

**In the Matter of a Complaint Pursuant to
Canadian Internet Registration Authority
Domain Name Dispute Resolution Policy**

Dispute Number: DCA-1113-CIRA
Domain Name: yachtworld.ca
Complainant: YachtWorld, Nova Scotia Company, U.L.C.
Registrant: Clift's Marine Sales (1992) Ltd & Angus Yachts
Registrar: Internic.ca Corp.
Panelist: Elizabeth Cuddihy, QC, ICA
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

The Parties

1. **The Complainant is** YachtWorld, Nova Scotia Company, U.L.C. of 111 Melville St, Suite 1220, Vancouver, BC, V6E 3V6 and 1959 Upper Water Street, Suite 900, Halifax, NS, B3J 3N2, hereinafter referred to as the "Complainant".
2. **The Registrant is** Clift's Marine Sales (1992) Ltd of 1 Port Street East Mississauga, ON, L5G4N1 and Angus Yachts of 1 Port Street East, Mississauga, ON, L5G 4N1, hereinafter referred to as the "Registrant".

The Domain Name and Registrar

3. The Domain Name at issue ("Disputed Domain Name") is yachtworld.ca.
4. The Registrar for the Disputed Domain Name is Internac.ca Corp, according to printout of CIRA's WHOIS record for the Domain Name.
5. The Disputed Domain Name was registered November 9, 2000.

Procedural History

6. The British Columbia International Commercial Arbitration Centre ("BCICAC") is a recognized service provider to the Domain Name Dispute Resolution Policy ("Policy") of the Canadian Internet Registration Authority ("CIRA").
7. On September 29, 2008, the Complainant filed a complaint with respect to the Disputed Domain Names ("Complaint"), which Complaint, BCICAC deemed to be in administrative compliance and the Complainant to be eligible.

8. By way of letter dated September 29, 2008, BCICAC so notified the Registrant of commencement of the dispute resolution process in respect of the Complaint. This notice was delivered by Fed Ex courier on October 1, 2008.

9. The Registrant did not file a Response.

10. BCICAC advised the parties that no Response had been received within the timeframe permitted therefor and, as permitted in Rule 6.5 the Complainant elected to convert to a single arbitrator.

11. On January 16, 2009, BCICAC appointed Elizabeth Cuddihy, QC, ICA as sole arbitrator to determine the matter in accordance with the rules.

12. Pursuant to Rule 5.8, there being no Response to consider, the matter is determined on the basis of the Complaint as filed.

The Complaint and Relief Requested

13. The Complainant, a company incorporated under Nova Scotia laws, submits that it is a Canadian licensee of Dominion Enterprises, a Virginia general partnership and the owner of the Yachtworld Mark in the United States, Canada and other countries around the world.

14. The Complainant further claims that Dominion Enterprises, the “Licensor” owns the Yachtworld Mark registered in the United States since June 24, 1997 and filed for registration in Canada July 23, 2008, which mark is licensed to it since 2003.

15. The Complainant further asserts that since 1995, Dominion Enterprises owns and operates the domain name <yachtworld.com> and the corresponding yachtworld website which prominently displays the Yachtworld Mark. Since 2003, the Complainant and Dominion Enterprises and other licensed users of the Yachtworld Mark have operated the yachtworld website.

16. The yachtworld website is a world leader in online boat sales and is the internet’s leading online marine publication with over 100 members spanning 120 countries, including Canada, listing over 100,000 boats for sale, exceeding \$55 billion dollars in value. The yachtworld website has been available in Canada since July 1996 and has been continuously accessed and used by internet users from Canada since that time.

17. The Complainant further submits that the Yachtworld Mark has been in use in Canada since as early as July 6, 1996 in connection with providing information about the

sale and charter of boats, the design, building, servicing and maintaining of boats; marinas; publications, software; and equipment relating to boating and navigation via a global computer communication network.

18. It alleges further that the Registrant is a competitor of the Complainant in the online boat sales industry and the owner of the domain name <cliftsmarine.com>. The Registrant has registered the Disputed Domain Name to redirect visitors to his own competing website <cliftsmarine.com>, thereby trading on the goodwill associated with the Yachtworld Mark in which he has no rights.

19. The Complainant further submits that the Disputed Domain Name is confusingly similar to the Yachtworld Mark in which the Complainant and the Licensor had Rights prior to the date of registration of the Disputed Domain Name, November 9, 2000, that the Registrant has no legitimate interest in the Disputed Domain Name, and that the Disputed Domain Name has been registered by the Registrant in bad faith in accordance with paragraph 3.7 of the Policy and requests that the Disputed Domain Name be transferred to the Complainant.

Eligibility of Complainant

20. In accordance with 1.4 of the Policy,

“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”) (currently available at http://www.cira.ca/en/cat_Registration.html) 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.”

21. The Complainant is a corporation under the laws of Nova Scotia, Canada and satisfies the Canadian Presence Requirements for Registrants as required by the Policy.

Analysis and Findings

22. Paragraph 4.1 of the Policy provides:

4.1 **Onus.** To succeed in a 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 as described in paragraph 3.6.

4.1 (a) Confusingly Similar

23. In applying the confusion analysis, paragraph 1.2 of the Policy provides that

“...’domain name’ means 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”

24. Paragraph 3.2 (1) of the Policy further provides that

“(a) ‘Mark’ is a trade-mark including the word elements of a design mark, or a trade-name that has been used in Canada by a person or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor, or a licensor of that person or predecessor from the wares, services or business of another person;”

25. The evidence shows that the Yachtworld Mark was registered in United States June 24, 1997 as Number 2073561. An application for registration of the Yachtworld Mark in Canada was filed with CIPO July 23, 2007. The CIPO application indicates that use in Canada of the Yachtworld Mark dates back to as early as July 6, 1996.

26. The Disputed Domain Name was registered November 9, 2000.

27. The Policy draws a distinction between rights in a mark registered in CIPO before the date a disputed domain name was registered and common law rights in a mark acquired through use by the complainant. In this instance, as the Disputed Domain Name was registered prior to the CIPO application date, one must examine whether the

Complainant or its Licensor had prior common law rights in the Yachtworld Mark in Canada.

28. As evidenced in Schedule 6 of the Complaint, the Yachtworld Mark has been prominently displayed in its advertising and promotion as early as July 6, 1996 in Canada in association with the following services: providing information about the sale and charter of boats, the design, building, servicing and maintaining of boats; marinas, publications, software, and equipment relating to boating and navigation, via a global computer communication network.

29. In addition, as evidenced in Schedule 7 to the Complaint, the Canadian visitor traffic to the site represents 6.1% of all visitors to the site, showing its notoriety among the Canadian boating and yachting community and industry.

30. The Complaint further alleges that by 2000, when the Disputed Domain Name was registered, Yachtworld had conducted hundreds of thousands of transactions through the yachtworld.com website and had expended thousands of dollars on advertising and promotion of the yachtworld website, which website prominently displayed the Yachtworld Mark.

31. Accordingly I am satisfied that the Complainant and its Licensor had prior common law rights in the Yachtworld Mark in Canada prior to the date of registration of the Disputed Domain Name by the Registrant.

32. In determining whether there exists a confusing similarity between a Domain Name and a mark as referred to in the Policy, a panel must only consider whether a person, as a matter of first impression, knowing the Complainant's corresponding mark only and having an imperfect recollection of it, would likely mistake the Domain Name for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark.

33. For purposes of the Policy, a domain name, means the domain name excluding the dot-ca suffix and is confusingly similar to a mark if the domain name so nearly resembles the mark in appearance, sound or ideas suggested by the mark as to be likely to be mistaken for the mark.

34. In the matter at hand, the Disputed Domain Name is identical to the Yachtworld Mark.

35. Accordingly for the reasons noted above, I find that the Disputed Domain Name is confusingly similar to the Yachtworld Mark in which the Complainant and its Licensor had rights prior to the date of registration of the Disputed Domain Name and continues to have such rights.

4.1(b) - Bad Faith

36. To determine this issue, I refer to paragraph 3.7 of the Policy which provides as follows:

“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 purposes 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.”

37. To establish bad faith on the part of the Registrant, the Complainant need prove only one of the above. The Complainant relies on paragraph 3.7 (c).

38. The evidence shows that neither the Complainant nor the Licensor has licensed the Yachtworld Mark to the Registrant, nor does it have a business relationship with the Registrant.

39. The evidence further shows that the Registrant was, at one time, a member of the yachtworld website and accordingly must have had knowledge of the Yachtworld Mark and its business well before the November 9, 2000 registration date of the Disputed Domain Name, which incorporates the Yachtworld Mark.

40. Furthermore, the evidence shows that the Registrant is a competitor of the Complainant and its Licensor in the online boat sales industry. The Disputed Domain Name website redirects to the Registrant’s own website, < cliff’smarine.com > thereby trading on the goodwill associated with the Yachtworld Mark by misdirecting consumers to its competing website, thereby potentially benefiting from diverting this traffic to his site.

41. Given that the Disputed Domain Name is entirely comprised of the Yachtworld Mark, internet users who encounter the Disputed Domain Name could be misled into believing that there is a business or commercial association with the Complainant, which, the evidence shows is not the case.

42. Evidence shows that the Complainant's attempts to resolve the issue have been unsuccessful.

43. Based on the evidence, I find that the Registrant has registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant or the Complainant's licensor or licensee of the Yachtworld Mark, who is a competitor of the Registrant.

44. I find that the Registrant has accordingly registered the Disputed Domain Name in bad faith as referred to in the Policy.

4.1 (c) Legitimate Interest of the Registrant

45. The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

46. In paragraph 3.6 of the Policy, an exhaustive list is applied which provides that a Registrant has a "legitimate interest" in a domain name "if, and only if" before a Complaint is filed, the domain name in question meets one or more of the six criteria set out therein.

47. The evidence shows that none of the criteria specified in paragraph 3.6 of the Policy can be relied upon by the Registrant.

48. Furthermore the Registrant has not provided a Response to the Complaint and has not established on a balance of probabilities that the Registrant has a legitimate interest in the Disputed Domain Name as described in paragraph 3.6 of the Policy.

49. Based on the evidence, I am satisfied on a balance of probabilities that the Registrant has no legitimate interest in the Disputed Domain Name.

Conclusion

50. Based on the evidence, I find that the Complainant has satisfied the requirements of Paragraph 4.1 of the Policy and the Registrant has no legitimate interest in the Disputed Domain Name and rule in favor of the Complainant.

Order

51. I direct that the registration of the Disputed Domain Name, be transferred to the Complainant.

DATED at Chester, Nova Scotia, this 30th day of January, 2009.

(sgd) Elizabeth Cuddihy, QC, ICA,
Sole Arbitrator