

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

Dispute Number: DCA 968-CIRA
Domain Name: www.trailpeak.ca
Complainant: Trailwest Online Inc.
Registrant: Talltech Systems Inc.
Registrar: Tucows.com
Panellists: Barry Effler, Chair, Cecil Branson, and David Wotherspoon, panellists.
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant is Trailwest Online Inc., 105 – 4438 W. 10th, Vancouver, British Columbia, V6R 4R8.
2. The Registrant is Talltech Systems Inc., 7079 196B Street, Langley, British Columbia, V2Y 2Z7.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue in this proceeding is: “trailpeak.ca”.
4. The Registrar is: Tucows.com (Tucows Inc. of Toronto, Ontario).
5. The Domain Name was registered by the Registrant on July 28, 2006.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre (“**BCICAC**”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“**Policy**”) of the Canadian Internet Registration Authority (“**CIRA**”).
7. The Complainant filed a complaint with respect to the domain name in issue in accordance with the Policy on December 20, 2006 (the “**Complaint**”).
8. The Registrant responded to the Complaint on January 9, 2007.

9. The BCICAC named Barry Effler as Chair, and Cecil Branson and David Wotherspoon as Panellists (the “**Panel**”).

10. The Panel has reviewed all of the material submitted by the Complainant and the Registrant and is satisfied that the Complainant is an eligible complainant under the Policy and Rules.

FACTS

11. The Complainant, Trailwest Online Inc., describes itself as operating an outdoor adventure website at trailpeak.com, providing information on trails for hiking, mountain biking, climbing, snowshoeing and other outdoor pursuits. The Complainant also sells TRAILPEAK branded goods, offers a paid premium subscription service to the site, and provides courses on the outdoors, product or “gear” reviews, news and a discussion forum for outdoor-related matters.

12. The Complainant’s revenues are from four sources: advertising on the TRAILPEAK website, teaching courses, sale of TRAILPEAK branded goods, and premium subscriptions.

13. The Registrant operates the websites clubtread.ca and clubtread.com which offer information, such as trail listings and gear reviews, as well as discussion forums related to outdoor activities. The Registrant also sells CLUBTREAD branded products.

14. The domain name TRAILPEAK.COM was registered on September 27, 2000 and the associated website was launched in July 2001. The Complainant has filed a Canadian trade-mark application for the trade-mark TRAILPEAK. The Complainant is the owner of the domain names trailpeak.net, trailpeak.org, trailpeak.us and trailpeak.info.

15. On July 28, 2006, the Registrant registered the domain name trailpeak.ca. The Registrant information includes the description: “hiking community”.

16. On August 3, 2006, the Complainant through counsel issued a cease and desist letter to the Registrant, requiring the transfer of trailpeak.ca.

17. In correspondence dated August 4, 2006, the Registrant told the Complainant that it was prepared to deal with the Complainant to “facilitate” the matter.

18. In correspondence to the Registrant dated August 15, 2006, the Complainant reiterated that it was the owner of common-law trade-mark rights in the TRAILPEAK trade-marks.

19. In correspondence to the Complainant dated August 22, 2006, the Registrant indicated that it refused to transfer trailpeak.ca to the Complainant and stated that it would not “relinquish the domain in the absence of any consideration with respect to my cost of acquiring, maintaining, transferring and or replacing the domain name”.

20. The Complaint is dated December 18, 2006 and was filed December 20, 2006.

POSITION OF THE COMPLAINANT

21. The Complainant says that the Registrant is in direct competition with the Complainant. It says that this is shown by the fact that the Registrant's clubtread.com and clubtread.ca websites, like the Complainant's, include a hiking trails database, gear reviews and a discussion forum for hikers, and that the Registrant also has an online store for CLUBTREAD branded products.

22. The Complainant asserts that the fact that the Registrant is in competition with the Complainant is also shown in the fact that the description associated with the clubtread.ca domain name is "a large collection of free hiking trails and your source for other outdoor information including maps, photos, and gear." The description associated with trailpeak.ca is "hiking community". The Complainant says that there are a number of third party websites that make reference to TRAILPEAK and Clubtread websites in the same listings, indicating that they provide the same kinds of service.

23. The Complainant says that due to the advertising on the Registrant's website, it is in a position to reap a financial benefit from trailpeak.ca.

Rights of the Complainants in the TRAILPEAK trade-marks

24. The Complainant says that by virtue of extensive and continuous use since at least July 2001, the Complainant is the owner of the TRAILPEAK trade-marks, and that therefore the Complainant has rights in the TRAILPEAK trade-marks in accordance with paragraph 3.3(a) of the Policy.

25. The domain name trailpeak.ca was registered on July 28, 2006, so the Complainant says that the Complainant's rights in the TRAILPEAK trade-marks predate the registration of trailpeak.ca.

Confusingly similar – Paragraph 3.1(a), 3.4

26. The Complainant argues that, in accordance with paragraph 3.4 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles the mark in appearance, sound, or in the ideas suggested so as to be likely to be mistaken for the mark.

27. The Complainant says that the domain name trailpeak.ca is identical to the trade-mark TRAILPEAK, as the domain is comprised exclusively of this mark, and the Registrant has incorporated the whole of it. It says that the Registrant cannot avoid confusion, given that trailpeak.ca so nearly resembles the TRAILPEAK trade-marks in appearance, sound and in the ideas suggested by the mark.

28. The Complainant submits that trailpeak.ca is therefore confusingly similar with the TRAILPEAK trade-marks in which the Complainant says it has rights prior to the registration of trailpeak.ca.

Registration in bad faith

Disruption of Competitor – 3.7(c)

29. The Complainant submits that the Registrant registered trailpeak.ca primarily for the purpose of disrupting the business of the Complainant, with whom it is in direct competition.

30. The Complainant says that there is no requirement that a domain name be active to satisfy the bad faith requirement under para. 3.7(c). It says, “it is sufficient that the mere registration of a domain name was intended to disrupt a complainant trade-mark owner.”

31. The Complainant argues that in this case, the Registrant and the Complainant are direct competitors. This, it says, should constitute evidence of bad faith, as in a case such as *Browne & Co. v. Bluebird Industries*, Resolution Canada Case No. 000002.

32. The Complainant argues that by virtue of being a direct competitor of the Complainant and incorporating the whole of the TRAILPEAK trade-mark in the disputed domain name and including references to the TRAILPEAK website on its site, the conclusion should be that the Registrant had actual knowledge of the Complainant’s rights in the TRAILPEAK trade-marks at the time it registered trailpeak.ca.

33. The Complainant says that the foregoing supports a finding of bad faith, such that the Registrant registered trailpeak.ca primarily for the purpose of disrupting the business of the Complainant, its direct competitor.

Sale for a profit

34. The Complainant says that the Registrant registered trailpeak.ca for the purpose of selling it to the Complainant for valuable consideration in excess of the Registrant’s actual costs in registering trailpeak.ca.

35. The Complainant says that solicitation of an offer to purchase a domain name even if no price is demanded can constitute evidence of bad faith, and cites *Red Robin International Inc. v. Tieu*, BCICAC CIRA Dispute No. 00001.

36. The Complainant says that the Registrant’s correspondence with the Complainant indicates an intention on the part of the Registrant to extract payment from the Complainant, and that the registration is therefore abusive in nature.

37. The Complainant says that on balance, the facts support a finding that trailpeak.ca was registered in bad faith contrary to paras. 3.7(a) and (c).

No legitimate interest in the domain name

38. In view of paragraph 3.6 (a-f) of the Policy, with respect to the Registrant's interest in the domain name, the Complainant submits that:

- (a) there has never been any relationship between the Complainant and the Registrant;
- (b) the Registrant has not used trailpeak.ca in good faith in association with any business or services;
- (c) the Registrant cannot claim a legitimate interest as trailpeak.ca is not a generic name of any wares, services or business;
- (d) the domain name has not been used in good faith or for a *bona fide* purpose;
- (e) the Registrant has never used the domain name in association with a non-commercial activity;
- (f) "Trailpeak" is not a legal name by which the Registrant is commonly identified;
- (g) the domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

39. The Complainant submits that considering all of the foregoing, the Registrant does not have a legitimate interest in trailpeak.ca

Relief Sought

40. The Complainant requests that trailpeak.ca be transferred from the Registrant to the Complainant.

POSITION OF THE REGISTRANT

Procedural Issues

41. The Registrant submits that the Complaint is not in compliance with CIRA Rules because it does not provide contact details for the panellists it has selected, pursuant to Rule 3.2(c).

42. The Registrant also argues that the Complaint is not in compliance with the rules because one of the panellists nominated by the Complainant does not appear on the list of available candidates on the Provider's website, and asks that that panellist not be elected to the panel.

43. Further, the Registrant submits that the complaint does not comply with the rules at paragraph 3.2(h) in that the Complaint does not adequately describe how each of the disputed

marks was used to describe and distinguish the “goods, services, business or non-commercial activity” of the complainant.

44. On the basis of the above procedural arguments, the Registrant asks the Panel to “refuse to decide and to dismiss the complaint.”

Response to the Complainant’s Position

Direct competition between the Registrant and the Complainant

45. The Registrant says that it is not a direct competitor of the Complainant.

46. The Registrant says that correspondence from the Complainant saying that it would wish to co-operate with the Registrant, saying “i.e. you run forums, we run trails,” indicates that they are not direct competitors as claimed, and that in fact the sites are materially different and do not compete directly with one another.

47. The Registrant says that the fact that trailpeak.com sells TRAILPEAK branded mugs and shirts on its website, whereas the Registrant does not sell mugs or shirts on any of its sites, indicates that it is not in direct competition with the Complainant, unlike other companies such as Mountain Equipment Co-op which do sell mugs and shirts.

48. The Registrant also says that as it does not offer or sell outdoor navigation training on any of its sites, nor does it provide paying members of its site with magazine subscriptions or other benefits, it is not in direct competition with the Complainant.

49. The Registrant argues that the fact that the websites of the parties are mentioned together in web directories is not evidence of the fact that the parties are in direct competition. It says that simply means that they cater to a similar demographic.

The Complainant’s rights in the Mark

50. The Registrant says that the Complainant has failed to show rights in any of the claimed marks that predated the registration. It says that therefore trailpeak.ca cannot be considered as being identical or confusingly similar to any mark in which the Complainant has rights.

51. The Registrant says that the Complainant does not own a registered trade-mark for TRAILPEAK or TRAILPEAK.COM. It says that the mark is not distinctive, and that while common-law rights can mature into trade-mark rights, the mere assertion of a right is insufficient to guarantee or confer it.

52. The Registrant asserts that the Complainant has continually failed to explain to the Respondent how the trade-mark has been used in respect of goods, services or business, and that the Complainant has not explained how the registration of trailpeak.ca interferes or competes with the Complainant’s provision of services. The Registrant says that, as such, the Complainant

cannot state that it enjoys a right in respect of the mark or prove that its use predates the disputed registration.

53. The Registrant challenges the claim of the Complainant that the TRAILPEAK branded goods and services sold on its site establish a right to the mark. The Registrant contends that the Complainant has used different versions of its logo at different times, and none of them have been used continuously since 2001 as a mark or as descriptive of a product or service of the Complainant. It asserts that the Complainant fails to indicate which of its designs is the mark it relies on and claims to have used continuously.

54. The Registrant asserts that the Complainant may not argue that the fact that other businesses link their websites to the TRAILPEAK site establishes any rights in the trailpeak.ca domain that are superior to those of the Registrant.

55. The Registrant contends that if the Complainant wishes to assert rights in the mark, it must also carry the burden of responsibility associated with that mark. It argues that if the Complainant had rights in the mark it had the obligation to proactively protect it, and therefore should have exercised its ample opportunity to register trailpeak.ca.

56. The Registrant asserts that as the domains trailpeak.net, trailpeak.org, trailpeak.us and trailpeak.info were registered subsequent to the Registrant's registration of trailpeak.ca, they cannot be used as evidence to prove any prior rights of the Complainant. In fact, it says, this should serve as evidence that the Registrant was not engaged in a pattern of registering domains in order to interfere with the Complainant's business or prevent it from registering its alleged mark as a domain.

Bad faith on the part of the Registrant

57. The Registrant says that there is no evidence of bad faith on its part.

58. The Registrant says that the fact that there has been no development of the trailpeak.ca site does not indicate bad faith. The Registrant says it has not profited from the domain and has made no predatory use of it.

59. The Registrant says there is no evidence that it registered the domain name "primarily for the purposes of disrupting the Complainant and its business," nor that it registered the domain name "primarily for the purpose of selling the domain name to the Complainant or to any competitor of the Complainant" for valuable consideration.

The Registrant's interest in the domain name

60. The Registrant says that it has a legitimate interest in the domain name, specifically the development of a non-commercial website catering specifically to mountain and trail climbers providing a forum to trail climbers for posting still and moving pictures of their ascents.

61. The Registrant says 'Trail Peak' designates an actual geographic location, and is commonly used in language.

62. Otherwise the Registrant says that the Complaint is laden with misrepresentations of fact, and that the Complainant has engaged in behaviour that defies the intent and spirit of the complaint process.

ANALYSIS AND FINDINGS

Procedural Issues

63. The Panel finds that the Complaint was filed in compliance with the Rules. The Registrant's claim that the naming of the panellists was insufficient is denied on two bases. First, the panellist that the Registrant asserts does not appear on the list of eligible panellists has recently been appointed to serve on the Court of Appeal of British Columbia, so is no longer a candidate and does not thus appear on the list. Second, the allegation that the names of panellists were provided without contact information is denied, as each of the nominees' contact information appears on the list of available candidates on the www.bcicac.com website.

64. The Registrant's claim that the Complaint was not in compliance with Paragraph 3.2(h) is denied, as the Panel finds that the Complaint has sufficiently described how the marks in issue have been used in relation to goods, services, business or non-commercial activity.

65. The Panel will therefore consider and decide the Complaint.

The Complaint

66. Paragraph 4.1 of the *CIRA Domain Name Dispute Resolution Policy* sets out that, to succeed, the Complainant must establish 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; and
- (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.7;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

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 the Registrant has a legitimate interest in the domain name as described in paragraph 3.6.

67. In other words, once the Complainant has met its evidentiary burden under subparagraphs 4.1 (a) and (b), either by positive or negative evidence, the onus is shifted to the Registrant who must then prove, on a balance of probabilities, that he is making legitimate use of the domain name.

68. It is the view of the Panel that, for the reasons that follow, the Complainant has met its burden under paragraph 4.1. The Complainant has established that it has a Mark according to the definition in para. 3.2(a). It has established that the domain name registered by the Registrant is confusingly similar to that mark. The Complainant has established that the Registrant registered the domain name in bad faith according to paragraph 3.7(c). The Complainant has also provided some evidence that the Registrant has no legitimate interest in the subject domain name.

Paragraph 4.1(a)

69. To succeed in meeting its onus under paragraph 4.1(a), the Complainant has to show that it has rights, in a Mark, and that the disputed domain name is confusingly similar to that Mark.

70. As per paragraph 3.2(a) of the Policy, a “Mark” includes:

A trade-mark, including the word elements of a design mark, or a trade name 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;

71. The Panel finds that the TRAILPEAK name is such a Mark. The Policy and previous awards are clear that a Complainant does not need to have a registered trade-mark: *Browne & Co. v. Bluebird Industries*, Resolution Canada Case No. 00002, *Canadian Broadcasting Corporation/Societe Radio-Canada v. William Quon*, BCICAC Case No. 00006 [“CBC/SRC”].

72. The Complainant asserts that it has rights in the Mark through its continued use from at least 2001. The Complainant has provided examples of the use of TRAILPEAK as a logo on the products it sells, in advertising, and in promotion for the services it provides.

73. The Panel finds that the Complainant has established the requisite rights in the Mark.

74. Paragraph 3.4 of the Policy provides a definition of the term ‘Confusingly Similar’. The Policy requires a finding that the Mark at issue is likely to be mistaken for the domain name at issue because of the resemblance in “appearance, sound or the ideas suggested by the Mark”. As such, the test is not one of confusion, as is normally found in Canadian trade-mark jurisprudence, but of resemblance.

75. It is the Panel's view that a person knowing the Complainant's mark, TRAILPEAK, would certainly mistake the domain name for the Complainant's corresponding mark. Here, there is no difference between the trailpeak.ca domain name and the TRAILPEAK mark. The second-level part of the domain name, 'TRAILPEAK' is phonetically identical to the Complainant's mark.

76. An Internet user who has knowledge of the name TRAILPEAK might easily mistake the domain trailpeak.ca as being somehow affiliated with or owned by the Complainant. This is sufficient to conclude that the domain name is confusingly similar to the Complainant's mark, TRAILPEAK: *Glaxo Group Ltd. v. Defining Presence Marketing*, CIRA Dispute Number 00020; *Great Pacific Industries. v. Ghalib Dhalla* CIRA Dispute Number 00009 ("*Great Pacific*"); *Government of Canada v. David Bedford, c.o.b. Abundance Computer Consulting*, BCICAC Case No. 00011; *CBC/SRC*, supra.

Paragraph 4.1(b) – Registration in Bad Faith

77. The Complainant asserts that the Registrant registered the domain name trailpeak.ca in bad faith, as it did so primarily for the purpose of disrupting the business of the Complainant, a competitor, according to Paragraph 3.7(c).

78. Paragraph 3.7(c) says:

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:

...

- (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.

79. The Panel agrees with the Complainant that the Registrant and the Complainant are in direct competition, as they operate similar websites that offer similar goods and services directed at a similar market. Both the Complainant and the Registrant operate websites targeted at outdoor enthusiasts, and provide databases of trails, gear reviews and branded products. Both sites appear in references on third party sites in the same listings and directories. Both sites obtain revenues from Internet traffic due to advertising. Due to these similarities, the Panel finds that the Complainant and Registrant are in competition.

80. Given the finding that the use of trailpeak.ca by the Registrant would be likely to cause confusion among Internet users, and that the Complainant and Registrant are competitors, the Panel finds that, on the balance of probabilities, the Complainant has shown that the Registrant registered trailpeak.ca in bad faith. The Panel finds that it is a reasonable inference to be made in this case that the Registrant acquired the domain name primarily for the purpose of disrupting the business of the Complainant.

81. The fact that the website is not currently running does not preclude this conclusion. Were the Registrant to operate trailpeak.ca it would cause confusion among users and would potentially disrupt the Complainant's business.

82. The Complainant has also asserted that the Registrant registered the domain name in bad faith, according to paragraph 3.7(a), as it was registered for the purpose of selling it to the Complainant for valuable consideration in excess of the Registrant's actual costs.

83. Paragraph 3.7(a) reads:

- (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;

84. The Complainant must prove bad faith under this paragraph on a balance of probabilities. However, the Panel finds that there is insufficient evidence to make a finding on this point. In consideration of the foregoing finding of bad faith under paragraph 3.7(c), however, it is not necessary for the Complainant's case.

85. The Panel finds that the Complainant has made out its case under paragraph 4.1(b), that on the balance of probabilities, the Registrant registered the domain name trailpeak.ca in bad faith.

Paragraph 4.1(c) – Legitimate Interest in the Domain Name

86. The Complainant asserts that the Registrant has no legitimate interest in the domain name trailpeak.ca. This assertion rests on the assumption that the Registrant knew of the TRAILPEAK trade-mark and set out to capitalize upon its similarity to trailpeak.ca.

87. The Complainant has succeeded in showing "some evidence" of this. As such, it falls to the Registrant to show that it has a legitimate interest.

88. The Policy states that a Registrant has a legitimate interest in a domain if, prior to notice of a complaint, it is able to demonstrate that it had any of the indicia of legitimate interest listed in paragraph 3.6 (a-f). The Panel finds that the Registrant did not succeed in doing so.

89. There has never been any business relationship between the Complainant and the Registrant, and the Registrant has never been licensed or authorized to use the TRAILPEAK marks for any purpose [paragraph 3.6(a, b)]. The TRAILPEAK name has not been used for the purpose of distinguishing the business or products of the Registrant [paragraph 3.6(c)].

90. The TRAILPEAK name is not generic [paragraph 3.6(c)], nor is it the geographical name of the location of the Registrant's non-commercial activity or its place of business [paragraph 3.6(f)]. The Registrant has not used the TRAILPEAK name for non-commercial activity [paragraph 3.6(d)], nor is it a reference by which the Registrant is commonly identified [paragraph 3.6(e)].

91. The Registrant has not adduced any evidence that counters the assertions about its lack of legitimate interest, and fails to make any positive claim to rights in the Mark. The Registrant does not provide a plausible explanation of how it would employ the domain name in a legitimate business fashion if it were to do so. The only reasonable inference is that the use of the site by the Registrant, a direct competitor, would be disruptive to the Complainant's business.

92. Applying the definition in paragraph 3.6 of the Policy, the Registrant does not have a legitimate interest in the domain name trailpeak.ca.

ORDER

93. The Panel finds that the Complainant has met the requirements of paragraph 4.1 of the Policy.

94. For the above reasons, the Panel orders that the domain name "trailpeak.ca" be transferred to the Complainant.

Barry Effler, Chair

Cecil Branson

David Wotherspoon

*Original signed by Barry
Effler for the Panel*

Per: Barry Effler, Chair

Date February 9, 2007