

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

Domain Name: BOWRING.CA

Complainant: Bowring & Co. Inc., c/o Mr Peter Bevilacqua
Registrant: Mr Erik Maddeaux
Registrar: 10 Dollar Domain Names Inc.
Panelists: David Allsebrook
Sharon Groom
David Lametti, Chair
Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is Bowring & Co. Inc., (“Bowring” or “Complainant”), whose provided contact address is 80 Dufflaw Road, North York, Ontario, M6A 2W1. The Complainant is represented by Mr Peter Bevilacqua, its Manager, Corporate IT & Security Services.

2. The Registrant is Mr Erik Maddeaux. His registered address is 1498 Indian Grove, Mississauga, Ontario, L5H 2S6.

B. The Domain Name and Registrar

3. The domain name at issue is < BOWRING.CA >. The domain name is registered with 10 Dollar Domain Names Inc.

C. Procedural History

4. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada on 16 May 2007. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* [“Rules”]. The Provider selected the panel of three and appointed the Chair according to the process outlined in the Rules. A Response to the Complaint was received from the Registrant via email on 12 July 2007.

D. Panel Members’ Impartiality and Independence Statements

5. As required by paragraph 7.1 of the Rules, all three panelists have declared to the Provider that they can act impartially and independently in this matter as there are no circumstances known to any of us which would prevent us from so acting.

E. Factual Background

6. The Registrant registered the domain name < BOWRING.CA > on 6 June 2006, when it became available on its previous registration lapsing.

7. The Complainant contends that the domain name is confusingly similar to its trade-mark, BOWRING, that the registration was made in bad faith and that the Registrant had no legitimate interest in the domain name. The Registrant disputed the Complainant's ownership of the BOWRING mark, its version of events surrounding the loss of the domain name, as well as the three substantive criteria of confusing similarity, bad faith and legitimate interest.

8. The complaint was filed with a copy of a certificate of Renewal of the trade-mark "BOWRING", Registration number TMA 311,800, dated February 28, 2001. The certificate does not name the owner of the trade-mark, and the Complainant provided no other evidence of the ownership of the Registration or of the BOWRING trade-mark. A search of the Registration in the on-line records of the Canadian Intellectual Property Office shows that the registration currently names "Tereve Holdings Ltd." as the owner. The Complaint alleges that the trade-mark rights were assigned to the Complainant, Bowring & Co. in November 2005. The Registrant's submissions referred the panel to a web page operated by the Receiver, comprising Ontario Superior Court documents respecting the bankruptcy of Tereve Holdings Limited. A Court Order dated April 11, 2006 approves agreements between the Receiver acting for Tereve and the Complainant, which by their dates and titles may well have conveyed ownership of the trade-mark BOWRING to the Complainant. However the agreements were not provided.

9. On 12 July, the Complainant requested an opportunity to respond to the contentions of the Registrant. Upon reading the submissions of the parties, the Panel instead requested additional information from the Complainant under CIRA Domain Name Dispute Resolution Rules, Rule 11.1 (Cf Appendix). The information requested was meant to supply the Panel with the precise information that would allow it to reach a fair and proper conclusion. With respect to ownership of the trade-mark, the panel requested:

Specifically we request that the Complainant:

(1) ...

(2) Provide argument and evidence that it is the owner of the BOWRING marks in Canada that are used as the basis for the Complaint. In addition, we require that the Complainant provide a history of the ownership of the BOWRING marks over the past 5 years, with a chain of title and the context of transfers of title, all of which is supported by appropriate documentation;

(3) ... and

(4)

10. Additional information was received from the Complainant on 6 August 2007. The Complainant filed an Ontario Superior Court of Justice Order made January 12, 2006 attesting to the bankruptcy of Tereve Holdings Ltd., and a Court order dated June 28 2006 granting an order “in the form attached”. The Panel was not provided with the attached order. The web page cited by the Registrant does not list any documents after April 2006.

11. The Panel decided at that point that it was not necessary to request a counter-response from the Registrant regarding the Complainant’s additional evidence, and proceeded with its deliberations.

F. CIRA Domain Name Dispute Resolution Policy Requirements

12. The *CIRA Domain Name Dispute Resolution Policy* [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the complaint (our emphasis):

To succeed in the Proceeding, the Complainant must prove, 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 . . .

G. Did the Complainant have rights in a Mark prior to the date of registration

13. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [or]
- (c) a trade-mark . . . that is registered in CIPO . . .

14. While there is a BOWRING mark currently registered at CIPO, the Complainant has not shown any evidence of its current ownership of the registered mark BOWRING in Canada. It has provided no documentation showing any assignment of the mark to it. The Complainant has not shown a chain of title that would indicate that it is the current owner of the mark.

15. Finally, two of us find that the Complainant has not shown clearly that it has used the mark in the course of business to identify its products or services. In this understanding of paragraph 3.2 and sub-paragraph 4.1 (a) of the Policy, the Complainant may base his claim to the mark (to which the domain name at issue is alleged to be confusingly similar) on either a registered ownership right in a trade-mark or a right arising out of the use of the trade-mark in the course of business.

16. The third panelist, David Allsebrook, regards the ownership specified in an existing trade-mark registration to be binding upon the panel, and finds that a party wishing to challenge it must do so before the Registrar of Trade-marks, or the Federal Court, who between them have the exclusive jurisdiction to alter or cancel a trade-mark registration. As s. 19 of the Trade-marks Act gives the registered owner of the trade-mark the exclusive right to use the trade-mark throughout Canada, and the registered owner is Tereve Holdings, Ltd., a CDRP panel cannot consider whether use of the trade-mark by the Complainant has taken place so as to give it rights which contradict s. 19 of the Trade-marks Act. Such an inquiry would be a disservice to the parties. The third panelist is of the view that a CDRP panel lacks the forensic tools such as sworn evidence and cross-examination, which are available in the other forums, and without which the panel could reach an inconstant result, provoking further litigation.

17. This failure to show rights in the mark that form the basis for the “confusingly similar” criterion, is sufficient grounds on its own to reject the Complaint.

H. Canadian Presence Requirements

18. The Panel would also like to comment additionally on Canadian Presence Requirements. Under paragraph 1.4 of the Policy, the Complainant must meet Canadian Presence Requirements (CPR):

1.4 Eligible Complainants. The person initiating a Proceeding (the “**Complainant**”) must, at the time of submitting a complaint (the “**Complaint**”), satisfy the Canadian Presence Requirements for Registrants (the “**CPR**”) ... in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“**CIPO**”) and the Complainant is the owner of the trade-mark.

19. There is some question as to whether the Complainant actually needs to *demonstrate or show* that it meets the CPR as a (pre-) condition to succeeding in the Complaint, or whether it merely needs to *warrant* that it meets the requirement.

20. As seen above, Paragraph 1.4 of the Policy does *not* say that the Complainant must *show* that it meets the CPR. Rather, the Complaint “must satisfy” the requirements. Moreover, paragraph 1.9 of the Policy says the Complainant must “represent and warrant” that it meets the CPR:

1.9 Commitments by Complainant. By initiating a Proceeding, the Complainant:

- (b) represents and warrants to CIRA and the Registrant that: (i) the Complainant satisfies the CPR at the time of submitting the Complaint or the Complaint relates to a trade-mark registered in CIPO and the Complainant is the owner of the trade-mark; and (ii) if CIRA transfers the Registration that is the subject of the Proceeding to the Complainant or a nominee of the Complainant, at the time of transfer, the Complainant, or nominee, will satisfy the CPR in respect of the domain name that is subject of the Proceeding.

Nowhere is evidence to show CPR compliance explicitly required. Although paragraph 3.1 deals with what allegations must be made for the complaint to proceed, they do not include expressly that the Complainant or its nominee must meet the CPR.

21. Finally, paragraph 4.1, set out above, omits compliance with the CPR as a criterion for success.

22. That being said, the preamble of s. 3.1 may include the burden of proving the CPR albeit implicitly (our emphasis):

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: ...”

In this reading, compliance with the Policy and Rules makes proving CPR a part of the burden placed on the Complainant.

23. While less explicit, it is the view of the Panel that the latter view is the more coherent with the rest of the Policy and Rules and that the Complainant does need to show compliance with the CPR.

24. In this case, the representative for the Complainant has a Canadian address, but no proof was offered of the Complainant’s actual place of incorporation. In addition, while the mark itself is registered in Canada, as we have seen above the Complainant’s ownership of the mark has not been proven. Finally, while the Panel has been pointed to a website owned by “Bowring” that might use the BOWRING mark, the question of who owns the website and is using the mark is ambiguous, as no specific reference to a

corporation is made on the website. As such the Complainant would have also failed to meet the CPR under the Policy.

25. The Complaint thus fails, and there is no need to examine other substantive issues.

I. Conclusion and Decision

26. The Complainant has not established that it had rights in the BOWRING mark. The Complaint is therefore rejected.

Dated 22 August 2007,

David Lametti
Sharon Groom
David Allsebrook

David Lametti, Chair

Sharon Groom

David Allsebrook

Appendix

Appendix

13 July 2007

Ms Catherine Leung,
Case Manager
ResolutionCanada

Dear Catherine,

Re bowring.ca: Request for Additional Information

I. The Complainant has requested the opportunity to rebut claims made by the Registrant. The Panel rejects this request as unnecessary given the Request for Additional Information that follows.

II. The Panel has begun to deliberate and wishes to request further evidence and argument from the parties, as per Paragraph 11.1 of the Rules.

Specifically we request that the Complainant:

(1) Provide evidence that it meets the Canadian Presence Requirements of Section 1.4 the Policy (as described in the embedded hyper-link, Canadian Presence Requirements for Registrants);

(2) Provide argument and evidence that it is the owner of the BOWRING marks in Canada that are used as the basis for the Complaint. In addition, we require that the Complainant provide a history of the ownership of the BOWRING marks over the past 5 years, with a chain of title and the context of transfers of title, all of which is supported by appropriate documentation;

(3) Provide evidence, if any, of the use of the mark by the Complainant or a predecessor in title in recent years; and

(4) Provide a complete history and supporting evidence on the registration of the bowring.ca domain name and on the circumstances surrounding its "cancellation".

Once the additional evidence and argument is received from the Complainant, we would like the Registrant to have the opportunity to reply.

Additional time will need to be added for our deliberations, once the additional information is received.

Regards,
David Lametti, Chair
Sharon Groom, David Allsebrook
Panellist