

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

Domain Name: pinggolf.ca

Complainant: Karsten Manufacturing Corporation, represented by Bryan Cave LLP

Registrant: Leonid Zapadinski

Registrar: eNom Canada Corp.

Panelists: Stefan Martin, Hugues G. Richard and Anton M.S. Melnyk (Chair)

Service Provider: British Columbia International Commercial Arbitration Centre

BCICAC File No. DCA-942-CIRA

DECISION

The Parties

The Complainant is Karsten Manufacturing Corporation, 2201 West Desert Cove, Phoenix, Arizona 85029 USA.

The Registrant is Leonid Zapadinski, 601 Clark Avenue West, Apt. 608, Thornhill, Ontario, L4J 8E1.

The Domain Name and Registrar

The Domain Name at issue is pinggolf.ca (“the Domain Name”).

The Registrar is eNom Canada Corp.

Procedural History

This is a proceeding under the Canadian Internet Registration Authority (CIRA) Domain Name Dispute Resolution Policy (Version 1.1 Effective 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 Rules were posted on the CIRA website on November 4, 2003. The British Columbia International Commercial Arbitration Centre (“the Centre”) is an approved Service Provider for CIRA.

By letter and e-mail dated September 6, 2006 the Centre advised the Parties that the Complaint was compliant with the requirements of the Policy and Rules. A hard copy of the Complaint and Centre letter dated September 6, 2006 was delivered to the Registrant by Federal Express on September 7, 2006.

By letter dated October 10, 2006, the Centre advised the Panel and the Parties that:

"... The Centre received an e-mail from a parking company DomainSpa.com on September 9, 2006 informing that the site www.pinggolf.ca has been closed and the Registrant is ready to transfer the above-named domain name to the Complainant; however, the Center has not received any instructions from the Complainant in respect to the proposal to terminate the arbitration..."

The Centre appointed, as panelists, Hugues G. Richard, Stefan Martin and Anton M.S. Melnyk, Q.C. (Chair).

The Panel has reviewed the submissions provided by the Complainant and agrees with the Centre that the Complaint complies with the formal requirements of the CIRA Policy and Rules.

This Panel finds that it was properly constituted and has jurisdiction to consider the Complaint.

The Complainant requests that the Domain Name be transferred to the Complainant, or, in the alternative, the Domain Name be cancelled.

Factual Background

The Complainant is the owner of the following trademarks registered in the Canadian Intellectual Property Office (CIPO):

<u>Mark</u>	<u>Reg'n No.</u>	<u>Reg'n Date</u>	<u>Goods</u>
PING	TMA173128	1970-12-04	golf clubs, etc.
PING (design)	TMA373014	1990-09-07	clothing, etc.
PING (design)	TMA373788	1990-09-28	golf clubs, etc.

The Complainant and its predecessors used the "PING" mark in Canada for over 40 years.

According to the CIRA WHOIS database, the Registrants Domain Name was registered

in 2004, long after the Complainant's use and registration of its trade mark PING.

The Registrant's website (Schedule 5 of the Complaint) deals with golf equipment in general and in part reads:

"This Domain is for Sale"

Analysis and Findings

Rule 5.8 of the Rules provides:

"5.8 No Response. If a Registrant does not submit a Response within the period for submission of a Response or any period extended pursuant to paragraph 5.4 or 5.6, the Panel shall decide the Proceeding on the basis of the Complaint unless the Proceeding is terminated by the Complainant pursuant to paragraph 8.1. (amended 2003-12-04)"

There is nothing before us to suggest that the Complainant's Submission is not credible.

To succeed, the Complainant must satisfy Section 3.1 of the Policy which provides:

"3.1 Applicable Disputes. A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules 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 no legitimate interest in the domain name as described in paragraph 3.6; and*
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7.*

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."

We shall now consider the applicable subsections of Section 3.1.

The Domain Name "pingolf.ca" incorporates the Mark "ping" in its entirety. Having regard to the fact that the Mark refers to goods and wares being "golf clubs, golf bags, golf balls

and accessories”, we have little doubt that on the evidence before us the Domain Name “pinggolf.ca” is “Confusingly Similar” to the Mark “ping”, as contemplated by Section 3.1(a) of the Policy and as defined in Section 3.4 of the Policy which reads:

*“3.4 **“Confusingly Similar”.** 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 be mistaken for the Mark.”*

We find that the Complainant had Rights, as defined in Section 3.3 of the Policy, to the Mark prior to the registration of the Domain Name and continues to have such Rights as contemplated by Section 3.1(a) of the Policy.

We find that the Complainant meets the requirements of Section 3.1(a) of the Policy.

Section 3.7 of the Policy provides:

*“3.7 **Registration in Bad Faith.** For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if and only if:*

- (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 was 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; or*
- (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.”*

Based on the Registrant's website which indicated “Domain for Sale” and the evidence of the Complainant as to the resulting confusion, we find bad faith as defined in Section 3.7(a) and

3.7(c) of the Policy and accordingly as required by Section 3.1(c) of the Policy.

Section 3.6 of the Policy provides:

“3.6 Legitimate Interests. *The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:*

- (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 used the domain name in Canada in good faith in association with any 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;*
 - (iii) *the place or origin of the wares, services or business;*
- (c) *the Registrant used 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 paragraphs 3.6(b), (c), and (d) “use” by the Registrants includes, but is not limited to, use to identify a web site.”

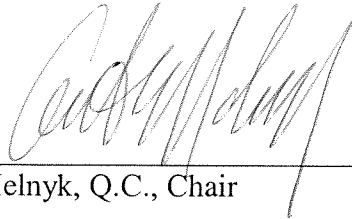
Based on the submission of the Complainant, none of the requirements of Section 3.6 were met by the Registrant. There, of course, was no evidence by the Registrant.

We find that the Registrant did not have a legitimate interest in the Domain Name as required by Section 3.1(b) of the Policy.

Decision

Accordingly, pursuant to paragraph 4.3 of the Policy, the Panel orders that the registration of the Domain Name pingolf.ca be transferred to the Complainant.

Stefan Martin, Anton M.S. Melnyk, Q.C., and Hugues G. Richard



Anton M.S. Melnyk, Q.C., Chair

Dated: October 30, 2006