

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE REGISTRATION
RESOLUTION POLICY (v 1.3) AND RULES (v 1.4)**

Complainant: Canadian Standards Association
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Disputed Domain Name restoreCSA.ca
(the “Domain Name”)

Registrar: Go Daddy Domains Canada, Inc.

Panel: Douglas M. Isenberg
David Wotherspoon
John Rogers (Chair)

Service Provider: British Columbia International Commercial Arbitration Centre
(the "BCICAC")

BCICAC File: DCA-1673 - CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (the "Policy") and Rules (the "Rules") of the Canadian Internet Registration Authority.

The Complainant filed a complaint dated April 24, 2015 (the "Complaint") with the BCICAC seeking an order in accordance with the Policy and the Rules directing that the registration of the Domain Name be transferred to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 of the Rules and, by email dated April 29, 2015 (the "Transmittal Email"), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rule 2.1 and Rule 4.3 of the Rules. The Transmittal Email determined the date of the commencement of proceedings in accordance with Rule 4.4 of the Rules to be April 29, 2015 and advised the Registrant that in accordance with the provisions of Rule 5 of the Rules, a response to the Complaint was to be filed within 20 days of the date of commencement of proceedings. The Registrant requested an extension of time for delivery of its response, and pursuant to Rule 5.4 of the Rules the BCICAC granted this extension to June 9, 2015.

The Registrant delivered its response to the BCICAC on June 9, 2015 (the "Response") in compliance with the Policy and the Rules and the BCICAC after a review of the Response determined it to be compliant.

In accordance with the provisions of Paragraph 6 of the Rules, the BCICAC appointed the undersigned as a three-person panel ("Panel").

The Panel determines that they have been properly appointed and constituted as the three member panel to determine the Complaint in accordance with the Rules.

CANADIAN PRESENCE REQUIREMENTS

Paragraph 1.4 of the Policy requires that the Complainant at the time of submitting the Complaint satisfy the Canadian Presence Requirements for Registrants in respect of the Domain Name unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office ("CIPO") and the Complainant is the owner of the trade-mark.

In the matter at hand, the Complainant is a Canadian not-for-profit membership association that maintains several offices in Canada and owns a portfolio of trade-marks registered with the CIPO, some of which are relate to the Complaint.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by the BCICAC and the Complainant, the Panel finds that all technical requirements for the prosecution of this proceeding have been met.

FACTS AND ALLEGATIONS

The facts and allegations before the Panel include the following:

1. The Complainant is a Canadian standards development, testing and certification organization with a global presence;
2. The Complainant alleges that:
 - a) the Registrant is a competitor of the Complainant in that the Registrant publishes and sells guide books regarding the Complainant's standards that compete in the market place with both the Complainant's books of standards and with the Complainant's own guide books pertaining to those standards;
 - b) After being sued by the Complainant for copyright infringement in a civil action in the Federal Court of Canada (the "Federal Court Action"), and without the consent of the Complainant, the Registrant registered the Domain Name together with a series of other top-level domain names ("Other Domain Names") on January 27, 2013;
 - c) The Domain Name resolves to a website at www.restoreCSA.com, which, in turn, links to the Registrant's website at www.psknight.com in order to promote the Registrant's business;
 - d) The Domain Name is confusingly similar to trade-marks owned by the Complainant, the Registrant does not have a legitimate interest or rights in the Domain Name, and the Registrant is using the Domain Name in bad faith with no entitlement in the Domain Name;
2. The Registrant is a corporation registered to carry on business in the Province of Alberta;
3. The Registrant alleges:
 - a) The Complainant publishes the *Canadian Electrical Code, Part 1, Safety Standards for Electrical Installations* (the "Code") and has been doing so since 1927;
 - b) The Code is a compilation of written work from various third party authors, one of which is associated with the Registrant;
 - c) In 1967, a party associated with the Registrant began to publish in various formats a publication originally called the *Canadian Electrical Code in Simple Terms and Diagrams* ;
 - d) For over three decades, the Complainant provided the Registrant and its predecessors with memoranda (the "Memoranda") containing the new revisions to the Code in advance of the Complainant publishing its newest Code edition;
 - e) In 2005 the long standing relationship between the Complainant and the Registrant began to break down and in 2011, the Complainant advised the Registrant in writing that it was terminating the licence it had previously granted to the Registrant; and
 - f) In June of 2012, the Complainant filed the Federal Court Action seeking among other remedies an interlocutory and final order requiring the Registrant to transfer ownership of the Domain Name to the Complainant;
4. The Registrant denies that the allegations of the Complainant in the Complaint and, in the Response, claims that the website connected with the Domain Name is a non-commercial website created for the legitimate purpose of criticism and advocacy related to the Complainant's role in the Canadian electrical regulatory process; and

5. The Registrant claims that the Federal Court Action includes claims regarding the Domain Name and the Other Domain Names and that the Complainant has filed a complaint nearly identical to the Complaint with the World Intellectual Property Organization Arbitration and Median Centre ("WIPO Complaint") regarding the Other Domain Names within days of filing the Complaint with the effect that there are now three separate proceedings for what the Registrant claims are essentially the same issues.

REMEDIES SOUGHT

The Complainant seeks that the Panel order that the registration of the Domain Name be transferred to the Complainant.

The Registrant seeks that the Panel:

1. exercise the discretion granted to it pursuant to Paragraph 13.2 of the Rules and terminate this proceeding;
2. in the alternative, exercise the discretion granted to it pursuant to Paragraph 13.2 of the Rules and suspend this proceeding; or
3. in the alternative dismiss the Complaint; and
4. pursuant to Paragraph 4.6 of the Policy find that the Complainant has acted in bad faith and award the Registrant costs.

DECISION

The purpose of the Policy as stated in paragraph 1.1 thereof is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

In keeping with this policy objective and to ensure that there is not a duplication of effort or conflicting jurisdictions, Paragraph 13 of the Policy places an obligation upon a party to a complaint under the Policy to give notice of any other proceeding involving the matter which is the subject of the complaint. Paragraph 13 provides:

PARAGRAPH 13 - COURT PROCEEDINGS

13.1 Notice of Other Proceeding. In the event that a Party initiates or becomes a party to any legal proceeding or other arbitration during the pendency of a Proceeding in respect of a domain name Registration dispute that is the subject of the Proceeding, it shall promptly give notice to the Panel and the Provider.

13.2 Stay or Termination. In the event that any legal proceeding or other arbitration is initiated prior to or during a Proceeding in respect of a domain name Registration dispute that is the subject of the Proceeding, the Panel or, if no Panel has been appointed, the Provider, shall have the discretion to decide whether to stay or terminate the Proceeding or to proceed to a decision.

It is to be noted that there is no reference in the Complaint to the details of either the Federal Court Action or to the WIPO Complaint.

It is also apparent from the material in the Response that the Federal Court Action deals directly with the subject matter of the Complaint.

As it would appear that the subject matter of the Complaint is merely one aspect of an ongoing dispute between the Complainant and the Registrant, and as we believe that the Federal Court of Canada is a better forum to resolve this dispute, including the subject matter of the Complaint, we have determined to grant the relief sought by the Registrant, to exercise the discretion granted to us pursuant to Paragraph 13.2 of the Policy, and to terminate this proceeding.

CLAIM FOR COSTS

The Registrant has claimed costs pursuant to paragraph 4.6 of the Policy.

Paragraph 4.6 of the Policy entitled “**Bad Faith of Complainant**” states:

If the Registrant is successful, and the Registrant proves, on a balance of probabilities, that the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of any Registration which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect of any Registration with any Provider until the amount owing is paid in full to the Provider.

Paragraph 4.6 requires that as a condition for the Registrant be successful in its claim for costs, it must first be successful in having a complaint dismissed. As we have determined to terminate this proceeding, the Registrant has not satisfied this condition, and, therefore, its claim is moot.

ORDER

The Panel, having exercised its discretion pursuant to Paragraph 13.2 of the Policy, hereby orders that this proceeding be terminated.

Dated: June 25, 2015.

On behalf of the members of the Panel.

A handwritten signature in black ink, appearing to read "R. John Rogers", is written over a light gray, textured background. The signature is fluid and cursive.

R. John Rogers, Chair