

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

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Domain Name:           YELLOWPAGE.CA

Complainant:           Yellow Pages Group Co.

Registrant:             Coolfred Co.

Registrar:             FastWebServer Internet Services Inc.

Panelists:             Paul Donovan, Sharon Groom, Teresa Scassa (Chair)

Service Provider:     Resolution Canada, Inc.

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**DECISION**

A.     The Parties

1.     The Complainant, Yellow Pages Group Co., is incorporated under the laws of Nova Scotia. Its principal place of business is located at 16 Place du Commerce, Ile des Soeurs, Verdun, Quebec.
2.     The Registrant for the domain name is Coolfred Co., which has its principal place of business at 18 Laurier Ave., Richmond Hill, Ontario. The contact person, Farhad Sadeghi, is the sole proprietor of Coolfred Co.

B.     The Domain Name and Registrar

3.     The disputed domain name is yellowpage.ca. The Registrar for the domain name is FastWebServer Internet Services Inc. The disputed domain name was registered on November 8, 2000.

C.     Procedural History

4.     This is a proceeding under the Canadian Internet Registration Authority (CIRA) *Domain Name Dispute Resolution Policy* (Version 1.1) (the *Policy*) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.2) (the *Rules*).

5. The history of the proceeding, according to information provided by the dispute resolution provider, Resolution Canada, Inc., is as follows:

- The Complainant filed a complaint against the Registrant with Resolution Canada, Inc., requesting that the current registration of the domain name yellowpage.ca be transferred to Yellow Pages Group Co. The Complaint was received by Resolution Canada on January 2, 2007.

- Notice and an electronic version of the complaint was sent to the Registrant on January 2, 2007. A hard copy of the Complaint was also sent by registered mail. Registered mail was used because the address provided by the Registrant was a post office box, and courier service is not available to post office boxes.

- The Registrant alleges that he did not receive the original electronic and hard copies of the Complaint as they were sent to incorrect electronic and mailing addresses.

- A second notice and electronic version of the Complaint was sent by e-mail to the Registrant on January 8, 2007.

- On January 13, 2007, the Registrant contacted Resolution Canada by email, stating that he had not received the hard copy of the Complaint. He provided an updated street address.

- On January 18, 2007, a hard copy of the Complaint was sent to the Registrant at the new address. The Registrant acknowledged by e-mail that he received a delivery notification from Purolator on January 19, 2007, and that he would receive the package from the courier on January 21, 2007. The courier's tracking records show that the package was actually received on January 23, 2007.

- The Registrant requested an extension until February 12, 2007 to file his response.

- An extension until February 9, 2007 to file the response was granted by Resolution Canada. The response was duly filed.

- In his response, the Registrant alleged that the Complainant had, contrary to para. 4.6 of the CDRP commenced the Complaint "for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer" of the disputed domain name.

- The Complainant responded to this allegation, as provided in para. 11.1 of the *Rules*. The response was filed on February 20, 2007.

- On February 20, 2007, in accordance with paragraph 6 of the *Rules*, Resolution Canada appointed a three-person panel comprised of Paul Donovan, Sharon Groom and Teresa Scassa. Dr. Scassa was named as Chair of the panel.

- As required by paragraph 7 of the *Rules* all three panelists have submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

#### D. Canadian Presence Requirements

6. The Complainant, Yellow Pages Group, Co., is a company incorporated under the laws of Nova Scotia. As such, it meets the Canadian Presence Requirements under paragraph 2(d) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

#### E. Factual Background

7. The Complainant owns the Canadian registered trade-mark YELLOW PAGES. This mark was registered on June 27, 1980 (TMA 246,988) for use in association with:

WARES:

(1) Prerecorded CD-roms containing advertising pertaining to various businesses.

SERVICES:

(1) Advertising businesses in directories and compiling and publishing businesses and telephone directories.

(2) Compiling and publishing mailing lists.

(3) Advertising businesses via CD-Roms, and compiling and publishing CD-Roms.

(4) Advertising businesses via internet, on-line, electronic publishing and electronic transmissions. (CIPO database, TMA 246,988)

It also owns the Canadian registered trade-mark YELLOWPAGES.CA. This mark was registered on February 2, 2003 (TMA 575,757) for use in association with:

WARES:

(1) Internet guide and directory on pre-recorded CD-ROMs containing advertising pertaining to individuals and various businesses.

SERVICES:

(1) Internet services namely business and individual on-line advertising services on behalf of others; on-line publishing and dissemination of information for others in an Internet guide and directory.

(2) Web site design and media consulting services. (CIPO database, TMA 575,757)

9. The Complainant claims use of the YELLOW PAGES mark since 1948, and use of YELLOWPAGES.CA since 1997. The Complainant operates a web site at yellowpages.ca. Reference to the CIRA Whois database indicates that the domain name for this site was approved on October 18, 2000.

10. The Registrant, Coolfred Co. registered the disputed domain name yellowpage.ca on November 8, 2000. There is evidence that for some period until 2006, the domain name resolved to a site parked with DomainSponsor.com. On January 20, 2006, and again on March 20, 2006, the Complainant sent two "cease and desist" letters to the Registrant regarding this parked site. The Registrant did not respond to the letters, but following receipt of the letters, the domain name ceased to resolve to a site parked with DomainSponsor.com. The domain name does not currently resolve to any web site.

F. CIRA *Domain Name Dispute Resolution Policy* Requirements

11. Paragraph 3.1 of the *Policy* requires the Complainant to establish 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.*

12. According to paragraph 4.1 of the *Policy*, the Complainant must establish elements (a) and (c) above on a balance of probabilities. The Complainant must also provide "some evidence" that the Registrant has no legitimate interest in the domain name.

#### G. Analysis

##### Confusingly Similar to a Mark in which the Complainant had Rights

13. In order to succeed with the Complaint, the Complainant must first 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 and continues to have such rights." (*Policy*, sub-para. 3.1) The *Policy* contains definitions of each of the terms "Mark", "Rights" and "Confusingly Similar."

14. The definition of "Mark" is found in sub-paragraph 3.2 of the *Policy*. Sub-paragraph 3.2(c) provides:

3.2 Mark. A "Mark" is:

...

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO;

15. The definition of "Rights" is found in sub-paragraph 3.3. Sub-paragraph 3.3(b) provides that a person has Rights in a Mark if:

in the case of paragraph 3.2(c), the Mark is registered in CIPO in the name of that person, that person's predecessor in title or a licensor of that person;

The panel finds that the Complainant has rights in the registered trade-marks YELLOW PAGES and YELLOWPAGES.CA. Both Marks are registered in CIPO, and the Complainant is listed as the owner of each Mark.

16. The Complainant has established that its rights in the mark YELLOW PAGES predate the registration by the Registrant of the disputed domain name. The YELLOW PAGES mark has been registered since 1980. The mark YELLOWPAGES.CA was not

registered until February 2, 2003, more than two years after the registration of the disputed domain name. Although the trade-mark registration claims use since 1997, the domain name yellowpages.ca was not registered until October 18, 2000. This registration does predate by a few weeks, the registration of the disputed domain name yellowpage.ca. Evidence of use of YELLOWPAGES.CA provided by the Complainant spans the period from 2000-2006. The panel is not wholly persuaded that the Complainant's rights in YELLOWPAGES.CA predate the registration of the disputed domain name. Nevertheless, this does not change the outcome of this decision, as the panel finds that the Complainant had clear, and long established rights in the Mark YELLOW PAGES, and that these Rights predate the Registrant's registration of the disputed domain name by many years.

17. The Complainant must establish on a balance of probabilities that the disputed domain name is "Confusingly Similar" to the Mark in which the Complainant has rights. According to para. 3.4 of the *Policy*, a domain name is confusingly similar to a Mark when it "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." Emerging case law under the *Policy* suggests that the test is one of "resemblance based upon first impression and imperfect recollection". (*Musician's Friend, Inc. v. L.A. Music*, CIRA Dispute Number 00074; *Thermos Products Inc. v. Michael Fagundes*, CIRA Dispute Number 00049).

18. The *Policy* defines "domain name" as "the domain name excluding the "dot-ca" suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA". Thus in determining whether the domain name YELLOWPAGE.CA is confusingly similar to the Complainant's Mark YELLOW PAGES, one must consider only the YELLOWPAGE portion. The panel is of the view that to the average internet user, based on first impression and imperfect recollection, YELLOWPAGE "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." The Complainant has successfully established that the disputed domain name is confusingly similar to its YELLOW PAGES Mark.

#### Registrant has No Legitimate Interest in the Mark

19. Under sub-paragraph 4.1(c) of the *Policy*, the Complainant must provide some evidence that "the Registrant has no legitimate interest in the domain name". Paragraph 3.6 identifies six circumstances in which a legitimate interest may arise. These are:

- (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; or (iii) the place of 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.*

20. The Complainant argued that the use of the domain name to resolve to a DomainSponsor.com landing page was not a good faith use of the mark as required by sub-paragraphs (a) to (d). Further, the Complainant argued that since sending its cease and desist letters to the Registrant, the domain name has not been used at all. As “Use” is a requirement of sub-paragraphs (a) to (d), there is, according to the Complainant, no legitimate interest within the meaning of those sub-paragraphs. The Complainant also argues that there can be no legitimate interest under sub-paragraphs (e) and (f), as there is no evidence that the domain name is the legal or other name of the Registrant, or that it is a geographical name of the Registrant’s non-commercial activity or place of business.

21. The Panel finds that the Complainant has met its burden of producing some evidence that the Registrant has no legitimate interest in the domain name. Further, the Panel finds that the Registrant has failed to provide evidence to establish a legitimate interest in the domain name yellowpage.ca.

22. The Panel agrees that no legitimate interest can be found under sub-paragraphs (e) or (f) because the domain name is not a legal or other name of the Registrant, nor is it a geographical name of the place of any non-commercial activity or business carried on by the Registrant.

23. Sub-paragraphs (a) through (d) of the *Policy* require “Use” of the domain name as a Mark or otherwise, in relation to wares or services, or in relation to a non-commercial activity. There is no need to reproduce the definition of “Use” here, as the domain name was not used as a Mark in relation to either wares or services. In fact, for the reasons set out below, the Panel finds it was not used by the Registrant at all.

24. The Registrant first registered the domain name in 2000. Although he indicates that a business plan has been developed for a web site to which the domain name would eventually resolve, the web site has never actually been developed and there has been no commercial activity pursuant to any business plan. Further, in response to the allegations by the Complainant of bad faith use by having the domain name resolve to a landing page for DomainSponsor.com, the Registrant produced evidence that this arrangement was entered into by his Registrar, without his knowledge. Upon receipt of the cease and desist letters from the Complainant regarding this use, the Registrant made enquiries with his Registrar, and asked for this use to cease immediately, which it did. The Registrant provided a copy of an e-mail from his Registrar explaining the Registrar's practices and indicating that "The park page for yellowpage.ca was effectively disabled on March 24, 2006 when we received your request." The Registrant also provided a copy of an e-mail from a Sales Support Specialist at DomainSponsor.com confirming that he did not have an account with that company. We find that the Registrant has not used the domain name within the meaning of the policy, and that, as a consequence, there can be no legitimate interest under sub-paragraphs 3.6(a) through (d).

#### Registration in Bad Faith

25. The exclusive bases for a finding of bad faith registration are set out in sub-paragraph 3.7 of the *Policy*. They are:

**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 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; 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*

**Paragraph 3.7(a)**

26. The Complainant argued that the Registrant, by entering into an agreement with DomainSponsor.com, had “rented” the domain name to DomainSponsor.com, and that DomainSponsor.com was a competitor of the Complainant. However, there was no evidence to suggest that any rental agreement had been entered into. Rather, the evidence supports the view that any initial connection between the domain name and DomainSponsor.com was without the knowledge of the Registrant, and that he received no revenue from the arrangement.

27. The Complainant's second argument under paragraph 3.7(a) turned on existence of the Registrant's web site at firstglobalserver.com. This site offers various internet services, including web design, web hosting, domain name registration and internet consulting. The site contains a section headed “Domains for Sale”, but the content of this section merely reads “This section is under construction and will be available soon.” No domain names are actually for sale at the site. The Complainant argued “one could find that the domain names registered by the Registrant may likely be sold there or that the page may be considered as an invitation to contact the Registrant to enquire about the domain names it has for sale.” (at para 55 of the Complaint). The Complainant argues that this, in combination with the Registrant's registration of its very well-known mark is sufficient to establish bad faith under paragraph 3.7(b). The panel is of the view that the fact that a related web site of the Registrant planned to offer domain names for sale is not adequate evidence of any offer to sell the disputed domain name. We find that bad faith under paragraph 3.7(a) is not made out.

**Paragraph 3.7(b)**

28. The Complainant argues that bad faith under paragraph 3.7(b) is made out because the Registrant registered the domain name in order to prevent the Complainant from registering its Marks as domain names, and that the Registrant has engaged in a pattern of registering domain names in order to prevent persons who have rights in trade-marks from doing so.

29. Paragraph 3.7(b) refers to the Registrant acting so as to prevent the Complainant “from registering *the Mark* as a domain name” (emphasis added). The Complainant's Marks are YELLOW PAGES and YELLOWPAGES.CA. The Panel notes that the Complainant has not been prevented from registering its Marks as domain names, as it has already registered the domain name “yellowpages.ca.” The view that the *Policy* refers, in para. 3.7(b), to the *specific* Mark, and not to variations of the Mark, is consistent with that expressed in *Microsoft Corp. v. Microscience Corp. (P.E.I.)*, CIRA Decision Number 00034.



30. In any event, the Panel finds that Complainant has not met its burden of showing that the Registrant has engaged in a “pattern” of registering domain names in such a manner. The Complainant asks the Panel to infer that the Complainant has a relationship with DomainSponsor.com, and that therefore the Complainant must have at least fifty domain names with a high internet traffic value. As noted earlier, the Registrant has provided evidence indicating that it had no direct relationship with DomainSponsor.com. Further, the Complainant has not actually produced any evidence that the Registrant actually owns a substantial number of domain names, nor is there any evidence that any of these hypothetical domain names represent or resemble trade-marks owned by others. We find that the Complainant has not satisfied us on a balance of probability that the domain name was registered in bad faith under paragraph 3.7(b)

### **Paragraph 3.7(c)**

31. The Complainant also argues that the Registrant has registered the Domain Name yellowpage.ca primarily for the purpose of disrupting the business of the Complainant who is a competitor of the Registrant. This argument also requires the Panel to accept, therefore, that there is a relationship between the Registrant and DomainSponsor.com, and that the Registrant has redirected at least 49 other domain names to a DomainSponsor.com landing page. The Complaint argues that this conduct would make the Registrant a competitor of the Complainant, which is in the business of offering internet directory services. As we have already noted, the Complainant has not met its burden of establishing that any relationship between the Registrant and DomainSponsor.com exists. The Registrant, for his part, has provided some proof that such a relationship does not exist, in the form of a letter from its domain name registrar indicating its own practices of parking unused domain names, and a letter from DomainSponsor.com stating that the Registrant did not have an account with them. We find that the Complainant has not established, on a balance of probabilities, that the domain name was registered by the Registrant in bad faith as per para. 3.7(c) of the *Policy*.

### **H. Conclusion**

32. To summarize our findings, the Panel is of the view that the Complainant has established that the domain name yellowpage.ca is confusingly similar with its Marks, that its rights in the Mark YELLOW PAGES predate the registration of the disputed domain name, and that the Registrant has no legitimate interest in the domain name. However, the Complainant has been unable to establish that the registration of the disputed domain name was in bad faith within the meaning of paragraph 3.7 of the *Policy*. Since proof of bad faith registration is an essential requirement under the *Policy*, the Panel finds that the Complainant has not made out a case for relief, and the Panel declines to order the transfer of the domain name yellowpage.ca to the Complainant.

### **I. Registrant’s Claim Regarding the Bad Faith of the Complainant**

33. The Registrant has asked the Panel for compensation in the amount of \$5,000 under paragraph 4.6 of the *Policy*. This paragraph provides:

4.6 If the Registrant is successful, and the Registrant proves, on a balance of probabilities, that the Complaint was commenced by the Complainant *for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of any Registration which is the subject of the Proceeding*, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. . . . (emphasis added).

34. As the Panel has found that the Complainant clearly had rights in its Marks, that the disputed domain name was confusingly similar to its Marks, and that the Registrant had no legitimate interest in the domain name, the Panel is not prepared to find that the Complaint was commenced in bad faith and without colour of right. Relief under para. 4.6 is denied.

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Teresa Scassa (Chair)

March 13, 2007