

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY
RESOLUTION OF COMPLAINT

Dispute Number: DCA - 2070 - CIRA
Domain Names: gamereadycanada.ca
Complainant: CoolSystems, Inc. dba Game Ready
Registrant: Nancy Berman
Panel: Melvyn J. Simburg (Chair), Thomas Manson, Q.C., and
David Wotherspoon
Service Provider: British Columbia International Commercial
Arbitration Centre

DECISION

The Parties

1. Complainant CoolSystems, Inc. is a manufacturer of durable medical equipment and manufactures and distributes a mechanical compression cryotherapy system sold under the name GAME READY®.
2. The Registrant Nancy Berman is the owner of Sports Recovery Systems, a former distributor of Complainant for GAME READY® products in Canada.

The Disputed Domain Name and Registrar

3. The Domain Name at issue is gamereadycanada.ca (Disputed Domain Name).
4. The Registrar of record for the Disputed Domain Name is Go Daddy Domains Canada, Inc.
5. The Disputed Domain Name was registered on October 20, 2005. WHOIS shows an update on February 26, 2019.

Procedural History

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognized service provider to the Domain Name Dispute Resolution Policy, (Policy) and the Rules, (Rules) of the Canadian Internet Registration Authority, (CIRA).

7. Complainant filed a complaint on March 4, 2019 (Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to Complainant.

8. BCICAC confirmed the Complaint to be in administrative compliance with the Rules. As the Complaint with attachments was filed exclusively online, BCICAC forwarded a copy of the Complaint to the Registrant in accordance with the Rules to tim@dwightmarine.ca.

9. The Registrant submitted its response to BCICAC on April 1, 2019. The response was in form in compliance with the Policy and Rules, but delivery was seven days after the timeframe required by the Rules, namely March 25, 2019.

10. Complainant filed a Reply on April 4, 2019, objecting to the Response as untimely filed without an application for extension and without Complainant's consent. The Panel has accepted filing of the Reply, but determines that the delayed Response filing was not a material delay and Complainant has not shown prejudice. Accordingly, the Panel accepts and has considered the Response. .

11. As required by paragraph 7.1 of the Rules, each Panellist has declared to BCICAC 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.

12. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would under paragraph 13.2 of the Rules result in a need to stay or terminate this proceeding.

Canadian Presence Requirements

13. In order for Complainant to be permitted to apply for registration of, and to hold and maintain the registration of a ".ca" domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.

14. Complainant is an eligible complainant under paragraph 1.4 of the Policy, because it meets the Canadian Presence Requirements as the owner of registered Canadian trademark GAME READY, Reg. No. TMA643241 issued June 29, 2005 based on an application filed December 5, 2001.

Relief Requested

15. Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Plaintiff.

The Positions of the Parties

The Position of Complainant

16. From 2005 to April 2016, Sports Recovery Systems, a Canadian corporation, served as Complainant's distributor in Canada for Complainant's GAME READY® products. Registrant's wife Nancy Berman is the owner and director of Sports Recovery Systems.

17. On October 20, 2005, Nancy Berman registered the Disputed Domain Name with herself as Registrant. Complainant contends that the registration was without its knowledge.

18. On January 1, 2015, Complainant and Sports Recovery Systems entered a written International Non-Exclusive Distribution Agreement with a term ending December 31, 2016. On October 6, 2015, the parties executed an addendum extending the expiration date to December 31, 2017.

19. On April 1, 2016, Complainant gave 30-days notice to Sports Recovery Systems of distribution rights termination. Under the Distribution Agreement Sections 8.3 and 8.4, the distributor is prohibited from using Complainant's trademarks in a domain name and upon termination must cease using Complainant's trademarks.

20. Complainant has several times requested Registrant to transfer the Disputed Domain Name. Registrant has not done so and has sought to tie transfer to an overall settlement payment from Complainant in relation to the distributorship termination. The Registrant's registration of the Disputed Domain Name was updated most recently on February 26, 2019. The website with the Disputed Domain Name now redirects automatically to www.sportsrecoveryystems.com.

21. Complainant has concerns that the Registrant has the ability to terminate the domain and has pointed it from a GAME READY® website to a different location. Complainant submits that this lack of control by Complainant over the domain is also an interference with Complainant's control over its trademark and use of the mark.

22. Complainant submits that the Registrant has no legitimate interest in the Disputed Domain Name and that the Disputed Domain Name was renewed without authorization and even without knowledge of the Complainant.

23. Complainant submits that Registrant originally registered the Disputed Domain Name improperly and without knowledge of the Complainant, but in any event thereafter the Disputed Domain Name became an improper registration when the Distribution Agreement was signed and also when the distribution authorization was terminated. Complainant asserts that the Registrant does not have a legitimate interest in the Domain, has no right to undertake any delivery of goods or services related to the Disputed Domain Name, and that the registration continues in bad faith under paragraph 3.5 of the Policy.

The Position of the Registrant

24. Registrant maintains that the original registration of the Disputed Domain Name was with Complainant's knowledge and approval in order to grow the GAME READY® System in Canada by Nancy Berman's Sports Recovery Systems on behalf of Complainant. Registrant has not addressed the reason for the registration's being filed in her name rather than listing Complainant or Sports Recovery Systems, but states that Registrant has registered several domain names and always does so under her name or her husband's and his company's name and account.

25. Registrant contends that Complainant's termination of the distribution arrangement was in bad faith, that the registration was on "autorenew," that she has not demanded payment for the Disputed Domain Name, but acknowledges that she has not voluntarily transferred it.

Analysis and Findings

26. The purpose of the Policy as stated in paragraph 1.1 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 Policy does not apply to other types of differences between owners of trademarks and Registrants of Domain names. The Panel expresses no opinion on Complainant's claims related to use of its trademark in connection with the sale or rental of goods by Registrant or others.

Relevant provisions of the Policy are provided below

27. Paragraph 4.1 of the Policy provides:

4.1 Onus. To succeed in a Proceeding, 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 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 Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Even if Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4 of the Policy.

28. Paragraph 3.2 of the Policy provides in part:

3.2 Mark. A "Mark" is

(a) a trade-mark, including the word elements of a design mark, or a tradename that has been used in Canada by a person, or the person's predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

The Policy does not require that a mark be registered in CIPO.

29. Paragraph 3.3 provides:

3.3 Confusingly Similar: In determining whether a domain name is "Confusingly Similar" to a Mark, the Panel shall consider only whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

In assessing whether a domain name is "Confusingly Similar," the Panel shall consider only the appearance, sound, or idea suggested and not have regard to other factors. According to paragraph 1.2 of the Policy, the presence of the country code top-level domain "dot-ca" does not alleviate the potential confusion between a trademark and domain name. The addition lacks distinctiveness and is not sufficient to give the Domain Name an individual meaning.

30. Paragraph 3.4 provides:

3.4 Legitimate Interest: For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the domain name:

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
- (b) the Registrant registered the domain name in Canada in good faith in association with wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
- (c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a website.

31. Paragraph 3.5 provides:

3.5 Registration in Bad Faith. For the purposes of paragraph 3.1(c) and 4.1(b), any of the following circumstances, in particular but without

limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

- (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 Complainant, or Complainant's licensor or licensee of the Mark, or to a competitor of Complainant, or the licensor or licensee 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 Complainant, or Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone 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 Complainant, or 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 location, by creating a likelihood of confusion with 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.

32. In summary, to succeed in a proceeding, Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a Mark in which Complainant had Rights prior to the registration of the Disputed Domain Name and continues to have such Rights;
2. The registration by the Registrant of the Disputed Domain Name is in bad faith; and
3. Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

Notwithstanding evidence presented that the Registrant has no legitimate interest in the Disputed Domain Name, the Registrant will succeed if the Registrant proves on a balance of probabilities that the Registrant has a legitimate interest in the Disputed Domain Name.

Confusingly Similar to a Mark

33. Evidence shows that Complainant is the owner of Complainant's Mark, that Complainant's Mark was in use when the Disputed Domain Name was initially registered, and Complainant continues to have its trademark rights and continues to use the Mark. The relevant definition of "Mark" requires that a trade-mark be "used". The term "use" is no longer defined in the Policy. The Complainant has been advertising and selling its services in Canada through a new distributor, thereby using the Mark since termination of Sports Recovery Systems as its distributor, and continues to do so. The Complainant therefore meets the use requirement.

34. In accordance with paragraph 3.3 of the Policy, a domain name is confusingly similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied. The Disputed Domain Name incorporates the entire words of the dominant features of Complainant's Mark.

35. In the case of *Great Pacific Industries v. Ghalib Dhala*, 00009 (CIRA Apr. 21, 2003), the Panel stated that the test of confusing similarity is whether the average Internet user, with an imperfect recollection of the Mark who wishes to access a website operated by Complainant, either by entering a domain name including the Mark into the address bar of an Internet browser or by entering the key terms of the domain name into an Internet search engine, would likely be confused as a matter of first impression.

36. Internet users who wish to access a website operated by the Complainant, either by entering a domain name including the Trade-mark into the address bar of the Internet browser, or by entering the key term of the Domain Name into an Internet search engine, would likely find the Disputed Domain Name as a matter of first impression. The Disputed Domain Name does not point to Complainant's website, but has been directed by the Registrant to point to www.sportsrecoverysystems.com, the website of Sports Recovery Systems.

37. Accordingly, for the reasons stated above, the Disputed Domain Name is confusingly similar to Complainant's Mark.

Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights

38. Complainant filed its trademark application in Canada for the GAME READY trademark on December 5, 2001, and received registration on June 29, 2005, in International Class 10 for medical equipment, namely, thermal therapy devices for controlling body temperature, hyperthermia and hypothermia care, and localized hot/cold therapy (TMA643241). The Disputed Domain Name was registered on October 20 2005 by Registrant. Registrant's use has been solely for the benefit of Sports Recovery Systems, which was a distributor of Claimant's products until May 1, 2016.

39. Complainant's Mark has been in continuous use from 2005 to the present by Complainant by distribution and sales of Complainant's products in Canada through Complainant's distributors.

40. The Panel is satisfied that Complainant's Mark was in use before initial registration of the Disputed Domain Name and accordingly Complainant had Rights in Complainant's Mark before the current Registrant's registration of the Disputed Domain Name and as the evidence shows that Complainant's rights are active, Complainant continues to have such Rights.

Was the Disputed Domain Name registered in bad faith?

41. The Panel notes that Section 3.5 of the Policy provides with respect to its subsections, that "any of the circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith."

42. Complainant submits that Registrant registered the Disputed Domain Name in Registrant's own name without Complainant's knowledge. Registrant asserts that the original registration was with Complainant's knowledge and consent and that the registration was intended to assist Complainant's business in Canada through the distribution of Complainant's products by Sports Recovery Systems.

43. The Panel finds that the facts of the initial registration are not determinative of the "bad faith registration" issue. Complainant terminated Sports Recovery Systems' distribution rights effective May 1, 2016. Thereafter, Registrant no longer held the registration rights even arguably as an agent for Complainant. Instead Registrant was no longer an agent and Registrant's refusal to transfer the Disputed Domain Name meant that Registrant acquired the Disputed Domain Name personally when the agency ended.

44. Evidence further shows that Registrant has failed to accede to Complainant's demand to transfer the Disputed Domain Name to Complainant. Although Registrant

contends it did not demand payment above registration costs, it “suggested” a price much higher, sought to tie transfer to resolution of a damages claim of Sports Recovery Systems, and has refrained from transferring the Disputed Domain Name to the present.

45. Additionally, Registrant retained an “autorenew” instruction with the Registrar so that the Disputed Domain Name ownership renewed in Registrant’s name, with an updated ownership date of February 26, 2019 showing Registrant’s ownership. Although “autorenew” creates a passive process in that it does not require another affirmative act by the Registrant other than paying the renewal fee, the Panel concludes that renewing the Disputed Domain Name in any manner is the equivalent of “acquiring” the domain name for purposes of Section 3.5.

46. Furthermore, Registrant has retained the Disputed Domain Name to redirect Internet traffic to Sports Recovery Systems, a competitor of Complainant.

47. Based on all the circumstances demonstrated in the material and all the evidence provided by Complainant, the Panel is satisfied that Complainant has proven bad faith registration of the Disputed Domain Name as required by the Policy. This conclusion is based on the following determinations, each of which alone constitutes Bad Faith Registration:

1. The Registrant “acquired” the Disputed Domain Name in the ways described above, primarily for the purpose of selling the Registration to the Complainant for valuable consideration in excess of the Registrant’s actual costs in registering or acquiring the Registration, which constitutes Bad Faith under Section 3.5(a).
2. Alternatively, the Registrant “acquired” the Disputed Domain Name in the ways described above, primarily for the purpose of disrupting the business of the Complainant or the Complainant’s licensed distributor, who is a competitor of the Registrant, which constitutes Bad Faith under Section 3.5(c).
3. Alternatively, the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the website of Sports Recovery Systems, in which Registrant has a relationship and interest, by creating a likelihood of confusion with the Complainant’s Mark as to the source, sponsorship, affiliation, or endorsement of the Sports Recovery Systems website, which constitutes Bad Faith under Section 3.5(d).

Legitimate Interest of the Registrant

48. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on Complainant to provide “some evidence” that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although “some evidence” is not defined, it imposes, in the Panel’s view, a lower threshold than would “a balance of probabilities.” The onus on Complainant is to provide “some evidence” of a negative.

49. Complainant has provided evidence that none of the conditions stated in the non-exhaustive list contained in paragraph 3.4 of the Policy is present in this dispute, and therefore has met its burden to provide “some evidence” that the Registrant has no legitimate interest in the Disputed Domain Name, and in fact Complainant has provided evidence that the Registrant’s interest is currently for an improper use.

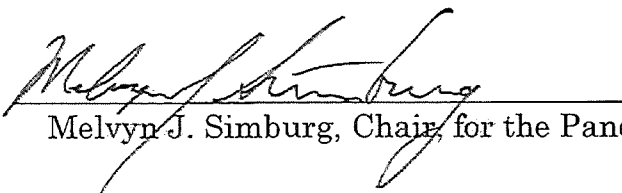
50. Registrant did not provide evidence that on a balance of probabilities refutes Complainant’s evidence. Based on the evidence provided, the Panel is satisfied that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision

51. For the reasons set out herein, the Panel decides in favor of Complainant and orders the transfer forthwith of the Disputed Domain Name to Complainant.

Dated April 30, 2019

Melvyn J. Simburg (Chair), David Wotherspoon, Thomas Manson, Q.C.



Melvyn J. Simburg, Chair, for the Panel

