

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

Domain Name: <westkelowna.ca>  
Complainant: District of West Kelowna  
Registrant: Baremetal.com Inc.  
Panellists: Patrick Flaherty, Peter Cooke, and Elizabeth Cuddihy  
Service Provider: British Columbia International Commercial Arbitration Centre

**DECISION**

**Parties**

1. The Complainant is the District of West Kelowna, a municipality in British Columbia, Canada.
2. The Registrant is Baremetal.com Inc.

**Domain Name**

3. The domain name that is the subject of this proceeding is <westkelowna.ca> (the “Domain Name”).

**Procedural History**

4. This is a proceeding under the CIRA Domain Name Dispute Resolution Policy, adopted by the Canadian Internet Registration Authority with the Effective Date of June 10, 2008 (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules, version 1.3 (the “Rules”). By registering the domain name with the Registrar, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and Rules.
5. The history of this proceeding, according to the information provided by the dispute resolution service provider, British Columbia International Commercial Arbitration Centre (“BCICAC”), is as follows:
  - (a) On August 14, 2009, the Complainant filed a complaint regarding the Domain Name with BCICAC.
  - (b) On August 18, 2009, having determined that the complaint was in administrative compliance with the requirements of the Policy and the Rules, BCICAC delivered a copy of the complaint to the Registrant.
  - (c) On September 2, 2009, the Registrant delivered its response to BCICAC.
  - (d) On September 9, 2009, the Registrant’s response was reviewed by the BCICAC and delivered to the Complainant.

- (e) On September 9, 2009 the Complainant delivered a letter correcting a statement of fact in its complaint.
- (f) Both the complaint and the response were filed in English, which is the language of this proceeding in accordance with paragraph 10.1 of the Rules.
- (g) In accordance with paragraph 6 of the Rules and considering the nominees of the parties, BCICAC appointed a three-person Panel comprised of Patrick Flaherty, Peter Cooke and Elizabeth Cuddihy. Mr. Flaherty was named as Chair of the Panel.
- (h) Each of the Panellists have delivered to BCICAC the required Statement of Impartiality and Independence, as required by paragraph 7 of the Rules.
- (i) Absent exceptional circumstances, the Panel was required to deliver its decision by September 30, 2009.
- (j) The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules. Based upon the information provided by BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met.

#### **Factual Background**

- 6. The Panel proceeds on the basis of the following facts set forth below as established in the submissions of the parties.
  - (a) The Complainant is a municipality originally incorporated as Westside District Municipality on December 6, 2007 . On January 29, 2009, the District's letters patent were formally amended to rename the Municipality "District of West Kelowna", subsequent to an ongoing community renaming initiative. This name change occurred approximately 22 months after the Domain Name was registered on April 2, 2007.
  - (b) On November 16, 2008, the District reserved the following domain names: [www.distofwestkelowna.ca](http://www.distofwestkelowna.ca); [www.westkelonadistrict.ca](http://www.westkelonadistrict.ca); and [www.districtwestkelowna.ca](http://www.districtwestkelowna.ca).
  - (c) On December 10, 2008, the Complainant contacted the individual registrants of [www.districtofwestkelowna.ca](http://www.districtofwestkelowna.ca) and the Domain Name to request that they be transferred to the Complainant. On January 8, 2009, the registered owner of [www.districtofwestkelowna.ca](http://www.districtofwestkelowna.ca) agreed to transfer its domain name to the Complainant. The registered owner of the Domain Name - the Registrant - rejected the offer to purchase.
  - (d) The Registrant is a businessman living in the District of West Kelowna. On April 2, 2007, the Registrant registered the domain name but did not commence using the website until November 2008. The Registrant now uses the Domain Name for a website that purports to operate as a portal for the benefit of businesses and organizations in the region.

### Positions of the Parties

7. The Complainant seeks an order requiring the Domain Name be transferred to it on the following bases:
- (a) The Domain Name is confusingly similar to marks in which the Complainant has rights, the names “District of West Kelowna” and “West Kelowna”, and more specifically:
    - (i) the Complainant has existing rights in the name “District of West Kelowna” through its Letters Patent incorporation document from the Province of British Columbia, amended on January 29, 2009 at the request of the municipal council;
    - (ii) Typically domain names of communities are reserved in the dot-ca registration for the use of the municipality of that name;
    - (iii) The Complainant is becoming commonly known as “West Kelowna” and will be identified as such on maps.
  - (b) The Registrant has no legitimate interest in the Domain Name because: (i) the Domain Name does not contain a mark in which the Registrant has used in good faith, but rather, is an attempt to capitalize on an association with the Complainant; (ii) the Registrant has not used the Domain Name in good faith in association with wares, services or businesses in respect of which the Domain Name is descriptive or generic names; (iii) the Domain Name does not constitute the Registrant’s legal or other names; and (iv) the Domain Name does not constitute geographic names or the location of the Registrant’s non-commercial activity or business.
  - (c) The Registrant registered the Domain Name in bad faith because it did so to prevent the Complainant from registering its trade-marks as a domain name and it has engaged in a pattern of registrations designed to do the same, and more specifically:
    - (i) The timing of the launch was strategic. The domain name was “parked” and remained inactive for over 19 months until two days after the announcement of the results of a naming opinion poll in which it was determined that West Kelowna was the favoured name;
    - (ii) The Registrant has also registered the following domain names:  
www.kelownawest.ca and www.westkelowna.bc.ca.
8. The Registrant contends as follows:
- (a) As of the date of the registration of the Domain Name, the Complainant did not have a prior right in, or use of, the Mark as the Domain Name was registered significantly before the Complainant came into legal existence and before actual or contemplated use of the name West Kelowna by the Complainant. In particular, the Registrant argues that municipalities cannot unilaterally reserve names after the fact, and that municipal names can only be reserved through the appropriate registration channels;
  - (b) The Registrant has a legitimate interest in the Domain Name because it was registered for specific business reasons, namely, according to the Registrant, to develop a portal/gateway to obtain access to information and businesses in the area, in the geographic proximity to the specific region of West Kelowna;

- (c) The Registrant is not using the Domain Name in bad faith because the Registrant did not register the Domain name to sell it, to prevent the Complainant from registering the Domain Name, or to interfere with the Complainant's business, as the Complainant did not exist at the time of registration;
- (d) The complaint was brought in bad faith, and is an attempt to cancel or obtain a transfer of the Domain Name unfairly and without colour of right.
- (e) The Registrant asserts that the complaint has been brought "unfairly and without colour of right" and thus seeks his costs of the proceeding under the terms of the Rules.

## Discussions and Findings

### (a) The Policy

9. As has been observed by Panels in other decisions,<sup>1</sup> the Policy applies only to disputes involving alleged bad faith registration of domain names in the dot-ca country code top level domain. The Policy, therefore, does not apply to all forms of dispute between trade-mark owners and domain name registrants. The Policy, therefore, is limited to situations in which a complainant asserts:
  - (a) the registrant's dot-ca domain name is "Confusingly Similar" (as defined in Policy paragraph 3.4) to a "Mark" (as defined in Policy paragraph 3.2) in which the complainant had "Rights" (as defined in Policy paragraph 3.3) prior to the date of registration of the domain name and continues to have such "Rights";
  - (b) the registrant has no legitimate interest in the domain name as described in Policy paragraph 3.6; and
  - (c) the registrant has registered the domain name in bad faith as described in Policy paragraph 3.7.<sup>2</sup>
10. The onus of proof regarding these three required elements is also prescribed in the Policy. The complainant must:
  - (a) prove, on a balance of probabilities, that 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";
  - (b) prove, on the balance of probabilities, that the registrant has registered the domain name in bad faith as described in Policy paragraph 3.7; and,
  - (c) provide some evidence that the registrant has no legitimate interest in the domain name as described in Policy paragraph 3.6.
11. Even if a 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 Policy paragraph 3.6.

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<sup>1</sup> *Cheap Tickets and Travel Inc. v. E-mail.ca Inc.* (January 31, 2003) BCICAC, Decision 4a.

<sup>2</sup> Policy paragraph 3.1.

**(b) The Complainant's Mark**

12. The Complainant must prove, on a balance of probabilities, that the 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” within the meaning of the Policy.
13. Policy paragraph defines a “Mark” as follows:
  - 3.2 *A “Mark” is:*
    - (a) *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;*
    - (b) *a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person’s predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;*
    - (c) *a trade-mark, including the word elements of a design mark, that is registered in CIPO;*  
*or*
    - (d) *the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the Trade-marks Act (Canada).*
14. Policy paragraph 3.3 provides a definition of the term “Rights in a Mark” as follows:
  - 3.3 *A person has “Rights” in a Mark if:*
    - (a) *in the case of paragraphs 3.2 (a) and 3.2(b), the Mark has been used in Canada by that person, that person’s predecessor in title or a licensor of that person or predecessor*
    - (b) *in the case of paragraph 3.2(c), the Mark is registered in CIPO in the name of that person, that person’s predecessor in title or a licensor of that person; or*
    - (c) *in the case of paragraph 3.2(d), public notice of adoption and use was given at the request of that person.*
15. The Complainant argues that it has existing rights in a Mark based on its letters patent, which were issued on January 29, 2009. However, the Policy provides that only in certain prescribed circumstances can rights attach to Marks under the Policy.
16. To qualify as a Mark under Policy paragraph 3.2(a), the Complainant must provide evidence that a trade-mark was used in Canada by the Complainant or its predecessor in title. Similarly, under 3.3(a), a right in the Mark only attaches to the Mark where use is shown. The mere assertion that the Complainant has rights, based on its incorporating documents, and a general chronology of its municipal political history, provides the Panel with a limited evidentiary record to find the requisite use of the Mark.

17. Furthermore, the Complainant must have had rights “prior” to the date of registration of the Domain Name by the Registrant and continue to have them. Policy paragraph 4.1 provides that the date of registration of a domain name is the date on which the domain name was first registered in the dot-ca registry or the predecessor registry operated by the University of British Columbia. The Complainant must therefore show pre-existing rights in the Mark prior to the time of registration of the domain name by the Registrant.
18. The Domain Name was registered by the Registrant on April 2, 2007. This is prior in time to the legal existence of the Complainant, which was incorporated as Westside District Municipality from December 6, 2007 until January 29, 2009. There is limited evidence on the record of prior use or any association between the Complainant and the Mark to indicate a pre-existing right in the Mark. In fact, based on the Complainant’s own record, it is clear that until January of 2009 it was uncertain whether the Complainant would become “Westside District Municipality” or the “District of West Kelowna”, rendering it difficult to assert a prior right in the Mark.
19. While the Complainant has asserted that a municipality’s name generally ought to function to reserve the associated domain name, this does not accord with the CIRA policy that addresses the issue. The Registration of Municipal Names Policy, Rules and Procedures (Version 1.4) provides as follows:

**Municipal Name Registration Policy:** CIRA will make “municipal names” available for registration only by the municipalities which correspond to those names under special rules and procedures to be determined by CIRA in its discretion.

**1. Municipal Name Registration Rules:** Natural Resources Canada maintains and publishes the Canadian Geographical Names Database (CGNDB), a list of Canadian geographical place names. For the purposes of CIRA’s Municipal Name Registration Policy, a “municipal name” is a name listed in one of the several classes of the version of the CGNDB being used by CIRA on the date on which a CIRA Certified Registrar submits a request to CIRA to register a municipal name on behalf of an applicant ...

*Registry Interpretation: If a name is not listed in that version of the CGNDB on a particular date it is not reserved by CIRA on that date even if it is the name of a municipality or former municipality or it was at one time listed in one of the relevant classes in the CGNDB. If a name is already registered at the time it is listed in that version of the CGNDB it is not available for registration.*

20. The clear implication of this policy in light of the registry interpretation is that unless a municipal name is specifically listed in the CGNDB at the time of the domain name registration is sought, the name is not reserved. Further, the registry interpretation provides that if a domain name is registered before the addition of the name to the CGNDB it is not available for registration by the municipality under the Policy. The Complainant does not meet the requirements of the Policy in that “West Kelowna” was not registered in the CGNDB at the time the Domain Name was registered, nor based on the evidence submitted by the Registrant, is it included in the CGNDB now. To be clear, the Panel’s determination is based on the record as presented and we make no finding on the applicability of the Policy should “West Kelowna” become registered in the CGNDB.

21. After careful consideration of all of the Complainant's evidence and argument, the Panel finds that the Complainant has not proven, on a balance of probabilities, that West Kelowna was a "Mark" within the meaning of the Policy prior to the Domain Name registration date. In particular, the panel concludes that the Complainant has not submitted sufficient evidence of any prior use of, and pre-existing right, in the mark so as to prove on a balance of probabilities that prior to the date of registration of the Domain Name on April 2, 2007, the Complainant had used the mark in association with carrying out, promoting or advertising its activity.

**(c) Other Requirements of the Policy**

22. Due to the Panel's conclusion as to the first required component of the Policy, it is not necessary for the Panel to consider the other requirements of the Policy, i.e. whether the Domain Name is "Confusingly Similar" to a Mark in which the Complainant had rights, whether the Registrant had no legitimate interest in the Domain Name and whether the Registrant has registered the Domain name in bad faith.


**(d) Bad Faith Complaint**

23. The Registrant asserts that the Complainant has brought the complaint in bad faith. Under Policy paragraph 4.6, if a registrant is successful and proves, on a balance of probabilities, that the complaint was brought by the complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of any domain name registration that is the subject of the proceeding, then the panel may order the complainant to pay to the provider in trust for the registrant an amount of up to five thousand (\$5000) to defray the costs incurred by the registrant in preparing for and filing material in the proceeding.
24. The Complainant has failed to establish, on a balance of probabilities, that it had a Mark prior to the date of registration of the domain name but that does not mean its complaint has been brought in bad faith. As the Municipality, the Complainant clearly has an interest in "West Kelowna", though not one that meets the requirements of a "Mark" as construed in the Policy on the record before us. Moreover, the Complainant has adduced a record which is consistent with the registration having been made in bad faith and that further supports the Complainant having reasonable grounds to bring the complaint (notably the lengthy period of delay from registration to activation of the website that resolves to the Domain Name and the timing of the launching of the active website in relation to the naming process undertaken by the Municipality, and the related domain names registered by the Registrant). The Panel thus finds that the complaint was not brought in bad faith within the meaning of the policy and no order of costs is made.

**Conclusion and Decision**

25. The Complainant has failed to prove, on a balance of probabilities, that it had Rights in the Mark prior to the date of registration of the Domain Name. Accordingly, the Complainant has not established one of the requirements set out in Policy paragraph 4.1. For that reason, the Panel dismisses the complaint.

Peter Cooke, Elizabeth Cuddihy, and Patrick Flaherty

A handwritten signature in black ink, appearing to read "Pat Flaherty", is written over a horizontal line. The signature is stylized and cursive.