

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

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Domain Name:       trxfitnessanywhere.ca  
Complainant:       Fitness Anywhere Inc.  
Registrant:         Bannerfrend  
Registrar:         Go Daddy Domains Canada, Inc.  
Panellist:         Sharon Groom  
Service Provider:   Resolution Canada, Inc.

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**DECISION**

**A.    The Parties**

1. The Complainant, Fitness Anywhere Inc. is a corporation located in the US.
2. The Registrant for the domain name is Bannerfrend, and the administrative contact is listed as Banner Frend. The address is listed as Biter St. No. 23, Louden, (no state given), United States 32323.

**B.    The Domain Name and Registrar**

3. The disputed domain name is trxfitnessanywhere.ca. The Registrar for this domain name is Go Daddy Domains Canada, Inc. The disputed domain name was registered on June 8, 2010.

**C.    Procedural History**

4. This is a proceeding under the Canadian Internet Registration Authority ("CIRA") *Domain Name Dispute Resolution Policy* (Version 1.1) (the "Policy") and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.2) (the "Rules").
5. The history of the proceeding as provided by the dispute resolution provider, Resolution Canada, Inc., is that the Complainant filed a complaint against the Registrant with Resolution Canada, Inc. requesting that the current registration of the domain name trxfitnessanywhere.ca be transferred to Fitness Anywhere Inc. The Complaint was dated October 15, 2010.

6. Resolution Canada, Inc. served notice of the Complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the Complaint was made by e mail on October 18, 2010 and also sent by courier on that day.

7. The Registrant was given twenty days to file a response but no response was filed.

8. The Complainant has elected to proceed before a panel consisting of only one panellist.

**D. Panellist Impartiality and Independence**

9. As required by paragraph 7 of the Rules, I have submitted to Resolution Canada, Inc. a declaration of impartiality and independence in relation to this dispute.

**E. Canadian Presence Requirements**

10. The Complainant, Fitness Anywhere Inc., is a US company. However it owns two Canadian trade-mark registrations, namely registration no. 725,248 for FITNESS ANYWHERE and registration no. 726,445 for TRX, both of which are contained in the disputed domain name. (While the trade-mark registrations and the domain name registrations referred to later show the Complainant's name as Fitness Anywhere, Inc., and the Complaint refers to the Complainant as Fitness Anywhere Inc., I am going to treat the lack of a comma in the Complainant's name in the Complaint as a typo and ignore it for the purposes of these proceedings.) As such it meets the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

**F. Factual Background**

11. The Complainant filed applications to register the trade-marks TRX and FITNESS ANYWHERE on July 19, 2007 based on use in Canada since January 23, 2006. The marks were registered on October 21 and October 3, respectively, 2008. The mark FITNESS ANYWHERE is registered for "manually operated exercise equipment, and instructional material sold together therewith as a unit". The mark TRX is registered for "manually operated multipurpose exercise, fitness and sporting equipment, and instructional material sold together therewith as a unit; physical fitness conditioning classes; physical fitness consultation; physical fitness instruction; physical education services". The Complainant has been using the marks TRX and FITNESS ANYWHERE in association with these wares and services in Canada since January 2006.

12. The Complainant registered the domain name fitnessanywhere.com on June 7, 2004 and the domain name trxfitnessanywhere.com on May 21, 2010. These domain names both resolve to the same website advertising the Complainant's TRX fitness equipment and its fitness services.

13. The Complainant states that the domain name trxfitnessanywhere.ca is not in use and that it leads to an error message indicating that the website could not be opened.

**G. CIRA Domain Name Dispute Resolution Policy**

14. Under paragraph 3.1 of the Policy it requires that the Complainant establish 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;

(b) the Registrant has registered the domain name in bad faith as described in section 3.7; and

(c) the Registrant has no legitimate interest in the domain name as described in section 3.6.

15. According to paragraph 4.1 of the Policy the Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name.

#### H. Analysis

##### Confusingly Similar

16. The Complainant has to show that it has rights in a mark (and continues to have these rights) that is confusingly similar to the domain name and that these rights pre-date the date of registration of the disputed domain name.

17. The date of registration of the domain name is June 8, 2010, therefore this is the relevant date for this analysis.

18. The Complainant states that it has used its marks 'TRX and FITNESS ANYWHERE in Canada to identify its wares and services since January 2006. The Complainant provides copies of pages from its website at [www.fitnessanywhere.com](http://www.fitnessanywhere.com) demonstrating current use of the marks TRX and FITNESS ANYWHERE and provides copies of advertisements and newspaper articles mentioning its products and services in association with the marks TRX and FITNESS ANYWHERE. It therefore appears that the Complainant uses these marks to distinguish its wares and services from those of others. These marks therefore satisfy the definition of a "mark" in subparagraph 3.2(a) of the Policy.

19. The Complainant has "rights" in these marks as it is the party that has used them in Canada (see subparagraph 3.3(a) of the Policy). These rights predate the date of registration of the disputed domain name as the marks were first used as of January 2006, which is prior to the relevant date of June 8, 2010. This is supported by the fact that the Complainant filed trade-mark applications for these marks in Canada on July 19, 2007 based on use since January 23, 2006. The fact that the marks still appear on the Complainant's website shows that the use of these marks is continuing.

20. The Complainant has thus established rights in the marks TRX and FITNESS ANYWHERE since prior to 2008, and has demonstrated that it continues to have these rights. The question then is whether these marks are confusingly similar to the domain name [trx.fitnessanywhere.ca](http://trx.fitnessanywhere.ca). The test for this is whether the domain name in question so nearly resembles the mark(s) in appearance, sound or in the ideas suggested by them as to be likely to be mistaken for the mark(s). This test does not require that the Complainant produce evidence of actual confusion as

recently suggested in *AM Ford Sales Ltd. v. Canada One Auto Group*, Decision # 00158, October 25, 2010. The test is whether, on the balance of probabilities, the domain name is "likely" to be mistaken for the mark. To require evidence of actual confusion goes much further than the Policy requires and creates an even more stringent test for confusion than is required in the *Trade-marks Act*.

21. In this case I find that the domain name is likely to be mistaken for each of the Complainant's marks as it incorporates the whole of each registered mark TRX and FITNESS ANYWHERE without any alteration. The fact that the Complainant's marks are combined does not detract from the likelihood that the domain name would be mistaken for either mark and in fact may increase the likelihood of confusion in the mind of anyone who is familiar with the Complainant's wares and services since not one, but two of the Complainant's marks are reproduced.

#### Legitimate Interest

22. Paragraph 3.6 provides six possible ways in which a Registrant may have a legitimate interest in a domain name. The submissions made by the Complainant indicate that the domain name does not lead to any active site.

23. The domain name is therefore not being used as a mark by the Registrant, so paragraph 3.6(a) is not satisfied. Also, the Registrant does not appear to have used the domain name in good faith in association with any wares, services or business. Therefore this Registrant's use does not fall under subparagraphs 3.6(b) or (c). Nor was the Registrant using the domain name in good faith in association with criticism, review or news reporting (paragraph 3.6(d)). Finally, the domain name is not the legal name or other identifier of the Registrant (3.6(e)), nor is it the geographical name of the location of the Registrant's place of business (3.6(f)). Therefore, none of the criteria in section 3.6 have been satisfied and I find that the Complainant has provided some evidence that the Registrant had no legitimate interest in the domain name.

#### Bad Faith

24. The Complainant has to show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.7 deals with the grounds which constitute bad faith. I do not find any evidence that the Registrant's activities support bad faith under subparagraph 3.7(a) as there is no evidence that the Registrant offered to sell the domain name to the Complainant for more than the Registrant's actual costs in registering it.

25. With regard to subparagraph 3.7(b), the registration of this domain name has prevented the Complainant from registering its marks, in combination, as a .ca domain name. But the question is whether the Registrant has engaged in a pattern of registering domain names to prevent rightful owners of marks from registering them as domain names.

26. The Complainant has indicated that it has been the subject of a number of confusingly similar domain name registrations based on its trade-marks and that it has already been successful in a series of disputes determined under the ICANN Uniform Domain Name Dispute Resolution Policy. One of these involved the same registrant as in this dispute, namely Banner Frend (and in this regard I am treating the names Bannerfrend and Banner Frend as one and the same). In the

other dispute, which is listed in Tab K of the Complainant's materials and refers to Case Number FA1006001330918, Banner Friend had registered the domain names trxfitnessanywhere.info and trx-fitnessanywhere.info. The panellist determined that these should be transferred from the registrant to Fitness Anywhere Inc. I find the fact that this Registrant also registered two other domain names practically identical to the domain name at issue currently, and which were found to have utilized the Complainant's trade-marks, demonstrates a pattern of registering domain names in order to prevent persons (in this case the Complainant) who have rights in marks from registering the marks as domain names.

27. I therefore find that the Complainant has demonstrated, on the balance of probabilities, that the Registrant has registered this domain name to prevent the Complainant from registering its marks as a domain name, and that the Registrant has engaged in a pattern of registering domain names for this purpose. I therefore do not need to consider subparagraph 3.7(c).


#### **I. Conclusion and Decision**

28. In conclusion, I find that the Complainant does have rights in the marks TRX and FITNESS ANYWHERE which predate the registration of the domain name. I also find that the domain name is confusingly similar to the Complainant's marks and that the Registrant had no legitimate interest in the domain name. Finally, I find that the Complainant has shown that the Registrant registered the domain name in bad faith.

29. I therefore order, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name trxfitnessanywhere.ca be transferred to the Complainant, Fitness Anywhere Inc.

Dated December 1, 2010

Sharon Groom



Sharon Groom  
December 1, 2010