

**IN THE MATTER OF A COMPLAINT IN ACCORDANCE WITH THE  
CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA) DOMAIN  
NAME DISPUTE RESOLUTION POLICY AND RESOLUTION RULES**

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Case number: DCA-899-CIRA

Disputed Domain Name: **rgis.ca**

Complainant: RGIS Inventory Specialists

Registrant: AccuTrak Inventory

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

Panel member: Kenneth A. Gamble (Chair)  
Jacques A. Léger  
Elizabeth Cuddihy

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**Panel's decision**

**1. Parties and Disputed Domain Name**

The Complainant is **RGIS Inventory Specialists (RGIS)**, whose address is 2000 East Taylor Road, Auburn Hills, Michigan 48326 U.S.A. The Complainant is represented by Eric Macramalla of the law firm Gowling Lafleur Henderson LLP, 160 Elgin Street, Suite 2600, Ottawa, Ontario K1P 1C3, Canada.

The Registrant is **AccuTrak Inventory (AccuTrak)**, located at Abaa Dr Abaa, NU 90210 China.

The disputed domain name is **rgis.ca**. The Registrar for that domain name is CanReg.com, 4611 Viking Way, Suite 270, Richmond, British Columbia V6V 2K9 Canada.

**2. Procedural History**

This is a dispute resolution proceeding initiated under the CIRA Domain Name Dispute Resolution Policy (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (the "Rules"). By registration of the domain name with the Registrar, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and the Rules.

According to information provided by the Service Provider, the BCICAC, the history of the proceeding is as follows:

- (a) The Complainant filed a complaint with respect to the above-referenced domain name in accordance with the Policy on January 24, 2006. The Complaint was reviewed and found to be compliant, and the Service Provider forwarded a copy of the Complaint to the Registrant on January 24, 2006 in accordance with the Rules.
- (b) The Registrant has not provided a Response.
- (c) The Complainant has not elected, as it was entitled under Rule 6.5 to do in the absence of Response from the Registrant, to convert from a panel of three to a single arbitrator, and the Service Provider has therefore appointed a panel of three arbitrators; Kenneth A. Gamble C.Arb. as Chair, Jacques A. Léger Q.C., and Elizabeth Cuddihy Q.C. (collectively “the Panel”).
- (d) Each of the members of the Panel has delivered to the Service Provider an Acceptance of Appointment as an Arbitrator and Statement of Independence and Impartiality, in conformity with the Rules.

The Complaint was filed in English, which is accordingly the language of the proceeding.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules and that, based upon the information provided by the Service Provider, all procedural requirements for the commencement and maintenance of this proceeding were met.

### **3. Facts**

The Complainant RGIS is the world’s largest inventory service provider. Founded in 1958, the company is offering its services to various sectors, including retail, warehousing, distribution and pharmaceutical sectors. Through 400 offices and 40,000 employees worldwide, the Complainant RGIS offers its inventory services to over 17,000 customers throughout Canada, the U.S., Mexico, Europe, South America, and the Middle East.

The Complainant RGIS is the registered owner of the Canadian trade-mark RGIS, registration No. TMA 344,421 as well as two other registered trade-marks: RGIS INVENTORY SPECIALISTS registration No. TMA 369,921 and RGIS INVENTORY SPECIALISTS Design, registration No. TMA 362,334.

The Complainant has been using its RGIS trade-mark extensively and continuously in Canada since at least as early as November 1984 in association with inventory services and is well known throughout Canada in connection with the provision of such services.

The Registrant AccuTrak offers inventory-related services in North America. It is in direct competition with the Complainant in that it caters the same type of clients and offers the same type of inventory services, including inventory consulting and reporting, inventory management, employee management and the provision of sales reports.

On May 29, 2001, the Registrant registered the domain name **rgis.ca** and pointed it to a website promoting the inventory services of Totals Inventory Professionals of Canada (“Totals Inventory”).

The Registrant is related to Totals Inventory in such way that Totals Inventory operates in South Eastern United States under the name “AccuTrak”. Also, the addresses corresponding to Totals Inventory and initially to AccuTrak are the same and the administrative contact for both companies is M. Everett.

On October 11, 2005, concerned about the misleading nature of the Registrant’s website, the Complainant issued a cease and desist letter advising the Registrant of its rights in the RGIS trade-marks, and requesting that **rgis.ca** be transferred to it. Said letter could not be delivered on the account of an invalid mailing address. However, the letter appeared to have been successfully delivered by email since no notice of false address had been received by the Complainant.

On October 14, 2005, the information relating to the **rgis.ca** domain name was altered to correspond to the actual information available, which shows China as a referral country, a California zip code, “Aba abaa” as a contact name and a New-Mexico telephone number. The website to which **rgis.ca** was pointing had also been altered to refer to the New Mexico Resource Organization (also known as R.G.I.S.), available at [rgis.unm.edu](http://rgis.unm.edu). The Complainant asserts that the New Mexico Resource Organization is in no way involved in the present case.

#### **4. Complainants Contentions**

The Complainant contends that its trade-marks constitute Marks within the terms of paragraph 3.2 of the Policy, and that by virtue of its use of the Marks in Canada, the Complainant has Rights in the Marks. It further contends that the disputed domain name registered by the Registrant is confusingly similar with the Complainant’s Marks, in particular the registered Canadian trade-mark RGIS.

The Complainant further contends that the Registrant has no legitimate interest in the disputed domain name, and that the domain name has been registered in bad faith. It requests transfer of the disputed domain name to the Complainant.

As previously stated, the Registrant has filed no Response.

## 5. Canadian Presence Requirements

Pursuant to paragraphs 1.4 and 3.4 of the Policy, and paragraph 2(q) of the *CIRA Policies Procedures and Guidelines: Canadian Presence Requirements For Registrants*, the disputed domain name **rgis.ca** is identical to the Complainant RGIS's registered Canadian trade-mark, RGIS, registration No. TMA 344,421, as well as including the exact word element with the Complainant RGIS's registered Canadian trade-marks RGIS INVENTORY SPECIALISTS registration No. TMA 369,921 and RGIS INVENTORY SPECIALISTS Design, registration No. TMA 362,334.

Accordingly, the Complainant satisfies the Canadian Presence Requirements as prescribed by the Policy.

## 6. Discussion and Reasons

To succeed in a proceeding under section 4.1 of the CIRA Policy, the Complainant must prove, on a balance of probabilities, that:

- 1- the Registrant's dot-ca domain name is confusingly similar to a mark in which the Complainant had rights prior to the date of the registration of the domain name and continues to have such rights;
- 2- the Registrant has registered the domain name in bad faith;
- 3- some evidence points that the Registrant has no legitimate interest in the domain name;

### (a) Is **rgis.ca** confusingly similar with the Complainant's Marks?

The trade-mark RGIS registered in the CIPO by the complainant constitutes a Mark under paragraph 3.2 (c) of the Policy. The other trade-marks described above also qualify as Marks under paragraph 3.2 (c). Under paragraph 3.3 (b) of the Policy, the complainant has Rights to the Marks since it has been registered in CIPO.

As it was held by the Panel in *Government of Canada, on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, BCICAC Case No. 00011, where a complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit the Panel to go behind the registration to determine whether the Mark is valid or invalid based upon lack of distinctiveness or non-

use. Said principle was confirmed in *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.*, BCICAC Case No. 00015:

“For the purpose of construing “confusing similarity” between the domain name and the complainant’s mark, the Policy draws a distinction between rights in a mark registered in CIPO before the date the domain name was registered and common law rights in a mark acquired through use by the complainant. With the former, a complainant need not demonstrate distinctiveness or use to establish “rights” in a mark which is alleged to be confusingly similar to the domain name. The registration of the mark in CIPO is sufficient in and of itself to establish such “rights” within the meaning of the Policy.”

In the present case, the trade-marks RGIS, RGIS INVENTORY SPECIALISTS and RGIS INVENTORY SPECIALISTS Design, were respectively registered in the CIPO on September 2, 1988, November 3, 1989 and June 29, 1990, well before the registration of the domain name **rgis.ca** by the Registrant on May 29, 2001. Hence, it must be held that the Complainant’s rights in the name RGIS precede those of the Registrant.

The registration and use of the trade-mark RGIS, and of the other registered trade-marks RGIS INVENTORY SPECIALISTS and RGIS INVENTORY SPECIALISTS Design, as referenced above, pre-date the registration of **rgis.ca** by the Registrant. Under section 3.4 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 to have been mistaken for the Mark. It was held by the Panel in *RRI Financial, Inc. v. Ray Chen*, WIPO Case No. D2001-1242 that a registrant cannot avoid confusion by appropriating another’s entire mark in a domain name. It must thus be held that the **rgis.ca** domain name is confusingly similar with the RGIS trade-mark since it has misappropriated the entirety of the registered trade-mark. Further, **rgis.ca** is confusingly similar to the registered Canadian trade-marks RGIS INVENTORY SPECIALISTS and RGIS INVENTORY SPECIALISTS Design, as it incorporates the whole of the distinctive element of these marks, namely, RGIS.

**(b) Has rgis.ca been registered in bad faith?**

To prove that the domain name rgis.ca has been registered in bad faith, the Complainant refers to paragraph 3.7 (c) of the Policy, which states that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant.

It has been established clearly by the Complainant that the Registrant and itself are direct competitors; the Panel does not need to adapt its analysis to a broader definition of competitor, since the commonly used definition is sufficient to the present case and the evidence presented to the Panel supports this thesis sufficiently (*TransUnion LLC v. 1491070 Ontario Inc.*, Resolution Canada Inc. Case No.00008).

In finding bad faith as per paragraph 3.7 (c) of the policy, the Complainant cites the Panel *Browne & Co. Ltd. v. Bluebird Industries*, Resolution Canada Case no. 00005:

“The Registrant and the Complainant are competitors in business. The Registrant conducts business under the name Bluebird Industries. The domain name “browneco.ca” has no apparent connection to the business activities of Bluebird Industries. The Registrant should readily understand that its use of the confusing domain name browneco.ca would mislead customers or would-be customers of the Complainant in directing them not to a web site of the Complainant, but to the web site of one of the Complainant’s competitors, the Registrant. It is reasonable inference that the Registrant acquired the domain name registration “primarily for the purpose of disrupting the business of the Complainant”, as stated in CIRA Policy, paragraph 3.7 (c).”

Panels have also held that bad faith exists in cases where the use of a domain name is likely to cause confusion among Internet users as to affiliation or sponsorship. This principle was confirmed in *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020:

“ The phrase “disrupting the business of the Complainant” as per the Policy has been held to be

satisfied where the use of the domain name creates a likelihood of confusion among end users as to affiliation or sponsorship, and includes trade-mark infringement and passing off.”

In the same way, the Panel held as follows in its finding of bad faith in *Sotheby's (Canada) Inc. v. PII Technologies Inc. and Keith Lihou*, BCICAC Case No. 00026:

“The Registrant is using the domain name in association with services that are similar if not identical to the services offered by the Complainant. Internet users who come upon the Registrant’s website may reasonably believe that it is the Complainant’s website or is endorsed, sponsored or approved by the Complainant.”

Those cases could be sufficient in establishing registration in bad faith from the part of the Registrant, but the Complainant submitted further arguments which deserve to be emphasised, especially since the Panel can infer from surrounding circumstances and common sense in determining whether a registrant’s actions are captured by paragraph 3.7 of the Policy (*Canadian Broadcasting Corporation /Société Radio-Canada v. William Quon*, BCICAC Case No. 00006). First, it argues that the use of **rgis.ca** by the Registrant to redirect Internet users to a website which competes directly with the Complainant RGIS constitutes a *prima facie* disruption of the complainant RGIS and its business. By using a domain name which is identical to the registered RGIS trade-mark, and confusingly similar with the two other RGIS trade-marks, the Registrant has clearly attempted to capitalize on the likelihood that Internet users would be confused into believing that **rgis.ca** would somehow connect them to the Complainant RGIS website, or one that is endorsed by, or affiliated with the Complainant RGIS. Since RGIS is a leader in its field, and also a competitor of the Registrant, it is reasonable to infer that the Registrant knew this diversion would be disruptive to the Complainant’s business.

Also, the fact that the initial mailing address provided in the Registrant information was not valid and that following the issuance of the Complainant RGIS’s demand correspondence, the Registrant information was amended to reflect false contact information, including a nonsensical mailing address, a false telephone number and an

inactive email address. A Registrant's provision of false contact information can support a finding of bad faith (*Biogen Inc. v. Xcalibur Communication*, Resolution Canada CIRA Dispute No. 00003) as can the failure to respond to a complainant's transfer request, especially when positive actions are taken after issuance of such demand (*Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon*, BCICAC Case No. 00006). Hence, the Panel finds this further supports that the domain name **rgis.ca** can be deemed to have been registered in bad faith by AccuTrak.

**(c) Does the Registrant have any Legitimate Interest in the Domain Name?**

To establish legitimate interest in a domain name under paragraph 3.6 of the Policy, the overall circumstances should demonstrate that the registration was obtained in good faith for the purpose of making *bona fide* use of the domain name.

However, the offering by a registrant of goods or services that competes with, or rival, the goods or services of a complainant in association with a domain name comprised of the complainant's trade-mark, undermines a claim of good faith or *bona fide* use (as set out in *Browne & Co. Ltd/Ltée v. Bluebird Industries*, Resolution Canada Case No. 00005). Hence, it is impossible to assert that the Registrant registered the domain name for *bona fide* use because being a competitor of the Complainant, it must have known that the use of the Complainant's trade-mark in the domain name would misdirect Internet users towards a competitor's website. Also, the domain name cannot be invoked as being used as a Mark, following paragraph 3.2 (a) of the Policy, because it was not used in order to distinguish the services or business of that person from the wares, services or business of another person. The Panel finds that the **rgis.ca** domain name is not descriptive pursuant to paragraph 3.2 (b), nor is it generic of the wares or services used in association in any language known in Canada, following paragraph 3.2 (c) of the Policy. The **rgis.ca** domain name was not used for a non-commercial activity (3.2 (d)), was not indicating a geographical location (3.2 (f)) nor was it used as a name, surname or other reference by which the Registrant was commonly identified, pursuant to paragraph 3.2 (e). Hence, and especially since the Registrant had never been licensed, or otherwise



authorised to use the RGIS trade-mark, the Panel finds that, following the evidence before it, the Registrant does not have any legitimate interest in **rgis.ca**.

### **Conclusion**

For the foregoing reasons, the Panel decides that:

- the Complainant is an entity which is permitted under the Canada Presence Requirements for the Registrant to hold and maintain the registration of a domain name;
- the domain name registered by the Registrant is confusingly similar to the trademarks in which the Complainant has rights;
- the domain name has been registered in bad faith;
- the Registrant has no legitimate interest in respect of the domain name **rgis.ca**.

Considering the aforesaid reasons, the Panel decides the dispute in favour of the Complainant, RGIS Inventory Specialists.

The Panel therefore orders, pursuant to paragraph 4.3 of the CIRA Policy, that the domain name **rgis.ca** be transferred to the Complainant, RGIS Inventory Specialists.

Dated this 6<sup>th</sup> day of March, 2006

Kenneth A. Gamble, Jacques A. Léger, Elizabeth Cuddihy,



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Kenneth A. Gamble (Chair)