

RECEIVED AUG 25 2006

BRITISH COLUMBIA INTERNATIONAL
COMMERCIAL ARBITRATION CENTRE

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

Domain Name: <forsale.ca>
Complainant: Globe Media International Corporation
Registrant: Dawn Internet Telephony Systems Inc.
Registrar: DomainsAtCost.ca Corporation
Panelists: Edward C. Chiasson, John F. Lee, Hugues G. Richard
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

Parties

The domain name <forsale.ca> (the “Domain Name”) is at issue in this proceeding.

The Complainant is Globe Media International Corporation, an Ontario corporation. The Registrant is Dawn Internet Telephony Systems Inc.

The Registrar of the Domain Name is DomainsAtCost.ca Corporation.

Procedural History

This is a proceeding under the Canadian Internet Registration Authority (CIRA) Domain Name Dispute Resolution Policy (Version 1.1 - Effective Date: December 4, 2003) (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules (Version 1.2 - Effective Date: December 4, 2003) (the “Rules”). Both the Policy and the Rules were posted on the CIRA website on November 4, 2003.

The history of this proceeding, according to the information provided by the dispute resolution service provider, British Columbia International Commercial Arbitration Centre (“BCICAC”), is as follows:

- (a) On July 11, 2006, the Complainant filed a complaint in English regarding the Domain Name with BCICAC (the “Complaint”).
- (b) The Complaint was reviewed and found to be compliant the requirements of the Policy and the Rules. By email dated July 11, 2006 the BCICAC advised the parties and forwarded a copy of the Complaint to the Registrant using the email address for the Administrative Contact of the Domain Name.

- (c) A hard-copy of the Complaint was delivered to the Registrant on July 12, 2006 by courier to an address in Kanata, Ontario. This Kanata address was provided by the Complainant and is not readily disclosed in the WHOIS record for the Domain Name. The Registrant's particulars on the WHOIS record for <forsale.ca> are shielded using the third party service Privacy.ca. The WHOIS record shows the Administrative and Technical contacts for the domain <forsale.ca> as Rob Hall, Chief Privacy Officer, Privacy.ca (43 Auriga Drive, Ottawa, Ontario).
- (d) The Registrant has not made submissions.
- (e) The Complainant has elected to maintain a three-person panel.
- (f) The BCICAC named Edward C. Chiasson, John F. Lee, Hugues G. Richard as panelists (the "Panel"). Mr. Lee was named Chair of the panel. Each of the Panelists delivered to the BCICAC the required Statement of Impartiality and Independence, as required by paragraph 7 of the Rules. The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules.
- (g) Absent exceptional circumstances, the Panel was required to deliver its decision no later than August 25, 2006.

While the Registrant has not made submissions, Paragraph 4.2 of the Policy requires that the Panel consider all the evidence presented in the Proceeding and that the Panel render its decision in accordance with the Policy and the Rules.

Background

The Complainant is the owner of the Internet domain name <for-sale.ca> and operates an on-line Internet advertising service. For a flat fee, the Complainant allows consumers to advertise products that are for sale. There are a variety of products listed on <for-sale.ca> including antiques, boats and automobiles. With each paid listing, the customer receives a "FOR SALE" sign that includes the term "www.for-sale.ca". The obvious purpose of this sign is to allow persons that see a product marked with this sign to then locate additional information on-line at "www.for-sale.ca". The Complainant's evidence is that its advertising business at "www.for-sale.ca" has been in business since at least as early as April 2003 and such use continues today.

The Complainant is the owner of Canadian trade-mark registration TMA 630,824 for the trade-mark "www.for-sale.ca" in association with the services, "hosting a website to permit the advertising of products and services of others in exchange for a licensing fee." This mark is registered as a stylized mark in all lowercase letters with the right to the exclusive use of WWW. and .CA disclaimed apart from the trade-mark.

The Registrant is named as Dawn Internet Telephony Systems Inc. A NUANS® search provided by the Complainant shows that this company was dissolved in 2004.¹ The domain

¹ On May 25, 2006, an Ontario Business license was secured for the name "Dawn Internet Telephony Systems" by Stefano Venneri as a sole proprietor. Mr. Venneri is the contact for the Complainant and this registration was raised by the Complainant to support its position that the Complainant secured to evidence that the Registrant has no

name <forsale.ca> was pre-existing and acquired by the Registrant by transfer on or about May 8, 2006.

The WHOIS service by CIRA only shows the current registration particulars for a domain name. On evidence from the Complainant, the domain name <forsale.ca> was previously owned by Sohail Khan. On March 10, 2006 the Complainant sent a without prejudice letter to Mr. Khan in London, Ontario alleging that use of <forsale.ca> infringed the Complainant's trade-mark rights in "www.for-sale.ca". The Complainant required that Mr. Khan cease and desist from the use of <forsale.ca> in association with his business and that <forsale.ca> be transferred to the Complainant.

Mr. Khan by his solicitor responded with a without prejudice offer to settle. Mr. Khan proposed to cease and desist from various uses of the phrase FOR SALE that would infringe or otherwise depreciate the goodwill of Canadian trade-mark registration TMA 630,824 owned by the Complainant. In exchange, the Complainant would pay consideration of \$5000 to Mr. Khan and provide a full and final release for the alleged infringing conduct. Mr. Khan did not offer to transfer the Internet domain name <www.forsale.ca> or forbear on other non-infringing uses of the Internet domain name <www.forsale.ca>.

The Complainant's submissions suggest that settlement negotiations continued but no explanation is given. The Complainant's evidence indicates that it made an offer to purchase <forsale.ca> for over \$7500 that was refused by Mr. Khan. The Complainant submits that Mr. Khan then transferred the domain to the Registrant in an attempt to evade the alleged trade-mark infringement.

The Complainant states that Dawn Internet Telephony Systems Inc. is or was a company of Mr. Khan. No further particulars of the relationship between Mr. Khan and Dawn Internet Telephony Systems Inc. are explained or given.

Prior to discovering a relationship between Mr. Khan and Dawn Internet Telephony Systems Inc., the Complainant made an offer of \$18,000 to the Registrant at <pmb540765@privacy.ca> to purchase the Internet domain name <forsale.ca>. The email in which the offer was made was automatically refused by <pmb540765@privacy.ca>.

The Complainant's evidence is that the Registrant has not used the Internet domain name <forsale.ca> in connection with any active website. Prior to July 5, 2006 the domain name provided a notice "Direct access to this location is not allowed". As of July 5, 2006 (the date the Complaint was finalized) the message at <forsale.ca> read, "Interested in purchasing the forsale.ca domain, send email to info@forsale.ca". At the time of this decision no such message existed and there is an active website at <forsale.ca> that advertises houses for sale by owner with one active listing.

legitimate interest in the disputed domain name. Whether or not the Complainant has secured a business license for the name that is identical to or similar to the Registrant has no bearing on this case and is curious given that such a registration may disrupt the business of the Registrant, which is the very conduct impugned by the Complainant.

The Complainant has commenced this process requesting, as a remedy, that the domain name <forsale.ca> be transferred to the Complainant.

Position of the Complainant

The Complainant seeks an order requiring the Domain Name to be transferred to it on the following bases:

- (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.
 - (i) The Complainant is the owner of the trade-mark "www.for-sale.ca" registered in the Canadian Intellectual Property Office (CIPO).
 - (ii) This mark was obtained by the Complainant in advance of the registration of the Domain Name.
 - (iii) The Domain Name is essentially identical to the registered trade-mark;

Accordingly, the Domain Name is confusingly similar to the Complainant's www.for-sale.ca mark.

- (b) The Registrant has no legitimate interest in the Domain Name as the Registrant has not satisfied any of the requirements set forth in paragraph 3.6 of the Policy.
- (c) The Registrant registered the Domain Name in bad faith as described in paragraph 3.7.

Discussion and Findings

Paragraph 4.1 of the Policy directs that the Complainant will succeed only where it proves, on a balance of probabilities, that:

- (a) The Registrant's dot-ca Domain Name is "Confusingly Similar" (as defined in Policy paragraph 3.4) to a "Mark" (as defined in Policy paragraph 3.2) in which the Complainant had "Rights" (as defined in Policy paragraph 3.3) 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 Policy paragraph 3.7; and
- (c) the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as described in Policy paragraph 3.6.

The Policy provides that even if the 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 he has a legitimate interest in the Domain Name as described in Policy Paragraph 3.6.

The established procedure in these matters is to examine the Complaint with regard to each of these three requirements.

Confusing Similarity Between the Domain Name and the Complainant's Mark

The panel concludes that the Complainant has not established, on a balance of probabilities, that the Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the registration of the Domain Name.

As noted above, Paragraph 4.1(a) requires the disputed domain name is confusingly similar to a mark in which the Complainant had rights “prior to the date of registration of the Domain Name”.

When was the disputed domain name registered? The evidence of the Complainant, on the basis of the WHOIS record, is that the disputed domain name was transferred to Dawn Internet Telephony Systems Inc. on May 8, 2006. The panel finds as a fact that the Registrant acquired this pre-existing domain name on or about this date.

Paragraph 3.1 of the Policy defines the date of registration of a domain name as the date it was created:

For the purposes of this Policy, the date of registration of a domain name is the date on which the domain name was first registered in the Registry or the predecessor registry operated by the University of British Columbia.

The Policy is unequivocal on this point and Paragraph 3.1 has been consistently interpreted to have this plain meaning: See for example, *Cheap Tickets and Travel Inc. v. Emall.ca Inc.* (January 31, 2003), *Canadian Thermos Products Inc. v. Michael Fagundes* (January 18, 2006).

The date that the domain name was “approved” as shown on the WHOIS record has been accepted by previous panels as evidence of the date that the first registered (See *Covercrete (Canada) Ltd v. Epoxy Solutions Inc.* (July 26, 2004)). The WHOIS record for <forsale.ca> shows that the domain name was *approved* on October 20, 2000 and the Panel accepts this as the date that the Domain Name was first registered.

The Complainant must establish that it had rights to a trade-mark that is confusingly similar to the domain name prior to October 20, 2000.

The Complainant claims that it has used the trade-marks “www.for-sale.ca” and FOR-SALE continually in Canada since at least as early as April, 2003. The Complainant claims that it

commenced use of the mark also in April, 2003. The Complainant's trade-mark registration TMA 630,824 was filed on the basis of intent-to-use in Canada on April 7, 2003 and the application passed to registration on January 21, 2005. There is no evidence of use of FOR-SALE or "www.for-sale.ca" as a trade-mark or a trade name prior to April, 2003.

On these facts, the Complainant has failed to establish that 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 as required under Paragraph 4.1(a) of the Policy.

In view of this finding, the Panel need not and does not decide whether the Registrant has acquired the registration of the Domain Name in bad faith or whether the Registrant has any legitimate interest in the Domain Name. As the Complainant has failed to discharge the first requirement of evidencing that it had Rights in a trade-mark or trade name as at the date of registration of the Domain Name, any remedy for the Complainant's allegations must be pursued in another forum.

Service of the Complaint

The Panel has one concern relating to the service of the Complaint on the Registrant. The Complaint was served by email to the email address for the Administrative Contact and delivered by courier to an address in Kanata, Ontario.

The Kanata, Ontario address was provided by the Complainant and does not appear in the Registrant information for the Domain Name. The Complainant did not explain where the Kanata, Ontario address for the Complainant was obtained.

The Panel notes that the Privacy.ca service will provide Registrant contact information by following the required procedure. A reasonable explanation may be that the Complainant completed this procedure; however, the Panel has not been provided with information in this regard.

Paragraph 2.1 of the Rules provides that Notice of the Complaint will be deemed to have been given by the Provider if the Complaint was delivered according to a specific protocol that includes delivery:

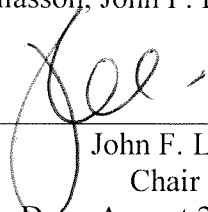
by prepaid postal or courier service, return receipt requested, to all facsimile and postal mail addresses: (i) of the Registrant and the administrative contact of record in the Registration Information for each Registration in issue.

If the Panel was required to proceed with a further analysis of "confusingly similar", the registration of the Domain Name in bad faith, or if the Registrant has any legitimate interest the Domain Name, then it would have requested further submissions under Paragraph 11.1 of the Rules from the Complainant to evidence that the Registrant had received timely notice of the Complaint.

Order

For the reasons set out above, the Panel orders that this Complaint be dismissed.

Edward C. Chiasson, John F. Lee, Hugues G. Richard

A handwritten signature in black ink, appearing to read 'J. Lee', is written over a horizontal line.

John F. Lee
Chair
Date: August 24, 2006

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