

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute number: NIA-092007-00144
Domain name: niagararegion.ca
Complainant: The Regional Municipality of Niagara
Registrant: John Vail
Registrar: Internic.ca Corp.
Panellist: Hugues G. Richard
Service Provider: Resolution Canada Inc.

DECISION

1. The Parties

Complainant is the Regional Municipality of Niagara, a municipal corporation created in 1970 pursuant to the *Regional Municipality of Niagara Act* (R.S.O. 1990, c. R.13) having its principal place of business at 2201 St. David's Road, P.O. Box 1042, Thorold, ON L2V 4T7.

Registrant is John Vail an individual whose known address is: 17 Inglewood Drive Hamilton, ON L8P 2T2.

2. The Domain Name and Registrar

The domain name at issue is: niagararegion.ca

The registrar of the domain name is Internic.ca Corp., 26 Auriga Drive, Ottawa, Ontario, K2E 8B7.

3. Procedural History

On September 17, 2007 the Complainant filed a proceeding against the Registrant with Resolution Canada Inc., asking that the rights in the niagararegion.ca domain name be transferred to the Complainant.

Resolution Canada Inc. is a recognized service provider pursuant to the CIRA Domain Name Dispute Policy.

Resolution Canada Inc. reviewed the complaint and found it compliant with the CIRA rules and policies. On September 19, 2007 Resolution Canada Inc. forwarded an email copy of the complaint to the Registrant in regards to paragraph 2.1 and 4.3 of the CIRA Policies and Rules.

In accordance with CIRA Dispute resolution Rule 5.1, the Registrant had twenty days from the date of commencement of the Proceeding (which is the date of the actual or deemed receipt of the notice by the registrant) to file with the Provider five copies of a Response to the Complaint.

On September 20, 2007 the Registrant contacted Resolution Canada Inc. asking for information about how to prepare his Response. Resolution Canada Inc. referred the Registrant to the CIRA website and the CIRA domain name dispute resolution dispute policy.

The Respondent did not file a response to the Complaint in the required twenty day period stated at rule 5.1. Therefore in accordance with paragraph 5.8 of the rules, the Panel shall decide the proceeding on the basis of the Complaint.

4. Factual Background

The Complainant is the Regional Municipality of Niagara, a municipal corporation created in 1970. The Complainant is obligated by law to deliver certain services to its residents, such as: water treatment, waste management, social housing and social assistance. These services are to be provided to the residents of the cities of St. Catharines, Thorold, Welland, Port Colborne, Niagara Falls, Grimsby, Lincoln, Pelham, Niagara on the lake, Fort Erie, West Lincoln and Wainfleet.

The Complainant maintains a website at www.regional.niagara.on.ca in order to inform residents on the services and programs provided by the Region.

The Complainant has registered with CIRA the following domain names: regionalniagara.ca in 2002 and goniagararegion.ca in 2003. Four other domain names have been registered by the Complainant with other agencies then CIRA: niagararegion.com (registered on 2007-03-28), niagararegion.org (registered on July 17, 2001), regionofniagara.com (registered on 2006-11-2), goniagararegion.com (registered on 2006-12-17).

Complainant is the owner of six official trade-marks which include logos and designs for the Niagara Regional Police Service and the Regional Municipality of Niagara Police Services Board. Three of these Marks were advertised in 1983, one in 1997 and the other in 2002, all advertisements giving public notice of the adoption and use of the marks in Canada.

Furthermore, on February 6, 2007, the Complainant applied for registration of the "Niagara Region" official trade-mark. The mark was advertised in the Trade-marks Journal of April 11, 2007, giving public notice under subparagraph 9(1)(n)(iii) of the *Trade-marks Act* of the adoption and use of the mark in Canada as an official mark for wares and services by The Regional Municipality of Niagara

Finally, the Complainant alleges the use of "The Regional Municipality of Niagara", "The Region of Niagara", "Regional Niagara" and "Niagara Region" marks since 1970. The Complainant also asserts that it conducts business under these four trade names.

The Registrant is a real-estate and brokerage agent.

On November 9, 2000 the Registrant registered the domain name niagararegion.ca. The domain name has since that time been used by the Registrant to redirect internet traffic to another of his websites, johnvail.com, which advertises a real estate and brokerage business based in Oakville.

The Registrant has failed to present a written response to Resolution Canada Inc. as required by paragraph 5.1 of the CIRA rules.

5. Parties contentions

A. Complainant

The Complainant asserts that “Niagara Region” is a mark and a trade name that has been employed since 1970 in order to distinguish the business and services provided by the Niagara Region. Complainant states that these names have become distinctive of the Regional Municipality of Niagara and provides us with a copy of Niagara Region’s “Identity Standards Guide” in order to assert its argument. This Guide which governs the use of Niagara region’s marks was issued in January 2005.

Complainant cites subparagraph 3.2(a) of the Policy which establishes that a Mark is a trademark, including a trade name that has been used in Canada by a person for the purpose of distinguishing the wares, businesses or services of that person.

Complainant provides evidence that it has six registered trademarks including logos and designs for the Niagara Regional Police Service and the Regional Municipality of Niagara Police Services Board. Furthermore, the “Niagara Region” Mark has been advertised in the Trade-marks Journal of April 11, 2007, therefore complainant alleges that the mark is protected under section 9 of the Trade-marks Act.

Complainant submits that the domain name niagararegion.ca is confusingly similar to marks in which the regional municipality has had rights prior to the registration of the domain name in November 2000.

Complainant submits that the domain name closely resembles, in appearance sound and ideas, the complainant’s trade-names and that the domain name could be mistaken with the Niagara region mark. Complainant asserts that Internet users could falsely associate the domain name with the complainant’s websites niagararegion.com and niagararegion.org. and that the registration of the domain name by the Registrant could divert internet users seeking Niagara Region’s official website.

According to the Complainant, the Registrant has no legitimate interest in the domain name under section 3.6 of the Policy.

Firstly, Complainant asserts that before the “Niagara Region” mark was advertised in the Trade-Marks journal on April 11, 2007 the Registrant had no established rights in the mark.

Complainant further asserts that the Registrant has not used the domain name in Canada in association with any wares, services or business. The only use made of the domain name is to redirect internet users to other sites of the Registrant.

Complainant adds that the properties advertised on the website which the domain name redirects the user too are not located in the Niagara region but in the town of Oakville. Therefore the domain name is not descriptive of the place of origin of the wares or services offered by the Registrant.

In regards to paragraph 3.6 c) of the Policy, Complainant states that the domain name is not the generic name of any of the wares, services or businesses conducted by the registrant.

Fourthly, Complainant alleges that the Registrant's website johnvail.com is used in order to conduct business and advertise real estate, therefore the domain name (which is used to redirect internet users to the johnvail.com website) is not used in association with a non-commercial activity.

Complainant further submits that the Registrant has never been commonly known or identified as Niagara region, and the domain name is not his legal name or surname.

Finally, the Complainant submits that the domain name is not the geographical name of location of the Registrant's non commercial activity or business as the domain name redirects to the johnvail.com website which advertises a real estate and brokerage business located in the regional Municipality of Halton.

Ultimately the Complainant submits that the Registrant registered the domain name in bad faith.

According to the Complainant, the Registrant has a history of registering domain names consisting of third party trademarks, in order to prevent the legitimate owners from registering them. Complainant submits that the registration of the niagararegion.ca domain name pursues such an end (Section 3.7 b) of the Policy).

Complainant alleges that it attempted to communicate with the Registrant on several occasions by phone, email and mail and that the Registrant never contacted the Complainant back. Complainant indicates that on, or about, March 9, 2006 the Niagara Region's web services administrator contacted the Registrant by phone to advise him that the Complainant was interested in acquiring the Domain Name. At that time the Registrant indicated that he would consider it. Having received no news from the Registrant, Niagara Region's Web Administrator sent an email to the Registrant on April 3, 2006 asking whether he had made a decision regarding the acquisition of the domain name by the Complainant. On July 28 of 2006 a letter by regular mail was sent to the Registrant advising him that Niagara Regional Municipality considered it had a legal right to use the domain name and that it was prepared to offer 500,00\$ to the Registrant in exchange for an agreement to transfer to the Region the ownership rights, title and interest in the domain name. This correspondence was left unanswered by the Registrant.

Complainant alleges that having received no answers from the Registrant, on March 6, 2007 one of its agents tried contacting the Registrant by phone and left a voice message followed by an email stating that Niagara Region was interested in acquiring the domain name. On March 26, 2006 the same agent left another voice message to the Registrant followed by an email re-establishing that the Complainant was interested in acquiring the domain name. Finally, on March 27, 2007 the Communications Strategist left a final voice message reiterating Niagara Region's desire to acquire the domain name.

The Complainant asserts that the Registrant never contacted its agents back, therefore preventing Niagara Region from registering its mark as a domain name. According to the Complainant such an attitude can help establish bad faith.

Furthermore, the Complainant refers to the fact that the Registrant owns diverse unrelated domain names to which he is not entitled, such as: cne.ca, hamiltonwentworth.ca, jjb.ca, realestateinvstor.ca, and torontoidustrial.ca. According to the Complainant this proves that the Registrant has developed a habit of preventing trademark holders from registering their marks as domain names. Complainant points out that these five domain names, of which three are identical to prior existing and active .com domains, redirect users to the Registrant's johnvail.com website.

The three <.ca> domain names that are identical to existing <.com> domain names are directly related to real investment business. This could suggest that the Registrant is attempting to attract his competitor's potential clientele to his own website for commercial gain. The other two registered domain names: cne.ca and hamiltonwentworth.ca are registered marks.

In regards to the present dispute, the Complainant has never used its Mark in connection with real-estate business. The Mark represents the Niagara Regional Municipality. Therefore, the Complainant submits that "where a domain name bears no connection to a Registrant, it is reasonable to infer that the domain name was acquired primarily for the purpose of disrupting the business of the complainant" (paragraph 57 of the Complaint).

The Complainant further contends that the Registrant has made no active use of the domain name since its registration on November 9, 2000 which constitutes yet another evidence of use in bad faith.

B. Registrant

The Registrant failed to present a response. Therefore, in accordance with Rule 5.8, the Panel shall base its decision on the Complaint.

6. Findings

Confusingly similar

In regards to Paragraph 4.1(a) of the Policy, 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".

Firstly, the Complainant submits that it has used the trade name "Niagara Region" in association with its businesses and services since 1970 and that it has established a reputation and association in the Mark which has become distinctive of the programs and services offered by the region. The Complainant cites that trade names and unregistered trade-marks are expressly protected in subparagraph 3.2(a) of the CIRA Policy.

The evidence provided establishes that the Complainant has registered various .ca, .com and .org domain names including niagarregion.com and niagararegion.org. However these registrations were made after the registration of the domain name by the Registrant.

The proof of the advertising of the Niagara Region Mark in the Trade-marks Journal of April 11, 2007 is irrelevant as this does not establish that the Complainant had rights in the Mark prior to the date of registration of the domain name. However it helps establish that the Complainant has existing rights in the use and the adoption of the Mark.

Complainant also refers us to its official website www.regional.niagara.on.ca which aims to inform residents of the programs and services provided by the region.

Complainant provides us with the Niagara Region Identity Standards Guide. The aim of this guide, published in 2005, is to inform people of the Niagara Region Logo and govern the use of the Mark.

The Complainant asserts that the trade name has been used since 1970 but does not provide us with complete evidence of this uninterrupted use.

However the fact that the Complainant has six registered trade-marks, including logos and designs for the Niagara Regional Police Service and the Regional Municipality of Niagara Police Services Board, and that three of these trade-marks were registered in 1983 helps establish the renown and the prior use of the Mark.

The test of the first impression and imperfect recollection of the average internet user who wishes to visit the Complainant's website is useful when it comes to deciding if a Mark is confusingly similar (See *Craigslist*, CIRA, Dispute number DCA-962-CIRA).

In the present case, considering the Complainant's status, social and economical involvement and notoriety in the given geographical area of Niagara, one can easily conclude that the Mark is distinctive and that a reasonable person living in the region will automatically associate the Mark to the Region and the services and programs it provides to the community.

It is therefore established that prior to the date of registration of the domain name, the Complainant had rights in a mark which is confusingly similar to the domain name, and continues to have such rights in the mark.

In accordance with paragraph 3.4 of the Policy, a domain name is confusingly similar to a mark if 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". In regards to paragraph 1.2 of the Policy, the dot.ca suffix is not taken into consideration when establishing similarity.

In this case, the domain name is identical to the trade-name as they are phonetically similar and composed of exactly the same words. An internet user searching for information about the Niagara region could reasonably mistake and associate the Registrant's domain name with the region (see *Canadian Broadcasting Corporation*, CIRA, Dispute number DCA 681-CIRA).

The Panel finds that in respect to paragraph 4.1 of the Policy, the Complainant has proven on a balance of probabilities that the domain name is confusingly similar to the "Niagara Region" mark in which the Complainant had rights prior to the registration of the domain name.

Absence of legitimate interest

The Complainant alleges that the Registrant has no legitimate interest in the Domain Name under paragraph 3.6 of the Policy. In order to establish such an assertion, the Complainant has to provide evidence that the Registrant does not meet any of the criteria enumerated under Paragraph 3.6 of the Policy.

(a) Use of the mark in good faith

Complainant submits that the Registrant has no legitimate interest in the domain name because the mark "Niagara Region" was advertised in the Trade-marks Journal of April 11, 2007 giving public notice under subparagraph 9(1)(n)(iii) of the *Trade-marks* Act of the adoption and use by the Niagara region of this mark as an official mark for services. Complainant adds that the Registrant has never had any rights in the mark prior to the municipality's advertising of the mark in the Trade-marks journal.

The mere fact that the mark was not a registered trade-mark in which the registrant had rights is not sufficient to establish that the Registrant has no rights in the Mark, as the CIRA Policy protects registered and unregistered trade-marks.

The Complainant has to prove the absence of rights in the mark.

Thus, the Complainant asserts that there is no active site at the domain name and that since its registration in November 2000, the domain name has only been used to redirect internet traffic to the Registrant's johnvail.com website which advertises a real estate and brokerage business.

Does redirection of internet traffic constitute "use" of a domain name? According to certain decisions such as *Browne & Co. Ltd. v. Bluebird Industries* (CIRA, Dispute number 00002), such a domain name is considered as in use.

However, if the Registrant has actually used the domain name, has he done so in good faith? One would think that registering a domain name in order to redirect internet traffic to a commercial website does not constitute a use in good faith. Especially since the domain name has been registered for seven years and that there is no evidence to establish that it was used for another purpose then to redirect traffic to the johnvail.com website.

As the Registrant has not filed a Response to the Complaint, the Panel has no indication whether the Registrant was planning on using the domain name for other means.

Therefore, based on the Complaint, the panel finds that the Registrant has no legitimate interest under paragraph 3.6(a) of the CIRA Policy.

(b) Use of a clearly descriptive domain name in good faith

Complainant submits (1) that the domain name is not descriptive of the character or quality of the wares, services or businesses it is used in association with and (2) that it is not descriptive of the conditions of, the persons employed in, the production of wares, the performance of the services or operation of the business it is used in association with.

The registrant's business is a real-estate and brokerage business. Niagararegion.ca is not descriptive of this business and its meaning is much too large for a reasonable person to associate it to real-estate and/or brokering.

Complainant further submits (3) that the domain name is not descriptive of the place of origin of the wares, services or business it is used in association with.

Evidence provides that the johnvail.com website, which the domain name redirects the user too, advertises a real-estate and brokerage business located in the Town of

Oakville, in the Regional Municipality of Halton. The panel has acquainted itself with the properties for lease or for sale listed on the johnvail.com website and finds they are all located in Oakville, which is indeed in the Halton Region.

Therefore, the niagararegion.ca domain name is not descriptive of the place or origin of the wares, services or business it is used in association with.

The Registrant has no legitimate interest under paragraph 3.6(b) of the CIRA Policy.

(c) Use of a generic domain name

The Complainant merely submits that the domain name is not the generic name of any wares, services or business it is used in association with. This assertion is true as the terms Niagara region do not specifically relate to the business of real-estate or brokering. Moreover, the business in question is not located in the Niagara Region.

The Registrant has no legitimate interest under paragraph 3.6(c) of the CIRA Policy.

(d) Use in good faith in association with a non commercial activity

Complainant has established that the domain name redirects internet users to one of the registrant's websites which advertises real estate and brokerage businesses; this does not represent a non commercial use of the domain name.

The Registrant has no legitimate interest under paragraph 3.6(d) of the CIRA Policy

(e) Use of registrant's name, surname or other reference by which he was commonly identified

The Registrant is known under the name of John Vail, the domain name Niagara Region does not consist of his name or surname. There is no evidence to the fact that he has ever been commonly identified as Niagara Region.

The Registrant has no legitimate interest under paragraph 3.6(e) of the CIRA Policy

(f) Geographical name of the location of the place of business

The Niagararegion.ca domain name redirects traffic to the johnvail.com website which advertises a real estate and brokerage business located in the town of Oakville, in the Regional Municipality of Halton. The panel has verified that Halton Region is located within the greater Toronto area. There is clearly no way the domain name could be considered as the geographical name of the location of the Registrant's business.

The Registrant has no legitimate interest under paragraph 3.6(f) of the CIRA Policy

Bad faith

The Complainant submits that, in regards to Paragraph 3.7(b) of the CIRA Policy, the Registrant registered the domain name in order to prevent the Complainant from registering the Mark as a domain name and that the Registrant 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. The Complainant must prove this assertion, on the balance of probabilities.

The Complainant has established that it has attempted on numerous occasions to contact the Registrant in order to express its interest in acquiring the domain name. The Respondent never answered the messages, emails or letters sent by the Complainant. Therefore Complainant asserts that the Registrant has been preventing it from registering the domain name, and has not explained what legitimate interest he has in the domain name. This fact alone cannot establish bad faith.

Can the Registrant be considered to be acting in bad faith when the mark he has registered as a domain name is constituted of a generic geographically descriptive term? As Justice Wright stated in *Black v. Molson Canada*, (2002) 21 C.P.R. (4th) 52 “simply because a domain name is identical or similar to a trade-mark name should not result in the transfer of the domain name to the trade-mark owner. In my view, unless there is some evidence that the use of the domain name infringes on the use of the trade-mark name, a person other than the owner of the trade-mark should be able to use the domain name”.

The Registrant uses the niagararegion.ca domain name in regards to his real-estate and brokering businesses. By doing so he does not infringe on the Complainant’s trade-mark, as the term Niagara is generic and descriptive of the Niagara region.

However, the fact that the Registrant does not do any business in the Niagara region and that the terms “Niagara region” are deeply associated in a reasonable person’s mind to the local regional municipality should have incited the Registrant to register a different domain name.

In regards to the pattern of registering domain names, quite a few decisions have decided that the registration of two domain names containing third party marks were sufficient to establish a pattern (see *Glaxo Group Limited*, CIRA, Dispute number DCA-780-CIRA and *Canadian Broadcasting Corporation*, CIRA, Dispute number DCA 681-CIRA). Evidence has established that the Registrant is the owner of five unrelated domain name registrations that contain third party trade-marks. These five domain names were all registered on November 9, 2000 which is the same date as the registration of the disputed domain name. All these domain names redirect users to the Registrant’s johnvail.com website.

The Registrant registered the cne.ca domain name despite the fact that CNE is a prohibited mark which was advertised on June 20, 1973. CNE stands for Canadian National Exhibition, and there is no established association or link between the Registrant’s business and this prohibited mark.

At the time of the registration of the hamiltonwentworth.ca domain name by the Registrant, Hamilton Wentworth was a regional government and Hamilton Wentworth was an official mark advertised on October 22, 1980. Clearly the Registrant, who does

not conduct business in the Hamilton region, has no legitimate interest in this particular mark.

The jjb.ca domain name is identical to the jjb.com domain name (created in 1994) which is the site of one of the Registrant's competitors J.J. Barnicke Limited, a real-estate services company. Once again, the Registrant does not seem to have any valuable reason to register such a domain name, unless preventing his competitor from registering the domain name.

The realestateinvestor.ca domain name is identical to the realestateinvestor.com domain name (created in 1996) which is a member site of the real estate investing community. Here too, it seems the only reason for which the Registrant registered this domain name is to prevent a competitor from registering the domain name under .ca. as there is no proof of any affiliation between the Registrant and the realestateinvestor.com website.

Finally, torontoindustrial.ca is identical to the torontoindustrial.com domain name (created in 1999) which is the website of a real estate company. Torontoindustrial.com has been a registered trade-mark since October 4, 2002 and there is no evidence to the fact that the Registrant is in any way associated to this particular real estate company.

Clearly, the registration of these five unrelated domain names corroborates the Complainant's claim that the Registrant has established a pattern of registering domain names and that his intention was to prevent the owners of rights in the marks from registering the marks as .ca domain names.

In conclusion, the panel finds that:

- (1) The domain name is confusingly similar to a Mark in which the Complainant had rights prior to the registration of the domain name and continues to have such rights.
- (2) The Registrant has no legitimate interest in the Mark.
- (3) The domain name has been registered in bad faith for the following reasons:
 - The Registrant's business is not related to the mark "Niagara region" and the registrant does not conduct business in the region.
 - The Registrant has engaged in a pattern of registering domain names in order to prevent persons who have rights in marks from registering these marks as domain names.

7. Decision

The Panel finds for the Complainant and orders that the registration of the domain name "niagararegion.ca" be transferred to the Complainant.

Date: November 7, 2007

Hugues G. Richard