

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

**Domain Name: ndgraphics.ca**

**Complainant: ND Graphics Inc.**

**Registrant: Robin Edward Boguski**

**Registrar: Go Daddy Domains Canada, Inc.**

**Panelists: David Allsebrook, Sharon Groom, Tim Bourne**

**Service Provider: Resolution Canada**

**DECISION**

**A. The Parties**

1. The Complainant is ND Graphics Inc. It is the owner of the registered trade mark ND GRAPHICS. The wares for which the trade mark is registered include “Graphic art supplies, namely inks, paints, substrates used in the sign and screen painting industry”.
2. The Complainant is represented by the law firm Wilson Vukelich LLP.
3. The Registrant is Robin Edward Boguski, with registered addresses in Leaksdale, Ontario and Toronto, Ontario.
4. No response to the Complaint has been received from the Registrant or anyone acting on his behalf.

**B. The Domain Name and Registrar**

5. The domain name at issue is NDGRAPHICS.CA. The Registrar is Go Daddy Domains Canada, Inc.

**C. Panel Member’s Impartiality and Independence Statement**

6. As required by paragraph 7.2 of the Rules, the undersigned panelists have declared to the Provider that they can act impartially and independently in this matter as there are no circumstances known to them, which would prevent them from so acting.

## **D. Facts**

7. The Complainant ND Graphics Inc. states the following facts.

8. ND Graphics Inc. is a subsisting Ontario company established in 2009. It is a national supplier of equipment and material for the sign and imaging industry. It is the successor to a company called ND Graphic Products Limited. ND Graphic Products Limited registered ND GRAPHICS as a trade mark in Canada in 1991 based upon use since 1983 in respect of the following wares and services:

### **WARES:**

(1) Graphic art supplies, namely inks, paints, substrates used in the sign and screen painting industry; and graphic art equipment, namely printing equipment and computer cutting graphic equipment.

### **SERVICES:**

(1) Operation of a business dealing in graphic art supplies and equipment.

9. ND Graphics' Internet presence is crucial to the operation of its business as customers of ND Graphics may only purchase equipment and material by either placing an order online or by telephone. To establish their Internet presence, ND Graphics and, its predecessor, ND Graphic Products Limited, have utilized the Trade-Mark in the registered domain name, "ndgraphics.com" collectively since 1995.

10. The Registrant, Mr. Robin Edward Boguski operates a business in Toronto, Ontario, known as All Signs Co., which sells custom signs, banners and displays. The Registrant has been a customer of ND Graphics itself and through its predecessor corporation, since 1990.

11. Mr. Boguski registered the domain name ndgraphics.ca in May 2012. The Domain Name redirects the Internet users to www.allsigns.com, a website advertising the wares and services of the Registrant's business All Signs Co.

12. On or about July 6, 2012, the Registrant contacted an ND Graphics sales representative in order to purchase a printer. During the conversation, the Registrant indicated a general dissatisfaction with ND Graphics and invited the sales representative to visit the Domain Name. ND Graphics visited the Domain Name and discovered that the Domain Name was redirecting Internet users to www.allsigns.com.

13. On or about July 11, 2012, ND Graphics wrote to the Registrant Via e-mail

requesting that the Domain Name be transferred to ND Graphics.

14. On or about the same day, the Registrant responded to ND Graphics' request via e-mail stating the following (text is set out as provided by the Complainant):

"I have been and always will be willing to negotiate ....  
I must point out that the URL www.ndgraphics.ca is Personal property and is not owned by ALL signs Co.  
ND Graphics can purchase the URL or Lease it, I could negotiate this transaction.  
I would discuss this only with someone in a position to make a serious financial decision.  
If ND Graphics is not interested the URL will be sold to others interested.  
Buying and selling URL's is common practice.  
There are many other suppliers.  
This is only business, not personal."

#### **E. CIRA Domain Name Dispute Resolution Policy Requirements**

15. In accordance with subparagraph 3.2(f) of the CIRA Domain Name Dispute Resolution Rules (version 1.4) a complainant must indicate the basis upon which it satisfies the Canadian Presence Requirements for Registrants in respect of the Domain Name.

16. ND Graphics satisfies the Canadian Presence Requirements for Registrants given that it is a corporation incorporated under the laws of Ontario, and that it is the owner of a Canadian registration of the trade mark ND GRAPHICS.

17. The Complaint arises under version 1.3 of the CIRA Domain Name Dispute Resolution Policy ("the Policy"), which came into effect on August 22, 2011. The Policy sets out at paragraph 4.1 what the Complainant must establish in order to succeed:

4.1 Onus. To succeed in the 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 3.5;

and the Complainant must provide some evidence that:

c. the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

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 3.4. "

#### **F. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?**

18. The Policy provides:

4.1 To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

d. 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".

19. The trade mark ND Graphics and the domain name ndgraphics.ca are confusingly similar. The domain is dropped for the purpose of ascertaining similarity under the policy. The omission of a space in the domain name does not introduce any distinction between the two otherwise identical marks.

20. The Complainant had rights prior to the date of registration of the domain name. It acquired the trade mark registration in September 2009, a few weeks after its incorporation, and retains it. The domain name was registered by Mr. Boguski in May 2012.

## **G. Was the domain name registered in bad faith?**

21. Article 3.5 of the Policy reads in part:

3.5 Registration in Bad Faith. For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

- a. the Registrant registered the domain name, or acquired the Registration, primarily for the purpose 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. (omitted)
- 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; or
- d. the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

22. The panel finds that the domain name was registered in bad faith. The Registrant did business with ND Graphics before registering ND Graphics' name and trade mark as his own domain name. He knew it was ND Graphics' name.

23. Mr. Boguski brought the domain name to the Complainant's attention. Linking it to his own business suggests mischievous intent. That this intent included a desire to sell the domain

name to the Complaint is affirmed by his email quoted below which states that "I have been and always will be willing to negotiate ...."

24. ND Graphics provided an affidavit of its Toronto Sales Manager, Robert Holness, averring that after it followed up on Mr. Boguski's invitation and asked him to transfer the domain name to it, Mr. Boguski offered to sell the domain name for \$150,000.

25. Mr. Boguski's actions suggest no motive beyond attempting to ransom the ndgraphics.ca domain name to the Complainant, contrary to subsection 3.5(a) of the Policy. Mr. Boguski formed and acted upon his intention to negotiate before ND Graphics was aware of his registration, such that his offer to sell the domain name was not explainable as an attempt to resolve a dispute conceived after the dispute began. He has not offered any explanation to the contrary.

#### **H. Legitimate Interest in the domain name**

26. The Policy provides that:

3.4 Legitimate Interests. For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

(a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

(b) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;

(c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;

(d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;

(e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or

(f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

27. The Complainant has provided evidence that the Registrant has no legitimate interest in the domain name. The Registrant knew of and did business with the Complainant before adopting the domain name. The domain name is identical to the Complainant's name and trade mark. The Complainant is said to have had an unspecified "dissatisfaction" with the Complainant, although nothing more is known about it, including whether the dissatisfaction existed at the time the domain name was registered.

28. The Registrant brought to the Complainant's attention that the domain name was linked to the All Signs Co. web site. We conclude that this was intended to provoke the Complainant into paying the Registrant to relinquish the trade mark rather than any bona fide use of the domain name by the Registrant. The Registrant acknowledges that his conduct is discreditable by assuring the Complainant in his email that "This is only business, not personal".

29. The Registrant has an obligation to respond to the Complaint, which he has not done. In the absence of any explanation from him as to his conduct, the Panel concludes that the Registrant has no legitimate interest in the domain name.

## **I Conclusion**

30. We find that the Complainant has satisfied the three necessary criteria for its Complaint to succeed, namely 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, the domain name was registered in bad faith, and the Registrant has no legitimate interest in the

domain name.

31. The Complainant has requested as its remedy the transfer of the domain name to it. Since the domain name is unique and is the subject of a registered trademark the transfer is appropriate.

32. For the reasons set out above, the Complaint seeking the transfer of the domain name NDGRAPHICS.CA is allowed and the domain name is ordered to be transferred to the Complainant.

Dated October 17, 2012

David Allsebrook



---

Sharon Groom



---

Tim Bourne



---