

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

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**Domain Name:** BOWRING.CA

**Complainant:** Bowring & Co. Inc  
**Registrant:** Eric Maddeaux  
**Registrar:** 10 Dollar Domain Names Inc  
**Panellist(s):** Paul Donovan  
David Lametti  
Myra Tawfik (Chair)  
**Service Provider:** ResolutionCanada

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**DECISION**

**1. The Parties:**

The Complainant, Bowring & Co. Inc is a company incorporated pursuant to the Ontario Business Corporations Act having its registered office address at 98 Orfus Road, Toronto, Ontario M6A 2L9. The Complainant is represented by Faskin, Martineau DuMoulin LLP, P.O Box 20, Suite 4200 Toronto-Dominion Centre, Toronto, Ontario M5K 1N6

The Registrant is Eric Maddeaux with a contact address at 1498 Indian Grove, Mississauga, Ontario L5H 2S6

**2. The Domain Name and Registrar**

The disputed domain name is BOWRING.CA and the Registrar is 10 Dollar Domain Names Inc.

**3. Procedural History**

On September 15, 2008, the Complainant initiated a complaint with ResolutionCanada under the Canadian Internet Registration Authority (CIRA) Dispute Resolution Policy (CDRP) and the CIRA Domain Name Dispute Resolution Rules (the Rules) requesting that the Complaint be submitted for decision in accordance with the CDRP and the Rules and requesting the transfer of the domain name BOWRING.CA.

ResolutionCanada is an approved Dispute Resolution Service Provider under the CDRP.

On October 3, 2008, the Registrant submitted a Response to the Complaint and requested costs pursuant to paragraph 4.6 of the CDRP and paragraph 12.6 of the Rules.

Further to Rule 6.5, Resolution Canada appointed a three-member Panel consisting of Myra Tawfik (Chair), Paul Donovan and David Lametti to adjudicate on the dispute and a notice of selection of the panelists was sent to all parties on October 23, 2008. Each panelist submitted a declaration of impartiality and independence prior to his or her appointment.

On October 23, 2008, the Complainant filed a Reply to the Response of the Registrant in respect of the claim for costs. On October 28, 2008, the Registrant filed a Reply to the Response of the Complainant in respect of the claim for costs.

The Panel notes that this is the second complaint launched by the Complainant under the CDRP against the Registrant with respect to this domain name. A panel in that case held for the Registrant, on the grounds that the Complainant had not met the Canadian Presence Requirement under the Policy, and, in a related point, had not established rights in the mark in Canada: *Bowring & Co., c/o Peter Bevilacqua v. Eric Maddeaux*, CIRA Dispute 00081 (2007).

#### **4. Eligible Complainant**

The Complainant meets the Canadian Presence Requirements for Registrants (2003) (the "CPR") as an eligible complainant under s 2(d). It is a corporation incorporated under the laws of Ontario.

#### **5. Parties' Contentions**

##### **A. The Complainant:**

The Complainant alleges that it is the registered trademark owner of nine trademarks each containing the words BOWRING or BOWRINGS either alone or in combination with other words and used in association with the operation of retail stores - the totality of which the Complainant refers to as the BOWRING FAMILY Marks. It claims rights in these registered trademarks as the assignee of Tereve Holdings Ltd through the intermediary of RSM Richter, Interim Receiver of the assets of Tereve Holdings Ltd.

More specifically, on November 21, 2005, RSM Richter Inc entered into an agreement with the Complainant whereby it assigned to the Complainant the BOWRING FAMILY Marks and the attendant goodwill. The assignment of the BOWRING FAMILY Marks was recorded in the CIPO Trademark Database on June 26, 2008.

The Complainant also maintains that it currently holds a number of domain names in the name BOWRING namely, <bowring.com>, <bowringhome.ca>, <bowringflowers.ca>. These domain names link to the Complainant's corporate website that is used to promote the Complainant's retail operations and its wares.

The Complainant alleges that the domain name in dispute, BOWRING.CA, had originally been registered by Tereve Holdings Inc but that, around the time of the Complainant's transaction with RSM Richter, the domain name was cancelled by CIRA allowing the Registrant to register the disputed domain name in June 2006.

The Complainant alleges that the Registrant is using a domain name that is confusingly similar to its Marks, that the Registrant has registered the domain name in bad faith and that he has no legitimate interest in the domain name.

In reply to the Registrant's request for costs, the Complainant alleges that it is acting in good faith in the honest belief that it has a legal right to the domain name. The Complainant further alleges that the lack of success in a previous complaint is not a bar to bringing another complaint before CIRA in respect of the same domain name. Finally, the Complainant acknowledges its failed attempts to purchase the domain name and argues that failed negotiations alone do not constitute bad faith on its part.

### **B: The Registrant**

The Registrant takes issue with the Complainant's assertion that it has had continuous use of the disputed domain name. The Registrant alleges that as a result of the bankruptcy of Tereve Holdings Inc., the Marks were not in continuous use and that at the time he registered the disputed domain name, on June 6, 2006, the Complainant did not have control over the Mark.

The Registrant claims that he has a legitimate interest in the domain name and that he has not registered the domain name in bad faith.

He further alleges that the Complainant has acted in bad faith in that it defaulted on two agreements to purchase the domain name. In addition, on or about May 16, 2007, the Complainant had submitted a previous complaint to CIRA in respect of the domain name BOWRING.CA. This complaint was rejected on August 22, 2007 because the Panel found that the Complainant had not established that it had rights in the Mark. In bringing this second action before CIRA, the Registrant alleges that the Complainant is acting in bad faith under s. 12.6 of the Rules and as such, requests that the Panel order costs against the Complainant.

## **6. Findings**

The Registrant raises a preliminary issue that must be addressed before the Panel can proceed on the Complaint. The Registrant claims that in light of the previous CIRA decision involving the same parties and the same domain name, the Complainant cannot revisit the same claim in a subsequent CIRA Complaint.

### **6.1: Is the Complainant entitled to proceed in this second complaint against the Registrant in respect of the same domain name given that its earlier complaint was rejected by a CIRA Panel?**

The Panel was of the view that it was entitled to rule on this Complaint in spite of the earlier CIRA proceeding. There is nothing in the CDRP or under the Rules that prohibit a Complainant from initiating a second proceeding in respect of the same domain name registration. Further, the earlier CIRA decision involving these parties did not address the substantive merits of the Complainant's claim but was decided on the basis that the Complainant had not provided evidence to demonstrate that it was an Eligible Complainant under the CPR and that it had rights in the Mark. These procedural defects have been corrected in this Complaint and this Panel is reviewing the claim on the merits for the first time.

The Panel does believe, however, that there may be cases in which a Complainant may be barred from initiating a second complaint in respect of the same domain name registration where a Complainant uses the CIRA process in order to harass or intimidate a Registrant. The Panel was of the view that the Complainant's actions in initiating this second Complaint were not of this nature.

We now turn to the claim on its merits

Under paragraph 4.1 of the CDRP, the burden is on the Complainant to prove, on a balance of probabilities, that

- 1) 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
- 2) The Registrant has registered the domain name in bad faith
- 3) Some evidence that the Registrant has no legitimate interest in the domain name

Under Rule 12.1, the Panel shall render its decision based on the CDRP and Rules, the evidence and arguments submitted and any relevant rules and principles of the laws of Ontario and the laws of Canada. Further, inferences can be drawn about the Registrant's motives in registering the domain name from the Registrant's conduct or other surrounding circumstances including the uses to which the domain name is put.

6.2. The Registrant's 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 in which Complainant continues to have such Rights

In support of its claims to rights in the Marks, the Complainant has filed an assignment of trademark agreement between it and RSM Richter dated November 21, 2005. In addition, the CIPO database demonstrates that the Complainant is the registered trademark owner of the BOWRING FAMILY Marks. The assignment agreement predates the registration by the Registrant of the disputed domain. As a result, the Complainant, as a registered trademark holder in Canada, has established that it had rights to the Mark BOWRING prior to the date of registration of the domain name by the Registrant. Any issues surrounding the validity of the Complainant's registered trademarks should be addressed through the relevant proceedings under the *Trademarks Act*.

Given that the disputed domain name is identical to the Complainant's Mark the Panel finds that the Complainant has met its burden of establishing confusing similarity.

6.3 The Registrant registered the domain name in bad faith

The Panel was of the view that the Complainant has discharged its burden of demonstrating that the Registrant registered the domain name in bad faith under paragraphs 3.7(b) and (c) of the CDRP –

The Registrant clearly engages in a pattern of registering domain names in order to prevent those who have trademark rights in the name from registering it as their domain name. The Registrant's extensive domain name registrations incorporating such diverse but recognizable brand names as, for example, Avon, Seiko, Pyrex evidences this pattern of bad faith conduct.

In *Omer de Serres v. Eric Maddeaux* (CIRA Dispute DCA-1005) the Panel found that the Registrant had engaged in a sustained practice of registering domain names and parking them with websites that redirect users to sponsored or advertised links. In this way the Registrant generates revenue for himself whenever a user clicks on a sponsored link. The Registrant has also been the Respondent in a third recent CDRP dispute, and in that decision was also found to have been in bad faith: *Staples, Inc. & The Business Depot v. Eric Maddeaux*, CIRA Dispute 00105 (2008).

The Registrant's argument that he has no control over the sites that appear on the website has no merit. Indeed, it is precisely because he knows that the parked domain name will direct users to competitors of the Complainant that the Registrant engages in this type of revenue-generating practice.

The Complainant has satisfied the Panel that the Registrant has registered the domain name with a view to disrupting the business of the Complainant. The domain name and the website attached to it provide links to business competitors of the Complainant.

The Panel agrees with the *Omer de Serres* Panel when it stated:

Resolving a disputed domain name to a customized Internet portal...with a view to reaping a commercial advantage by attempting to capitalize on consumer confusion constitutes *prima facie* evidence of bad faith as per paragraph 3.7(c) of the Policy...

The Registrant claims that he is intending to use the domain name in relation to an online jewelry business he has yet to establish. The Panel was of the view that a vague and unsubstantiated intention to use the domain name at some unspecified date is insufficient to dispel the evidence of bad faith.

#### 6.4 The Registrant has no legitimate interest in the domain name

The Complainant must provide some evidence that the Registrant had no legitimate interest in the domain name. It alleges that the Registrant does not hold any trademarks similar to the Marks and that its sole purpose in having registered the domain name was to confuse consumers by redirecting them to its website in direct competition with the Complainant. A Registrant has a legitimate interest in the domain name for the reasons set out in paragraph 3.6 of the CDRP. None of the six legitimate uses identified in this paragraph apply to this case. The Registrant had no right in the Marks at the time of registration of the domain name, it was not acting in good faith in registering the domain name and it is making a commercial use of the domain name. Finally, the domain name is not the legal name of the Registrant nor is it the geographical name of the location of its business.

#### 7. Decision:

The Panel concludes that the Complainant has established its entitlement to a remedy under paragraph 4.3 of the CDRP. The domain name is confusingly similar to a Mark in which the Complainant has and continues to have rights. The Registrant registered the domain name in bad faith and without legitimate interest. The Complainant has requested a transfer to it of the domain name BOWRING.CA. The Panel orders the transfer of the disputed domain name BOWRING.CA to the Complainant.

Since the Panel has upheld the Complaint, it need not address the Registrant's claim for costs.

Dated November 13, 2008

Myra Tawfik  
Paul Donovan  
David Lametti



Myra Tawfik  
Chair



Paul Donovan



David Lametti