its initial burden.

It therefore becomes incumbent on the Registrant to prove, on a balance of probabilities that the Registrant has a legitimate interest in the Domain Name. The Registrant did not submit a response, and so the Panel has no answer to the Complainant’s allegation. This lack of response is fatal to the Registrant.

The panel must conclude that the Registrant has no legitimate interest in the Domain Name, pursuant to paragraph 4.1(c) of the Policy.

## CONCLUSION AND DECISION

The Complainant has proven, on a balance of probabilities, that the Domain Name is confusingly similar to a Mark in which the Complainant had rights and in which the Complainant continues to have such rights. The Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith. The Complainant has also adduced some evidence that the Registrant has no legitimate interest in the Domain Name, and the Registrant, by not filing a response has not met its burden of proof to prove otherwise.

For these reasons, the complaint regarding the Domain Name is successful, and the Domain Name will be transferred to the Complainant.

A handwritten signature in black ink, appearing to read "Peter C. Cooke". The signature is written in a cursive, somewhat stylized font.

Peter C. Cooke  
Dated June 17, 2015