

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN INTERNET
REGISTRATION AUTHORITY (“CIRA”) DOMAIN NAME DISPUTE RESOLUTION
POLICY (“POLICY”)**

Complainant: Delta T Corporation d/b/a Big Ass Fan Company

Complainant’s Representative: Joshua G. MacFadden
Furman & Kallio
Regina SK

Registrant: Armstrong-Douglas Design Solutions

Registrant’s Representative: Lianne J. Armstrong
Cohen Highley LLP
London ON

Disputed Domain Name: <bigassfans.ca>

Registrar: DomainsAtCost Corp.

Panel: Eric Macramalla, Denis N. Magnusson (Chair), Hugues Richard

Service Provider: Resolution Canada

DECISION

Parties

The Complainant is Delta T. Corporation, a corporation based in Lexington, Kentucky, USA. The Complainant also does business under the name Big Ass Fan Company. The Registrant is “Armstrong-Douglas Design Solutions”, a business name of Kevin Armstrong-Douglas. The Registrant is located in London, Ontario.

Disputed Domain Name and Registrar

The domain name in dispute is <bigassfans.ca> which was registered January 21, 2006. The Registrar is DomainsAtCost Corp.

Eligible Complainant

The Complainant is the owner of Canadian trademark registration TMA668,715 for the mark “Big Ass Fan”. As the domain name at issue is <bigassfans.ca>, the Complaint does relate to a trademark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of the trademark. This satisfies the Eligible Complainant requirement of Policy 1.4.

Procedural History

The Complainant filed this Complaint with the Provider Resolution Canada in or about May 2008. The Provider, finding the Complaint to be in order under the Policy, transmitted the Complaint to the Registrant. The Registrant submitted a Response. The Provider appointed Eric Macramalla, Denis N. Magnusson (Chair), and Hugues Richard as the Panel to decide this Complaint.

Relief Requested

The Complainant requested that the Panel order that the domain name registration be transferred from the Registrant to the Complainant, or in the alternative be cancelled.

Background Facts

The Complainant is in the business of designing, manufacturing and selling fans for industrial, agricultural and commercial applications. The Complainant began using “Big Ass Fan” as a trademark in or about June, 2000. The Complainant registered the domain name <bigassfans.com> in November, 2000. The Complainant adopted “Big Ass Fan Company” as a trade name. The Complainant created a web site at that domain address from which it was possible to purchase “Big Ass Fan” products. The Complainant applied to the United States Patent and Trademark Office (“USPTO”) to register “Big Ass Fan” as a trademark in February 2002. The trademark was registered in the US in January 2003.

In July, 2002 the Complainant entered into an agreement with Sun-North Systems Ltd. of Seaforth Ontario appointing Sun-North the exclusive distributor of the Complainant’s high-volume low-speed fans. In March, 2003 Sun-North exercised its right to terminate its agreement with the Complainant.

In April 2003, the Complainant filed an application in the Canadian Intellectual Property Office (“CIPO”) to register the trademark “Big Ass Fan” in Canada. That application was based on the applicant’s right, under the Trade-marks Act s. 16(2), to register a mark already registered in another treaty country (the US for this application) which mark the applicant has used. That application matured to registration on July 26, 2007.

The principals behind Sun-North Systems Ltd. caused Envira-North Systems Ltd. to be formed. Envira-North is a competitor of the Complainant in high velocity low speed fans and commercial ventilation systems.

In January, 2006 Envira-North Systems Ltd. retained the Registrant Armstrong-Douglas Design Solutions to design a website for Envira-North. Envira-North instructed the Registrant to register the domain name at issue <bigassfans.ca>, which registration was obtained on January 21, 2006. The Registrant, Armstrong-Douglas, became the registered owner of the domain name. A website was located at the domain <bigassfans.ca> hosted on Envira-North’s servers. While the Registrant Armstrong-Douglas was the formal legal owner of the domain name registration, Armstrong-Douglas’s client, Envira-North, was the beneficial owner of the registration.

In March, 2007 the Registrant received instructions from its client Envira-North to transfer formal legal ownership of the domain name registration to Envira-North. The Response states:
“Armstrong-Douglas mistakenly believed that transferring the domain names into Envira-North’s account at domainsatcost.ca transferred ownership of the domain names. . . . Envira-North’s domain names, including bigassfans.ca, were transferred into Envira-North’s account at domainsatcost.ca. . . . Envira-North had exclusive control over its domain names, including bigassfans.ca. “

On May 23, 2008 the Registrant was informed for the first time by the Complainant that there was a dispute concerning the bigassfans.ca domain name. The Registrant informed the Complainant that the domain name was then under the exclusive control of Envira-North.

The Complaint was issued and served on the Registrant.

The Registrant was informed by the Registrar, that it remained the domain owner of record for the domain name as the formal steps necessary for transfer of ownership had not been effected. This was so, the Registrant was informed, despite the Registrant having created a separate account with the Registrar to which the Registrant assigned the domain name, which account was created for the benefit of Envira-North, and despite Envira-North controlling the use of any domain name in that account.

The Registrant contacted a principal of Envira-North who stated that Envira-North was no longer using the bigassfans.ca domain name and would cooperate in the necessary steps to transfer the domain name to the Complainant.

However, the Registrant was informed that no transfer of the domain name could take place while the Complaint was outstanding.

Position of the Registrant

The Registrant takes no position on the Complaint. Further the Registrant states that, “[a]t all times, [the Registrant] was prepared to follow direction from the beneficial owner of the disputed domain name, Envira-North”.

Onus on Complainant

Policy 4.1 requires that:

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.

[emphases added]

(a) Confusingly Similar

Mark in Which Complainant Had and Has Rights

The domain name in dispute was registered on January 21, 2006. Under Policy 4.1(a) the Complainant must show that it had Rights in a Confusingly Similar Mark prior to the date of the registration of the domain name.

Policy 3.2(c) defines “Mark” to include a trademark *registered* in the CIPO. The Complainant has such a Mark, “Big Ass Fan”. While the Complainant applied to register this Mark on April 3, 2003, the Mark was not registered as a trademark until July 26, 2006. Thus, the Complainant had not acquired Rights in the Mark as a registered trademark prior to the date on which the domain name was registered.

However, Policy 3.2(a) also defines Mark as

A trade-mark . . . or a trade name *that has been used in Canada* by a person . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person;

The Complainant had begun to use “Big Ass Fan” as a trademark in the US in June, 2000 and it registered the domain name <bigassfan.com> in November 2000. The Complainant created a website at this domain and adopted the style “Big Ass Fan Company” as a business name which appeared on the web site.

The Complainant’s website at its <bigassfan.com> domain name was and is accessible by Internet users located in Canada. That website, at least in its present form, enables site users to place orders for Big Ass Fan Company products for delivery to such users. While unclear in the submissions, the Panel is prepared to infer, particularly in these somewhat unusual circumstances of essentially an unopposed Complaint, that some Big Ass Fan products were delivered to Canadian customers prior to the date of the registration of the domain name on January 21, 2006. We are encouraged in this finding by noting that the Complainant had entered into a product distribution agreement with a Canadian distributor Sun-North in July 2002 which remained in operation until March 2003. The submissions do not expressly state that products were distributed in Canada in this period in association with the Big Ass Fan mark, but the Panel is prepared to make that inference in the unusual circumstances of this case. The Panel further notes that the Complainant was sufficiently concerned about the status of its Big Ass Fan trademark in Canada that it filed an application to register that trademark in the CIPO in April, 2003. This occurrence supports the reasonableness of the Panel’s inference that as of this date products had already been distributed, and/ or that of April 2003, the Complainant intended soon to distribute products in Canada, in association with that Mark.

The Panel concludes that the Complainant had Rights in Canada in the Mark “Big Ass Fan” prior to the date of the registration of the domain name, January 21, 2006. The Complainant continues to have Rights in such Mark through its CIPO trademark registration.

Confusingly Similar

Policy 3.4 defines “Confusingly Similar”:

“A domain name is Confusingly Similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.”

In assessing similarity, the dot-ca suffix of the domain name is ignored, Policy 1.2. The Complainant’s Mark is its unregistered (later registered) trademark “Big Ass Fan”. Apart from capitalization, spacing, and a pluralisation, that Mark is the same as the disputed domain name <bigassfan>. The domain name is Confusingly Similar to the Complainant’s Mark.

b) Bad Faith

The Complainant has the burden of proving that the domain name was registered in Bad Faith as defined in Policy 3.7

In the Response, the nominal Registrant of the domain name, Armstrong-Douglas, “. . . specifically denies that he registered the domain name in bad faith. At all material times, he was following instructions provided by Envira-North, the beneficial owner of the disputed domain name.”

The Panel accepts this submission.

However, for the purposes of this Complaint, it is the bad faith of the beneficial owner, not that of the mere nominal owner, that is at issue.

Policy 3.7 has a restrictive definition of what can constitute the Registrant’s necessary Bad Faith in registering the domain name. There is Bad Faith, “*if, and only if*” one or more of three specific circumstances obtain. The Complainant submitted that the Registrant had registered the domain names in Bad Faith under Policy 3.7(c):

“(c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant . . . who is a competitor of the Registrant.”

The beneficial owner of the domain name, Envira-North, is a competitor of the Complainant in the manufacture and sale of high velocity low speed fans for agricultural, industrial and commercial applications. The principals behind Envira-North are the same as those behind Sun-North, with which the Complainant had a short lived exclusive distribution arrangement, which arrangement was cancelled at the initiative of Sun-North. At the time of the Complaint, a website at the domain name <bigassfans.ca> redirected Internet users to an Envira-North website at <enviranorth.com/index.htm>. In these circumstances, it is reasonable to infer that the beneficial owner of the domain name registration, Envira-North, instructed the nominal owner, Armstrong-Douglas, to register the domain name for Envira-North’s purpose of disrupting the business of its competitor, the Complainant. This constitutes Bad Faith under Policy 3.7(c).

c) No Legitimate Interest

The Complainant must submit some evidence that the Registrant has no Legitimate Interest in the domain name as defined in Policy 3.6. Bad Faith had to be assessed with reference to the beneficial owner of the domain name, Envira-North, and not the mere nominal owner, Armstrong-Douglas, and so does Legitimate Interest. The Complainant has submitted evidence that the beneficial owner of the domain name cannot satisfy any of the six heads of Legitimate Interest in Policy 3.6

Conclusion and Order

The Complainant has satisfied the Complainant’s burden under the Policy of establishing Confusing Similarity, Bad Faith, and some evidence that the Registrant does not have a Legitimate Interest in the domain name.

For the reasons set out above, the Panel grants the relief requested by the Complainant and orders that the domain name registration <bigassfans.ca> be transferred to the Complainant.

August 23, 2008

Signed

Eric Macramalla

Denis N. Magnusson (Chair)

Hugues Richard