

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

DECISION

Domain Name: ride509.ca

Complainant: Teton Outfitters, LLC

Registrant: Guy Diotte

Registrar: GoDaddy Domains Canada, Inc.

Service Provider: Resolution Canada

Panelists: Daria Strachan (Chair), David Allsebrook, Eric Macramalla

A. THE PARTIES

1. The Complainant, Teton Outfitters, LLC (the “Complainant”), is a corporation located in Minnesota, USA.
2. The Registrant for the domain name is Guy Diotte (the “Registrant”), located in Montreal, QC.

B. DISPUTED DOMAIN NAME AND REGISTRAR

3. The disputed domain name is ride509.ca (the “Domain Name”).
4. The Registrar for this domain name is GoDaddy Domains Canada, Inc. (the “Registrar”).
5. The disputed domain name was registered on March 14, 2013.

C. PROCEDURAL HISTORY

6. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy Version 1.3* (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules Version 1.5* (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.
7. The Complainant filed its Complaint on October 24, 2018 (the “Complaint”). The date of commencement of the proceeding was October 29, 2018.

8. The provider, Resolution Canada, served notice of the Complaint on the Registrant as required pursuant to Paragraph 4.3 of the Rules. Service of the Complaint was made by e-mail on October 29, 2018.
9. The Registrant filed his response on December 3, 2018.
10. On February 25, 2019, the Panel was appointed. As prescribed by Paragraph 7 of the Rules, the Panel has declared to Resolution Canada that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel that would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

11. The Complainant is an American company, that operates the website ride509.com where it promotes the sale of its goggles, boots, helmets and outerwear. It owns a Canadian trademark registration for the mark 509, Registration No. TMA970488 (the “509 Trademark”). The Panel is therefore satisfied that the Complainant satisfies the Canadian Presence Requirement as stated in paragraph 1.4 of the Policy.

E. THE POSITION OF THE PARTIES

The Complainant’s Position

12. Established in 2005, the Complainant began making short films and recordings of backcountry snowmobiling using the 509 mark and variations thereof, such as “RIDE 509”. The Complainant states that it manufactured a wide range of clothing and protective gear product, and became a market leader in those categories. The Complainant promoted its 509 brand, including the use of the phrase “Ride 509” in its marketing and promotional materials. As such, the Complainant states its rights in the Mark precede the Domain Name registration of March 14, 2013.
13. Moreover, the Complainant submits that the Domain Name is confusingly similar to the Complainant’s 509 Trademark.
14. The Complainant also alleges that the Respondent does not have a legitimate interest in the Domain Name as it does not have any rights to the 509 Trademark (3.4(a)). Further, the Respondent does not use the Domain Name in good faith, instead forwarding consumers to its own site with various third party products for sale (3.4(b)). The Domain Name is not a generic name (3.4(c)), nor is it being used in connection with non-commercial activities (3.4(d)). The Domain Name is not the Respondent’s legal name (3.4(e)), nor is it the geographical name of the Registrant’s place of business (3.4(f)).
15. The Complainant alleges that the Respondent acquired the Domain Name specifically to prevent the Complainant from using it.

16. The Complainant highlights the fact that the Domain Name redirects potential consumers to Respondent's website that showcases competing products alongside those of the Complainant. The Complainant alleges that potential consumers are likely to be misdirected resulting in a disruption to the Complainant and its business. Accordingly, the Complainant submits that the circumstances support a finding of bad faith as per paragraph 3.5 (c) of the Policy.
17. The Complainant further states that the Respondent's attempt to divert and attract internet users to its website by using a Domain Name that is confusingly similar to the Complainant's ride509.com domain name, is in violation of paragraph 3.5(d) of the Policy.
18. The Complainant alleges that the Registrant's willingness to sell the Domain Name when it asked the Complainant for an offer to buy the Domain Name shows not only that the Registrant lacks legitimate rights, but that its' registration was in bad faith. In addition, the Complainant notes that the Registrant had actual knowledge of the Complainant's Mark at the time it registered the Domain Name, which reinforces a finding of bad faith.
19. The Complainant requests that the Domain Name be transferred from the Registrant to the Complainant.

The Registrant's Position

20. The Registrant purchased the 509 merchandise through legitimate channels as a Canadian distributor of the 509 products. From 2009 to 2012 the Registrant purchased 509 merchandise for sale and promotion.
21. On March 14, 2013, the Registrant registered the Domain Name to facilitate the sale of the Registrant's remaining 509 inventory on its website.
22. The Registrant is still selling leftover 509 inventory on its website, all of which it procured legitimately. The other product lines being offered on the splashndirt.ca website are not competitors of the 509 products.
23. It was not until the spring of 2018 that the Complainant contacted the Respondent. Upon so doing, the Registrant offered to sell the Domain Name. The Complainant refused the Registrant's offer and instead brought the within complaint.

F. DISCUSSION AND REASONS

24. 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 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;
- 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.

(a) Is the Registrant's Domain Name Confusingly Similar?

- 25. In order to satisfy this branch of the test, the Complainant must show that it has rights in a Mark that pre-dates the registration date of the Domain Name, and that the Domain Name is confusingly similar with the disputed Mark (paragraph 3.3 of the Policy).
- 26. The Domain Name was registered on March 14, 2013. The registration of the 509 Trademark was filed in 2017. The evidence the Complainant has provided in reference to common law rights that predate this registration may not be sufficient to determine the question of whether the Complainant had rights in the Mark, in Canada, prior to the registration of the Domain Name. That said, the Respondent readily admits that he was a distributor of the 509 brand in Canada from 2009 – 2012, prior to the Domain Name registration. As such, the Complainant had rights in the Mark within Canada that predated the Domain Name's registration in 2013.
- 27. 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).
- 28. 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.
- 29. In the case at hand, the Domain Name is identical to the Complainant's ride509.com domain name. It also contains the 509 Trademark within the second level domain. The Panel accepts the Complainant's position, and finds that the Domain Name is likely to be mistaken for the Complainant's 509 Trademark.

(b) Was the Domain Name Registered in Bad Faith?

30. The Complainant must show, on the balance of probabilities, that the disputed Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds that constitute bad faith. These grounds are not exhaustive; rather it is left open for the Panel to conclude that there are other grounds that lead to a finding of bad faith conduct.
31. The crux of this matter lies in the determination as to whether the Domain Name was registered in bad faith.
32. Paragraph 3.5 of the Policy states that a finding of bad faith registration of a domain name is evidenced where one of the following four conditions are met:
 - (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;
 - (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
 - (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or
 - (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other online location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.
33. The Complainant seeks to fit the registration of the Domain Name by the Registrant under paragraphs 3.5(a), (c) and (d). It is incumbent on the Complainant to dispel any doubts about bad faith by showing that, on the balance of probabilities, there could be no good faith.

34. The fact that the Registrant did not offer to sell the Domain Name to the Complainant until he was approached by same in 2017, notably more than four (4) years after registering the Domain Name, contradicts that circumstances set out under Paragraph 3.5(a) of the Policy.
35. The Registrant registered the Domain Name while selling 509 merchandise that he had purchased in good faith from the company as a Canadian distributor. As the Complainant has not indicated when the Registrant ceased being an official distributor of the 509 brand, it has not been established that in 2013, the Registrant registered the Domain Name for the purpose of disrupting the business of the Complainant under paragraph 3.5(c) of the Policy. In fact, it is entirely plausible that the registration was done in an effort to facilitate the sale of the Complainant's 509 merchandise in Canada (see: *ICE IP S.A. v. CanWest Distributors*, 2014 CarswellNat 5040 at para. 32).
36. Upon visiting the splashndirt.ca website, the 509 merchandise is clearly set out under the 509 brand on the Respondent's website, just as the other brands are clearly identified by their brand name. Moreover, when clicking on the various brands, the other brands being sold on the Respondent's website are not in direct competition with the 509 merchandise as those other brands do not appear to include goggle, boots, outerwear or helmets in their product lines. There does not appear to be any confusion or deceit taking place in this instance. As such, it has not been proven that the registration was undertaken to attract traffic to the Registrant's site to the detriment of the Complainant pursuant to paragraph 3.5(d) of the Policy.
37. The Panel thus concludes that the Complainant has failed to show that the Registrant registered the Domain Name in bad faith as defined by the Policy or under terms analogous to the kinds of criteria identified in the Policy.

(c) Does the Registrant have a "Legitimate Interest" in the Domain Name?

38. Given the Panel's finding that bad faith has not been established in this instance, it is unnecessary to answer the question of "legitimate interest".

G. CONCLUSION AND DECISION

39. The Complainant has not established that the Domain Name was registered in bad faith as defined by the Policy. For this reason, the Complaint fails.

Dated March 26, 2019.



Daria Strachan, Chairperson



David Allsebrook